

View results

Respondent

15

Anonymous

11:30

Time to complete

Contact details

Kindly submit your and your groups contact details below. Please also include the authors of the reports.

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I. Current law and practice

Please answer the below questions with regard to your Group's current law and practice.

5.

1) In your Group's current laws or regulations, are there any provisions that specifically concern trade mark protection on the internet or social media? Please answer YES or NO. If YES, please list these.

Yes

No

6.

1) (continued) Please add any comments below.

7.

2) Is there any authority in the country or region of your Group which deals with trade mark infringement matters on the internet or social media, which is different from the authority for traditional off-line trade mark infringement matters? Please answer YES or NO. If YES, please specify.

Yes

No

8.

2) (continued) Please add any comments below.

9.

3) Is there any special mechanism/procedure available in the country or region of your Group to handle trade mark infringement matters on the internet or social media? Please answer YES or NO. If YES, please clarify.

Yes

No

10.

3) (continued) Please add any comments below.

11.

4) What ways of use of a trade mark on the internet and social media might constitute trade mark infringement if there is no permission from the trade mark owner? Please choose one or more answers from the following choices:

a) use to sell a product or service online;

b) use as a keyword (in a search engine or ranking at a platform);

c) use as a metatag;

d) use as a hashtag;

e) use in a review posting;

f) use as the name of a social media account or an online shop name;

g) use for a comparison;

h) use to endorse or promote another party's product or service;

Other

12.

4) (continued) Please add any comments below (optional).

The Australian Trade Marks Act 1995 (Cth) does not distinguish between online and offline infringement of a trade mark (TM). It is therefore necessary to examine the general infringement provisions and consider how they would apply to each of the online uses raised by (a)-(f) of the Study Question. General principles applicable to online sphere The Australian Act distinguishes between three forms of infringing use. Use by the defendant of the plaintiffs' registered TM as a sign in relation to: (1) goods or services in respect of which the TM is registered; (2) goods or services of the same description or closely related to that for which the TM is registered; and (3) goods or services which are unrelated. Goods or services in respect of which the TM is registered For category (1), infringement is established if the defendant used, as a TM, a sign that was substantially identical with, or deceptively similar to the plaintiff's TM (s 120(1)). Goods or services which are of the same description or closely related For category (2), there will be no infringement if the defendant establishes the use was not likely to deceive or cause confusion (s 120(2)). Well-known marks For category (3) it is necessary to establish that the plaintiff's TM was 'well-known' and that by reason of it being well known 'the sign would be likely to be taken as indicating a connection' between the unrelated goods or services and the registered owner of the TM (s 120(3)(c)). Moreover, the plaintiff must establish that as a result that 'interests of the registered owner are likely to be adversely affected' (s 120(3)(d)). Specific principles applicable to online sphere • Use of TM by defendant as badge of origin constitutes infringement: It is relevant to note that all three of the above infringement scenarios require the plaintiff to establish that the defendant did not merely use the sign but used the sign as a TM or a badge of origin: Edgetec International Pty Ltd v Zippykerb (NSW) Pty Ltd (2012) 98 IPR 1. This is particularly relevant in the online scenarios noted in the Study Qs. For example, it may be possible for a defendant to establish that the use of the sign was not use as a TM but was instead for another purpose such as a hashtag or keyword. • Use of TM by defendant to describe plaintiff's good not infringement: Again, this is particularly relevant in the online sphere. For example, a social media influencer can argue that the use of a TM was to describe the nature and quality of the plaintiff's goods. If it can be established that the defendant used the plaintiff's TM as a badge of origin, infringement can be established. The precise requirements to be established by the plaintiff will depend on the nature of the allegedly infringing use (see categories 1-3 above). If the plaintiff's TM is well-known in Australia, TM infringement may also be established where the defendant's goods are unrelated goods to those of the plaintiff. While, the term 'well-known' TMs is not defined, s 120 (4) provides that in deciding whether a TM is well-known in Australia, the decision-maker must take account of the extent to which the TM is known within the relevant sector of the public, whether as a result of the promotion of the TM or for any other reason. In Lamont v Malishus (No.4) [2019] FCCA 3206, 14 November 2019, Justice Manousaris of the Federal Court found that the defendant had infringed the TM of the plaintiff, 'MALISHUS', through use of that word on Facebook pages offering for sale clothing in Australia bearing that word. As a result of the Federal Court case of Veda Advantage Limited v Malouf Group Enterprises Pty Limited [2016] FCA 255 (Veda), the Australian law in this area is clear. Where a defendant uses a registered TM as a keyword in a search engine (in this case, the Google Adwords service) such use does not constitute infringement. This is because the keywords are not seen by users.

