<table>
<thead>
<tr>
<th>Title</th>
<th>Google AdWords and Trademark Rights: the European and Hong Kong Approaches</th>
</tr>
</thead>
<tbody>
<tr>
<td>Author(s)</td>
<td>Lee, ASC; Gillet, E</td>
</tr>
<tr>
<td>Citation</td>
<td>iP Hong Kong-European Union Series 2013, Hong Kong, China, 7 November 2013</td>
</tr>
<tr>
<td>Issued Date</td>
<td>2013</td>
</tr>
<tr>
<td>URL</td>
<td><a href="http://hdl.handle.net/10722/206373">http://hdl.handle.net/10722/206373</a></td>
</tr>
<tr>
<td>Rights</td>
<td>This work is licensed under a Creative Commons Attribution-NonCommercial-NoDerivatives 4.0 International License.</td>
</tr>
</tbody>
</table>
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Google AdWords and Trademark Rights
the European and Hong Kong Approaches

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The University of Hong Kong
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Dr. Emmanuel GILLET
Visiting Scholar, European Union
Academic Programme (EUAP)
Hong Kong
mail@egillet.com

Hong Kong Baptist University
7th November 2013
Introduction
### Internet Statistics for 2012

<table>
<thead>
<tr>
<th>Category</th>
<th>Data</th>
</tr>
</thead>
<tbody>
<tr>
<td>Internet users worldwide</td>
<td>2.4 billion (1/3 of the world population)</td>
</tr>
<tr>
<td>Webpages</td>
<td>46 billion</td>
</tr>
<tr>
<td>Searches on Google</td>
<td>1.2 trillion</td>
</tr>
</tbody>
</table>
AdWords: How does it work?

Scenario #1
AdWords: How does it work?

Source: Google
AdWords: How does it work?

Locations
- Which locations do you want to target (or exclude) in your campaign?
  - All countries and territories
  - Hong Kong
  - [Enter a location to target or exclude.]
  - Advanced search

Languages
- English

Bid strategy
- Basic options | Advanced options
  - I'll manually set my bids for clicks
  - AdWords will set my bids to help maximize clicks within my target budget

Budget
- HK$ 100 per day
  - Actual daily spend may vary.
AdWords: How does it work?

Create an ad:

To get started, write your first ad below. Remember, you can always create more ads later. **Learn how to write a great text ad**

<table>
<thead>
<tr>
<th>Headline</th>
<th>Best watches Hong Kong</th>
</tr>
</thead>
<tbody>
<tr>
<td>Description line 1</td>
<td>Luxury watches free delivery</td>
</tr>
<tr>
<td>Description line 2</td>
<td>Save 50% Now!</td>
</tr>
<tr>
<td>Display URL</td>
<td><a href="http://www.bestwatcheshongkong.hk">www.bestwatcheshongkong.hk</a></td>
</tr>
<tr>
<td>Destination URL</td>
<td><a href="http://www.bestwatcheshongkong.hk">http://www.bestwatcheshongkong.hk</a></td>
</tr>
</tbody>
</table>

**Ad preview:** The following ad previews may be formatted slightly differently from what is shown to users. **Learn more**

**Side ad:**

Best watches Hong Kong
www.bestwatcheshongkong.hk
Luxury watches free delivery
Save 50% Now!

**Top ad:**

Best watches Hong Kong
www.bestwatcheshongkong.hk
Luxury watches free delivery
Save 50% Now!

**Ad extensions** expand your ad with additional information like a business address or product images. **Take a tour**
AdWords: How does it work?

Keywords

Select keywords
Your ad can show on Google when people search for the keywords you choose here. These keywords also determine which managed placements are good matches for your ads.

Tips
- Start with 10-20 keywords.
- Be specific: avoid one-word keywords. Choose phrases that customers would use to search for your products and services.
- By default, keywords are broad matched to searches to help you capture a wider range of relevant traffic.
  Use match types to control this.
- Learn more about choosing effective keywords.

