

# Online infringement – a private affair

In Israel, debate focuses on online trademark infringement versus the infringer's right to privacy

As the Internet becomes increasingly popular, online trademark infringement is becoming more common. As a result, traditional trademark protection methods have had to be adapted in order to take the unique characteristics of the online environment into consideration.

The challenges which trademark owners must confront when facing online infringements are complex, and extend beyond purely legal problems. This article focuses on the practical and technological difficulties which confront trademark owners whose trademarks have been infringed online. These difficulties start with identifying and locating the infringer, since internet users enjoy a great degree of anonymity. This anonymity is a serious problem, given that the delivery of relevant legal documentation is the essential first step in initiating legal action: sending such documents by email is still not considered to constitute legal delivery in many jurisdictions, including Israel.

Trademark owners whose trademarks have been infringed online and which wish to locate an anonymous infringer can usually ascertain either the email address of the infringer (if known – for example, where a civil wrong has been committed from the email address) or the internet service provider (where the Internet Protocol (IP) address of the computer used for the infringement is known).

Email account suppliers and internet service providers are considered third parties in infringement disputes, being extraneous to disputes between the rights owner and the infringer. Obtaining legal remedies in the form of orders for disclosure of information from a third party is not simple, especially in the absence of explicit legislative arrangements in this respect. Furthermore, in many cases the

information that can be accessed by third parties is neither full nor accurate, especially with regard to the identity and personal details of the email account owner, which is based on information provided by the account owner when the account was created. Operators or service providers are not required to check that such information is accurate, and individuals who plan to perform illegal activities using an account are unlikely to provide accurate details of their identity or whereabouts.

The Internet is a relatively new legal arena, and technology can develop far more quickly than the corresponding legislation on online infringement can be amended. As a result, the courts are often forced to find solutions and make creative rulings in order to supply some measure of legal relief to injured parties.

## **Rami Mor v Barak**

In late 2009 the Israeli Supreme Court ruled on an appeal against a District Court ruling (*Rami Mor v Barak*, Civil Appeal Permission 4447/07). Rami Mor claimed that he had been slandered online and petitioned the courts to order the relevant internet service provider to help him to identify and locate the culprit. The Supreme Court decision established a fundamental rule – the Mor rule – regarding the disclosure of the details of anonymous internet users.

The court addressed the question of whether the courts have the authority to order a third party to help in revealing the identity and details of anonymous internet users. Thus, the court was called upon to find the right balance between the disadvantages associated with the potential misuse of online anonymity and the advantages of such anonymity with regard to freedom of speech and the protection of privacy rights. The court also had to include

in its considerations the plaintiff's right to his good name, which is protected in a special statute.

The court ruled in favour of the anonymous internet user's right to free speech and rejected the plaintiff's motion to have the user's identity revealed. In doing so, the court placed a defensive wall to prevent third parties – including the entities behind website operators and email account owners – from being ordered to reveal the identity and details of anonymous internet users. Nevertheless, the court clarified that there was nothing general in its ruling which closed the door on parties wishing to reveal the identity of individuals who have caused a civil wrong over the Internet. Furthermore, the court emphasised that if a civil wrong also constitutes a crime, the injured party has the option of filing a complaint with the police. As an enforcement authority, the police service must act according to the investigative powers vested in it by law.

Thus, the court chose not to provide remedies which were investigative in nature. It preferred to leave the provision of suitable remedies in the hands of the appropriate law enforcement authorities, given that no appropriate provision exists in Israeli law regarding the issuance of court orders to reveal the identity of anonymous internet users. The court felt that it could not invent such a provision through so-called 'judicial legislation' and assumed that, sooner or later, legislation to settle this issue would be passed, creating a suitable framework for discussion.

In 2008 an electronic commerce bill was submitted to the Knesset (the Israeli Parliament). Among other things, it provided legislative arrangements to authorise the courts to order internet service providers that supply access or

services to infringers to provide an injured rights owner with the details required to identify an infringer. Until the bill is adopted, it has no legal validity, but it is reasonable to assume that the courts will not completely disregard the approach that it outlines.

### **Google Israel Ltd v Brokertov Ltd**

Despite the fact that the Mor rule was established in a case relating to a civil wrong, until recently the rule was also considered to be a barrier against revealing the details of internet users in trademark cases relating to online infringement. However, in July 2010 the Israeli Supreme Court changed its position (*Google Israel Ltd v Brokertov Ltd*, Civil Appeal 1622/09).

The case was an appeal by Google Israel against a District Court ruling that had ordered the company to reveal the details of an anonymous internet user who, according to a trademark owner, was responsible for a website which had a domain name that infringed the trademark. The trademark owner had partial information regarding the alleged infringer. This information included the email and IP addresses of the website, but was insufficient to allow for legal action against the parties responsible for the website. The trademark owner asked the court to order Google to reveal additional details of the website owner, based on the partial details that were already known.

The court ruled in favour of the plaintiff and ordered Google to reveal the IP address. Google appealed on the basis of the Mor rule. The Supreme Court ruled that trademark infringements cannot be protected based on the principle of the freedom of speech, and that therefore there was no barrier to revealing the identity of the anonymous online trademark infringer.

Despite this finding, the court ultimately accepted the appeal and struck out the District Court's decision for technical reasons. According to the Supreme Court, the plaintiff should have taken action against Google USA, rather than Google Israel. Furthermore, the court expressed doubts over the effectiveness of the requested legal remedy, since the practical and technical difficulties of the case rendered the dispute purely academic. Despite the fact that the plaintiff eventually located the party behind the infringing website, he did not succeed in having the website taken down.

The Supreme Court also remarked that it lacked not only the legal instruments with which to enforce the revelation of anonymous infringers, but also the



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practical-technological instruments. The court voiced the hope that this situation would be resolved in the near future.

In its verdict the court referred to the selection of the third-party defendant, and considered that the filing of the law suit against Google Israel, rather than Google USA, to be inappropriate. It also indicated that the legal remedy granted by the District Court was problematic, in that Google was ordered to reveal information which was available only to the relevant internet service provider, since Google possessed information about email accounts only. This outlines the extent to which the courts are unfamiliar with the many technical nuances relating to issues of online anonymity.

### **Comment**

The *Google* decision established a rule whereby the principle of freedom of speech on the Internet constitutes no defence against a trademark infringement claim. In certain circumstances, the courts may order the revelation of an online user's identity, even if such an order adversely affects a infringer's right to privacy or freedom of speech.

Thus, trademark owners whose rights have been infringed over the Internet retain the possibility of taking legal action against third parties in order to obtain details of the infringer's identity and location. However, precision is required to ensure that the suit is filed against what the courts will view as the correct third party, and in defining the legal remedy requested. [WTR](#)