13.

5) Are there any different tests applying to online trade mark infringement compared with traditional off-line trade mark infringement? Please answer YES or NO. If YES, please specify.

- Yes
 No

14.

5) (continued) Please add any comments below.

15.

6) What factors are taken into account when assessing whether there is jurisdiction regarding the use of a trade mark online (on a website or app)? Please choose one or more answers from the following choices:

- a) whether the consumers in your country or region can access the website or app;
- b) whether the server of the website or app is located in your country or region;
- c) whether the website or app uses a local language of your country or region;
- d) whether the website or app allows to pay in the local currency of your country or region;
- e) whether goods/services are delivered to consumers in your country or region by the user of the trade mark on that website or app;
- f) whether there is any business facility of the user of the trade mark in your country or region;
- g) whether there are any promotional activities targeting consumers in your country or region by the user of the trade mark;
- Other

16.

6) (continued) Please add any comments below (optional).

The High Court decision in *Dow Jones v Gutnick* (2002) 210 CLR 575 is the leading Australian authority on online jurisdiction. While the case dealt with online defamation, the principles can be extrapolated to the present context. Further, the case of *Lamont v Malishus* (No 4) [2019] FCCA 3206 provides useful principles on establishing jurisdiction in domain name disputes. Again, while not on TMs, useful insights can be gained. On the basis of the High Court in *Dow Jones* emphasis of the place where online material is read/viewed, it would seem that the use of a local language in the country would be relevant in establishing jurisdiction. This is supported by *Malishus* in which the Federal Court held that where a party directed or 'targeted' their service to Australian consumers, it would support a finding of jurisdiction in Australia. The use of a local language would be strong evidence that the jurisdiction was targeted. *Dow Jones* – It is the place of downloading of material, not the uploading of material, that is relevant to determining jurisdiction. Nb: with respect to assessing jurisdiction in matters concerning use of TMs in virtual reality worlds, e.g. the Metaverse, Australian courts haven't considered this yet.

17.

7) a) Can the use of another party's trade mark as a keyword in keyword search advertisement services^[1] without the trade mark owner's permission infringe that trade mark? Please answer YES or NO.

[1] Keyword search advertisement refers to such an advertisement wherein the information about the keyword buyer or any party the buyer appoints appears alone in the search result or in the front or at a prominent position of the search results when one conducts the search with such keyword.

Yes

No

18.

7) a) (continued) Please add any comments below (optional).

19.

7) b) If YES, under which conditions is trade mark infringement established?

20.

8) a) Do one or more online market platforms in the country or region of your Group^[2] provide services to stop trade mark infringement on their platform? Please answer YES or NO.

[2] Herein "online market platforms in the country or region of your Group" refers to those local online market platforms or those international ones that operate in your country or region.

Yes

No

21.

8) a) (continued) Please add any comments below (optional).

22.

8) b) If YES, what services are provided? Please tick the below boxes that apply (in the comment box you may specify if these differ for different platforms):

- notice and take-down
- shop-shut down
- initiative policing and investigation of trade mark infringement
- authentic products verification
- trade mark recording system
- Other

23.

8) b) (continued) Please add any comments below (optional).

Australians have access to a variety of user reporting interfaces. Leading social media sites, including Facebook, Instagram and Twitter, provide such services. These companies will take down content that violates their terms and conditions. In addition, Amazon's Brand Registry has a TM recording system that helps registered owners protect their TMs. Beyond such private systems, users can report misleading or deceptive TM use to the Australian Competition and Consumer Commission. However, IP Australia is not involved in TM surveillance and protection. Its website notes '[a]s the owner of intellectual property (IP) rights, it's your responsibility to ensure you enforce them. We will not police your rights or launch legal proceedings on your behalf. Effective enforcement of your IP rights is necessary to maintain their value in legal terms, to deter potential infringers and to retain the ability to attract commercial value'. <https://www.ipaustralia.gov.au/ip-infringement/enforcing-your-ip>

24.

9) a) According to your Group's current laws and practice, can a social media influencer bear liability for his or her endorsement of a product or service infringing another party's trade mark? Please answer YES or NO.

- Yes
- No

25.

9) a) (continued) Please add any comments below (optional).

26.

9) b) If YES, under which conditions is trade mark infringement established?

If a social media influencer establishes that another party's trade mark was merely used to describe the nature or quality of this other party's goods, infringement will not be established. However, if the public would reasonably assume that this other party's services were those of the trade mark owner, infringement, will be established. This is a question of fact to be determined with regard to the 'purpose and nature of the use in its context. Edgetec International Pty Ltd v Zippykerb (NSW)

II. Policy considerations and proposals for improvements of your Group's current law

27.

