



Report 1: 2023 AIPPI World Congress – Istanbul – Trade marks resolution

Thanks to the generous support of the Belgian AIPPI Group, I was able to attend the annual AIPPI World Congress in Istanbul in October 2023. In what follows, I will provide a report of the congress, and more in particular on the adopted Resolution on “*proving trade mark use*”.

I. General remarks

The congress did not have one overarching theme or subject. However, one of the recurring topics in various sessions that I attended during the congress, and which were discussed outside the sessions amongst attendees, concerned the impact of artificial intelligence (“AI”) on intellectual property (“IP”). Both challenges and opportunities were highlighted on different occasions.

The intersection between AI and IP poses a number of challenges. Issues such as determining the authorship, ownership, liability, and ethical considerations surrounding AI-generated works all require careful legal and policy considerations. There are many questions, with little answers at the moment.

However, AI also brings about opportunities. AI could be used to optimize IP strategies, and enable more efficient IP portfolio management. An example frequently given during the congress was that AI is being used to improve the efficiency of patent searching and analysis. As AI tools become more advanced, they might be able to identify and assess potential patent infringement more quickly and accurately.

Furthermore, digital watermarking and blockchain technology can be used to prevent the unauthorized use of IP, or at the very least, could make it easier to track down infringers.

Administrative bodies, such as IP offices, could also benefit from using AI tools in the course of their own activities. This may include the determination of whether an application fulfils the respective protectability requirements. In this respect, it was underlined that AI tools should not replace humans in the examination of applications but might compliment a human examiner. AI tools could help to establish more coherent decision-making within and across IP offices. This being said, the digitization and automation of IP office processes must maintain, or should even improve, the procedural protection for applicants and should strive to render their AI tools transparent and explainable.

It is clear that as AI continues to advance, it is crucial to adapt IP frameworks to effectively address these emerging challenges and opportunities.



II. Study questions and resolutions

Prior to and during the congress, I had the opportunity to prepare for and participate in the Study Committee and subsequent Plenary Session on the trade mark related study questions on “*proving trade mark use*”.

It was not the first time the subject of trade mark use was studied in an AIPPI Resolution. In 2011, a resolution (Q218) was adopted on “the requirements of genuine use of trade marks for maintaining protection”. In addition, resolutions have been adopted as regards “Use of a Mark as a Legal Requirement” (Q168) and “Impact of Use on Maintenance and Renewal” (Q70) in 2002 and in 1978 respectively. Furthermore, in 2018 and 2021, AIPPI published its first and second editions of the Law Series Book “Genuine Use of Trademarks”, which contains a comparative study of the legal provisions and practice across multiple jurisdictions, including the Benelux.

The objective of this year’s study question was to re-examine the current use requirement for trade marks. The underlying reason for this is clear, as trade mark use is an essential and fundamental requirement under trade mark law. Therefore, the practical relevance for trade mark holders and practitioners alike cannot be understated. Furthermore, this Resolution sets out to examine how the law on trade mark use should be developed going forward, as new technology emerges, particularly the use of the mark online and in virtual worlds. These new developments pose uncertainty, and hence further guidance is needed. A key finding showed that over 90% of the National Regional Groups agreed that there should be harmonization in this respect.

From a linguistic point of view, it should be clarified that the adopted Resolution distinguishes between the words ‘use’ and ‘genuine use’. The adopted Resolution uses ‘use’ in relation to facts (i.e. the usage of the trade mark) and ‘genuine use’ in relation to the legal requirement or evidential requirement.

Based on the National Regional Group reports, there was a clear consensus on several points on how to prove trade mark use. Paragraphs one to four invoked little substantive debate during the Study Committee, nor during the Plenary Session. A large majority agreed that:

- 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. Therefore, no *de minimis* rule applies;
- the use must be more than merely token, which means that it must not serve solely to preserve the rights conferred by the registration;
- there should be no restrictions on the type of acceptable evidence to demonstrate genuine use;
- the same evidential requirements for proof of genuine use apply for reputable or well-known trade marks;
- the evidence of use should indicate the place, time, extent and nature of such use.



An important point was agreed upon in paragraph 5 of the Resolution. Leadership of the Study Committee expressed that during the preparatory work of the draft Resolution, it was heavily debated whether “the law relating to the evidential requirements for proving genuine use of a trade mark should be consistent before courts and before administrative bodies” should be included in the Resolution. In a turn of events, 100% of the voting members of the Study Committee agreed with this paragraph. When discussing this paragraph in the Plenary Session, the UAE Group proposed an amendment which aimed for further harmonization, by stating that: “the law and practice relating to evidential requirements for proving genuine use of a trade mark should be consistent before courts and before IP offices/ administrative tribunals”. During the Plenary Sessions, 70% of voting members agreed to the amendment, which led to its adoption. Subsequently, 95% of voting members agreed to the paragraph as a whole.

