

WELCOME ADDRESS

DELIVERED BY

**THE HONOURABLE DATO' SRI HASNAH BINTI DATO' MOHAMMED
HASHIM
FEDERAL COURT JUDGE OF MALAYSIA**

ON THE OCCASION OF THE

**JUDICIAL WORKSHOP ON
INTELLECTUAL PROPERTY LAW AND PRACTICE**

“EMERGING ISSUES ON TRADEMARK LAWS”

ON

26th OCTOBER 2023

Salutations

Distinguished guests, ladies and gentlemen,

Assalamualaikum warahmatullahi wabarakatuh and a very good morning to all of you.

1. A very warm welcome to my friends and colleagues from all ASEAN Judiciaries to the Judicial Workshop on Intellectual Property Law and Practice. On behalf of the Malaysian Judiciary, it gives me great

pleasure to welcome you, whether you are here in person or joining us virtually from various corners of the ASEAN region.

2. Regrettably, the Right Honourable Chief Justice of Malaysia, Tun Tengku Maimun Bt Tuan Mat is unable to grace this occasion with her physical presence today due to previously scheduled commitments. Despite her unavoidable absence, she extends her warmest regards. She offers her sincere apologies for the same and wishes us a productive and insightful workshop.
3. This workshop marks a significant step in our collective pursuit of knowledge and expertise in the ever-evolving field of intellectual property (or “IP”) law. I am delighted to see the convergence of legal minds dedicated to enhancing their understanding and application of IP laws, which play an indispensable role in our increasingly knowledge-based global economy.
4. Indeed, the existence of a robust IP regime has been recognised as a necessary prerequisite for the collective transformation of ASEAN into a dynamic, innovative and competitive region. The ASEAN Economic Community Blueprint 2025 identifies IP as a fundamental element in achieving national and regional socio-economic development.¹ The most recently adopted ASEAN IP Rights Action Plan 2016-2025 further highlights the critical role of IP in the context of trade and investment flows, as well as the importance of regional

¹ ASEAN Economic Community Blueprint 2025 (Jakarta: ASEAN Secretariat, November 2015) <https://asean.org/wp-content/uploads/2021/08/AECBP_2025r_FINAL.pdf> accessed 9 October 2023.

cooperation in protecting and enforcing IP rights.²

5. In a contemporary landscape, intellectual property (IP) transcends being a mere abstract concept; it stands as a driving force behind economic growth and innovation. It is therefore imperative for us to remain vigilant in monitoring the latest IP developments and adapt our jurisprudence accordingly. This imperative leads us to the central theme of this workshop, "Emerging Issues on Trademark Laws". As adjudicators of IP disputes, we are perpetually confronted by the dynamic nature of trademark laws, especially as they intersect with new and disruptive technologies.
6. This workshop presents a unique and timely opportunity for us to delve into the intricacies of trademark law and practice in the digital age. The evolving digital landscape has given rise to novel challenges and opportunities in the realm of trademarks, necessitating a comprehensive understanding of the legal, technological, and commercial aspects at play. As the custodians of trademark adjudication, it is incumbent upon us to not only comprehend the nuances of traditional trademark laws but also to navigate the complexities introduced by digital transformation, e-commerce, and evolving consumer behavior.
7. By engaging in substantive discussions and knowledge exchange during this workshop, we can equip ourselves with the insights and perspectives needed to effectively adjudicate trademark disputes in

² The ASEAN Intellectual Property Rights Action Plan 2016-2025: Meeting the Challenges of "One Vision, One Identity, One Community" through Intellectual Property <[https://www.aseanip.org/docs/default-source/content/asean-ipr-action-plan-2016-2025-\(for-public-use\).pdf](https://www.aseanip.org/docs/default-source/content/asean-ipr-action-plan-2016-2025-(for-public-use).pdf)> accessed 10 October 2023.

the context of the digital economy. Furthermore, this collaborative endeavor will enable us to proactively shape jurisprudence that is responsive to the evolving IP landscape, thereby fostering a robust and adaptive legal framework that aligns with the imperatives of innovation, commerce, and consumer protection.

