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Google AdWords and Trademark Rights



the European and Hong Kong Approaches

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7th November 2013

AdWords: Legal Issues ↗

Introduction

Internet Statistics ↗

Internet Statistics for 2012

Internet users worldwide	2.4 billion (1/3 of the world population)
Webpages	46 billion
Searches on Google	1.2 trillion

AdWords: How does it work? ↗

Scenario #1

AdWords: How does it work? ↗

Select campaign settings

Create an ad group

Type: **Search & Display Networks - Standard**

Campaign name: watches

Type: Search and Display Networks

- ☒ **Standard** - Keyword-targeted text ads for Search and Display Networks
- ☐ **All features** - All the features and options available for the Search and Display Networks

[Learn more about campaign types](#)

Networks To choose different networks, edit the campaign type above, or create a new campaign.

- ✓ **Google Search Network**
 - ☒ Include search partners
- ✓ **Google Display Network**

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

[Advanced search](#)

For example, a country, city, region, or postal code.

Languages ? **English** [Edit](#)

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\$ per day

Actual daily spend may vary. ?

Source: Google

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](#)

Headline	<input type="text" value="Best watches Hong Kong"/>
Description line 1	<input type="text" value="Luxury watches free delivery"/>
Description line 2	<input type="text" value="Save 50% Now!"/> 22
Display URL <small>?</small>	<input type="text" value="www.bestwatcheshongkong.hk"/>
Destination URL <small>?</small>	<input type="text" value="http://"/> <input type="text" value="www.bestwatcheshongkong.hk"/>

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](#)

Source: Google

AdWords: How does it work? ↗

Keywords

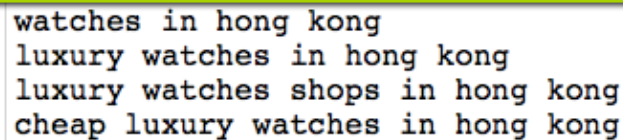
Select keywords

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.



```
watches in hong kong
luxury watches in hong kong
luxury watches shops in hong kong
cheap luxury watches in hong kong
```

No sample keywords available.

Source: Google

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](#)

Headline	<input type="text" value="Cartier Watches Hong Kong"/>
Description line 1	<input type="text" value="Best Cartier Watches Cheap Price"/>
Description line 2	<input type="text" value="Save 40% on your Cartier Watch"/>
Display URL ?	<input type="text" value="www.luxurywatches.hk"/>
Destination URL ?	<input type="text" value="http://"/> <input type="text" value="www.luxurywatches.hk"/>

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](#)

Source: Google

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.

Watches Cartier in Hong Kong
Cheap Cartier in Hong Kong

Source: Google

AdWords: How does it work? ↗



AdWords: How does it work? ↗

The screenshot shows a Google search for 'watches' on the Hong Kong domain. The browser address bar shows 'https://www.google.com.hk/#q=watches'. The search bar contains 'watches' and the search button is visible. Below the search bar, the 'Web' tab is selected, showing 'About 504,000,000 results (0.36 seconds)'. The results are divided into 'Ads related to watches' and 'Organic results'. The ads include links to Dior, World of Watches, Minmen, Cartier, IWC, Tissot, Montblanc, and Omega. The organic results include a Wikipedia entry for 'Watch' and an Amazon.com link for 'Watches - Men's, Women's, Kids', Designer, Fashion'.

Web Images Maps More Search tools

About 504,000,000 results (0.36 seconds)

Ads related to **watches** ⓘ

Dior Luxury Watches - dior.com
www.dior.com/Watchmaking
Visit the Dior Official Website to Discover our New **Watch** Collections
Christian Dior has 861,851 followers on Google+

Watches - Pre-Black Friday Watch Super Sale
www.worldofwatches.com/
Up-To 90% Off + Free Shipping!
WorldofWatches.com has 152 followers on Google+
[Men's Watches](#) - [Women's Watches](#) - [Free Shipping All Watches](#) - [Top Sellers](#)

Top 10 watches - minmen.com.hk
www.minmen.com.hk/
More than 50 luxury brands

Watch - Wikipedia, the free encyclopedia
en.wikipedia.org/wiki/Watch
A **watch** is a timepiece, typically worn either around the wrist or attached on a chain and carried in a pocket. Wristwatches are the most common type of **watch** ...

Watches | Amazon.com: Men's, Women's, Kids', Designer, Fashion
www.amazon.com/Watches-Mens-Womens-Kids-Accessories/b?ie...
Free Shipping & Free Returns on **Watches** including Michael Kors, TAG Heuer, FOSSIL, Invicta, Burberry, Marc Jacobs, Swatch, Bulova, Timex, Casio, Citizen ...

Watches | Zappos.com FREE Shipping
www.zappos.com/watches
Perfect your wrist with a comfortable Fit with a wide range of watches for men and

Ads ⓘ

Luxury Watches List in HK
watches.scmp.com/
SCMP Luxury **Watches** Directory.
Jewelry Watches&Retailers in HK. Go

Cartier Timepieces Collection
www.cartier.hk/
Cartier Timepieces Collection:
Creations with Excellence.

IWC Watch
www.iwc.com/
Precision engineering
and design.

TISSOT Swiss Watches
www.tissot.ch/
Swiss classic timepiece with
brilliant craftsmanship. Learn more

萬寶龍頂級世界名錶
www.montblanc.com/
體現傳統製錶工藝與先進技術的完美配搭,
突顯出高級計時錶的性能及風範。

OMEGA Watch - Boutiques
www.omegawatches.com/
Check here for the closest
OMEGA Boutiques and retailers.

AdWords: How does it work? ↗

The screenshot shows a Google search results page for the query "watches cartier". The browser address bar shows "https://www.google.com.hk/#q=watches+cartier". The search bar contains "watches cartier". The results page shows "About 17,800,000 results (0.54 seconds)".

Ads related to watches cartier

- Cartier Official Website - Fine Jewellery and Timepieces - cartier.hk**
www.cartier.hk/
Luxury and elegance.
- Cartier - HauteHorlogerie.org**
www.hautehorlogerie.org/
the best of Fine Watchmaking: full Encyclopedia, Brands and Watches !
- Official Cartier websites & online stores - The renowned French ...**
www.cartier.com/
Cartier – Fine watches (Ballon Bleu de Cartier, Tank...), jewelry, wedding and engagement rings, leather goods and other luxury goods from the famous French ...
Collections - Jewelry - Bridal - Timepieces
- Fine Timepieces - Luxury Timepieces - Cartier**
www.cartier.com/collections/timepieces
Men's Watches. Ballon Bleu de Cartier · Tank · Calibre de Cartier · Santos de ...
Women's watches. Tank · Ballon Bleu de Cartier · Baignoire · Pasha de Cartier ...
- Cartier Watches | The Watch Gallery®**
www.thewatchgallery.com/cartier-watches
Cartier watches available at the authorised retailer The Watch Gallery®. A collection of men's and ladies' watches presented with an option of 0% finance.
- Cartier Watches - Jomashop**
www.jomashop.com/cartier.html
Joma Shop offers quality Cartier watches at discount Cartier watches prices. Free shipping on most vintage Cartier watches. antique Cartier watches. Cartier ...

Cartier
Jeweler
Société Cartier designs, manufactures, distributes and sells jewelry and watches. Founded in Paris, France in 1847 by Louis-François Cartier, the company remained under family control until 1964. Wikipedia

Ads

- 名門名表 Minmen**
www.minmen.com.hk/
100% guarantee
百分百保证
- Cartier Prices**
www.ask.com/Cartier+Prices
Cartier Prices.
Discover and Explore on Ask.com!
- Cartier Used**
www.alhea.com/Cartier+Used
Find Cartier Used Now
Multiple Search Engines at Once!