Enter one keyword per line.

No sample keywords available.

watches in hong kong
luxury watches in hong kong
luxury watches shops in hong kong
cheap luxury watches in hong kong
AdWords: How does it work?

Scenario #2
**AdWords: How does it work?**

Create an ad

To get started, write your first ad below. Remember, you can always create more ads later. Learn how to write a great text ad.

<table>
<thead>
<tr>
<th><strong>Headline</strong></th>
<th>Cartier Watches Hong Kong</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Description line 1</strong></td>
<td>Best Cartier Watches Cheap Price</td>
</tr>
<tr>
<td><strong>Description line 2</strong></td>
<td>Save 40% on your Cartier Watch</td>
</tr>
<tr>
<td><strong>Display URL</strong></td>
<td><a href="http://www.luxurywatches.hk">www.luxurywatches.hk</a></td>
</tr>
<tr>
<td><strong>Destination URL</strong></td>
<td><a href="http://www.luxurywatches.hk">http://www.luxurywatches.hk</a></td>
</tr>
</tbody>
</table>

**Ad preview:** The following ad previews may be formatted slightly differently from what is shown to users. Learn more

**Side ad**

- Cartier Watches Hong Kong
- www.luxurywatches.hk
- Best Cartier Watches Cheap Price
- Save 40% on your Cartier Watch

**Top ad**

- Cartier Watches Hong Kong
- www.luxurywatches.hk
- Best Cartier Watches Cheap Price
- Save 40% on your Cartier Watch

**Ad extensions** expand your ad with additional information like a business address or product images.

- Take a tour
Keywords

Select keywords
Your ad can show on Google when people search for the keywords you choose here. These keywords also determine which managed placements are good matches for your ads.

Tips
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- By default, keywords are broad matched to searches to help you capture a wider range of relevant traffic. Use match types to control this.
- Learn more about choosing effective keywords.

Enter one keyword per line.

Watches Cartier in Hong Kong
Cheap Cartier in Hong Kong
AdWords: How does it work?
AdWords: How does it work?
Potential legal issues
1. History and scale of judicial cases

2. Legal issue for advertisers
   - Infringement of trademarks rights

3. Legal issues for Google
   - Infringement of trademarks rights
   - Liability as an Internet service provider

4. Cooperation
1

History and scale of judicial cases
1. History and scale of judicial cases

<table>
<thead>
<tr>
<th>First cases (in France)</th>
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<tr>
<td>Nanterre court of first instance, 13 October 2003, <em>Ste Viaticum v. Google</em></td>
</tr>
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</table>
1. History and scale of judicial cases: Epidemic development

Source: Darts-IP
1. History and scale of judicial cases

### Most recent decisions

<table>
<thead>
<tr>
<th>Decision</th>
<th>Country</th>
</tr>
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<tbody>
<tr>
<td>Kammergericht, <em>Coty Germany v. Panther Holding</em>, 15 October 2013</td>
<td>Germany</td>
</tr>
<tr>
<td><em>Allied Interstate LLC v. Kimmel &amp; Silverman P.C.</em>, 2013 WL 4245987 (SDNY August 12, 2013)</td>
<td>USA</td>
</tr>
<tr>
<td>Paris court of first instance, 12 July 2013, <em>Rent a car v. Traveljigsaw</em></td>
<td>France</td>
</tr>
</tbody>
</table>

Source: Darts-IP
2

Legal issue for advertisers

Infringement of trademarks rights
European Union
EU Preliminary ruling procedure

Article 267 of the Treaty on the functioning of the European Union
EU Preliminary ruling procedure

Article 267 of the Treaty on the functioning of the European Union
France
AdWords: Legal Issues

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2. Legal issue for advertisers: infringement of trademarks rights


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<td>Advertiser: yes</td>
<td>yes</td>
</tr>
<tr>
<td>Google: yes</td>
<td>yes</td>
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</table>
2. Legal issue for advertisers: infringement of trademarks rights

