



INTERNATIONAL IP LAW: CONVERGING ON DIVERGENCE

Professor David Tan
NUS Law

OVERVIEW

- Assumptions – WIPO, TRIPS
- The Social Media Challenge
- USA – EU – China
- Trends – Copyright, Trademarks, Personality Rights

ASSUMPTIONS

- Converging Intellectual Property Laws
- WIPO Copyright Treaty 1996 – 101 contracting parties
 - a special agreement under Berne Convention which deals with the protection of works and the rights of their authors in the digital environment
- TRIPS Agreement 1995 – 164 members
 - comprehensively sets out the minimum standards of IP protection to be provided by each WTO member



THE SOCIAL MEDIA CHALLENGE



WHAT PEOPLE DO ON SOCIAL MEDIA

- (Re)Post Photos
- (Re)Post Text
- (Re)Post Videos



Pinterest

LEGAL ISSUES

- Fake News
- Hate Speech
- Cyberbullying
- Invasion of Privacy
- IP Infringement



New cyber-bullying weapon: Mobile phones

Widespread use of handsets make youths an easy target

KENNY CHEE

POLYTECHNIC student Alice (not her real name) got a shock in November last year, when she realised that a female classmate had taken upskirt photos of her by using a mobile phone.

The classmate then showed the photos to other students and openly taunted Alice, 19, about it.

Although embarrassed, she ignored the bully.

"Sooner or later, bullies will get bored and switch targets," she said.

Sure enough, the bully stopped taunting Alice last December.

Alice's case reflects an emerging form of cyber-bullying through the use of mobile phones among youths



COMMUNICATING FEAR: Though cyber-bullying cases involving mobile phones have gone up, phone bullying can be hard to spot. (PHOTO: EVERETT)

THE SOCIAL MEDIA CHALLENGE

- Technological **“Nudge”**
 - Each post > text, photo, video
 - Potentially infringing content
- Construct virtual identity
 - Convey emotions, aspirations, desires
 - Express (political) opinions
 - Maintain online diary of activities



Pinterest

THE SOCIAL MEDIA CHALLENGE

- Different legal standards around the world
 - Constitutional rights (especially freedom of expression and privacy)
 - Local culture



Pinterest

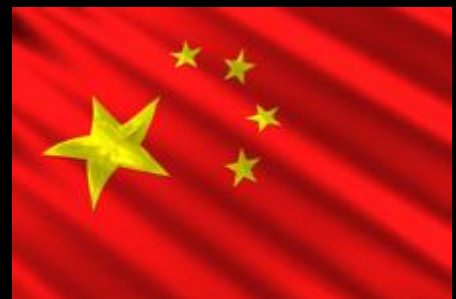
DIVERGENCE

- Freedom of Speech/Expression
- Freedom of Competition
- Privacy
- Economic Development
- Cultural Relativism



DIVERGENCE

- General global **standards** converge but national **rules** diverge
 - Copyright
 - Trademarks
 - Personality Rights



COPYRIGHT

- USA v EU
 - EU Copyright Directive 2019 (e.g. Art 13: online platforms have a duty to ensure that none of their users infringe copyright)
 - US Digital Millennium Copyright Act (DMCA); open-ended fair use (17 USC § 107)



COPYRIGHT

- TRIPS Agreement (Art 13)



"Members shall confine limitations and exceptions to exclusive rights to **certain special cases** which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the rights holder."

COPYRIGHT

- US “fair use” but categorical fair dealing elsewhere
 - US (and soon SG): **open-ended fair use** exception
 - UK, AU and China: **categorical fair dealing** – infringing use must fit into one of the enumerated categories – “parody/satire” present in UK & AU but not China and Hong Kong



COPYRIGHT

- UK & SG – AU – EU

- 2012 and 2018 – UK court granted a **dynamic injunction** to block access to Newzbin2; SG court granted a dynamic injunction that would require network service providers in Singapore to block access to 53 online locations which were initially identified as Flagrantly Infringing Online Locations
- 2016 – AU Federal Court declined to issue an order sought by the applicants which would permit them to extend the scope of the main site-blocking order to include additional domain names, IP addresses and/or URLs without any further order of court
- 2019 – EU Copyright Directive Art 13: **online platforms have a duty** to ensure that none of their users infringe copyright



TRADEMARKS

- Counterfeit products sold over the internet
 - US – *Tiffany v eBay* (2nd Cir 2010)
 - eBay is not contributorily liable for TM infringement of another merely for failing to anticipate that others would use its service to infringe a protected mark; eBay's VeRO notice-and-takedown system allowing owners of IP rights to report was adequate
 - France – *Louis Vuitton v eBay* (Paris CC 2008)
 - eBay did not fulfill its obligation of making sure that its activity does not result in illegal acts; eBay's responsibility is aggravated by the fact that it deliberately refused to establish efficient and appropriate means to fight against counterfeiting, such as those consisting of obliging the sellers to provide, upon request, a purchase bill or a certificate of authenticity of the products put on sale etc.