Potential legal issues

AdWords: 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

AdWords: Legal Issues ↗

1. History and scale of judicial cases

First cases (in France)

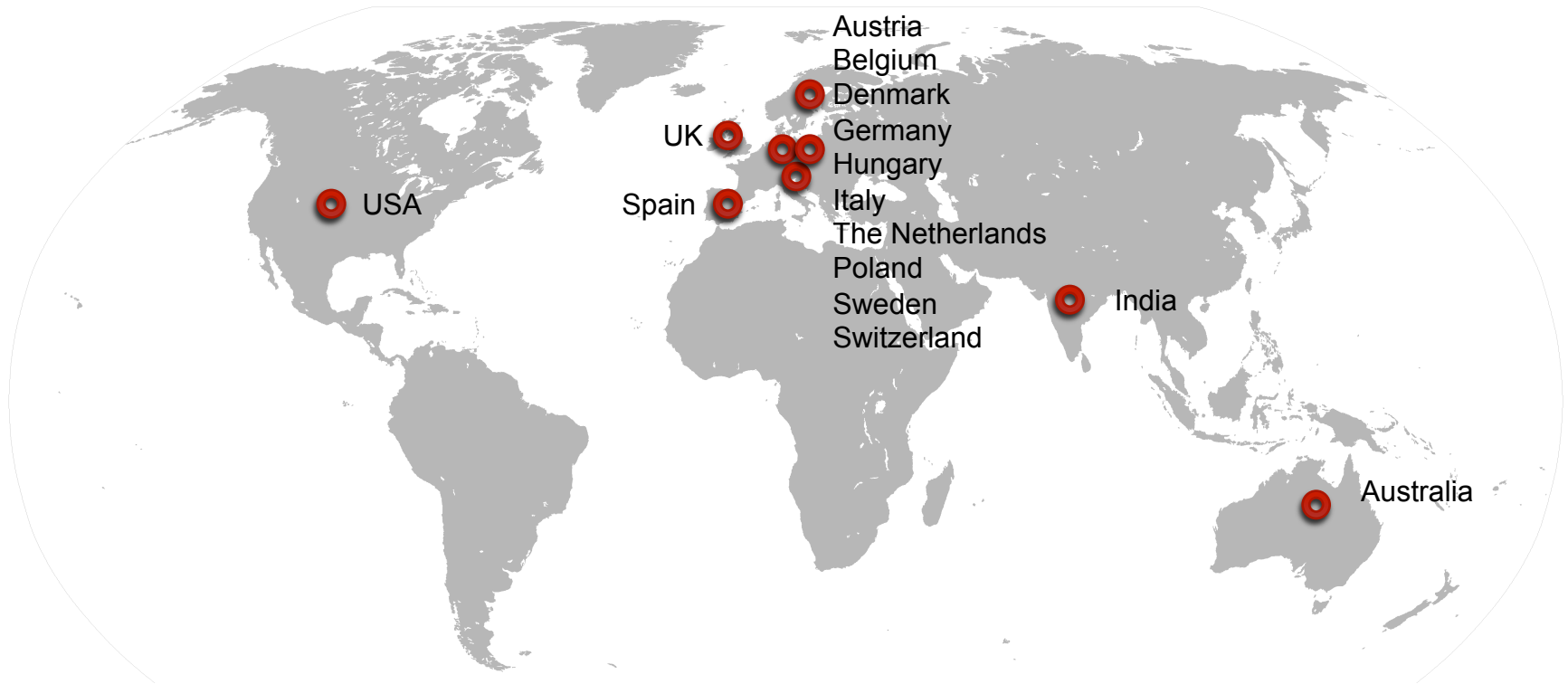
Nanterre court of first instance, 13 October 2003, *Ste Viaticum v. Google*

Paris court of first instance, 4 February 2004, *Louis Vuitton Malletier v. Google*

Nanterre court of first instance, 14 December 2004, *CNNRH v. Google et al.*

AdWords: Legal Issues ↗

1. History and scale of judicial cases: Epidemic development



Source: Darts-IP

AdWords: Legal Issues ↗

1. History and scale of judicial cases

Most recent decisions	
Kammergericht, <i>Coty Germany v. Panther Holding</i> , 15 October 2013	Germany
<i>Allied Interstate LLC v. Kimmel & Silverman P.C.</i> , 2013 WL 4245987 (SDNY August 12, 2013)	USA
Paris court of first instance, 12 July 2013, <i>Rent a car v. Traveljigsaw</i>	France
Source: Darts-IP	

