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Chapter 1 Introduction

1.1 Introduction to Metaverse

As a *potential evolution of the internet*, the Metaverse is identified as a virtual world for communication and interaction in a virtual environment¹. Being a portmanteau of the word 'Meta' from Greek origin 'μετ' stands for 'beyond' or the state 'after' and comprises a vast universe². In the extensive world of global interactive provisions, Metaverse has emerged as a very powerful platform for engaging people in diversified creative domains, and commercial expansions to different businesses and brands in particular³. At the futuristic frontier, the research led by the European Parliament (2023) revealed that the metaverse can closely replicate and imitate reality, whether it is a digitized version of the real world, a mirror image of it, or a digital twin. Alternatively, it can exist independently of the physical realm and be populated by artificial intelligence, with the potential for various combinations of these elements, either in singular or multiple iterations (see Architectural Layers of Metaverse in Figure 1).

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¹ AA Thornton, Trademarking in the Metaverse. AA Thornton IP LLP. June 1 2023. <https://www.lexology.com/library/detail.aspx?g=117c33aa-8741-41e9-a6b7-3df4b8ddcf3b> accessed 18 July 2023

² Francesca Maria Ugliotti and Anna Osello (2022) Human Fragilities Supported by the Digital Social World, in *Handbook of Research on Implementing Digital Reality and Interactive Technologies to Achieve Society 5.0*. IGI Global. June 2022

³ Ibid.

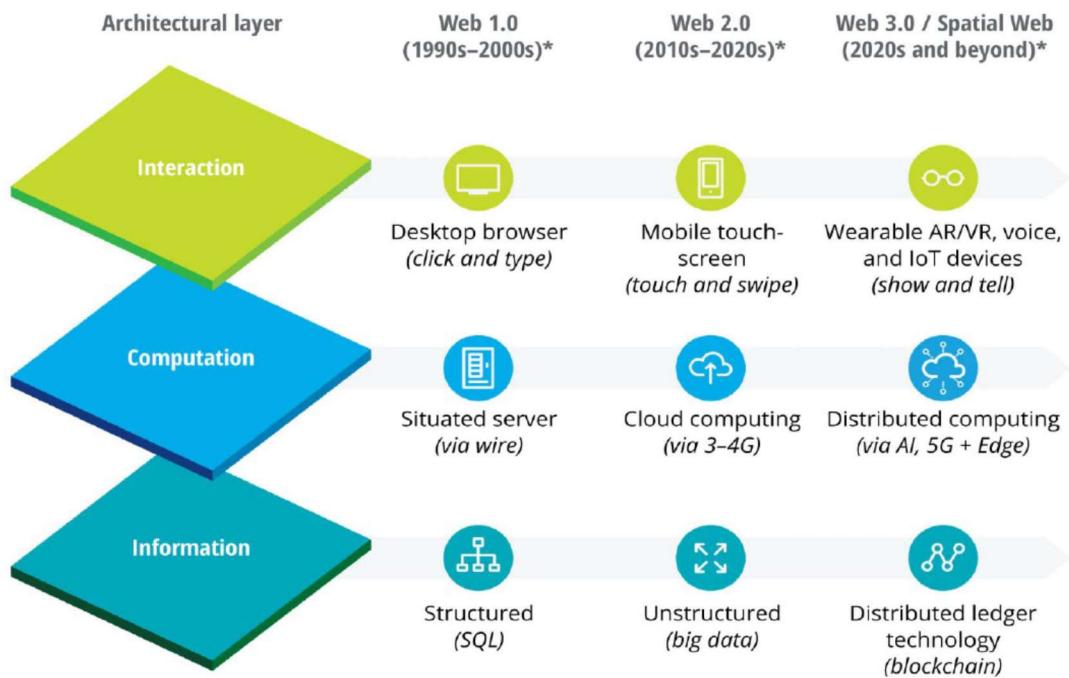


Figure 1 Architectural Layers of Metaverse

Source: European Parliament (2023, p.12) [Guaranteed Grades - Projectsdeal.co.uk](https://www.projectsdeal.co.uk)

About Figure 1, the metaverse is seen as a progression beyond previous internet iterations, such as Web1 (the worldwide web) and Web2 (the era of social media). In the context of Web3, individuals actively participate in the creation of virtual worlds, marking a significant shift in how people engage with and shape online environments. Thus, by the usage of Augmented reality (or AR) in combination with virtual reality (VR), Metaverse is capable of offering a 3D environment for initiating innumerable activities from all kinds of online platforms⁴ with easy and quick interactive provisions through various kinds of virtual avatars⁵ (see Figure 2 for detailed scopes of Metaverse).

⁴Valentina Torelli, '3D Trade Marks: Distinctiveness and Scope of Protection', in Hayleigh Bosher, and Eleonora Rosati (eds), *Developments and Directions in Intellectual Property Law: 20 Years of The IPKat* (Oxford, 2023). <https://doi.org/10.1093/oso/9780192864475.003.0025> accessed 18 July 2023

⁵Nitish Desai. *Metaverse: A New Universe: Legal, Regulatory and Tax Issues*. Nishith Desai Associates. July 2022

What does the Metaverse do?

The metaverse is the next generation of the Internet: it enables creators to deliver connected, immersive experiences based around activities.



Figure 2 Scopes of Metaverse

Source: Radoff (May 2021)

For a comprehensive understanding of the Metaverse, Jon Radoff offered a detailed ground of seven layers of the Metaverse (see Figure 3).