Paragraphs 6 and 7 concern the use of the trade mark in a form different from the registered form. Naturally, it was agreed upon that 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. However, there was some debate as to how this *in concreto* assessment should be carried out. Leadership of the Study Committee proposed to include three factors which were most commonly found across the reports from National Regional Groups. These factors should facilitate the assessment of whether the variation can be accepted as use of the registered trade mark. The list of factors in paragraph 6 included in the Resolution should therefore be interpreted as an exemplative list and not an exhaustive one.

Similar comments apply for the specific variations listed under paragraph 7, as these examples are merely included for illustrative purposes and are by no means exhaustive. The example under paragraph 7, c) caused some debate during the Plenary Session. The Dutch Group took issue with this example and its broad formulation and tried to include a disclaimer. Due to the inclusion of a general disclaimer by referring to the conditions laid out under paragraph 6 at the beginning of paragraph 7, any amendments proposed were ultimately unsuccessful and the sub-section of this paragraph remained unaltered in its adoption.

In paragraph 7, d), the UAE Group proposed an amendment to one of these examples to include the circumstance where the registered trade mark is used in conjunction with its transliteration (i.e. a conversion of the original language term into an identical sounding term in the local language). This circumstance is particularly relevant for jurisdictions that use non-Latin characters. A large majority agreed that the use of this type of variation does not alter the distinctive character of the registered mark and should therefore be accepted as use of this trade mark. This amendment was therefore agreed upon.

The most controversial part of the Resolution centered around the use of the trade mark in an online context. The issue is of great practical relevance when a trade mark owner can show online use, and offer of goods or services, in the territory concerned, but does not have actual sales of goods or provisions of services in the territory. The Canadian Group explained that the use of a trade mark on an internet web page does not constitute genuine use, as it does not (necessarily) relate to a sale of a good. Different rules apply as it relates to the provision



of services under Canadian law. In this context, the Canadian Group proposed to include an amendment that would clarify that the qualification of use in an online context depends on the applicable laws of the jurisdiction. After some discussion during the Plenary Session, the Canadian Group withdrew its proposal, as it would interfere with AIPPI's main objective, namely harmonization. It was agreed upon that online use may constitute genuine use. This thesis was not further debated.

However, questions arose around the particular terminology used. The original wording of paragraph 8 and 9 stated that "the use of a trade mark on the internet / website may constitute genuine use". A discussion arose around the scope of the "the internet", "website" and "online". The latter being broader, as it includes other online uses that do not solely center around websites but also include, for example, apps installed on a mobile device. This issue arose during the Study Committee, and again during the Plenary Session. After having discussed various definitions proposed by different working groups for these concepts, it was decided that delineating these concepts in a clear and concise manner would be too difficult and probably a task best suited for engineers, not legal practitioners. During the Plenary Session, it was agreed upon that "use of a trade mark on the internet / on a website" should be replaced by the broader term "online use of a trade mark".

Paragraphs 10 and 11 specifically deal with the use of the trade marks in virtual worlds (such as, for example, the Metaverse, Roblox or Horizon Worlds) in relation to non-virtual goods and/or services. From my understanding, this would encompass a situation where goods or services which exist in the "real world" (for example, a Peugeot 206) are modelled or otherwise depicted in a "virtual world" (for example, purchasable by players as an item in Roblox).

In principle, when proving the use of a registered trade mark, the place of the use should be indicated. Given the broad geographic territory of a virtual world, how should the place of use of the trade mark be determined? After some discussion, it was agreed that use in the virtual world could constitute use for non-virtual goods. In paragraph 11, guidance is provided on which factors should be considered when assessing such use for a particular jurisdiction. Promotional activities targeting the relevant public, using a local currency and local language in the jurisdiction are all taken into account. Furthermore, whether the relevant public in the jurisdiction has access to and participates in the virtual world should be considered as well.

Lastly, several National Groups raised concern that it is not sufficiently clear what is meant by use "online" and use "in virtual worlds", and whether there is a degree of overlap in these concepts. Initial ideas to further clarify this by way of definitions, were not retained in the final text of the Resolution. Leadership announced that trade mark use in the virtual world might be a topic to explore further in the years to come, maybe by way of a separate Resolution.

In paragraph 12, a non-exhaustive list is included of circumstances that can be considered valid justifications of non-use of a trade mark. An important and needed territorial clarification to this paragraph came from the Irish Group. The reasons can only be considered valid justification of non-use of the trade mark "within the territory or part of the territory in which the



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trade mark is registered". Conversely, circumstances outside of the territory cannot be considered as justifications of non-use of the trade mark within the territory.

The Resolution as a whole was approved by 99.4% and subsequently adopted at the Executive Committee.

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