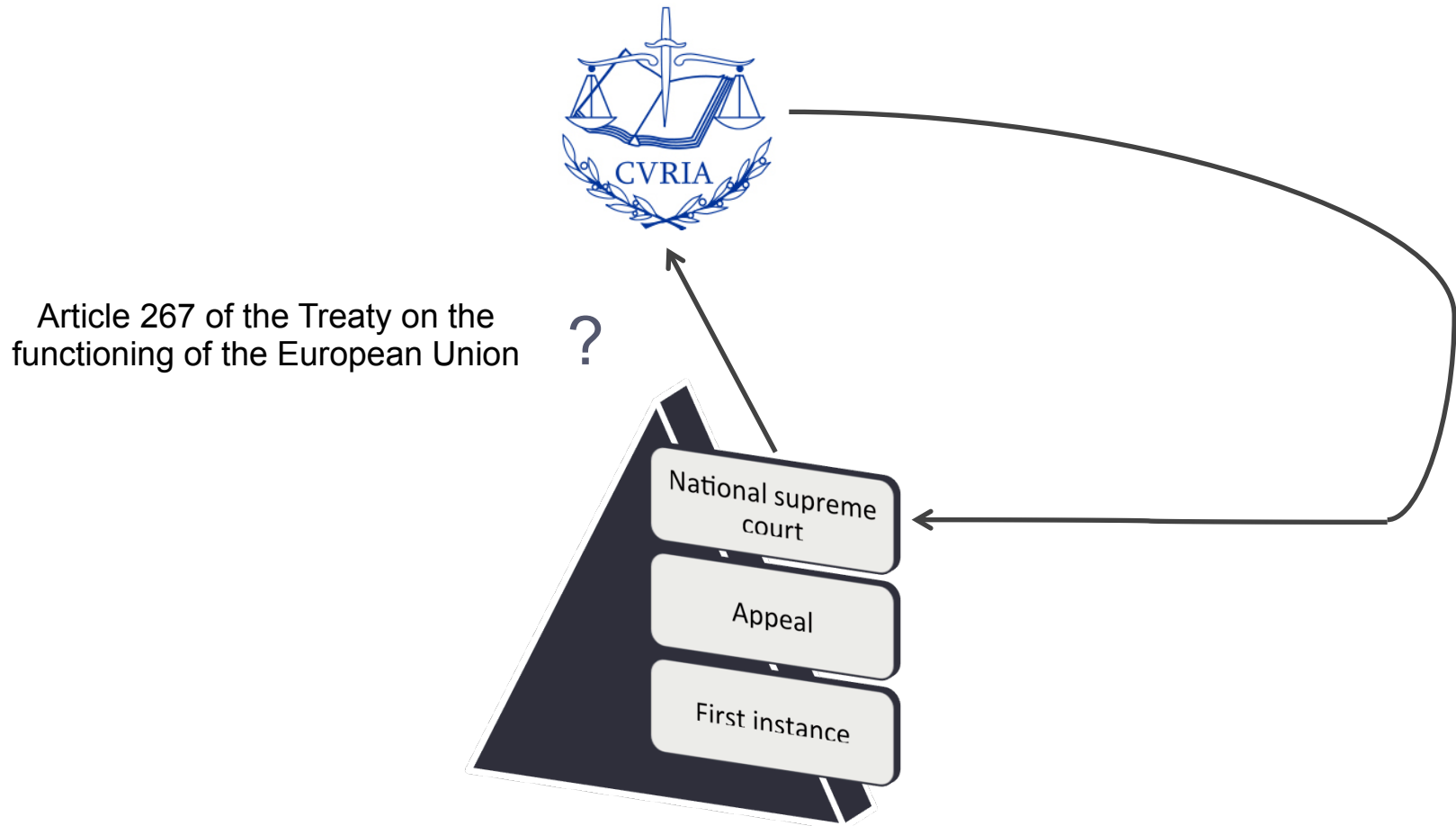
2

Legal issue for advertisers Infringement of trademarks rights

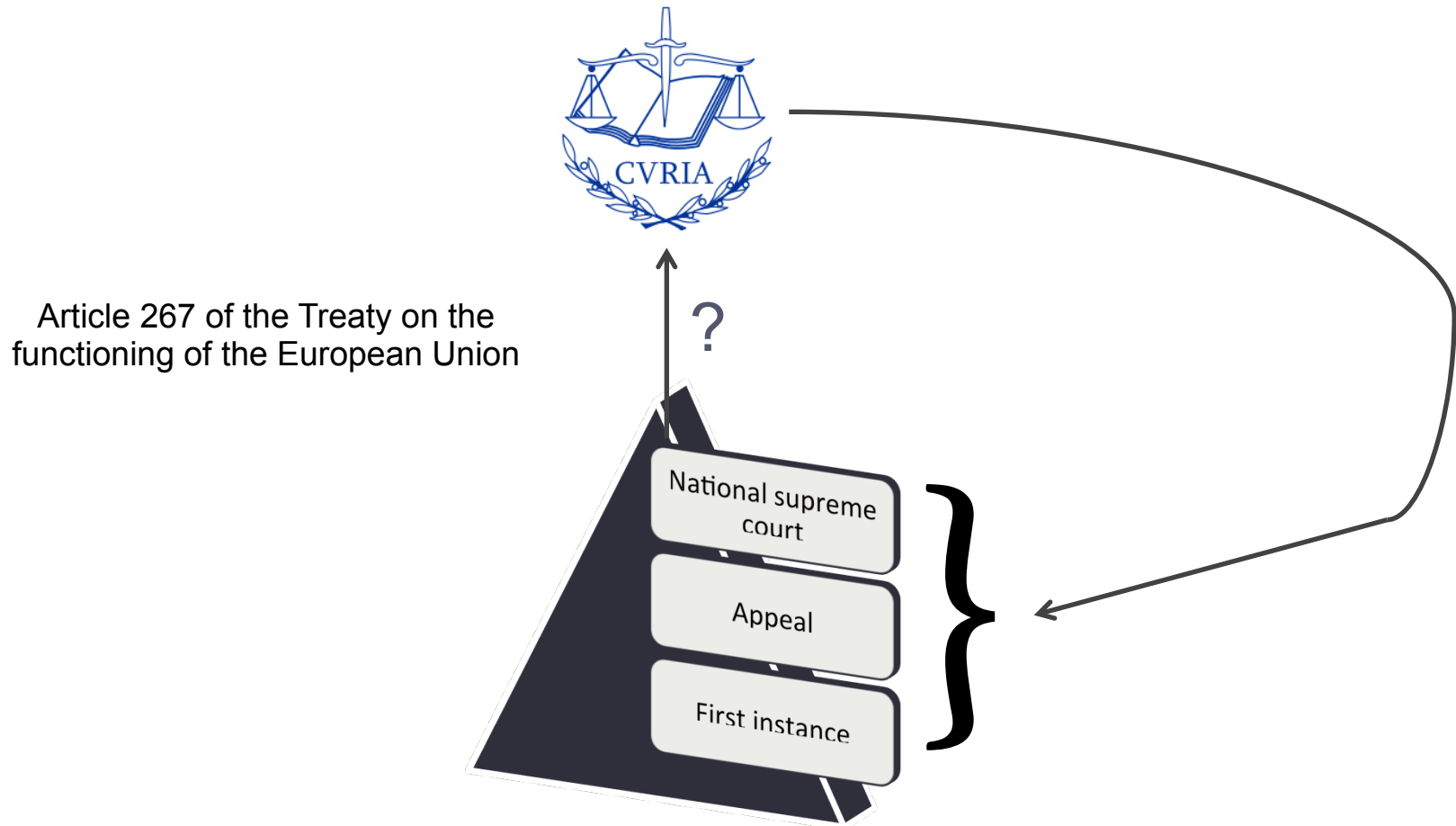


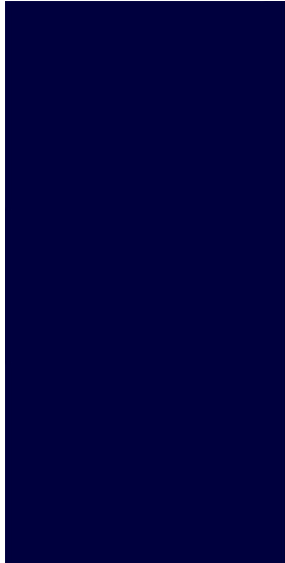
European Union

EU Preliminary ruling procedure ↗



EU Preliminary ruling procedure ↗





France



AdWords: Legal Issues ↗

First cases (in France)

Nanterre court of first instance, 13 October 2003, *Ste Viaticum v. Google*

Paris court of first instance, 4 February 2004, *Louis Vuitton Malletier v. Google*

Nanterre court of first instance, 14 December 2004, *CNNRH v. Google et al.*

AdWords: Legal Issues ↗

2. Legal issue for advertisers: infringement of trademarks rights

Nanterre court of first instance, 14 December 2004, <i>CNNRH v. Google et al.</i>	
<u>Parties:</u>	<u>Infringement:</u>
Trademark owner	X
Advertiser: yes	yes
Google: yes	yes

AdWords: Legal Issues

2. Legal issue for advertisers: infringement of trademarks rights



Cour de cassation, 20 May 2008 (3 decisions)

Ste Viaticum 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?

AdWords: Legal Issues

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;

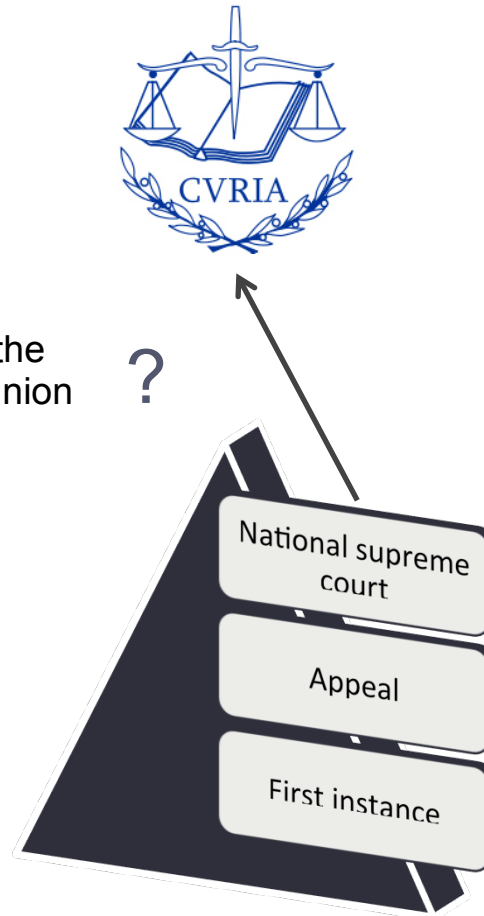
(b) any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists **a likelihood of confusion** on the part of the public, which includes the likelihood of association between 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



AdWords: Legal Issues ↗

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



AdWords: Legal Issues ↗

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”.

