

Trademark Workshop
“Covert Trademark Use in the Internet: Licit or Illicit?”

Monday, November 19th, 2018,
Peacock Ballroom 2, Pullman Hotel
13:15 - 17:15 hours

a. Speakers

- i. Ms. Clare A. Cornell, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP (United Kingdom.)

Covert Trademarks: A View from Europe

- ii. Mr. Melvin Pang, Amica Law, LLC (Singapore); and

*AdWords, Bad Words? - Trademark Use and Infringement in Keyword Advertising
– A Singapore Perspective*

- iii. Ms. Carolina Del Rio, Clarke, Modet & C° (Chile) and
Ms. Raquel Flanzbaum, Berton Moreno + Ojam (Argentina)
[Latin America Group]

Covert Trademarks: A View From Latin America

- b. Moderator – Mr. Thomas J. Treutler, Tilleke & Gibbins (Vietnam).

Summary of Presentation and Speakers' Profile



Ms. Clare A. Cornell
Speaker

“Covert Trademarks: A View from Europe”

INTRODUCTION

1. Consider the position regarding use of third party trade marks in adwords and metatags
2. Consider liability of parties involved in sale and use of these marks as adwords / metatags
3. Review of the body of case law built up around the use of third party trademarks as adwords and metatags in Europe
4. Consider laws in Europe and how they apply when marks are used covertly on the internet.

CASES TO BE CONSIDERED

1. Reed Executive Plc v Reed Business Information Ltd
2. Argos Ltd v Argos Systems Inc
3. Interflora Inc v Marks & Spencer Plc
4. Google France Sarl v Louis Vuitton Malletier SA
5. Wintersteiger AG v Products 4U Sondermaschinenbau GmbH
6. Belgian Electronic Sorting Technology NV v Bert Peelaers and Visys NV

DISCUSSION OF APPLICABLE LAW

1. EU Trade Mark Directive
2. Application into national laws
3. Council Directive concerning misleading and comparative advertising
4. Passing off

Speaker's Profile

Clare Cornell leads Finnegan, Henderson, Farabow, Garrett & Dunner, LLP's London trade mark group and has 20 years' experience in the IP industry. Her practice focusses on all aspects of trade mark portfolio management. Clare also specialises in trade mark enforcement and seeking settlement of complex IP disputes.

Clare Cornell is a dual qualified UK and EU trade mark and patent attorney. Skilled in coordinating national and international trade mark filing strategies, Clare serves an international client base, including through the UK IPO, EUIPO and WIPO's Madrid International trade mark registration system.

Recognized as an "IP Star" in the United Kingdom by Managing Intellectual Property, Clare has broad experience in contentious proceedings in the UK and Europe, and in negotiating settlement agreements. Ms. Cornell provides a broad range of advice in high-level IP due diligence programs, advising on all aspects of IP as well as the preparation of agreements for the transfer of IP portfolios. She has assisted in multimillion-dollar IP due diligence projects during both the acquisition and divestiture of businesses, as well as coordinated multi-jurisdictional post-acquisition IP assignment programs. Her technical experience includes advising clients in the IT, textile, construction, chemical, clothing, alcoholic beverage, packaging, and nutraceutical industries.



Mr. Melvin Pang
Speaker

“AdWords, Bad Words? Trademark Use and Infringement in Keyword Advertising”- A Singaporean Perspective

Outline

1. The presentation will begin with an analysis of the evolution of cases in different jurisdictions regarding keyword advertising, particularly the US, UK and the EU
2. Next, we will establish that Singapore law is currently at a crossroads, as its courts have not received a case for that would allow them to clarify their position on the law surrounding keyword advertising.
3. Given that legal scholars predict that Singapore will follow or take a path similar to the UK approach, we then explore how the *Interflora* case developed through the UK courts, the European Court of Justice and its subsequent referral back to the UK High Court.
4. Finally, we will compare Singapore’s laws with that of the UK, ascertaining whether the approach in *Interflora* can work within the Singaporean framework and viewed through the prism of the growing sophistication of internet consumers.

Relevant Cases

1. C-236 to 238/08 *Google France*
2. *Cosmetic Warriors Ltd. and Lush Ltd. v. Amazon.co.uk Ltd. and Amazon EU Sarl* [2014] EWHC 181 (Ch)
3. *Interflora Inc v Marks & Spencer Plc* [2014] EWHC 4168 (Ch)
4. *GEICO v. Google Inc.*, 330 F. Supp. 2d 700, 701 (E.D. Va. 2004)
5. *Rescuecom Corp. v. Google Inc.* 562 F.3d 123 (2nd Cir. 2009)
6. *Rosetta Stone v. Google*, 676 F.3d 144 (4th Cir. 2012)

Legal Opinions/Articles

1. Susanna Leong, *Intellectual Property Law of Singapore* (2013)
2. Tyson Smith, *Googling a Trademark: A Comparative Look at Keyword Use in Internet Advertising*, Tex. Int'l L.J. 2010, Vol 46, Issue 1, 23
3. Nicole, van der Laan *The Use of Trade Marks in Keyword Advertising. Developments in ECJ and National Jurisprudence* (April 5, 2012). Lee, Nari/et al. (ed.): Intellectual Property, Unfair

Competition and Publicity - Convergences and Development (EIPIN Series). Cheltenham, UK/Northampton, MA, Edward Elgar, 2014, pp. 231-286; Max Planck Institute for Intellectual Property & Competition Law Research Paper No. 12-06.