Cour de cassation, 20 May 2008 (3 decisions)
Ste Viatricum c. Google
Louis Vuitton Malletier v. Google
CNNRH v. Google

Preliminary ruling / Question #1

Does the reservation by an economic operator, by means of an agreement on paid internet referencing, of a keyword triggering, in the case of a request using that word, the display of a link proposing connection to a site operated by that operator in order to offer for sale goods or services, and which reproduces or imitates a trade mark registered by a third party in order to designate identical or similar goods, without the authorisation of the proprietor of that trade mark, constitute in itself an infringement of the exclusive right guaranteed to the latter by Article 5 of the Directive 89/104?
2. Legal issue for advertisers: infringement of trademarks rights

Article 5 (Rights conferred by a trade mark)

1. The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:
   (a) any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered;
   (b) any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association between the sign and the trade mark.

2. Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

(...)
EU Preliminary ruling procedure

Article 267 of the Treaty on the functioning of the European Union
2. Legal issue for advertisers: infringement of trademarks rights

CJEU, Google v. Louis Vuitton Malletier, Viaticum and CNRRH (23 March 2010)
Joined Cases C-236/08 to C-238/08

The functions of trademarks
- **essential function**: indicating the origin of the trademark
- guaranteeing the quality of the goods or services
- communication function
- investment function
- advertising function
2. Legal issue for advertisers: infringement of trademarks rights

CJEU, Google v. Louis Vuitton Malletier, Viaticum and CNRRH (23 March 2010) 
Joined Cases C-236/08 to C-238/08

Essential function: indicating the origin of the mark

Para. 84: “The function of indicating the origin of the mark is adversely affected if the ad does not enable normally informed and reasonably attentive internet users, or enables them only with difficulty, to ascertain whether the goods or services referred to by the ad originate from the proprietor of the trade mark or an undertaking economically connected to it or, on the contrary, originate from a third party”.
2. Legal issue for advertisers: infringement of trademarks rights

CJEU, Google v. Louis Vuitton Malletier, Viaticum and CNRRH (23 March 2010)  
Joined Cases C-236/08 to C-238/08

Ruling

“[T]he proprietor of a trade mark is entitled to prohibit an advertiser from advertising (...) in the case where that advertisement does not enable an average internet user, or enables that user only with difficulty, to ascertain whether the goods or services referred to therein originate from the proprietor of the trade mark or an undertaking economically connected to it or, on the contrary, originate from a third party.”
EU Preliminary ruling procedure

Article 267 of the Treaty on the functioning of the European Union
2. Legal issue for advertisers: infringement of trademarks rights

Cour de cassation, 13 July 2010, **CNNRH v. Google**

The advertiser is liable for trademark infringement

Reason: ads affected the essential function of the trademark
The Netherlands
2. Legal issue for advertisers: infringement of trademarks rights

Hoge Raad der Nederlanden, 12 December 2008, Portakabin v. Primacabin

Preliminary ruling / Question

whether Article 5(1) of Directive 89/104 must be interpreted as meaning that a trade mark proprietor is entitled to prohibit a third party from displaying – on the basis of a keyword which is identical to that mark, and which that third party has chosen for an internet referencing service without the proprietor’s consent – an ad for goods or services identical with, or similar to, those in respect of which that mark was registered.
EU Preliminary ruling procedure

Article 267 of the Treaty on the functioning of the European Union
2. Legal issue for advertisers: infringement of trademarks rights

CJEU, Portakabin v. Primakabin (8 July 2010) C-558/08

Ruling #1

“[A] trade mark proprietor is entitled to prohibit an advertiser from advertising (...) where that advertising does not enable average internet users, or enables them only with difficulty, to ascertain whether the goods or services referred to by the ad originate from the proprietor of the trade mark or from an undertaking economically linked to it or, on the contrary, originate from a third party”.
2. Legal issue for advertisers: infringement of trademarks rights