AdWords: Legal Issues ↗

2. Legal issue for advertisers: infringement of trademarks rights

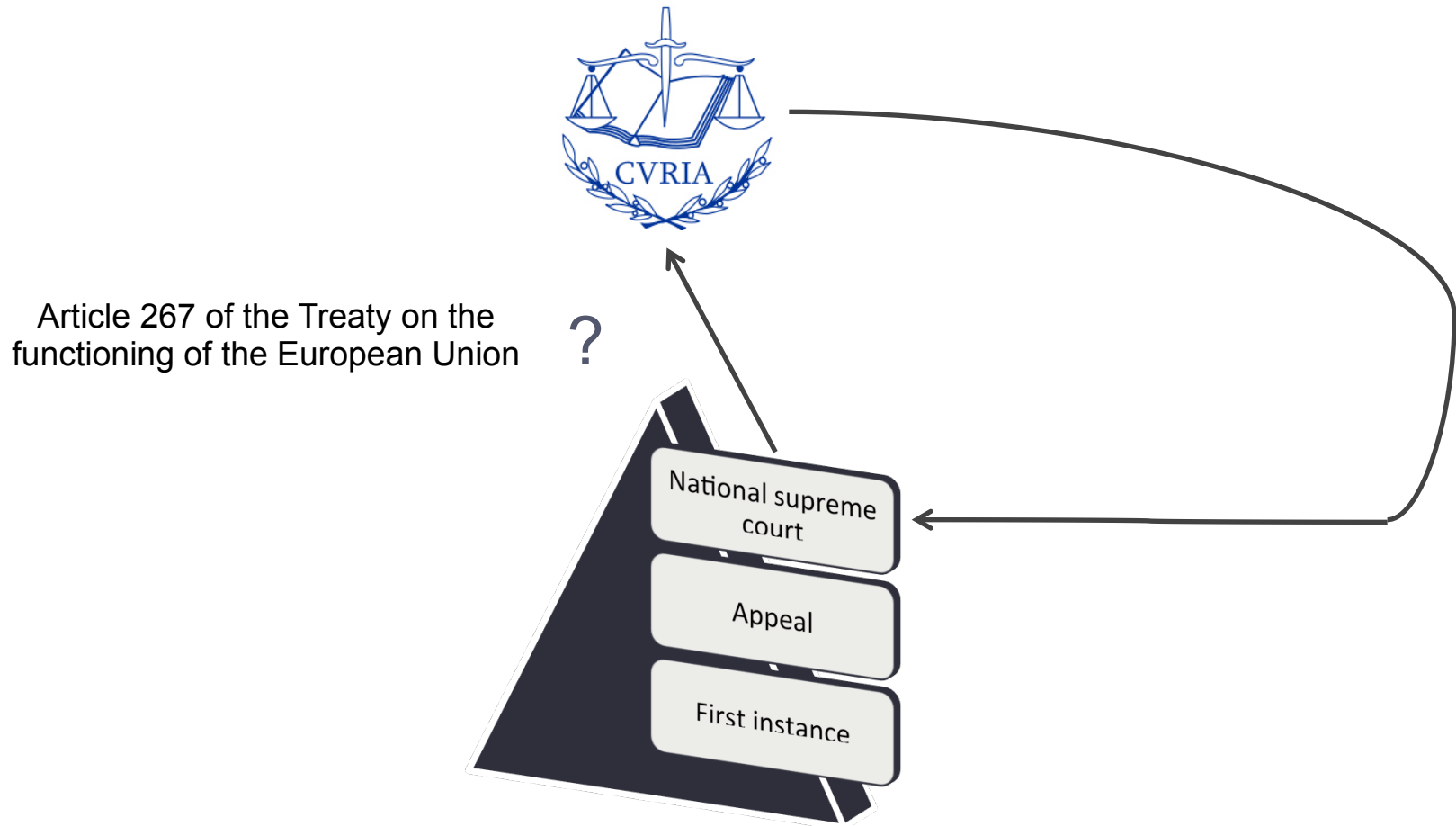


CJEU, *Google v. Louis Vuitton Malletier, Viaticum and CNRRH* (23 March 2010)
Joined Cases C-236/08 to C-238/08

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 ↗



AdWords: Legal Issues ↗

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



Flickr © fritscdejong



AdWords: Legal Issues ↗

2. Legal issue for advertisers: infringement of trademarks rights



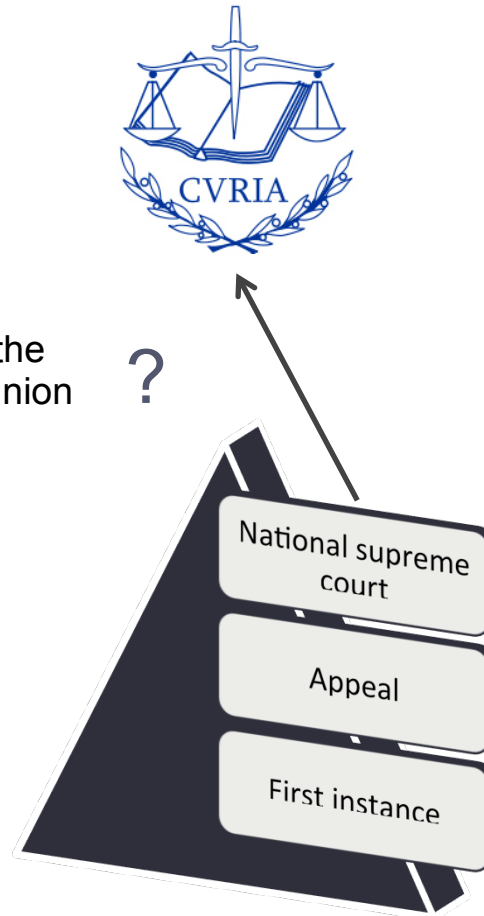
Hoge Raad der Nederlanden, 12 December 2008, *Portakabin v. Primacabin*

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



AdWords: Legal Issues ↗

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”.

AdWords: Legal Issues

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.

AdWords: Legal Issues ↗

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



AdWords: Legal Issues ↗

2. Legal issue for advertisers: infringement of trademarks rights

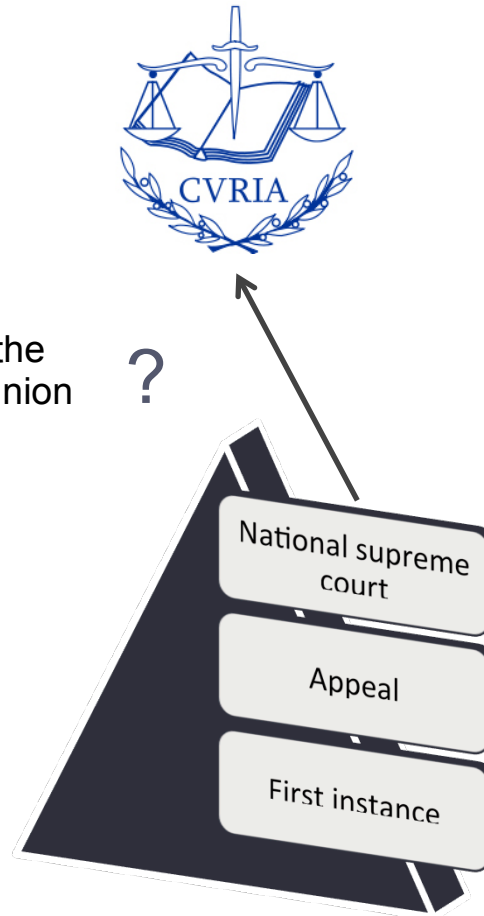


High Court (Chancery division), 29 April 2010, *Interflora v. Marks & Spencer*

Several Questions...