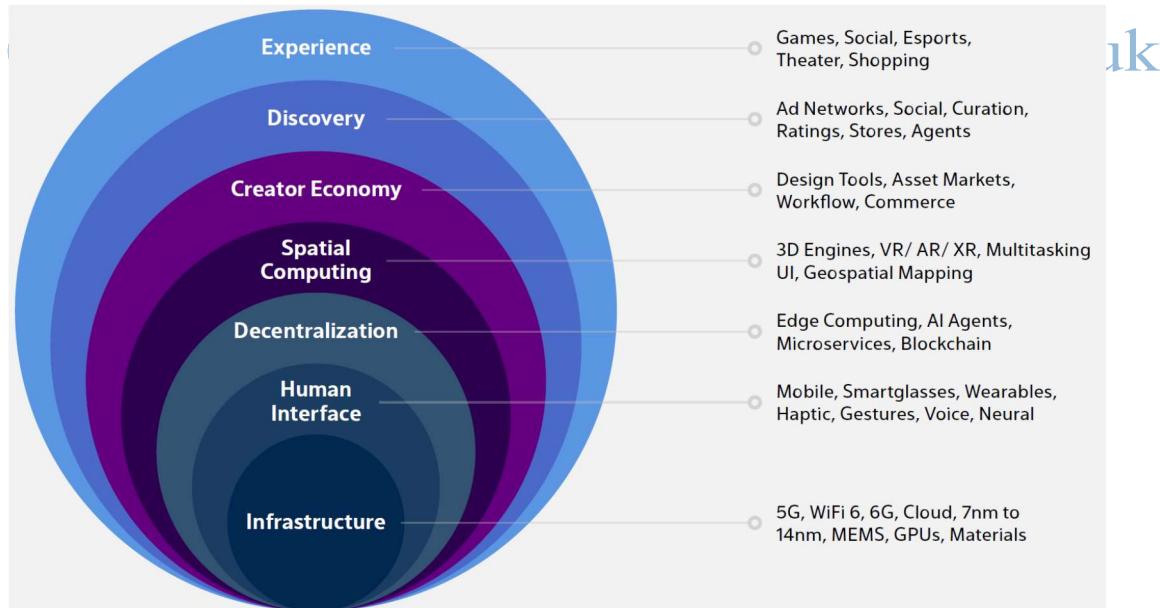


Figure 3 The Composition of Metaverse: Seven Layers

Source: Radoff (April 2021)

As stated in Figure 3, the Metaverse can be accessed by any user through different kinds of gadgets and devices such as Virtual Reality (VR) headsets and Augmented Reality (AR) devices, to experience, discover, create economic changes, and generate spatial computing,

decentralisation, human interface, and infrastructure without any legal restriction. With such widespread interactive scopes to all kinds of users, the platform for Metaverse is under serious threat of trademark infringement⁶⁷. Moreover, there is still no sign of a specific law or regulation to prevent trademark infringement in Metaverse⁸.

It is at this frontier that this research concentrates on understanding the hurdles to comprehending the implementation of trademark laws in the virtual world of Metaverse, as against the traditional world; and thereby develop a comparative analysis of the challenging instances of preventing trademark infringement as faced by the US and EU, under the regulations of the United States Patent and Trademark Office (USPTO) and the European Union Intellectual Property Office (EUIPO).

1.2. Problem Statement

The identified problem statement for this research is:

Though the traditional trademark infringement laws by USPTO and EUIPO are effectively applied to physical business scenarios, still these laws are incapable of protecting the trademarks of the companies in the virtual world of Metaverse.

1.3. Case Studies

With the expansion of business across Metaverse, the insecurities and infringement possibilities of trademarks have surged distinctively. Further, with the prevalent ambiguity among the USPTO and EUIPO in making specific trademark laws for Metaverse, this research holds relevance in offering justified grounds for effective decisions for structuring policies in this particular domain.

For this purpose, this research will analyse various cases which hold a resemblance to the issue of trademark infringement. As of now, there are very limited cases found in terms of

⁶ Valerie Brennan, et al, *A Brave New World: Handling of Trademarks and Other IP in Virtual Offerings*. International Franchise Association 54th Annual Legal Symposium. May 16 and 17, 2022

⁷ Mayank Pandey, IPR CHALLENGES IN THE METAVERSE. *Journal of Legal Research and Juridical Sciences*, 2(2), 2023 pp. 303-316

⁸ INTA, *International Trademark Association Releases White Papers on Trademarks in the Metaverse and Non-Fungible Tokens*. Press Releases. April 14, 2023, <https://www.inta.org/news-and-press/press-releases/the-international-trademark-association-releases-white-papers-on-trademarks-in-the-metaverse-and-non-fungible-tokens/> accessed 18 Aug. 2023

trademark infringement in Metaverse. In this research the case of Hermès Int'l v. Rothchild, where Luxury retailer Hermès International sued digital artist Mason Rothschild, alleging Rothschild infringed on the famous Birkin handbag trademark by creating and selling MetaBirkins NFTs (nonfungible tokens)⁹; Nike Inc. v. StockX LLC, where The sportswear giant Nike sued the online marketplace StockX, alleging that StockX inappropriately used the Nike trademark on its NFTs¹⁰; and Roblox Corporation et al, v. WowWeeGrp. Ltd, where the creation platform Roblox alleges that WowWee toymakers infringed their trademark by reproducing Roblox's popular avatars as a line of toys and misleading consumers into believing that Roblox sanctioned those items¹¹; will be considered for a specific understanding of trademark infringement in the virtual world. However, to understand the challenges towards the implementation of trademark regulations by USPTO and EUIPO for Metaverse, this research will also consider some cases which are closely connected to the intellectual, abstract and creative domains of trademark infringement. These cases will be from traditional businesses, yet will be marked to gain insight into the possibilities of infringement that Metaverse can face in future.

1.4. Overview of Relevant Studies

Many relevant studies interpreted the Metaverse as the ultimate platform for growth. However, there are contradictory declarations about the usage of the Metaverse for the economic profitability of any business¹². The most accepted understanding of Metaverse in existence is identified as a digitally generated virtual environment, which is operated by humans with the extensive support of computer-generated programs and Artificial Intelligence. It creates automated avatars or characters that are integral to the virtual renditions of varied kinds of products, such as toys, furniture, apparel, automobiles and

⁹TFL. Hermès v. Rothschild: A Timeline of Developments in a Case Over Trademarks, NFTs. The Fashion Law. July 31, 2023. <https://www.thefashionlaw.com/hermes-v-rothschild-a-timeline-of-developments-in-a-case-over-trademarks-nfts/> accessed 12 August 2023

¹⁰Case 1:22-cv-00983-VEC Document 32 Filed 05/10/22.
<https://fingfx.thomsonreuters.com/gfx/legaldocs/movanoemmpa/IP%20NIKE%20STOCKX%20amendclean.pdf> accessed 18 July 2023

¹¹Roblox Corp. v. WowWeeGrp, 22-cv-04476-SI (N.D. Cal. Dec. 2, 2022)