Article 7(1) of the directive 89/104

Exhaustion of the rights conferred by a trade mark

The trade mark shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the Community under that trade mark by the proprietor or with his consent.
2. Legal issue for advertisers: infringement of trademarks rights

CJEU, Portakabin v. Primakabin (8 July 2010) C-558/08

Ruling #2

"[A] trade mark proprietor is not entitled to prohibit an advertiser from advertising (...) the resale of goods manufactured and placed on the market in the European Economic Area by that proprietor or with his consent, unless there is a legitimate reason (...) which justifies him opposing that advertising, such as use of that sign which gives the impression that the reseller and the trade mark proprietor are economically linked or use which is seriously detrimental to the reputation of the mark."
United Kingdom
2. Legal issue for advertisers: infringement of trademarks rights

High Court (Chancery division), 29 April 2010, *Interflora v. Marks & Spencer*

Several Questions…
EU Preliminary ruling procedure

Article 267 of the Treaty on the functioning of the European Union
2. Legal issue for advertisers: infringement of trademarks rights

CJEU, Interflora v. Marks & Spencer (22 September 2011) C-323/09

Ruling #1

“[T]he proprietor of a trade mark is entitled to prevent a competitor from advertising goods or services identical with those for which that mark is registered, where that use is liable to have an adverse effect on one of the functions of the trade mark”.

2. Legal issue for advertisers: infringement of trademarks rights

Article 5(2) (well-known trademarks)

Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.
2. Legal issue for advertisers: infringement of trademarks rights

CJEU, Interflora v. Marks & Spencer (22 September 2011)
C-323/09

Ruling #2

“[T]he proprietor of a trade mark with a reputation is entitled to prevent a competitor from advertising (…) where the competitor thereby takes unfair advantage of the distinctive character or repute of the trade mark (free-riding) or where the advertising is detrimental to that distinctive character (dilution) or to that repute (tarnishment).

Advertising on the basis of such a keyword is detrimental to the distinctive character of a trade mark with a reputation (dilution) if, for example, it contributes to turning that trade mark into a generic term”.
2. Legal issue for advertisers: infringement of trademarks rights

CJEU, *Interflora v. Marks & Spencer* (22 September 2011) C-323/09

BUT

Ruling #3

“[T]he proprietor of a trade mark with a reputation is not entitled to prevent, *inter alia*, advertisements displayed by on the basis of keywords corresponding to that trade mark, which put forward – without offering a mere imitation of the goods or services of the proprietor of that trade mark, without causing dilution or tarnishment and without, moreover, adversely affecting the functions of the trade mark with a reputation – an alternative to the goods or services of the proprietor of that mark”.

competitors
2. Legal issue for advertisers: infringement of trademarks rights

CJEU, *Interflora v. Marks & Spencer* (22 September 2011)
C-323/09

Ruling #3 (explanation 1)

Para. 81. “Thus, when the use, as a keyword, of a sign corresponding to a trade mark with a reputation triggers the display of an advertisement which enables the reasonably well-informed and reasonably observant internet user to tell that the goods or services offered originate not from the proprietor of the trade mark but, on the contrary, from a competitor of that proprietor, the conclusion will have to be that the trade mark’s distinctiveness has not been reduced by that use, the latter having merely served to draw the internet user’s attention to the existence of an alternative product or service to that of the proprietor of the trade mark”.
2. Legal issue for advertisers: infringement of trademarks rights

CJEU, *Interflora v. Marks & Spencer* (22 September 2011) C-323/09

Ruling #3 (explanation 2)

**DIRECTIVE 2006/114/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL**

of 12 December 2006

concerning misleading and comparative advertising
EU Preliminary ruling procedure

Article 267 of the Treaty on the functioning of the European Union
2. Legal issue for advertisers: infringement of trademarks rights