EU Preliminary ruling procedure ↗

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



AdWords: Legal Issues ↗

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”.

AdWords: Legal Issues

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.

AdWords: Legal Issues ↗

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”.

AdWords: Legal Issues ↗

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

AdWords: Legal Issues ↗

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”.

AdWords: Legal Issues ↗

2. Legal issue for advertisers: infringement of trademarks rights

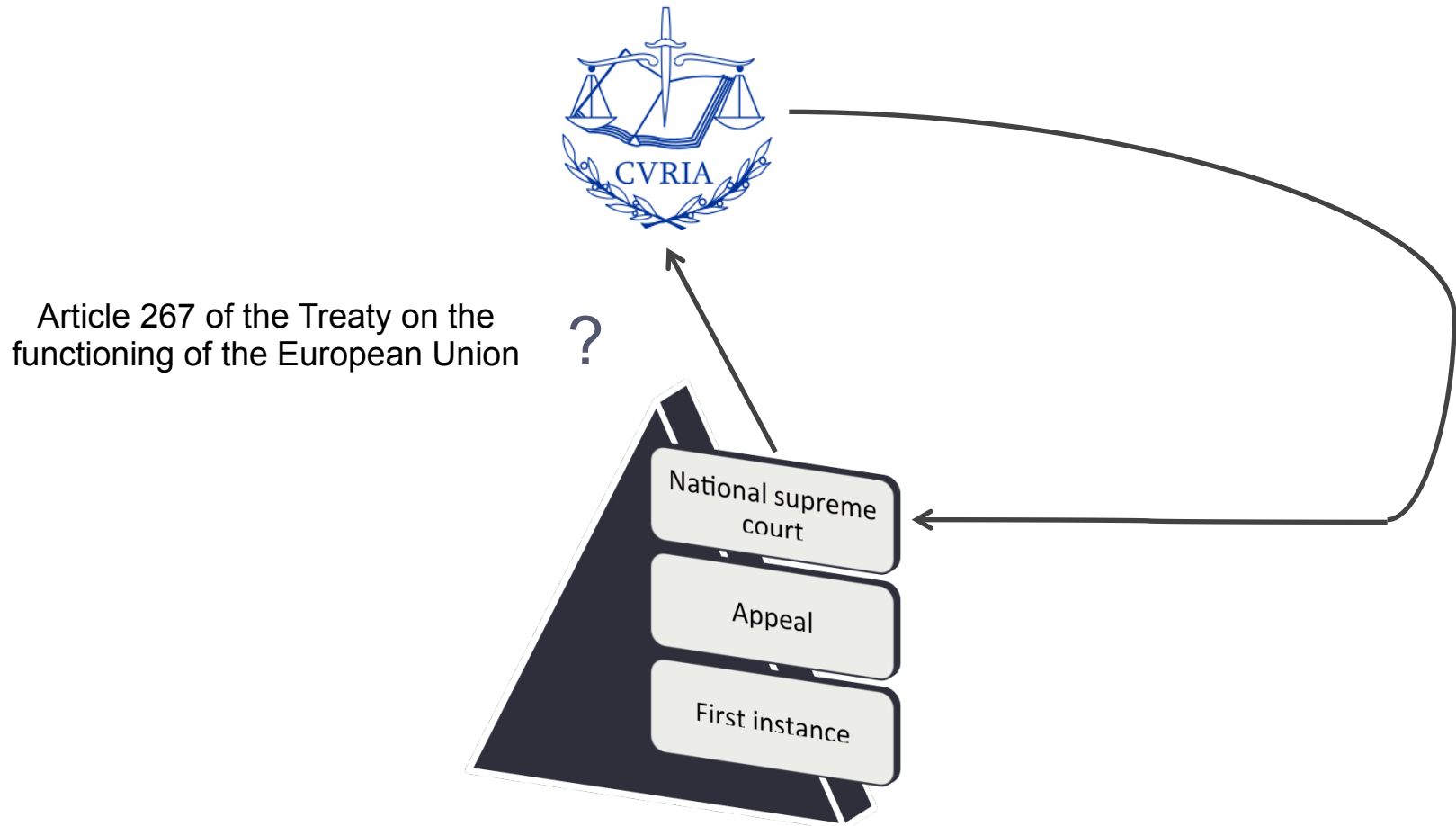


CJEU, *Interflora v. Marks & Spencer* (22 September 2011)
C-323/09

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 ↗



AdWords: Legal Issues ↗

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

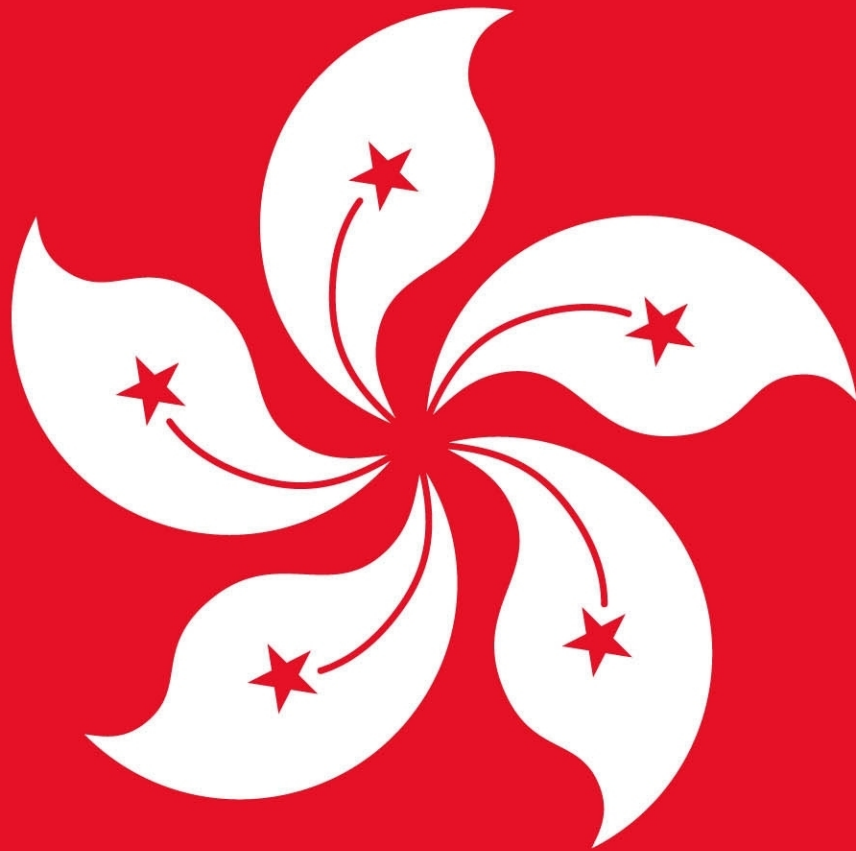
“**Trademarks owners are entitled** to prevent a competitor from advertising – on the basis of a keyword which is identical with the trade mark and which has been selected in an internet referencing service by the competitor without the proprietor’s consent – goods or services identical with those for 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

AdWords: Legal Issues ↗

2. Legal issue for advertisers: infringement of trademarks rights

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

↗ <http://www.legislation.gov.hk/eng/home.htm>

AdWords: Legal Issues ↗

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**

AdWords: Legal Issues ↗

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**

AdWords: Legal Issues ↗

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**

AdWords: Legal Issues ↗

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

AdWords: Legal Issues ↗

2. Legal issue for advertisers: infringement of trademarks rights

LVMH
MOËT HENNESSY • LOUIS VUITTON

CHANEL

**Well-Known
Trademarks**



GUCCI


AdWords: Legal Issues ↗

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**

AdWords: Legal Issues ↗

2. Legal issue for advertisers: infringement of trademarks rights



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



Directive 89/104/EEC (1988) to Approximate TM Laws, Art 5

(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.