8. A trademark serves as the embodiment of a brand's identity, serving to distinguish a company's products, concepts, or designs from those of others. Much like a name is integral to an individual, a trademark holds central importance to a business or enterprise. Over time, a trademark accrues its own goodwill, often transcending its original purpose to become a defining element of the business itself. This phenomenon underscores the significance of trademark protection, as any misuse or infringement of a trademark has the potential to detrimentally impact the reputation, goodwill, and overall image of the business.
9. As astutely observed by Professor Ng-Loy Wee Loon³, "*...the trader deserves protection for the time and effort he spent in building up a particular sign as his trademark, and he should be protected against unfair competition from traders who are out to take a free ride on the goodwill or reputation he has acquired for his goods or services.*" This encapsulates the essence of trademark protection, emphasizing the fundamental principle that businesses deserve safeguarding against unfair exploitation of the goodwill they have diligently cultivated.
10. The imperative of trademark protection extends beyond mere legal considerations; it is rooted in the principles of fairness, commercial

³ Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (2nd edn, Sweet & Maxwell, 2014).

integrity, and consumer trust. By upholding robust trademark protection, we not only preserve the rights of businesses to the fruits of their labour but also fortify the foundations of a competitive and ethical marketplace. Protection against trademark misuse is paramount in upholding the authenticity and integrity of brands, thereby fostering an environment conducive to innovation, consumer confidence, and healthy competition.

11. The protection of trademarks is indispensable in safeguarding the essence and integrity of brands. It serves to uphold the hard-earned goodwill and reputation of businesses, ensuring that they are shielded from unfair exploitation and competition. By preserving the sanctity of trademarks, we contribute to the maintenance of a fair, transparent, and trustworthy commercial landscape that benefits businesses, consumers, and the broader economy.

12. The advent of artificial intelligence (or “AI”) has revolutionised the landscape of trademark law, particularly in the area of trademark searches and registration. Traditionally, trademark professionals and businesses conducted trademark searches by manually searching databases of registered trademarks. However, with the emergence of AI, trademark searches can now be conducted more efficiently using algorithms that can analyse vast databases to identify potential conflicts with existing trademarks in a fraction of the time it would take a human. By enhancing the accuracy and thoroughness of trademark searches, AI tools ultimately expedite the process of trademark registration, allowing businesses to secure their brand identities more swiftly and effectively.

13. The impact of AI is not confined solely to the early stages of trademark registration. It also extends into the domain of trademark enforcement. AI-powered systems enable trademark owners to monitor the usage of their trademark across various digital platforms, including websites, e-commerce sites and social media. AI's capacity to swiftly detect and respond to trademark infringements and counterfeit goods is invaluable in protecting the integrity of trademarks in an ever-expanding online marketplace. As technology continues to advance, so do the methods employed by infringers, making AI-driven protection of trademarks all the more crucial. This evolving landscape necessitates an agile approach to trademark law that can adapt to the rapid changes in technology, ensuring that trademarks remain a robust and enforceable means of safeguarding brand identities in an increasingly digital and interconnected world.

14. While AI has undoubtedly yielded numerous benefits in the realm of trademark law, it has also introduced unique challenges in respect of trademark infringement. AI tools require texts, images and parameters for use as training data. However, such data is often scraped from the web without the creator's consent, leading to potential trademark infringement. This problem was illustrated in a lawsuit filed earlier this year in the United States by the stock photography company, Getty Images against Stability AI, the creator of an AI art generator.⁴ Through the lawsuit, Getty Images accused Stability AI of copying over 12 million images from its database without its permission, including distorted versions of the Getty watermark, thereby infringing its trademark.

⁴ *Getty Images (US), Inc v Stability AI, Inc*, Case No. 1:23-cv-00135-GBW (United States District Court for the District of Delaware).

15. Furthermore, there have been concerns regarding trademark infringement in the context of creative outputs generated by AI platforms. AI-powered bots and algorithms can autonomously generate content, logos or product designs that bear similarities to existing trademarks, potentially causing confusion among consumers or diluting the distinctiveness of established brands. Thus, the very technology designed to assist in trademark protection can paradoxically contribute to the proliferation of trademark infringement, underscoring the need for careful oversight and regulation in the evolving landscape of AI and trademark law.

16. Another intriguing facet of the digital era that is reshaping the trademark landscape is a novel asset class known as Non-Fungible Tokens (or “NFTs”). In essence, NFTs are uniquely identifiable tokens that are stored on a digital ledger using blockchain technology. As NFTs are completely unique and cannot be exchanged like-for-like, their sale and trade have gained prominence in recent times following the tokenising of virtual artworks on NFT platforms. However, this trend of tokenisation has been deemed problematic from a trademark perspective as there have been instances where trademarked words, logos, designs or silhouettes have been turned or incorporated into various NFTs without the prior approval of the trademark owner.

17. The application of trademark laws in the context of NFTs was recently considered in the United States in the case of *Hermès v Rothschild*.⁵ The defendant in this case had created and sold one

⁵ *Hermès International, et al. v Mason Rothschild*, Case No. 1:22-cv-00384-JSR (United States District Court for the Southern District of New York).

hundred NFTs known as MetaBirkins, which showcased digital handbags featuring bright fur designs in the iconic ‘Birkin’ style. This prompted Hermès, the French luxury goods giant that produces the Birkin bags, to initiate a lawsuit against the defendant for trademark infringement. Hermès claimed that the defendant’s usage of the name “MetaBirkins” had misled consumers into believing that the NFTs are affiliated with the Hermès brand, allowing the defendant to profit off of the brand’s goodwill.

