International Trademark Association

1250 Connecticut Avenue, N.W. Suite 700
Washington, D.C. 20036-2643, USA
T: +1-202-261-6570
inta.org

International Trademark Association Comments in Response to:
Request for Comments on Intellectual Property Protection for Artificial Intelligence Innovation

The International Trademark Association (INTA) appreciates the opportunity to provide comments in response to the USPTO's Request for Comments on Intellectual Property Protection for Artificial Intelligence Innovation. 84 Fed. Reg. 58,141 (Oct. 30, 2019), 84 Fed. Reg. 66,176 (Dec. 12, 2019).

With the rise in the use of artificial intelligence (AI) in the practice of law in general and by trademark registries specifically, INTA established a subcommittee within our Emerging Issues Committee to consider AI's impact on brand owners. The subcommittee produced two reports in 2019: the first being "Report on the Use of AI by IP Registries" which took a selected global look at the trend; and the second being "Artificial Intelligence (AI) and the Future of Brands: How will AI Impact Product Selection and the Role of Trademark for Consumers?" As these reports focused on trademarks, INTA's comments below, which are drawn from the reports, are limited to two questions posed by the USPTO.

INTA continues to develop its position on the various issues posed by AI and looks forward to working with the USPTO as it develops its own policies and procedures in applying AI to the registration process.

Question 7: Would the use of AI in trademark searching impact the registrability of trademarks? If so, how?

INTA has explored this issue by researching adoption by IP registries of artificial intelligence (AI) to learn how AI is currently being used. Nine IP registries responded to INTA's survey to share their internal practices (Australia, Chile, China, Japan, Norway, the Russian Federation, Singapore, EUIPO and the USA). The questionnaire asked registries to provide details of the AI solutions they had adopted (or were considering adopting), and what effect the implementation of these solutions had on their work. Registries were also asked to consider how implementation of these AI solutions affected (or would affect) the work of their examiners, other staff within their office, and other trademark professionals interacting with their offices.

Many of the registries that responded are in the early stages of adopting AI solutions. Of the nine respondent registries, five registries are still developing trademark image search systems, which incorporate AI. These registries are using databases of figurative trademarks and previous search results to train their search systems, with the search results being subject to evaluation and review by trademark examiners. Examiner feedback is then used to further improve the algorithms underlying the AI.

Registries in the developmental stages were hopeful that the incorporation of AI in their search systems would enhance search processes such as: (a) recognizing non-abstract elements, which enables the finding of conceptually similar, yet visually dissimilar marks; (b) finding conceptually similar words and devices from words of different languages; and (c) assisting in mark segmentation such that individual elements within a composite mark could also be searched.

It is evident that human review of AI-assisted search results is crucial particularly in the development stage, where feedback is used to fine-tune the underlying algorithms. Further, human feedback remains important in the implementation phase to ensure that AI search tools continue to be effective, consistent and accurate.

In conclusion, the use of AI by IP registries is gaining prevalence. AI technologies are beginning to be implemented in trademark searching, trademark examination and stakeholder interactions with the aim of improving the efficiency and consistency of the handling and processing of trademark registrations. As implementation of AI solutions by many of the respondent registries is in the early stages, the full extent of the possibilities is not yet clear with developments still being explored. Nevertheless, from the responses received, the trend among IP registries appears to be towards positive engagement with AI solutions, embracing and exploring the possibilities that artificial intelligence may provide in the prosecution and registration of trademarks.

Question 8: How, if at all, does AI impact trademark law? Is the existing statutory language in the Lanham Act adequate to address the use of AI in the marketplace?

Artificial Intelligence may have implications for brand owners seeking to protect the trademarks they own, which identify a particular source and level of quality that they have invested significant time and resources to establish in the marketplace. For example, if a customer makes an oral command to a virtual assistant or smart home device to "order BRAND X product" and, despite having specified a brand, is presented with various low cost or compatible alternatives, what recourse does a brand owner have? Moreover, what obligation does an AI provider have to intervene and prevent this type of consumer misdirection?

Many industry experts suggest the responsibility of AI providers should be akin to that of Internet search engine providers or web hosting providers.[1] While these existing policies (e.g., contributory infringement) may be a reasonable place to start, there are also some novel issues presented by the adoption of AI that may require a closer examination of the resulting impact on

[1] See https://www.lexology.com/library/detail.aspx?g=081aa32a-f9bc-4a89-8bce-6e5ea80c80ef; http://www.hgf.com/media/1173564/09-13-AI.PDF.

trademark law. Two notable considerations are the impact AI may have on how trademark examiners and courts think about "likelihood of confusion" and the "average consumer."[2]

Traditionally, trademark law has focused on the visual, conceptual, and phonetic similarity in assessing the similarity of two potentially conflicting trademarks. With AI being used instead of the "average consumer" in making product comparisons, perhaps these and other traditional concepts like "imperfect recollection" and a varying degree of care exercised by product price point no longer apply.[3] Instead, brand owners and trademark practitioners may need to re-evaluate the strength of infringement theories that rely principally on initial interest and point of sale confusion and instead explore theories of infringement that place greater emphasis on the harm caused by post purchase confusion.

Conclusion:

Again, INTA appreciates the opportunity to provide comments in response to this inquiry. We look forward to working with the USPTO on this issue going forward and will keep the agency apprised as the Association continues its research these issues and develops its position on AI. For more information about INTA's research and reports on these issues, please contact INTA's Director of Government Relations, Jennifer McDowell at jmcdowell@inta.org.

[2] The "average consumer" is a concept in both European and US trademark law used to assess whether two trademarks are confusingly similar. "The consumer who is to be protected from confusion by trademark law is not necessarily the sophisticated buyer who makes careful distinctions, but a hypothetical 'average consumer.'" *See* 1 Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 2:22 (5th Ed. 2017).

[3] *See* https://www.wipo.int/pressroom/en/articles/2019/article_0005.html.