¹²Gwo-Jen Hwang and Shu-Yun Chien, Definition, roles, and potential research issues of the metaverse in education: An artificial intelligence perspective. *Computers and Education: Artificial Intelligence*. 3, 2022

even weaponry, which are liable to carry trademarks or copyrighted designations¹³. In a way, the literature on the Metaverse generally has found that the Metaverse is a platform that functions under the provisions of intellectual property regulations, yet it is subject to pertain to the insubstantial or vague or the "corpus mysticum (mystical body)" representation of an object¹⁴. Such representation can stand irrespective of the virtual or physical existence of the object. However, concerning trademarks in the Metaverse there is less literature on the regulations set in the way of protecting any kind of vague representation of objects, services or content in the virtual world of the Metaverse¹⁵. None of the literature is found on investigating the lack of effort from the developers of Metaverse to offer some practical or authentic grounds for the objects, services and content. At least scholarly information stood in favour of trademark rights analogous to the physical realm¹⁶. It is the extensive presence of intellectual and creative elements in the virtual world that makes it vulnerable to getting replicated and cracking fraudulent deals most conveniently¹⁷. There are gaps in understanding and regulating the Metaverse, mainly due to issues in its design, particularly with the software, leading to problems that users have to address.¹⁸ It is worth understanding here that being highly user-friendly is the key to the growth and popularity of Metaverse, it is also the reason for generating the extensive amount of insecurities regarding the trademark status of businesses involved in Metaverse¹⁹. As such there are serious challenges to attain financial gain from the Metaverse platform without getting copied or infringed. However, there is no comprehensive assessment of the challenges to trademark law and enforcement in the Metaverse and this is what this paper tries to fill. These are the core concerns that are in search of effective regulations to restrict

¹³Mayank Pandey, IPR CHALLENGES IN THE METAVERSE. *Journal of Legal Research and Juridical Sciences*, 2(2), 2023 pp. 303-316

¹⁴ Ibid.

¹⁵ Kevin Giang Barrera and Denish Shah, Marketing in the Metaverse: Conceptual understanding, framework, and research agenda. *Journal of Business Research*. 155, Part A, January 2023

¹⁶ Ibid.

¹⁷HuanshengNing, et al, A Survey on Metaverse: the State-of-the-art, Technologies, Applications, and Challenges. *IEEE Internet of Things Journal*, 10(16), pp. 14671-14688. 18 Nov 2021

¹⁸ Filipe A. Fernandes and Cláudia M. L. Werner. A Scoping Review of the Metaverse for Software Engineering Education: Overview, Challenges, and Opportunities. *PRESENCE. Virtual and Augmented Reality*. 2023

¹⁹ Ibid.

trademark infringement under the legal administration of USPTO and EUIPO and are the core focus of this research.

1.5. Gap in the Literature

The current regulations implemented by the USPTO and EUIPO regarding the concern of trademark infringement in the Metaverse are the major gap to be investigated by this research. The trademark laws on traditional fields of business by USPTO and EUIPO are constructed effectively. However, when it comes to trademark-related issues in the virtual world of Metaverse these regulations stand limited in guaranteeing adequate defence against potential infringement. It is this legal gap that none of the literature tried to bridge, and so this research is engaged to identify necessary justifications for developing necessary trademark laws for Metaverse.

1.6. Research Question

On the one hand, the United States Trademark and Patent Office (USPTO) refused Metaverse-focused trademark applications and on the other hand, the European Union Intellectual Property Office (EUIPO) stated that trademark protection does not automatically extend to the Metaverse. Amidst such legal ambiguities, *what* possible regulations should be adopted by both USPTO and EUIPO to prevent trademark infringement of virtual goods and content in the Metaverse? And how should they be designed?

1.6.1 Sub-questions

- Are the current legal regulations of the USPTO and the EUIPO effective in preventing trademark infringement for virtual goods and content?
- What factors are leading to the Metaverse conundrum in implementing the trademark policies by the USPTO and the EUIPO?
- What legal initiatives should be considered by the USPTO and the EUIPO to avail trademark protection policies in Metaverse?

1.7. Methodology and Limitations

As this research is focused on understanding the challenges in terms of establishing trademark laws for Metaverse so that the infringements can be prevented, the selected

research methodology will be a qualitative research approach²⁰. Moreover, as this research will investigate various causes related to the risks of trademark infringement involved in Metaverse, the data will be collected from secondary sources, and this validates this research towards the implementation of qualitative research methodology²¹.

1.7.1 Methodology

Following 1.6. Research Question and 1.6.1 Sub-questions, this research considered the qualitative research methodology to gain insight into the conflicts and the provisions to mitigate the possible trademark infringement issues under the provisions of using Metaverse for business purposes as against the current regulations set by USPTO and EUIPO.

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This research will adopt exploratory methods for the in-depth comparative analysis of trademark infringement challenges in the US and EU. The justification for this selection is its facilities for the collection of comprehensive data and the development of the reviewed analysis of the attained data²², added by specific detection of the key elements which are subject to creating conflict²³ with the current trademark infringement laws followed under USPTO and EUIPO. As such this research will extensively consider investigations of trademark infringement cases and laws by following desk-based research of the data collected from secondary sources²⁴. The adaption of desk-based investigative provision

²⁰Taghreed Alshehri, Norah Abokhodair, Reuben Kirkham, and Patrick Olivier. *Qualitative Secondary Analysis as an Alternative Approach for Cross-Cultural Design: A Case Study with Saudi Transnationals*. In CHI Conference on Human Factors in Computing Systems (CHI '21), May 08–13, 2021, Yokohama, Japan. ACM, New York, NY, USA, 15 pages. <https://doi.org/10.1145/3411764.3445108> accessed 18 Aug. 2023

²¹ Leslie A. Anderson and Trena M. Paulus, Secondary Qualitative Analysis in the Family Sciences. *Family and Consumer Sciences*, 49(4), pp. 362-375. June 2021. <https://doi.org/10.1111/fcsr.12403> accessed 18 Aug. 2023

²² Chara Makri and Andy Neely. Grounded Theory: A Guide for Exploratory Studies in Management Research. *International Journal of Qualitative Methods*, 20. 2021

²³ Susan Carter et al, An exploratory study: Using adapted interactive research design and contributive research method. *The Journal of Academic Librarianship*. 49(1) 2023.

²⁴ Susan Mbulakilonzo & Ayobami Ojobode. Research Methods for Public Policy. In: Aiyede, E.R, Muganda, B. (eds) *Public Policy and Research in Africa*. Palgrave Macmillan, Cham. 2023

comprises the practice of collecting relevant information from valid sources²⁵, which would be here about the official legal sites of USPTO and EUIPO.

1.7.2 Limitations

While qualitative exploratory reviews are effective for understanding complex contexts and generating solutions for issues like trademark infringements in the Metaverse, they have limitations. These include potential researcher subjectivity and the risk of biased or generalized conclusions²⁶. However, limitations arise from the study's timeframe and the inability to control external factors, such as the numerous trademark infringement cases in traditional business scenarios.