AdWords: Legal Issues ↗

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

AdWords: Legal Issues

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


AdWords: Legal Issues ↗

3. Legal issues for Google: infringement of trademarks rights by Google?

 Nanterre Court of First Instance, 13 October 2003, <i>Ste Viaticum c. Google</i>	
<u>Parties:</u>	<u>Infringement:</u>
Trademark owner	X
Advertiser: no	X
Google: yes	yes

AdWords: Legal Issues ↗

3. Legal issues for Google: infringement of trademarks rights by Google?

 Paris court of first instance, 4 February 2004, <i>Louis Vuitton Malletier v. Google</i>	
<u>Parties:</u>	<u>Infringement:</u>
Trademark owner	X
Advertiser: no	X
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AdWords: Legal Issues ↗

3. Legal issues for Google: infringement of trademarks rights by Google?



Cour de cassation, 20 May 2008 (3 decisions)

Ste Viaticum c. Google

Louis Vuitton Malletier v. Google

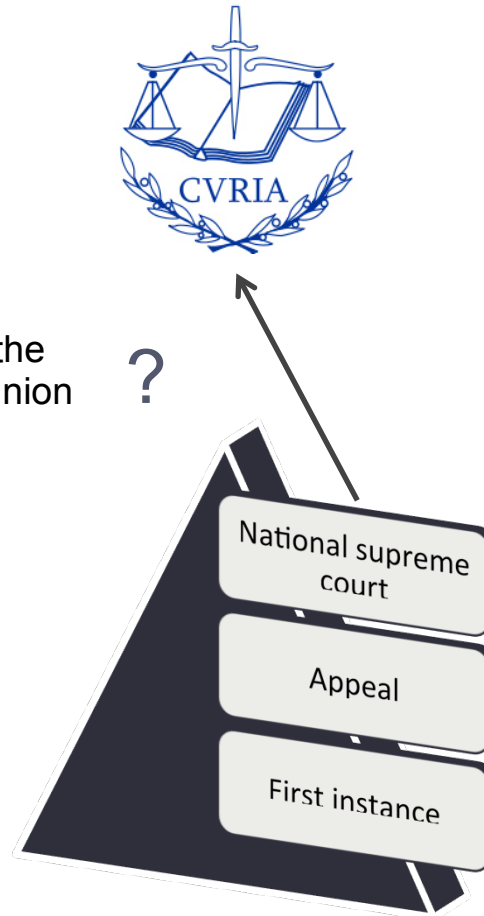
CNNRH v. Google

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



AdWords: Legal Issues ↗

3. Legal issues for Google: infringement of trademarks rights by Google?

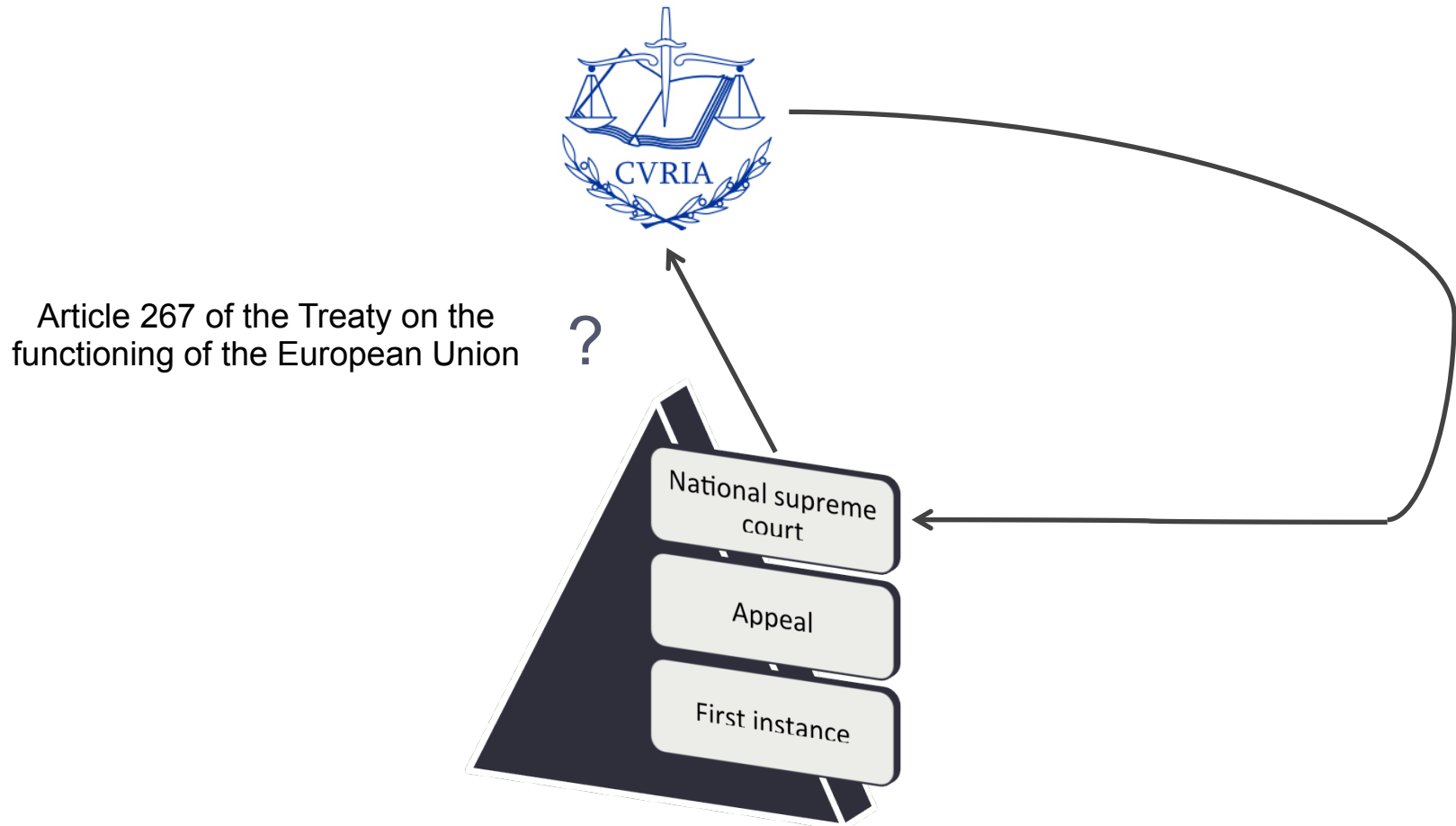


CJUE, *Google v. Louis Vuitton Malletier, Viaticum and CNRRH* (23 March 2010)
Joined Cases C-236/08 to C-238/08

