



2023 AIPPI World Congress – Istanbul
Adopted Resolution
25 October 2023

Resolution

2023 – Study Question – Trade Mark

Proving trade mark use

Background:

- 1) This Resolution concerns proving trade mark use. It focuses on proving use in the context of the genuine use requirement of a trade mark to maintain trade mark registration and does not address proving use to acquire reputation or distinctiveness of a trade mark or proving infringing use.
- 2) The subject of trade mark use was studied in several AIPPI Resolutions, such as Q218 “The requirement of genuine use of trade marks for maintaining protection (2011)”, Resolution Q70 “Impact of Use on Maintenance and Renewal (1978)” and Resolution Q168 “Use of a Mark as a Legal Requirement (2002)”. AIPPI also published its Law Series Book “Genuine Use of Trademarks” in 2018 and 2021 introducing the legal provisions and practice about trade mark use in various jurisdictions. Due to its high practical relevance and the emergence of

new challenges and questions, for instance use in virtual worlds, more extensive study and this Resolution are justified.

- 3) 41 Reports were received from AIPPI's National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (which can be found at www.aippi.org).
- 4) At the AIPPI World Congress in Istanbul in 2023, the subject matter of this Resolution was further discussed within a dedicated Study Committee, and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.

AIPPI resolves that:

- 1) There should be no quantitative minimum level or duration threshold for the evidence required to prove genuine use of a trade mark in the relevant period.
- 2) There should be no restrictions on the type of acceptable evidence to demonstrate genuine use. All such evidence should be given appropriate weight according to the circumstances of the case, based on the overall assessment of the entire evidence submitted.
- 3) Reputable/well-known/famous/historical trade marks should be subject to the same evidential requirements for proof of genuine use as any other trade mark.
- 4) The evidence of use should indicate the place, time, extent and nature of such use. Nevertheless, it should not be required to demonstrate such specific information for every single piece of evidence, and the evidence should be considered and assessed as a whole.

- 5) The law and practice relating to the evidential requirements for proving genuine use of a trade mark should be consistent before courts and before IP offices/administrative tribunals. The law and practice relating to the evidential requirements for proving genuine use of a trade mark should not impose undue or excessive burdens on trade mark owners in proving genuine use.
- 6) The use of a trade mark in a form differing from the form as registered, in elements which do not alter the distinctive character of the trade mark as registered, should be accepted as use of the trade mark as registered. This assessment should be carried out on a case-by-case basis. In particular, the following factors should be considered when judging whether the use of the variation should be accepted as genuine use of the registered trade mark:
 - a) whether the relevant public perceives them as the same mark;
 - b) the degree of distinctiveness of the registered trade mark and of the variation;
 - c) the features of the industry in which the trade mark is used and the business customs of the industry in relation to trade mark use.
- 7) Subject to paragraph 6 above, in general, the following variations should be viewed as not altering the distinctive character of the registered trade mark:
 - a) non-distinctive elements are added to or omitted, partially or wholly, from the registered trade mark;
 - b) the font, size, and/or colour of the registered trade mark is changed, partially or wholly:
 - i. in case of a word trade mark, as long as the word remains identifiable in the form used;

- ii. in case of a figurative trade mark, as long as the variation consists of characteristics which are not essential to the distinctive character of the registered trade mark;
 - c) the layout of the different elements in the registered mark is changed, for instance, changing the up-and-down arrangement into a left-and-right arrangement;
 - d) the registered trade mark is used in conjunction with another trade mark or in conjunction with its transliteration.
- 8) Online use of a trade mark, e.g. on the internet, on a website or in social media except as provided in paragraphs 10 and 11, may constitute genuine use. The criteria for assessing such use should generally be the same as for non-online use, and applied on a case-by-case basis.
- 9) In particular, the following factors should be taken into account when assessing whether the online use of a trade mark should be accepted as genuine use in a particular jurisdiction in which the trade mark is registered:
- a) whether there is a sale of goods or provision of services made to the relevant public from that jurisdiction;
 - b) whether there is content targeting the relevant public in that jurisdiction, including:
 - i. whether there is use of a local language of the jurisdiction;
 - ii. whether payment in the local currency of that jurisdiction is allowed;
 - iii. whether local contact details such as telephone numbers, addresses etc. are provided;
 - c) whether a trade mark owner conducts economic activity or has an economic connection in that jurisdiction in connection with the goods or services.

- 10) The determination of whether the use of a trade mark in a virtual world/metaverse also counts as the genuine use of the trade mark in relation to non-virtual goods/ services should be made according to the circumstances of each case. Among other things, the purpose of using the trade mark in the virtual world/metaverse, and its relationship with the non-virtual goods/services, as well as the perception of the relevant public, should be taken into account.
- 11) In particular, the following factors should be taken into account when assessing whether the use of a trade mark in a virtual world/metaverse should be accepted as genuine use in a particular jurisdiction:
 - a) whether the relevant public in the jurisdiction has access to and participates in the virtual world/metaverse;
 - b) whether there are any promotional activities targeting the relevant public in the jurisdiction by the user of the trade mark or the provider of the virtual world/metaverse;
 - c) whether the virtual world/metaverse provides the option of using a local currency of the jurisdiction;
 - d) whether the virtual world/metaverse provides the option of using a local language of the jurisdiction.
- 12) Circumstances beyond the control of the trade mark owner should be a valid justification for non-use, and such reasons should be considered on a case-by-case basis. In particular, the following reasons should be considered as valid justifications for non-use of the trade mark within the territory or part of the territory in which the trade mark is registered:
 - a) force majeure;
 - b) policy restriction or prohibition;

- c) requirement of a mandatory licence or marketing authorization, which takes a long time to obtain.
- 13) The burden of proof to justify non-use in the case of a widely known event, such as the COVID-19 pandemic, should be the same as otherwise, except that there should be no need to prove the fact of such an event widely known in the relevant jurisdiction. Nevertheless, it should still be necessary to prove proper reasons for non-use beyond the control of the trade mark owner, and beyond the mere fact of the widely-known event.