1.8. Chapter Structure

This research paper comprises five chapters. Chapter 1 introduces the research, establishing its context, problem statement, literature review, research questions, methodology, and limitations. Chapter 2 explores Research Question 1 related to trademark laws and their adaptation to the Metaverse, referencing INTA (International Trademark Association) white papers and regulations from USPTO and EUIPO. Chapters 3 and 4 critically analyze Research Questions 2 & 3 respectively. These chapters deal with the trademark infringement cases under USPTO and EUIPO, examining the challenges posed by the Metaverse assessing the effectiveness of existing legal regulations and thereby identifying the need for legal reforms. Finally, Chapter 5 concludes the research, comparing US and EU trademark laws to derive effective solutions for the Metaverse conundrum and address research gaps, thus resolving the research problem.

²⁵ Aoife Stephenson et al, Exploring the views of desk-based office workers and their employers' beliefs regarding strategies to reduce occupational sedentary behaviour, with an emphasis on technology-supported strategies. *JOURNAL OF OCCUPATIONAL AND ENVIRONMENTAL MEDICINE*, 62(2), 149-155. 2020

²⁶ Ibid

Chapter 2: Trademark Laws and the Metaverse Conundrum

2.1 Introduction

This chapter discusses trademark laws in Metaverse, focusing on the conceptual and legal aspects of this unique digital space. As the Metaverse becomes increasingly important for future generations and commerce, we delve into the legal concerns surrounding trademarks within this virtual realm.

It's important to note that since the metaverse is a relatively new concept, trademark laws for this virtual world are still a subject of ongoing debate. One major issue revolves around how virtual images in the metaverse can be registered, as opposed to physical goods. Additionally, more issues, which are not yet fully addressed by the legal system, are emerging in parallel with traditional trademark laws for physical products and will be analysed in this research.

This chapter first explores the importance of trademark laws for physical goods and services and then delves into the complexities of trademark laws in the metaverse, considering international perspectives and the stances of organizations like the United States Patent and Trademark Office (USPTO) and the European Union Intellectual Property Office (EUIPO). Finally, we assess the white paper declarations from INTA regarding trademark matters in the metaverse, particularly in terms of implementing trademark laws in this borderless digital space.

2.2 Trademark: Definition and Relevance

According to the World Intellectual Property Organization (WIPO), the sign identified as a trademark comprises the capability of distinguishing one brand from another and thereby signifying the specified goods or services offered by the brand²⁷. WIPO stated that any distinct symbol, words, numerals, letters, drawings, image, colours, shapes, pictures, logotypes, or combination of these aspects to represent an enterprise is a trademark and must be recognised as a tool for value creation.

²⁷ WIPO. Making a Mark. Intellectual Property for Business Series Number 1. World Intellectual Property Organization. 2011
https://www.wipo.int/export/sites/www/sme/en/documents/guides/customization/making_a_mark_nig.pdf
accessed 18 Aug. 2023

Further, when it comes to types of IP (Intellectual Property) it offered a detailed understanding of various categorical distinctions of trademark under both conventional and non-conventional platforms (see Figure 4).



Figure 4 Types of Trademarks²⁸

Source: IPOS (2022)

In consideration of the types of trademarks noted in Figure 4, it is important to understand that the significance of having a trademark is a matter of concern in the business world. As noted by WIPO is the purpose of establishing a positive image in the market whereby the consumers can easily detect and distinguish one

²⁸ IPOS, Trade MarksInfopack. Intellectual Property Office of Singapore. 2022. <https://www.ipos.gov.sg/docs/default-source/resources-library/trade-marks/infopacks/TM-infopack-12Oct2022.pdf> accessed 18 Aug. 2023

brand from another and choose the one as per personal choice. It is therefore important that the trademarks by companies should be acquired with legal protection so that no other competitor can avail itself of the positive image of the brand thus creating confusion and deceiving consumers with the respective product or service²⁹.

2.2.1 Concerns of Trademark Infringements

The concerns related to trademark infringement happen when some companies offer identical images of other companies to represent themselves in the market³⁰. Considering WIPO's regulations the trademark of a company should be protected by choosing a domain that is not the trademark of any other company. Further, innumerable national and international laws are engaged in the trademark registration process to protect against any sort of infringement. As per these laws, the most common thread in case of trademark infringement is the cancellation of the trademark of the business that copied it from an original brand and can be subject to a financial penalty³¹. The trademark (TM) protects its owner, even if a competitor manufactures different products and in the metaverse, this gets implied, even if a company is not physically present in the Metaverse. The case of WONDERCOLA³² by WIPO offers TM protection in countries in the domain of soft drinks, and even with unrelated goods and services. Therefore, if another company decides to market various products like T-shirts or sunglasses using the WONDERCOLA mark in the Metaverse, it would be required to obtain authorization from Wondercola Ltd. Failing to do so could result in legal action for the violation of trademark rights.

2.2.2 Physical Trademark Cases in Conflict with Metaverse

In the Metaverse, several limitations become apparent when applying traditional trademark and intellectual property laws to virtual spaces. The McDonald's Corporation v. Joburgers

²⁹ Ibid.

³⁰ IPOS, 2022.

³¹ WIPO, 2011

³² WIPO, 2011

Drive-Inn Restaurant (Pty) Ltd. (1996)³³ case illustrates the challenge of defining trademark boundaries for terms and phrases in this digital realm. In the legal dispute of McDonald's Corporation v. Joburgers Drive-Inn Restaurant (Pty) Ltd. (1996), McDonald's challenged Joburgers' use of "Cob" (close of business) in their promotions, but the court ruled it didn't infringe on McDonald's trademark because it referred to low-wage, unskilled jobs without product association. In the metaverse, the McDonald's case can get more complicated because even the general public can create their stuff or avail user-generated content and the ways to communicate and share always keep on changing. So, to protect trademarks well in the metaverse, there is a need to ensure effective protection in the dynamic digital environment without stifling creativity.

Another limitation arises from the *Mattel v. MCA Records* (2002)³⁴ case, emphasizing the difficulty of defining trademark protection boundaries for parodies and brand references, which can get further complicated in the Metaverse. In this case, the song "Barbie Girl" faced allegations of unauthorized Barbie trademark use, but the court deemed it a parody, not a trademark violation, as it didn't promote a product or service. The court ruled in favour of MCA Records, considering the song "Barbie Girl" a parody rather than trademark infringement, as it didn't promote a specific product or service. This emphasises the challenge of applying traditional trademark laws to virtual spaces because the challenge of limiting the playful take on a cultural reference demands a more explanatory approach to enforcing trademarks in the metaverse.