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 ↗



AdWords: Legal Issues ↗

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

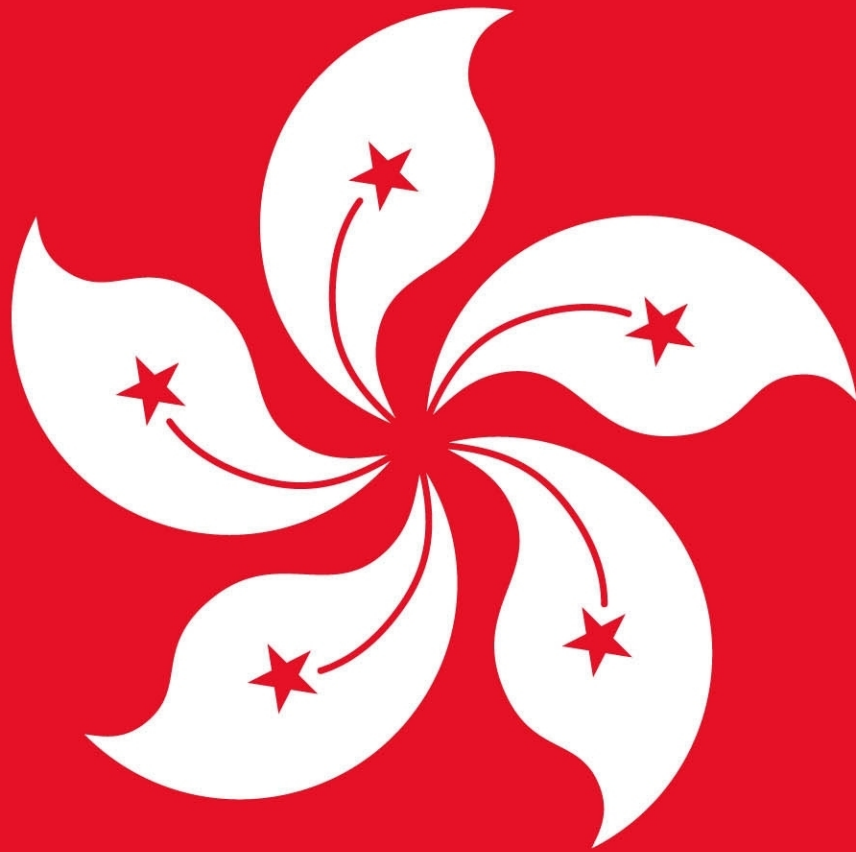
AdWords: Legal Issues ↗

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)



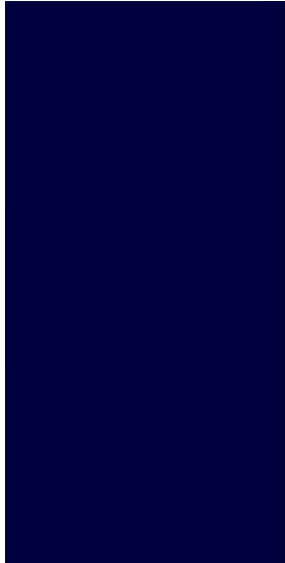
Hong Kong

3.2.

Liability of Google as an Internet service provider (ISP)



European Union



France



AdWords: Legal Issues ↗

3. Legal issues for Google: liable as an Internet service provider (ISP)?



Cour de cassation, 20 May 2008 (3 decisions)

Ste Viaticum 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?

AdWords: Legal Issues ↗

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:

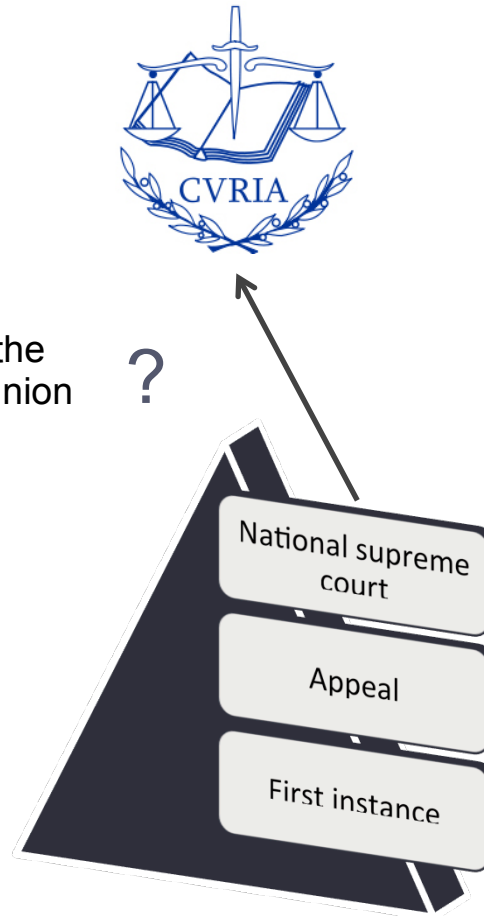
(a) the provider does not have actual knowledge of illegal activity or information and, as regards claims for damages, is **not aware of facts or circumstances** from which the illegal activity or information is apparent; or

(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



AdWords: Legal Issues ↗

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

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.**”



AdWords: Legal Issues ↗

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

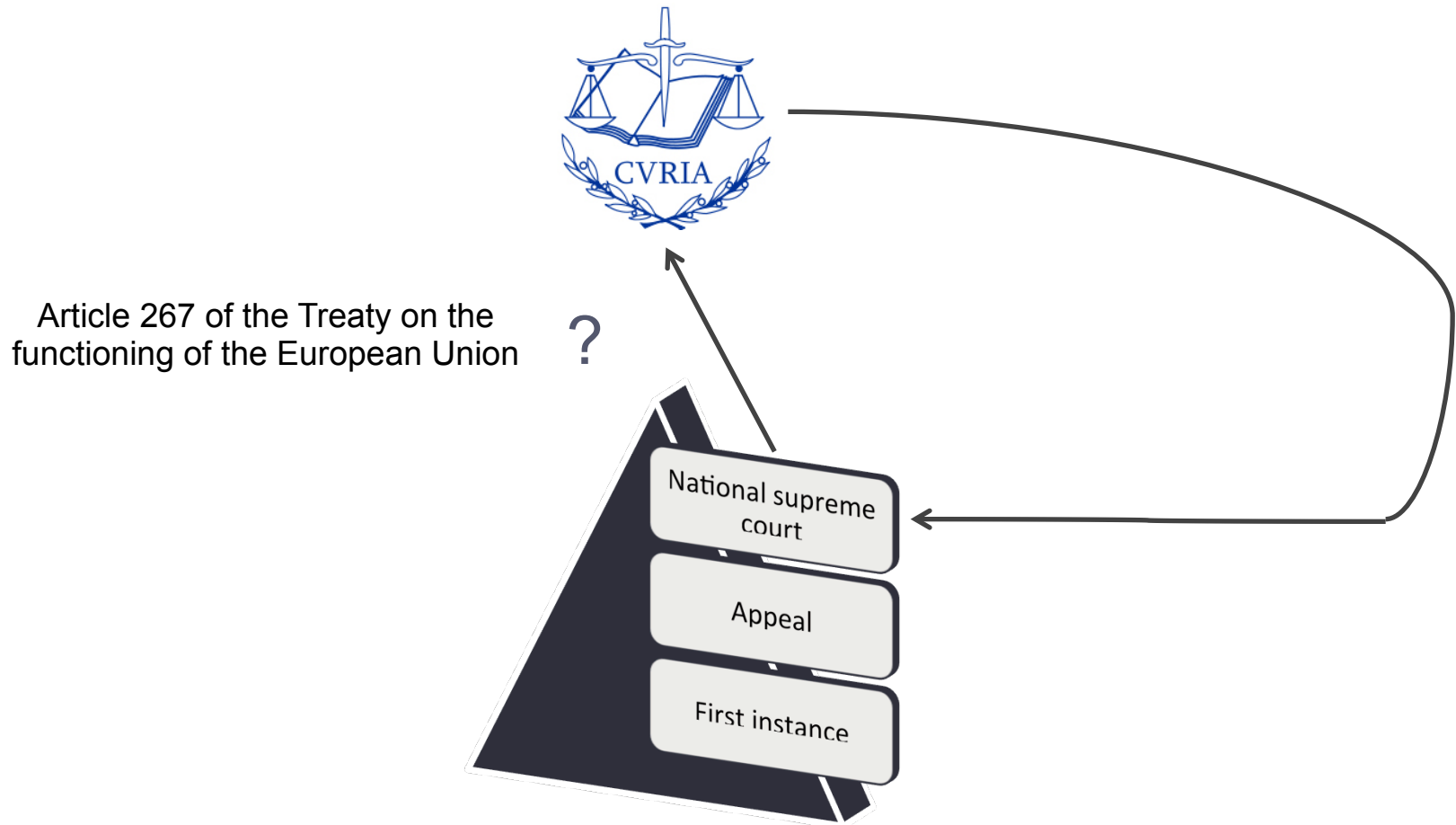
Principle:

