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BOOK REVIEW

Internet Intermediaries and Trade Mark Rights. Althaf Marsoof. 2019. Pp 249. \$157 (hardback); electronic version available. Routledge, Taylor & Francis Group, 2 Park Square, Milton Park, Abingdon, Oxon OX14 4RN, UK.

Trademark infringement on the Internet is rampant, and Internet intermediaries play a key role in facilitating infringement online. These intermediaries—which include Internet Service Providers (“ISPs”), hosts that provide digital space or store third-party content, and navigation providers—provide essential services to infringers online and may be in the best position to stop infringement.

In *Internet Intermediaries and Trade Mark Rights*, Althaf Marsoof explores the legal and policy underpinnings of Internet intermediary liability for trademark infringement on the Internet. While the focus of the work is English law, the author also includes discussion of related European and international legal principles where appropriate. The author has made a concerted effort to keep the work fresh by including discussion of current legislative and recent case law developments. The book is also very timely, considering that the role of intermediaries is at the very forefront of recent public debate regarding regulation of online conduct. While it by design does not include every single “trademark infringement and intermediary liability” case, it does provide an in-depth discussion of key representative high-profile cases, in turn making it an essential resource for trademark practitioners and others wanting to know more about trademark rights and its interplay with Internet intermediaries. This publication is a worthy addition to the library of any firm that (or individual who) handles trademark disputes.

The primary strength of the book lies in Dr. Marsoof’s selection of a mix of practitioners and legal scholars from around the world to explore the in-depth historical, practical, theoretical, and scenario-based explanations of the operation of Internet intermediaries that should be useful to anyone practicing in the trademark field. Each chapter focuses on two regimes, generally, albeit not exclusively, from the perspective of English law, a select few jurisdictions of the European Union, or United States law. Since the book focuses primarily on reviewing the state of existing precedents and existing research, rather than developing new research, readers should keep in mind that the book’s main contribution in most places is its collection of existing precedents and comparisons of the similarities and differences of the applicable laws in the United Kingdom (“UK”), United States (“U.S.”) and the European Union (“EU”).

The book commences with an overview of Internet intermediaries (ISPs, hosts, and service providers) and defining their roles—shifting focus from online/individual infringers and touching upon the aspect of counterfeiting in the continuing efforts to deal with online infringements exclusively from a trademark point of view. It examines the role of Internet intermediaries and their liability for providing access to, hosting, or indexing content promoting trademark infringement in the backdrop of existing statutory and common-law principles, and the book proposes reforms to remedy the limitations and shortcomings in the existing legal framework. The text is divided into nine chapters canvassing all major issues in reasonable depth with reference to leading case law in the United Kingdom, United States, and a select few continental EU member states with the aim of generating a common ground in establishing Internet intermediary liability for trademark infringement.

In the second chapter, the author analyzes the significance of the “use” requirement under the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS Agreement”), the U.S. Trademark Act (the “Lanham Act”), and the EU Trade Marks Directive to develop key principles in establishing Internet intermediary liability for the unauthorized use of trademarks by third parties. He provides comprehensive coverage of trending issues concerning keyword advertising with a special emphasis on Google’s AdWords (now Google Ads) and the applicability of the “commercial communication” requirement. Dr. Marsoof discusses the intermediary’s active role and commercial involvement with underlying transactions, part of which is concerned with the intermediary’s own offerings as opposed to merely providing access to, hosting, or indexing content to infringers (a concept introduced by the Court of Justice of the European Union in *Google v. Louis Vuitton*). Ample authority for each proposition is provided by way of footnotes.