The *Apple Corps Ltd v. Apple Computer Inc.* (2006)³⁵ case refers to the iconic Apple logos associated with both companies and reveals the limitation of determining trademark protection for logos and symbols as highly complex in the metaverse. In this case, Apple Corps' concerns about Apple Computer's ITMS logo was that The Beatles (founder of Apple Corps'), primarily used a colourful, artistic Apple logo in connection with their music

³³ *McDonald's Corporation v. Joburgers Drive-Inn Restaurant (Pty) Ltd.* [1996] Case No:547/95

³⁴ Heather Wallack, *Mattel, Inc. v. MCA Records, Inc.* 296 F.3D (9th Cir. 2002), 12 DePaul J. Art, Tech. & Intell. Prop. L. 477. 2002. <https://via.library.depaul.edu/jatip/vol12/iss2/7> accessed 18 Aug. 2023

³⁵ 5rb. *Apple Corps Ltd v Apple Computer Inc* [2006] EWHC 996 (Ch). Barristers are regulated by the Bar Standards Board. London. 8 May 2006. <https://www.5rb.com/case/apple-corps-ltd-v-apple-computer-inc/> accessed 18 July 2023

business, whereas Apple Computer used a sleek and modern Apple logo for their technology products. The court ruled in favour of Apple Computer Inc., stating that their use of the Apple logo in connection with technology products did not infringe upon the trademark rights of Apple Corps Ltd. in the music industry, as it was for the iTunes store, not music ID. Apple Corps' concerns about Apple Computer's use of its logo and iTunes-related elements were dismissed by the court, emphasizing the need for tailored trademark protection strategies. The relevance stands in the context of Metaverse, where individuals and businesses face challenges in safeguarding unique virtual brand assets to prevent confusion and infringement.

In the context of patent protection, the Apple Inc. v. Samsung Electronics Co. Ltd. (2012)³⁶ the case highlights the challenge of safeguarding design patents, emphasizing the need for clear boundaries and protection of innovative designs in virtual environments to prevent infringement and encourage continued creativity in the Metaverse. This case involved Samsung incorporating patented tech, ruled an infringement, with a \$539 million award for Apple. Samsung's infringement on Apple's exclusive technological rights led to a substantial legal penalty, highlighting the necessity for tailored intellectual property enforcement strategies in the metaverse, characterized by swift innovation.

The limitation observed with Cadbury's purple trademark in the UK on safeguarding trademark rights in the metaverse for specific colours is very complicated, because the visually immersive nature of virtual environments challenges the distinction of brands based on specific colours, impacting the clarity and effectiveness of colour-based trademarks. While initially registered in 2008, the trademark faced opposition and had the ruling reversed in 2014, showcasing the difficulty of maintaining colour trademarks in virtual environments where visuals play a crucial role. Here, Cadbury's purple trademark in the UK initially approved in 2008, faced opposition and had the ruling reversed in 2014³⁷. This case established the imperative for brands to adjust to the changing dynamics of colour trademarks within the metaverse.

³⁶Apple Inc. v. Samsung Electronics Co. Ltd. [2012] The Supreme Court of the United States. No. 15-777. December 6 [2016]

³⁷Société des Produits Nestlé S.A. v. Cadbury UK Ltd. [2014]. R.P.C. 7 EWCA Civ 1174,

Finally, in *Jaguar Land Rover Ltd. v Ineos Industries Holdings Ltd.* (2021)³⁸, the Metaverse limitation arises from the challenge of obtaining trademark protection for distinct shapes or designs. In this case, Jaguar Land Rover lost against Ineos Industries, contesting the "Grenadier" label's resemblance to their Defender model, but the court sided with Ineos, stating the Land Rover shape wasn't eligible for trademark protection.

The court denied trademark protection for the Land Rover shape, revealing the difficulty of securing trademarks for product design in virtual environments filled with creative and innovative designs. This emphasizes the need for brands to carefully navigate the evolving legal landscape in the Metaverse when it comes to trademark rights for specific shapes.

Thus, the aforementioned cases highlight that the complexity of trademark issues in the metaverse arises from the fact that regulations depend on court judgments making it challenging to universally recognize every creation as trademark-protected, aligning with the notion that not every creation benefits from trademark protection even in virtual spaces.

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2.3 Prevalence of Trademark Laws

In the process of selecting and creating a significantly strong trademark, WIPO recommended the need for a support system based on effective management of information details on training for trademark management, legal assistance, and extensive usage of tools for creating and investigating the uniqueness of the trademark in the physical world³⁹. The relevant protective shell for restricting trademark infringement, WIPO suggested that there should be adequate awareness campaigns led by the companies to generate brand recognition in the market. A trademark effectively distinguishes products within a competitive market by allowing customers to identify a company's offerings through its trademark. This fosters a sense of brand loyalty, which greatly benefits the company. This is the reason that the trademark laws must be structured in such a manner they can safeguard the identity representation of a company, and any endeavour to replicate or mimic a trademarked name or logo must lead to legal ramifications. These legal protections

³⁸ NIPC, *Trade Marks - Jaguar Land Rover Ltd. v Ineos Industries Holdings Ltd.* The Newspaper Licensing Agency Ltd and Others v Meltwater Holding BV and Others. August 09, 2020

³⁹ WIPO, 2011

facilitate seamless business transactions and develop secure business deals⁴⁰. Trademarks serve as potent marketing tools, enabling the creation of brand names and logo recognition. This strategic marketing effort helps solidify brand identity and reputation in the market. By leveraging this approach, brands can effectively utilize online platforms and social media to establish a robust market presence. To illustrate, when customers search for a brand online, it amplifies website traffic, leading to increased sales and service uptake⁴¹. This, in turn, elevates website rankings and draws even more visitors. This protection is cost-effective for businesses and the pathway for obtaining long-term advantages, as it remains in force for the company's lifetime with renewals every ten years after the initial registration. These renewals are typically budget-friendly, offering an enduring advantage as long as the business remains operational⁴². Such proceedings are the core prevalence of trademark laws as through restricted regulations on infringement, these laws will be able to offer scopes for business growth and generate promotions for business expansion. A robust and recognizable trademark plays a pivotal role in building trust and credibility with customers. It assures consumers that the company is legitimate and devoted to delivering high-quality products and services⁴³.