- 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 ↗



AdWords: Legal Issues ↗

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

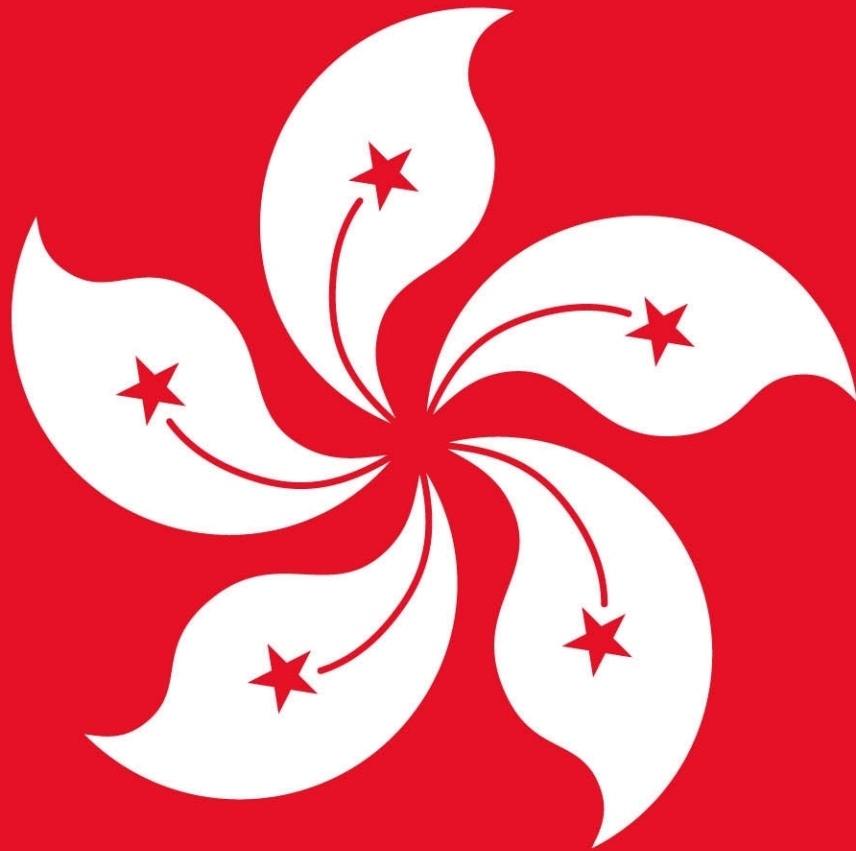
AdWords: Legal Issues ↗

3. Legal issues for Google: infringement of trademarks rights by Google?



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(among dozens of decisions)



Hong Kong

AdWords: Legal Issues ↗

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.

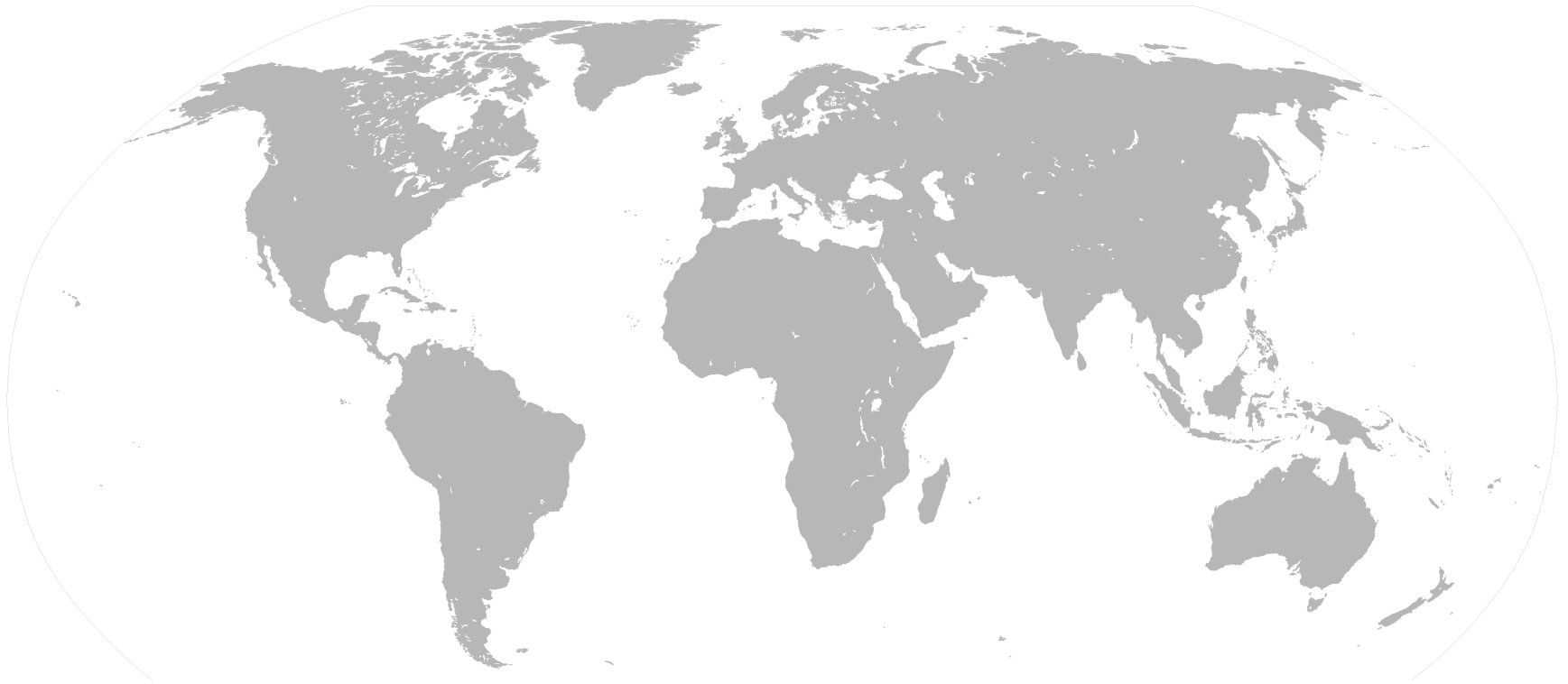
They did not know the content of each posting;

- 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 ↗



AdWords: Legal Issues ↗



Search Advertising Policies Help



◀ Advertising Policies Help

Advertising Principles

Overview

List of policies

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.

several, 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.

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 more 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](#).

You're viewing our Advertising Policies. For general AdWords support, [visit the AdWords Help Center](#).

Related

[Policy updates](#)

[List of policies](#)

Source: Google

Thank you



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Hong Kong Baptist University
7th November 2013