High Court (Chancery division), 21 May 2013, *Interflora v. Marks & Spencer*

Para. 318. “Taking into account the factors mentioned by the CJEU, the factors relied upon by Interflora and the factors relied upon by M & S, the conclusion I have reached is that (...) the M & S advertisements which are the subject of Interflora’s claim did not enable reasonably well-informed and reasonably attentive internet users, or enabled them only with difficulty, to ascertain whether the service referred to in the advertisements originated from the proprietor of the Trade Marks, or an undertaking economically connected with it, or originated from a third party”.
**Ordinary Trademarks**

"**Trademarks owners are entitled** to prevent a competitor from advertising – on the basis of a keyword which is identical with the trade mark and which has been selected in an internet referencing service by the competitor without the proprietor’s consent – goods or services identical with those for which that mark is registered, where that use is liable to have an adverse effect on one of the functions of the trade mark”.

**Trademarks owners are not entitled** to prohibit an advertiser from advertising the resale of goods manufactured and placed on the market in the European Economic Area by that proprietor or with his consent, unless there is a legitimate reason, which justifies him opposing that advertising, such as use of that sign which gives the impression that the reseller and the trade mark proprietor are economically linked or use which is seriously detrimental to the reputation of the mark.

**Well-known Trademarks**

**Owners of well-known trademark are** entitled to prevent a competitor from advertising on the basis of a keyword corresponding to that trade mark, which the competitor has, without the proprietor’s consent, selected in an internet referencing service, where the competitor thereby takes unfair advantage of the distinctive character or repute of the trade mark (free-riding) or where the advertising is detrimental to that distinctive character (dilution) or to that repute (tarnishment).

**Owners of well-known trademark are not** entitled to prevent advertisements displayed by competitors on the basis of keywords corresponding to that trade mark, which put forward an alternative to the goods or services of the proprietor of that mark".
Hong Kong
2. Legal issue for advertisers: infringement of trademarks rights

- No local decisions yet
- Legislation similar to UK / EU
- Trade Marks Ordinance (TMO)

2. Legal issue for advertisers: infringement of trademarks rights

SECTION 18(1) Trade Mark Ordinance

A person infringes a registered trade mark if he uses in the course of trade or business a sign which is **identical** to the trade **mark** in relation to **goods** or services which are **identical** to those for which it is registered.

► identical mark  ► identical goods
2. Legal issue for advertisers: infringement of trademarks rights

SECTION 18(2) Trade Mark Ordinance

A person infringes a registered trade mark if:

(a) he uses in the course of trade or business a sign which is identical to the trade mark in relation to goods or services which are similar

(b) the use of the sign in relation to those goods or services is likely to cause confusion on the part of the public.

► identical mark  ► similar goods  ► likely to cause confusion
2. Legal issue for advertisers: infringement of trademarks rights

SECTION 18(3) Trade Mark Ordinance

A person infringes a registered trade mark if:

(a) he uses in the course of trade or business a sign which is similar to the trade mark in relation to goods or services identical or similar

(b) the use of the sign in relation to those goods or services is likely to cause confusion on the part of the public.

- similar mark
- similar goods
- likely to cause confusion
2. Legal issue for advertisers: infringement of trademarks rights

SECTION 18(4) Trade Mark Ordinance

A person infringes a registered trade mark if:

(a) he uses in the course of trade or business a sign which is identical or similar to the trade mark in relation to goods or services which are NOT identical or similar

(b) the trade mark is entitled to protection under the Paris Convention as a well-known trade mark

(c) the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark
2. Legal issue for advertisers: infringement of trademarks rights

Well-Known Trademarks

LVMH
MOËT HENNESSY LOUIS VUITTON

CHANEL

VISA

GUCCI
2. Legal issue for advertisers: infringement of trademarks rights

CA Sheimer TM Application [2000] RPC 484

**VISA**

**condom**

**identical or similar mark**

**goods** NOT **identical or similar**

takes **unfair advantage** of, or is **detrimental** to, the distinctive character or repute of the trade mark

►►► NOT CONCERNED whether confusion
2. Legal issue for advertisers: infringement of trademarks rights