2.3.1 Trademark and Internet

INTA specified that trademarks and the internet are relevant to the metaverse as they play a crucial role in regulating and protecting brand identities, digital assets, and intellectual property in the dynamic online environment, ensuring clarity, ownership, and prevention of infringement within virtual spaces⁴⁴. In the year 2008, David I. Bainbridge identified a few of the core concerns of trademark laws concerning internet usage, especially in situations where some general trademark considerations are applicable irrespective of

⁴⁰ WIPO. *TRADEMARKS AND THE INTERNET*. Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications. Twenty-Fourth Session Geneva. World Intellectual Property Organization. November 1 to 4, 2010.

⁴¹ Ibid.

⁴² WIPO, Chapter 2 The Economics of Trademarks, in World Intellectual Property Report Brands – Reputation and Image in the Global Marketplace. WIPO. Economics & Statistics Series. World Intellectual Property Organization. 2013.

⁴³ Ibid.

⁴⁴INTA, *International Trademark Association Releases White Papers on Trademarks in the Metaverse and Non-Fungible Tokens*. Press Releases. April 14, 2023, p. 51

jurisdiction.⁴⁵ In the case of the internet, Bainbridge noted that the registration proceedings for the trademark in the form of a domain name rely on the factor of functioning in the form of a trademark and not just as a domain. Bainbridge referred to Digeo Broadband Inc's Trade Mark Application [2004] RPC 638, where the overall impression of the selected domain name which will also act as a trademark gets counted for trademark registration⁴⁶. This was confirmed in Digeo Broadband Inc's Trade Mark Application [2004] RPC 638 which involved an application to register a series of 308 marks, all including the word 'DIGEO'. Examples included DIGEO, DIGEO.COM, DIGEO.CO.UK and DIGEO.FR. The objection in that case was for marks to be registerable as a series, under section 41(2), the differences must be such as not to substantially affect the identity of the trade mark. That does not mean to say that the marks may have each been registerable individually. Further, Bainbridge offered examples like TESCO.com, which was accepted for both domain and trademark registration, whereas 'BUY.COM' was refused. In a way, Bainbridge directed the implementation of trademark laws in the internet world as a matter that holds the likelihood of confusion on websites, which is complex, and stated that without the cautiousness of internet users, this can prevail more critically. Bainbridge also stated that though banner ads' use of trademarks for search terms might not cause confusion, still meta-tags can be infringed if these tags are used as trademarks. Further, when it comes to jurisdiction in the matter of global infringement cases, Bainbridge appealed for effective usage of trademark laws as per registration territory. These complications are noted to attain many critical scenarios with the advent of the metaverse. Whatever Bainbridge noted was the stepping stone for detecting the hurdles that trademark laws were liable to face in the future, and metaverse generated extensive challenges on this path.

⁴⁵ David I. Bainbridge, *Introduction to Information Technology Law*. Pearson Education Limited. Sixth Edition. 2008 pp. 190-198

⁴⁶ Ibid.

2.3.2 Hermès Int'l v. Rothschild: The Breakthrough

In 2021, there was a big legal clash between Hermès and artist Mason Rothschild. Hermès accused Rothschild of using their trademark in his NFTs⁴⁷⁴⁸ called "MetaBirkins." Rothschild argued he had the right to do this under the First Amendment. Initially, he said his NFTs were a tribute to Hermès, but later he claimed they were a statement about animal cruelty in fashion.

Hermès took Rothschild to court in January 2022, alleging trademark infringement, among other things. They wanted money and a ban on Rothschild using their trademarks. The jury determined that while the "MetaBirkin" NFTs were considered works of artistic expression to some extent, Rothschild's intention to create confusion among potential consumers rendered him ineligible for First Amendment protection, resulting in a \$133,000 damages award to Hermès⁴⁹.

Guaranteed Grades - Projectsdeal.co.uk
This case became significant because it involved NFTs and raised questions about how real-world trademarks apply in virtual spaces. It also influenced other similar legal battles involving NFTs, like one with Yuga Labs and the Bored Ape Yacht Club in Singapore. There were developments in the case, including a permanent injunction, appeals, and debates about the law and the First Amendment in the digital world. As such, serious awareness regarding the protection of trademarks in the metaverse has become relevant all over the world, particularly in terms of enforcing the physical trademarks that can protect the metaverse trademarks.

2.4 Trademark Registration Issues in Metaverse

To understand trademark registration issues in Metaverse, it is important to gain insight into the application process for a trademark in general (see Figure 5).

⁴⁷ NFTs, or non-fungible tokens, are unique digital identifiers recorded on a blockchain, certifying ownership and authenticity of various digital assets like art, music, cartoons, film clips, JPEGs, postcards, sports trading cards, virtual real estate, and pets, and they cannot be copied, substituted, or subdivided.

⁴⁸ CLIFFORD CHANCE. NON-FUNGIBLE TOKENS: THE GLOBAL LEGAL IMPACT. CLIFFORD CHANCE. JUNE 2021.

<https://www.cliffordchance.com/content/dam/cliffordchance/briefings/2021/06/non-fungible-tokens-the-global-legal-impact.pdf> accessed 18 July 2023

⁴⁹ Hallie Kiernan and Anna B. Naydonov. *Infringement is still infringement, even in the metaverse: New York jury finds "MetaBirkin" infringing, not protected artistic expression.* White & Case LLP. 10 February 2023.



Figure 5 International Trademark Application Process⁵⁰

Source: WIPO (2021)

In the case of the metaverse, the notable proceeding for trademark registration is still followed as per the path marked in Figure 5. However, many reports on trademark-related registrations and policies have affirmed that there is no determined trademark law dedicated only to the virtual business world of the metaverse⁵¹⁵²⁵³⁵⁴. These reports confirmed that the entire concept of maintaining trade and commerce-based practices in virtual reality is in itself a matter of great concern for deciding trademark regulatory or legal frameworks for the metaverse. There is a constant shift of intellectual property concerns and issues related to virtual goods and content over real-life products and services⁵⁵. As a result, the traders and the consumers are in constant confusion regarding their rights, facilities risks and even the uncertainties related to the involvement in the metaverse⁵⁶. However, the increasing popularity of accessibility and convenient provisions towards cross-border trading facilities

⁵⁰ WIPO, Madrid System: Filing International Trademark Applications – The Process. World Intellectual Property Organization. 2021

⁵¹ EICSEA. *Intellectual Property in the Metaverse. Episode II: Trade Marks*. European Innovation Council and SMEs Executive Agency. 29 March 2022

⁵² Cesar Ramirez-Montes. EU Trademarks in the Metaverse. *IDEA The Law Review of the Franklin Pierce Center for IP*. 2022. Volume 63 – Number 3