TRADEMARKS

- TRIPS Agreement (Arts 15 & 17)



WORLD TRADE
ORGANIZATION

“a Member [is not prevented] from denying registration of a trademark **on other grounds.**”

“Members may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that such exceptions take account of the legitimate interests of the owner of the trademark and of third parties.”

TRADEMARKS

- AU – Trade Marks Act s 42 –

An application for the registration of a trade mark must be rejected if:
(a) the trade mark contains or consists of **scandalous matter**; or
(b) its use would be **contrary to law**.

- SG – Trade Marks Act s 7(4) –

A trade mark shall not be registered if it is:
(a) contrary to **public policy or to morality**

- US – 15 USC § 1052(a)

Consists of or comprises **immoral**, deceptive, or **scandalous matter**; or matter which may **disparage** or falsely suggest a connection with persons, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute



DISPARAGING TRADEMARKS

- US Sup Ct – *Matal v Tam* (2017)

- Simon Tam chose THE SLANTS in order to “reclaim” and “take ownership” of stereotypes about people of Asian ethnicity.
- The public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers.
- Speech that demeans on the basis of race, ethnicity, gender, religion, age, disability, or any other similar ground is hateful, but the proudest boast of the Supreme Court’s free speech jurisprudence is that it protects the freedom to express hated thoughts.
- TMs are private speech; the disparagement clause **violates the Free Speech Clause of the First Amendment**



SCANDALOUS TRADEMARKS

- US Fed Cir – *In re: Brunetti* (2015); Sup Ct (2019)
 - Fed Cir reversed PTO's refusal to register the mark FUCT because it comprises immoral or scandalous matter under 15 USC § 1052(a).
 - PTO found the term "fuct" is used on products containing sexual imagery and that consumers perceive the mark as having "an unmistakable aura of negative sexual connotations."
 - Applied *Matal v Tam* – the provision impermissibly discriminates based on content in violation of the First Amendment.
 - For immoral or scandalous marks, this message is often uncouth. But it can espouse a powerful cause. Whether marks comprise immoral or scandalous subject matter hinges on the expressive, not source-identifying, nature of trademarks. It is a "bedrock First Amendment principle" that "speech may not be banned on the ground that it expresses ideas that offend."



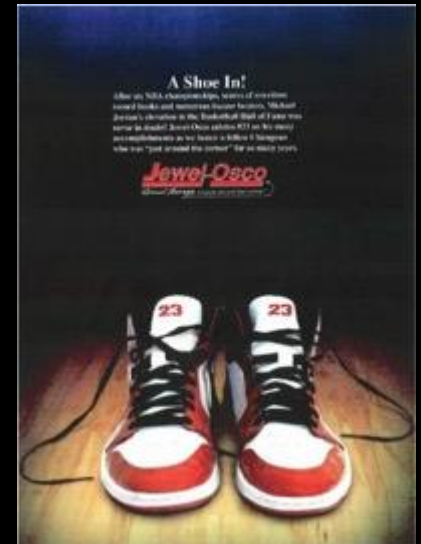
PERSONALITY RIGHTS

- Right of Publicity or Image Right
 - Protects against commercial exploitation of identity, name, likeness – USA (right of publicity); China (right of portrait 肖像权)
- Right of Privacy
 - Protects dignitary interests e.g. Art 8 of European Convention on Human Rights

SOME CONVERGENCE ?

- Michael Jordan

- US – *Jordan v Jewel Food Stores* (7th Cir 2014)
- China – *Jordan v Qiaodan Sports* (Beijing Supreme People's Court 2016) - ‘乔丹’



Michael Jordan Wins Rights to His Chinese Name in Court

Bloomberg News
December 8, 2016, 11:36 AM GMT+8 Updated on December 9, 2016, 5:16 AM GMT+8



CONCLUSIONS

- WIPO, TRIPS – only broad general standards
- Divergence in terms of national applications
- “International” in the 21st century





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