CJEU, Davidoff v Gofkid (Hong Kong company) (9 January 2003) C-292/00


(2) Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are NOT similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.
2. Legal issue for advertisers: infringement of trademarks rights

SECTION 18(4) Trade Mark Ordinance

A person infringes a registered trade mark if:

(a) he uses in the course of trade or business a sign which is **identical or similar** to the trade **mark** in relation to **goods** or services which are **NOT** **identical or similar**
2. Legal issue for advertisers: infringement of trademarks rights

_Christie’s v Chritrs [2012] 5 HKLRD 829 CFI_

Para 51. Although the wording suggests that the application of the sub-section is confined to the use of the similar mark on goods or services “not identical or similar” to those for which the well-known mark is registered, it has been authoritatively decided that it ought to be read to apply to the use by the defendant on goods and services “whether or not similar or identical”
3
Legal issues for Google
3.1. Infringement of trademarks rights by Google
European Union
3. Legal issues for Google: infringement of trademarks rights by Google?

Nanterre Court of First Instance, 13 October 2003, Ste Viaticum c. Google

<table>
<thead>
<tr>
<th>Parties</th>
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<tr>
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<td>X</td>
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3. Legal issues for Google: infringement of trademarks rights by Google?

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Cour de cassation, 20 May 2008 (3 decisions)
Ste Viatricum c. Google
Louis Vuitton Malletier v. Google
CNNRH v. Google

Preliminary ruling/Question #2

Must Article 5(1)(a) and (b) of [Directive 89/104] be interpreted as meaning that a provider of a paid referencing service who makes available to advertisers keywords reproducing or imitating registered trade marks and arranges by the referencing agreement to create and favourably display, on the basis of those keywords, advertising links to sites offering goods identical or similar to those covered by the trade mark registration is using those trade marks in a manner which their proprietor is entitled to prevent?
EU Preliminary ruling procedure

Article 267 of the Treaty on the functioning of the European Union
3. Legal issues for Google: infringement of trademarks rights by Google?

CJUE, Google v. Louis Vuitton Malletier, Viaticum and CNRRH (23 March 2010)
Joined Cases C-236/08 to C-238/08

Ruling

An internet referencing service provider which stores, as a keyword, a sign identical with a trade mark and organises the display of advertisements on the basis of that keyword does not use that sign within the meaning of Article 5(1) and (2) of Directive 89/104 or of Article 9(1) of Regulation No 40/94.
EU Preliminary ruling procedure

Article 267 of the Treaty on the functioning of the European Union
3. Legal issues for Google: infringement of trademarks rights by Google?

- Cour de cassation, 13 July 2010, CNNRH v. Google
- Cour de cassation, 13 July 2010, GIFAM v. Google
- Cour de cassation, 13 July 2010, Viaticum v. Google
- Cour de cassation, 13 July 2010, Louis Vuitton Malletier v. Google

Google is not liable for trademark infringement
3. Legal issues for Google: infringement of trademarks rights by Google?

Since then...

French courts never considered Google liable for trademark infringement

(among dozens of decisions)
3.2. Liability of Google as an Internet service provider (ISP)
European Union
3. Legal issues for Google: liable as an Internet service provider (ISP)?

Cour de cassation, 20 May 2008 (3 decisions)

Ste Viatricum c. Google
Louis Vuitton Malletier v. Google
CNNRH v. Google

Preliminary ruling/Question #3

May the provider of the paid referencing service be regarded as providing an information society service consisting of the storage of information provided by the recipient of the service, within the meaning of Article 14 of [Directive 2000/31], so that that provider cannot incur liability before it has been informed by the trade mark proprietor of the unlawful use of the sign by the advertiser?’
3. Legal issues for Google: liable as an Internet service provider (ISP)?