10) a) Could your Group's current law or practice relating to the use by third parties of trade marks on the internet and social media be improved? Please answer YES or NO.

- Yes
- No

28.

10 a) (continued) Please add any comments below (optional).

29.

10 b) If YES, please explain how or in what way it should be improved.

30.

11) Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

- Yes
 No

31.

11) (continued) Please add any comments below (optional).

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

32.

12) Do you believe that there should be harmonisation in relation to trade mark protection on the internet and social media? Please answer YES or NO.

If YES, please respond to the following questions without regard to your Group's current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved

- Yes
 No

33.

12) (continued) Please add any comments below (optional).

34.

13) Should there be any provisions that specifically concern trade mark protection on the internet or social media? Please answer YES or NO.

- Yes
 No

35.

13 (continued) Please provide any comments below (optional).

36.

14 Should there be any authority to deal with trade mark infringement matters on the internet or social media, which is different from the authority for traditional off-line trade mark infringement matters? Please answer YES or NO.

Yes

No

37.

14 (continued) Please provide any comments below (optional).

38.

15 Should there be any special mechanism/procedure to handle trade mark infringement matters on the internet or social media? Please answer YES or NO.

Yes

No

39.

15 (continued) Please provide any comments below (optional).

40.

16 What ways of use of a trade mark on the internet and social media should constitute trade mark infringement if there is no permission from the trade mark owner? Please choose one or more answers from the following choices:

a) use to sell a product or service online;

b) use as a keyword (in a search engine or ranking at a platform);

c) use as a metatag;

d) use as a hashtag;

e) use in a review posting;

f) use as the name of a social media account or an online shop name;

g) use for a comparison;

h) use to endorse or promote another party's product or service;

Any other use of a trade mark as a trade mark w/

41.

16 (continued) Please add any comments below (optional).

42.

17) Should there be any different tests applying to online trade mark infringement compared with traditional off-line trade mark infringement? Please answer YES or NO. If YES, please specify.

- Yes
 No

43.

17) (continued) Please provide any comments below.

44.

18) What factors should be taken into account when assessing whether there is jurisdiction regarding the use of a trade mark online (on a website or app)? Please choose one or more answers from the following choices:

- a) whether the consumers in the country or region can access the website or app;
 b) whether the server of the website or app is located in the country or region;
 c) whether the website or app uses a local language of the country or region;
 d) whether the website or app allows to pay in the local currency of the country or region;
 e) whether goods/services are delivered to consumers in the country or region by the user of the trade mark on that website or app;
 f) whether there is any business facility of the user of the trade mark in the country or region;
 g) whether there are any promotional activities targeting consumers in the country or region by the user of the trade mark;
 Any other factors that tends to prove or disprove

45.

18) (continued) Please add any comments below (optional).

46.

19) a) Should the use of another party's trade mark as a keyword in keyword search advertisement services^[3] without the trade mark owner's permission infringe that trade mark? Please answer YES or NO.

[3] Keyword search advertisement refers to such an advertisement wherein the information about the keyword buyer or any party the buyer appoints appears alone in the search result or in the front or at a prominent position of the search results when one conducts the search with such keyword.

- Yes
 No

47.

19) a) (continued) Please provide any comments below (optional).

48.

19) b) If YES, under which conditions should trade mark infringement be established?

49.

20) a) Should online market platforms provide services to stop trade mark infringement on their platform? Please answer YES or NO.

Yes

No

50.

20) a) (continued) Please provide any comments below (optional).

51.

20) b) If YES, what services should be provided? Please tick the below boxes that apply:

notice and take-down

shop-shut down

initiative policing and investigation of trade mark infringement

authentic products verification

trade mark recording system

Other

52.

20) b) (continued) Please add any comments below (optional).

53.

21) a) Should a social media influencer bear liability for his or her endorsement of a product or service infringing another party's trade mark? Please answer YES or NO.

Yes

No

54.

21) a) (continued) Please provide any comments below (optional).

55.

21) b) If YES, under which conditions should trade mark infringement be established?

If a social media influencer establishes that another party's trade mark was merely used to describe the nature or quality of this other party's goods, infringement will not be established. However, if the public would reasonably assume that this other party's services were those of the trade mark owner, infringement, will be established. This is a question of fact to be determined with regard to the 'purpose and nature of the use in its context: Edegetec International Pty Ltd v Zippykerb (NSW)

Other

56.

22) Please comment on any additional issues concerning any aspect of trade marks and the internet and social media you consider relevant to this Study Question.

N/A

57.

23) Please indicate which industry/cultural sector views provided by in-house counsel are included in your Group's answers to Part III.

Professor of Technology law/ Legal Academic

