



2022 AIPPI World Congress – San Francisco
Adopted Resolution
13 September 2022

Resolution

2022 – Study Question – Trade Marks

Trade Marks and the Internet and Social Media

Background:

- 1) This Resolution concerns the use and protection of trade marks on the internet and social media. This includes websites and online platforms (including online marketplaces).
- 2) This Resolution concerns issues related to trade mark infringement. It does not address any use requirements for trade mark registration or maintenance, nor other trade mark invalidity grounds.
- 3) The issue of conflicts between trade marks and domain names (addressed in the Resolution for Q143) is not addressed in this Resolution. Additionally, the use of the trade mark and issues related to trade mark infringement in the Metaverse and NFTs are not addressed in this Resolution.
- 4) 44 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 (see link below).
- 5) At the AIPPI World Congress in San Francisco in 2022, 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) Use of a trade mark on the internet or social media should constitute a use which can be infringing, so long as the necessary elements of infringing use under national law are met.
- 2) Providing that any other requirements for infringement are met, infringement of a trade mark will arise where, inter alia, the following acts on the internet or social media occur without the permission of the trade mark owner:
 - a. use of the trade mark to offer, sell, promote or advertise a product or service online;
 - b. use of the trade mark as the name of a social media account or an online shop name;
 - c. use of the trade mark as a keyword;
 - d. use of the trade mark as a metatag;
 - e. use of the trade mark as a hashtag;
 - f. use of the trade mark to endorse or promote another party's product or service.
- 3) A court, tribunal or competent authority shall have jurisdiction to determine whether any uses on the internet or social media infringe a trade mark enjoying protection in that jurisdiction, if that website, online platform or social media is accessible in that jurisdiction and there are other factors, indicated in paragraph 4 below, liable to have an effect in that jurisdiction, making that jurisdiction the appropriate forum.
- 4) The following factors in particular shall be regarded as relevant to determine jurisdiction pursuant to para. 3:
 - a. whether goods/services/content are supplied to consumers in that jurisdiction by the unauthorised user of the trade mark on that website, online platform or social media;
 - b. whether there is any content targeting consumers in that jurisdiction by the unauthorised use of the trade mark on that website, online platform or social media;
 - c. whether the website, online platform or social media allows payment in the local currency of that jurisdiction;
 - d. whether the website, online platform or social media uses local contact details such as telephone numbers, addresses etc.;
 - e. whether the unauthorised user of the trade mark on the website, online platform or social media has any presence or place of business or uses any logistical services in that jurisdiction; and/or
 - f. whether the website, online platform or social media uses a local language of the jurisdiction, including use of call centers using local language of that jurisdiction.

- 5) Online platforms should provide expedited and efficient mechanisms to enforce trade mark rights on their platforms, including notice and take-down procedures and at least three of the following as a minimum:
 - a. stay-down procedures;
 - b. shut down of a seller, an online shop or marketplace;
 - c. a list of registered trade marks that are in use notified to the online platform;
 - d. the ability for a user of a trade mark in an online platform to indicate authentic product verification; and
 - e. a mechanism for investigating and informing the trade mark owner of any potential infringement on their platform and supplying the contact details of any potential infringer.

- 6) Social media influencers should be liable for their endorsement, undertaken in a commercial context, of a product or service which infringes another party's trade mark.

Link:

- [Summary Report](#)