4. Stefan Bechtold and Catherine Tucker, *Trademarks, Triggers and Online Search*

Speaker's Profile:

Melvin Pang is an Associate Director at Amica Law LLC and his legal practice primarily focuses on IP litigation and enforcement, managing the trade mark portfolios for both local and international clients as well as handling and advising on pharmaceutical regulatory compliance and the patent linkage process in Singapore. Melvin regularly advises and represents locally listed corporations as well as Fortune 500 companies, including Starbucks and Amazon in the end-to-end protection of their brand and trade mark portfolios. This includes managing the search and registration of their trademarks, appearing at infringement, opposition and invalidation actions at both the Registry and Court-levels, as well as devising and executing anti-counterfeiting and enforcement strategies.

Melvin also has extensive experience in the field of trade mark and patent litigation and has advised and acted for clients across diverse fields, ranging from representing an Italian manufacturer of porcelain stoneware tiles in a trade mark opposition action before the Court of Appeal - the highest court in Singapore - to acting for a De Beers subsidiary in relation to a patent infringement suit for the manufacture and sale of synthetic diamonds. Melvin also has a strong pharmacological advisory and litigation practice and has advised and acted for listed pharmaceuticals such as Sanofi-Aventis, Pfizer and Sun Pharmaceuticals in local regulatory as well as patent linkage and infringement proceedings.



Ms. Carolina Del Rio
Speaker



Ms. Raquel Flanzbaum
Speaker

“Covert Trademarks: A View From Latin America”

INTRODUCTION

1. The purpose of this presentation is to analyze the legal framework concerning use of metatags and keywords in Latin America
2. Having this in mind, we shall discuss some relevant decisions in selected countries of the region, with particular emphasis on the following points:
3. Competitor liability for using somebody else’s trademark
4. Liability of online platforms
5. Search engine liability (Google, Yahoo)
6. Accordingly we shall examine the applicable regulations. Trademark infringement, unfair competition, none of these? Local, regional, multilateral?
7. Finally we shall examine the relevant opinions of the legal scholars in the region

COURT DECISIONS (this list may change)

1. *Comercial Full Diesel S.A. v. Comercial Neumaq S.p.A.* (17 Civil Court of Santiago, Chile, March 30, 2016)

2. *Nike International Ltd. v. Deremate.com de Argentina S.A.* (Federal Court of Appeals in Civil and Commercial Matters, Division 1, May 5, 2015, Argentina).
3. *Organización Veraz S.A. v. Open Discovery S.A.* (Federal Court of Appeals in Civil and Commercial Matters, Division 3, May 4, 2018, Argentina)
4. Brief reference to the decisions issued in *Rodríguez, María Belén v. Google Inc. and Yahoo de Argentina S.R.L.* (Supreme Court, October 28, 2014, Argentina).

APPLICABLE LAW

1. Trademark Law
2. Unfair Competition
3. Decision 486 of the Andean Community of Nations
4. Mercosur Trademark Protocol

RELEVANT OPINION FROM LEGAL SCHOLARS

1. Likelihood of confusion? Consumer deception? Lawfulness?
2. Subjective liability: actual knowledge? Active or neutral role? Bad faith?
3. Well-known trademarks v. "Rest of the world"? Dilution, no dilution?
4. Damages

Speakers' Profile:

Carolina Del Rio is the Managing Director of Clarke, Modet & Co. Chile with a demonstrated history of working in the legal Intellectual Property services.

Under her leadership, Clarke, Modet & Co. Chile, was recognized for the third time with the "IP Enforcement Law Firm of the Year in Chile" by the magazine Corporate INTL Legal Awards Magazine (2015, 2016 and 2017). This recognition highlights the work of the firm in Chile, in enforcing the rights of Industrial and Intellectual Property in the country.

Raquel I. Flanzbaum's practice is focused on Intellectual and Industrial Property, comprising both prosecution and litigation.

Ms. Flanzbaum was a partner in the Intellectual Property Practice at Mitrani Caballero Ojam & Ruiz Moreno. Previously, she was a senior associate with Bruchou, Fernández Madero, Lombardi & Mitrani (2006-2007), an associate with Clarke, Modet & Co. (1997-2005) and the general counsel of Vialorenz S.A. (1994-1997).

She is a member of the Argentine Association of Patent & Trademark Agents (A.A.A.P.I.) and of the International Trademark Association (INTA), where she is involved in the International Classification Subcommittee, which is part of the Harmonization of Trade Mark Law & Practice Committee.



Mr. Thomas J. Treutler
Moderator

Moderator's Profile:

Thomas J. Treutler is the Managing Director of Tilleke & Gibbins' Hanoi and Ho Chi Minh City offices. Tom is fluent in Vietnamese and is registered to practice as a foreign lawyer in Vietnam and before the United States Patent and Trademark Office and the United States Court of International Trade. He has drafted numerous patents that have been granted in the U.S. in areas relating to semiconductors, networking, encryption and database technology for clients including Intel, Cisco and Oracle.

Recognized as a leading lawyer in intellectual property by Chambers Asia Pacific, The Legal 500 Asia Pacific, and Managing IP, Tom has extensive experience in IP enforcement and has secured a number of landmark victories for foreign investors operating in the life sciences and technology sectors. Tom is the former Chair of the East Asia and Pacific Subcommittee of INTA's Famous and Well-Known Marks Committee, is a member of the INTA Asia-Pacific Global Advisory Council, and currently sits on the INTA Copyright Committee. He also serves as the Chairman of AmCham Vietnam's IT, Telecom & IPR (ITTI) Committee. He is a member of the Dean's Global Advisory Board of Indiana University Bloomington's Maurer School of Law.