18. At the time the claim was commenced by Hermès, the registration of its “BIRKIN” trademark was limited to physical goods. One of the key issues that accordingly arose in the case was whether the trademark protection for physical goods extended to virtual goods. The jury in the case did not expressly address this issue, but found the defendant’s creation and sale of the MetaBirkin NFTs as constituting trademark infringement.
19. It is incontrovertible that the impact of emerging technologies on trademark law is poised to grow as these technologies become more advanced and sophisticated. Therefore, it would be unwise to force technology to adapt to existing trademark laws. Instead, trademark laws should be interpreted and even modified, if necessary, to effectively accommodate the novel dimensions introduced by technology to trademark issues.
20. In addition to exploring interesting questions about the interplay between trademark law and emerging technologies, this workshop will also delve into the crucial subject of preliminary injunctions. A preliminary injunction is one of the most powerful weapons in the

arsenal of a trademark owner. It enables the prompt cessation of any trademark infringement and preserves the status quo pending the full ventilation of the dispute at trial.

21. A particular form of preliminary injunction that has garnered increased attention in recent years is the dynamic blocking injunction. In the context of the modern internet, a regular blocking injunction targeting a specific domain or website with infringing content can easily be circumvented by relocating the same content to another domain or website. A dynamic blocking injunction seeks to address this conundrum by requiring internet service providers (or “ISPs”) to further block any new domain names, URLs or IP addresses that provide access to the infringing content. The development and refinement of dynamic blocking injunctions presents a delicate balancing act between the countervailing interests of trademark owners and ISPs. We can certainly look forward to a stimulating discussion on how this emerging issue has been handled across different jurisdictions.
22. The final topic that will be covered in this workshop is the concept of bad faith in relation to trademark registrations. In trademark law, bad faith refers to the intentional and dishonest use or registration of a trademark with the intention to deceive consumers or unfairly compete with other businesses. Our speakers today will dissect two recent cases that discuss the application and interpretation of this evolving concept.
23. Two significant cases have recently brought the issue of bad faith trademark registration to the forefront. Firstly, the Singapore High

Court's decision in Triple D Trading Pte Ltd v Fanco Fan Marketing Pte Ltd⁶ highlighted a scenario where the plaintiff was found to have registered a trademark in bad faith, aiming to leverage the goodwill associated with a similar existing trademark held by the defendant. This case underscores the critical implications of bad faith registration on the integrity of the trademark system and the protection of existing goodwill.

24. Secondly, the pending appeal before the UK Supreme Court in SkyKick UK Ltd and another v Sky Ltd⁷ and others has captured considerable attention within the legal and business communities. This appeal centers on the allegation that the respondent registered its trademarks for an excessively broad range of goods and services, some of which are beyond the scope of its core business, without any genuine intention to utilize the marks for those specific goods and services. This case is poised to play a pivotal role in shaping the legal landscape concerning bad faith trademark registration under UK law.
25. The decision of the UK Supreme Court is highly anticipated as it is expected to provide much-needed clarity on the test for determining a bad faith trademark registration. This landmark ruling will not only influence the interpretation and application of trademark law but also have broad implications for businesses, legal practitioners, and trademark owners navigating the intricacies of trademark registration and protection. The outcome of this appeal is poised to set a definitive precedent, offering guidance and establishing a consolidated framework for addressing bad faith trademark

⁶ Triple D Trading Pte Ltd v Fanco Fan Marketing Pte Ltd [2022] SGHC 226.

⁷ SkyKick UK Ltd and another (Appellants) v Sky Ltd and others (Respondents), Case ID: 2021/0181 (UK Supreme Court).

registrations, thus contributing to the overall integrity and effectiveness of the trademark system.

26. The topics that I have outlined thus far are at the forefront of IP discussions globally. As such, I am confident that the insights and knowledge we gain throughout the course of this workshop will pave the way for us to effectively address the opportunities and challenges presented by the ever-evolving landscape of IP law in the ASEAN region.
27. As I draw this address to its close, I must place our profound gratitude to the steadfast support of the officials from the International Trademark Association (INTA). Their unwavering support has been an instrumental pillar in the planning and execution of this workshop. Furthermore, I want to extend my heartfelt appreciation to all the speakers and participants who have joined us today virtually. You've transcended geographical barriers and time zone differences to be with us, demonstrating a commendable dedication to the cause. The support and the strength of your engagement have indeed been a testament to the significance of this gathering.
28. In closing, I wish us all a fruitful and enriching workshop.

Thank you.