Article 14 of the Directive 2000/31/EC on electronic commerce

Hosting

1. Where an information society service is provided that consists of the storage of information provided by a recipient of the service, Member States shall ensure that the service provider is not liable for the information stored at the request of a recipient of the service, on condition that:

(a) the provider does not have actual knowledge of illegal activity or information and, as regards claims for damages, is not aware of facts or circumstances from which the illegal activity or information is apparent; or

(b) the provider, upon obtaining such knowledge or awareness, acts expeditiously to remove or to disable access to the information.

(…)
EU Preliminary ruling procedure

Article 267 of the Treaty on the functioning of the European Union

National supreme court
Appeal
First instance
3. Legal issues for Google: liable as an Internet service provider (ISP)?

Ruling #3

“Article 14 of Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market (‘Directive on electronic commerce’) must be interpreted as meaning that the rule laid down therein applies to an internet referencing service provider in the case where that service provider has not played an active role of such a kind as to give it knowledge of, or control over, the data stored. If it has not played such a role, that service provider cannot be held liable for the data which it has stored at the request of an advertiser, unless, having obtained knowledge of the unlawful nature of those data or of that advertiser’s activities, it failed to act expeditiously to remove or to disable access to the data concerned.”
3. Legal issues for Google: liable as an Internet service provider (ISP)?

CJEU, Google v. Louis Vuitton Malletier, Viaticum and CNRRH (23 March 2010) Joined Cases C-236/08 to C-238/08

Principle:
- the ISP cannot be held liable

Exceptions:
- The ISP can be held liable if:
  - It has played an active role on the creation, choice… of the data (here, keywords and description of the advertisement)
  - Having knowledge of the unlawful nature of the data, it failed to act expeditiously to remove or to disable the data
EU Preliminary ruling procedure

Article 267 of the Treaty on the functioning of the European Union
3. Legal issues for Google: liable as an Internet service provider (ISP)?

Cour de cassation, 13 July 2010, CNNRH v. Google
Cour de cassation, 13 July 2010, GIFAM v. Google
Cour de cassation, 13 July 2010, Viaticum v. Google
Cour de cassation, 13 July 2010, Louis Vuitton Malletier v. Google

Google is not liable
3. Legal issues for Google: infringement of trademarks rights by Google?

Since then…

French courts never considered Google liable as an Internet service provider

(among dozens of decisions)
Hong Kong
3. Legal issues for Google: liable as an Internet service provider (ISP)?

*Oriental Press v Fevaworks (Golden Forum)*
FACV 15/2012 (CFI Judgment 4 July 2013)

CFA held that the respondents had established defence of “innocent dissemination” in relation to the defamatory statements.

They did not know the content of each posting;

- did not authorize publication;
- did not exercise editorial or general control over the publication process; and
- so did not realistically have the ability or opportunity to prevent publication.

After they came to know of the defamatory postings, they acted with reasonable care since they promptly removed them.
4. Cooperation
AdWords: Legal Issues
Trademarks - Country requirements

Over the last several years, we have been working to streamline our AdWords trademark policies. In 2009, we updated these policies in more than 100 countries, and we made similar changes across Europe in 2010. In all these countries, the policies have provided more choice for users, and helped businesses of all sizes manage their campaigns more easily, enabling them to connect with more customers.

Starting soon, AdWords advertisers in seven additional countries will have more choice when selecting keywords for their AdWords campaigns. We will be making these countries' policies consistent with our global policies: Australia, Brazil, China, Hong Kong, Macau, New Zealand, South Korea, and Taiwan. This policy change will go into effect on April 23, 2013.

Our trademark policy is being updated to reflect greater alignment with the global policy. This is similar to the way a shopper benefits when they see a variety of brands' products on a store shelf. Even if they are looking for a particular brand of running shoe, for example, seeing many different options enables them to compare features, prices, and to buy the best running shoe for them. The same idea applies on the web — people searching for one brand of product should be able to easily find information about products from similar brands to make informed decisions.

For more information about our AdWords Trademark policy, have a look at our help center.

Source: Google
Thank you

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