In the third chapter, Dr. Marsoof sheds light upon common law principles, comparing Section 10(5) of the Trade Marks Act, 1994 and Section 32 of the Lanham Act, in turn discussing various approaches concerning “accessory liability” to assess its potential application to the context of trademark law and Internet intermediaries fixing the liability of joint tortfeasors. He then analyzes the scope of accessory liability in common law as well as criminal accessory liability along with its limitations and, finally, as a species of tort. Finally, after discussing the propositions made by legal scholars such as Joachim Dietrich and Paul S. Davies in establishing a “common design requirement” expressly rejecting the views of the judiciary and arguing in favor of the recognition of liability for assisting civil wrongs, the author predicts how legislative reforms will attempt to address such issues in the future.

Chapter 4 explores various approaches that have been developed and adopted concerning key EU Directives by domestic courts and in some of the EU Member states—France, Germany, and Belgium, as well as in the United States, especially in the context of contributory infringement established in *Inwood v. Ives* along with a select few more decisions with similar fact patterns. Taking its cue from the progressive approaches adopted in the United States and the three Continental EU Member States, the author proposes developing a legislative response to address the shortcomings in current UK law.

Chapter 5 addresses the nature and scope of a proposal for law reforms and suggests an amendment to the United Kingdom's Trade Marks Act 1994 underlining the need for broadening the scope of liability for trademark infringement with respect to three classes of intermediaries. This includes a draft provision that intersects with EU law that aims to establish a mechanism for the aggrieved trademark proprietors' right to claim damages with monetary relief.

Chapter 6 is devoted to notice and takedown procedures and how they operate in the trademark context. The author has, however, opted to present a generalized view on the subject. The discussion also includes copyright issues concerning the Digital Millennium Copyright Act safe harbor provisions, including academic commentaries and empirical studies to counterbalance the abuse of takedown procedures.

In the seventh chapter, the author identifies four categories of notices of infringement—"clear-cut cases," "context-specific cases," "trade mark bullying," and "frivolous assertions," and discusses the interplay between third-party use and free speech rights proposing effective safeguards to ensure a fair-and-balanced approach to this practice. The distinction asserted through the categories of notices can be extremely helpful to those using this as a reference when tackling trademark disputes involving Internet intermediaries.

Chapter 8 touches upon the legal basis for injunctive relief against intermediaries, which highlights trademark as well as copyright issues. The discussion is infused with trenchant dissections of key cases with contributions from notable judges discussing the "actual knowledge" requirement and the development of injunctive remedies against ISPs for copyright and trademark infringements online.

In the final chapter, the author considers ways to improve the efficacy, balance, and fairness of the injunctive remedy in a more tiered and structured approach that complies with the principles of natural justice. He envisages layers of safeguards against abuse, specifically in relation to injunctions against navigation providers and hosts. He also proposes the adoption of a versatile framework that allows the enforcement of judgments—just like the Hague Convention on Foreign Judgments in Civil and Commercial Matters

1971 in addressing the needs of right holders specifically for the intellectual property context.

Internet Intermediaries and Trade Mark Rights is a practical and extensive guide to this area of the law and should be considered a must-read for anyone practicing in the trademark field. The book provides a blueprint for understanding how best to craft an enforcement strategy against intermediaries and protect trademarks from online infringers when formulating strategic advice for clients. With the aid of Dr. Marsoof's work, the reader can have a decidedly improved understanding of the options available concerning trademark law and its interplay with intermediary liability especially in relation to UK, U.S., and EU law. The author has managed to make this book a truly comprehensible and uncomplicated exposition of the law in plain English and with enlightened commentary scattered throughout. The relatively short discussions, theories, and scenarios arranged by numerous headings and subheadings in every chapter and supplemented by numerous footnotes help to keep the reader's attention throughout. The author has done an admirable and impressive job of assembling guidance and opinion from legal scholars and academicians from around the world in one accessible reference book. However, one of the most helpful aspects of the book is that it discusses key issues and important questions in a way that allows thoughtful readers to draw their own conclusions. In summary, this book is a highly valuable, if not indispensable, resource for practitioners of all levels of experience who are confronted with aspects of trademark law and its inextricable role with Internet intermediaries in modern day practice.

Yashvardhan Rana