⁵³ Valerie Brennan, Jess Dance, Marisa Faunce, Susan Meyer, and Kathryn Thomas. *A Brave New World: Handling of Trademarks and Other IP in Virtual Offerings*. International Franchise Association 54th Annual Legal Symposium. May 16 and 17, 2022

⁵⁴ ETL. *How brand owners can prepare into the Metaverse*. Euromoney Trading Limited. ManagingIP.com AUTUMN 2022

⁵⁵ Megan L. McKeown and William J. Snyder. *Brand Protection and Enforcement Considerations for Trademark Owners in the Metaverse*. Insights. December 2022

⁵⁶ Valerie Brennan et al, 2022

has made the metaverse, the most preferred platform for all kinds of businesses⁵⁷. Even after having limited scopes to maintain trademark regulations, most of the businesses are working within the metaverse with the urge to come in contact with maximum numbers of consumers spread all over the world⁵⁸. On the contrary, the entire purpose of meeting consumer demands and protecting the goodwill of the companies involved in the metaverse is a practical global challenge and the concerns are under serious investigation by USPTO and EUIPO.

2.4.1 Trademarks in Metaverse: Relevance and Complexities

The core concern regarding the usage of metaverse in the business domain is its unclear concept of trademark for business users. Amidst the present state of confusion and non-availability of trademark laws in the metaverse, it becomes important to understand the concept and relevance of trademarks, added by the kinds of complexities involved in trademark policies and practices.

The term Trademarks refers to the identified symbol, or sign, which can be a logo or words to distinguish a particular product or service from its competitors in the market⁵⁹. The core purpose of trademark laws for metaverse is to prevent disputes over virtual property names, brand logos, and digital assets and protect the brand reputation and the goodwill of the product or the service in the market⁶⁰. The basic strength of a trademark is to make the consumer attain informed choices about a brand so that there is the possibility for an authentic purchase⁶¹. Apart from distinguishing one brand from the other, the trademark provisions facilitate the company in establishing its brand image through all kinds of advertising platforms to reach the maximum number of consumers and promote the brand image⁶².

⁵⁷ Cesar Ramirez-Montes, 2022

⁵⁸ Ibid

⁵⁹ Valerie Brennan, et al, 2022.

⁶⁰ Ibid

⁶¹ DevkiNandan. Trademark, Introduction, Functions, Requirements & Salient Features. May 12, 2020. <http://dx.doi.org/10.2139/ssrn.3625716> accessed 18 July 2023

⁶² Ibid

On the contrary, there are innumerable concerns and challenges that businesses can face and suffer due to the lack of trademark regulation in a particular business domain; here is the case of the metaverse. The two complexities that the courts are unable to handle in the context of the metaverse are:

- 1) When the trademark is claimed for online and offline products as duplicate creation of the products, and
- 2) Instances of infringement for taking advantage of the positive brand image of the original physical brand online.

In case of any emergencies of cases in metaverse like Nike, Inc. v. StockX LLC and Ryder Ripples against Bored Ape Yacht Club⁶³; the courts remain ambiguous in their decisions.

In Nike, Inc. v. StockX LLC, Nike initiated a lawsuit against StockX, on February 3, 2022. The lawsuit was centred on trademark infringement due to StockX's NFTs featuring Nike sneakers. Nike argued that due to its long-standing metaverse presence, StockX's unauthorized use of Nike trademarks on Vault NFTs is likely to confuse consumers, create a misleading connection between the two entities, threaten the distinctiveness of Nike's marks in identifying its digital products, and potentially weaken the overall strength of Nike's famous trademarks. On December 30, 2022, the court rejected the request for discovery regarding Nike's "Digital Sneakers," as they were virtual shoes made for use in video games and other similar things.

Moving to the subsequent case, in June 2022, Yuga Labs sued Ryder Ripples over his RR/BAYC project for false advertising and trademark infringement. In April 2023, a judge ruled in favour of Yuga Labs, citing confusion and "false designation of origin." In October 2023, Ripples and co-defendant Jeremy Cahen were ordered to pay over \$1.5 million in disgorgement, damages, and attorneys' fees⁶⁴.

⁶³Case 1:22-cv-00983-VEC Document 32 Filed 05/10/22.

<https://fingfx.thomsonreuters.com/gfx/legaldocs/movanoemmpa/IP%20NIKE%20STOCKX%20amendclean.pdf> accessed 18 July 2023

⁶⁴ Brayden Lindrea. *Ryder Ripples ordered to pay Yuga Labs \$1.6M in copyright lawsuit*. Cointelegraph. Oct. 27, 2023.

Cases like StockX infringed Nike trademark⁶⁵ and Ryder Ripps sued by Bored Ape Yacht Club (BYAC)⁶⁶ under the real of the metaverse trademark problems exemplify challenges in preventing the infringement of well-established brands within virtual assets. Recognizing that digital assets and trademarks face unprecedented problems, the legal decisions emphasize the significance of legal considerations on privacy and jurisdictional challenges in the metaverse. The judicial outcomes threaten the distinctiveness of trademarks in identifying digital products within the metaverse, where the intangible nature of virtual goods complicates the traditional understanding of brand identity.

2.4.2 INTA White Papers

The International Trademark Association (INTA) in collaboration with the World Intellectual Property Office (WIPO) has issued two white papers focusing on the metaverse and non-fungible tokens (NFTs). These papers are "*Trademarks in the metaverse*" and "*Non-Fungible Tokens*"⁶⁷. These papers focussed on advocating for a standardized approach to trademark classification in these emerging digital environments⁶⁸. As stated in these white papers, INTA declared that there is an increase in the surge of national registering authorities reporting on the trademark applications, for doing business in the virtual reality, metaverse in particular. INTA highlights challenges in metaverse trademark enforcement due to complexities in detecting trademark infringement as in Nike, Inc. v. StockX LLC and counterfeiting as in Ryder Ripps v. Bored Ape Yacht Club without detection of any established jurisdiction. It plans to work with governments and international bodies for clearer court rules⁶⁹.

⁶⁵ Case 1:22-cv-00983-VEC Document 32 Filed 05/10/22.

https://fingfx.thomsonreuters.com/gfx/legaldocs/movanoemmpa/IP%20NIKE%20STOCKX%20amendclea_n.pdf accessed 18 July 2023

⁶⁶ Case 2:22-cv-04355 Document 1 Filed 06/24/22.

<https://fingfx.thomsonreuters.com/gfx/legaldocs/xmpjoweyjvr/IP%20BOREDAPES%20TRADEMARKS%20complaint.pdf> accessed 18 July 2023

⁶⁷ INTA, *International Trademark Association Releases White Papers on Trademarks in the Metaverse and Non-Fungible Tokens*. Press Releases. April 14, 2023

⁶⁸ Maura O'Malley. *INTA Issues White Papers OnNfts And The Metaverse*. The Global Legal Post. 2023

⁶⁹ INTA, 2023, p. 60

2.4.2.1 Correlation between Physical-world vs. Metaverse Brands

About the challenges in metaverse due to trademark infringement (Nike, Inc. v. StockX LLC), and counterfeiting (Ryder Ripps v. Bored Ape Yacht Club) without any jurisdiction, INTA proceeds to investigate the concerns deeply. Against all these odds, INTA detects that there is a correlation and relative significance between physical-world brands and metaverse brands, along with their associated reputation under intersecting spectrums (see Figure 6):

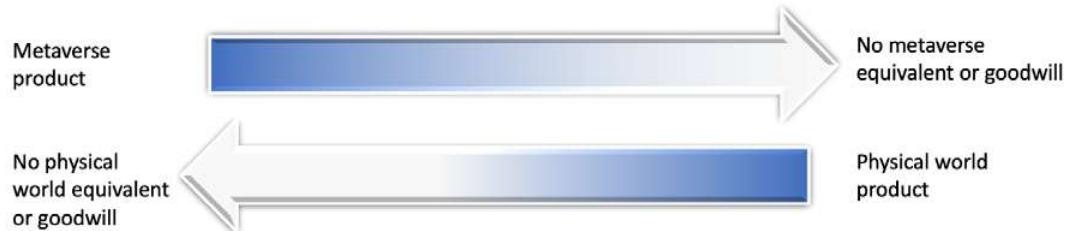


Figure 6 Overlapping Spectrums Physical-world Brands & Metaverse Brands⁷⁰

Source: INTA (2023)

The spectrums as noted in Figure 6, are marked To make trademarks more connected in people's minds, which comprises the growing trend for overlap between virtual and real goods, where consumers see a link between them. Figuring out the legal concept of using trademarks in the virtual world is tricky, though, because it depends on things like the type of product, industry, and customer base. As the metaverse changes, there could be new ways to display trademarks and build a good image, things that trademark offices and courts haven't dealt with before due to the metaverse still evolving. INTA wants to make the metaverse more stable and secure for brand experts, suggesting that it should follow existing trademark rules from real life, like those of USPTO and EUIPO, and this research aims to address that gap.

2.5 Conundrum of Trademark Laws in Metaverse

As identified in the 2.2.2 Physical Trademark Cases in *Conflict with Metaverse*, the real-life trademarks as practised by the US and the EU member states are thought to be effective in addressing the trademark issues, yet they leave gaps in addressing the trademark concerns in the virtual world of metaverse. In the year 2022, there were 5,800 trademark applications for non-fungible tokens (NFTs) and 4,150 trademark applications for the

⁷⁰ INTA, 2023, p. 28

metaverse to USPTO. On the other hand, there were 1,157 NFT trademark applications and 205 trademark applications for metaverse to the EUIPO⁷¹. Most of these applications are on hold due to the non-availability of specific trade mark laws. With a rising number of trademark applications for the metaverse in the US and EU, it is crucial to address the unique challenges of NFTs, like issues related to digital ownership, interoperability, copyright infringement, need for establishing standards and regulations in this rapidly evolving and decentralized space. As such it is significant to ensure a clear framework for metaverse trademark laws by USPTO and EUIPO, as existing laws meant for physical goods led to acceptance, partial modification, or rejection of applications.

Moreover, the major concerns identified from the 2.2.2 Physical Trademark Cases in *Conflict with Metaverse*, were related to trademark regulations which are challenged in terms of protecting intangible virtual goods like digital items and virtual currencies, requiring innovative adaptations, and various digital presentations for illustrating goods and services. There are also concerns related to branding and object representations in virtual spaces without any distinct operations and accessibility of the users from every walk of society, causing severe liability to the possibilities of trademark infringement.

2.5.1 Roblox Corporation et al., v. WowWeeGrp. Ltd

In the lawsuit of Roblox Corporation v. WowWee Group Ltd⁷², filed in a San Francisco federal court, despite WowWee's collaboration with an in-game designer, Roblox accuses WowWee's "My Avastars Fashion Dolls" of infringing its copyrights and trademarks by mimicking its online gaming avatars. WowWee vehemently denies these claims and is determined to defend its product and brand vigorously. They also mentioned their efforts to resolve the dispute amicably and have voluntarily distanced their dolls from Roblox. Meanwhile, Roblox, a pioneer in the metaverse concept, has refrained from commenting on the ongoing lawsuit.

Roblox's lawsuit alleges that WowWee, based in Hong Kong, partnered with Gamefam, a prominent developer on the platform, to create dolls resembling player avatars in "My

⁷¹ Osborne Clarke. *Virtual tops, real trademarks: how in the US and Europe to navigate fashion IP in the metaverse*. Osborne Clarke. 2nd Nov 2022. <https://www.osborneclarke.com/insights/virtual-tops-real-trademarks-how-us-and-europe-navigate-fashion-ip-metaverse> accessed 18 July 2023

⁷²Roblox Corp. v. WowWeeGrp, 22-cv-04476-SI (N.D. Cal. Dec. 2, 2022)

Avastars: RP." It argues that WowWee aimed to exploit Roblox's success without involving Roblox, using its brand, reputation, goodwill, and intellectual property. Roblox also emphasizes its existing agreement with Jazwares LLC for avatar dolls and claims that WowWee never sought a similar license. The legal action includes allegations of copyright and trademark infringement, violations of terms of use, and false advertising, with Roblox seeking a court order to stop doll sales and unspecified financial damages. Thus, as the metaverse comprises trademark infringement, violations of terms of use, false advertising, counterfeiting, etc. and includes new virtual and augmented reality elements, trademarks also change a lot, needing flexible ways to protect them, and this might mean we need new laws and agreements internationally to deal with these changes.

2.6 Concerns of Territorial Jurisdiction

Trademark protection is generally confined to the jurisdiction where you've registered your trademark. While international treaties and agreements can provide some assistance, enforcing trademark rights across borders can be challenging due to the territoriality principle and differences in legal systems. In case, a company sells a product with a trademark protected in country A and an infringement occurs in country B, then the company might face challenges in enforcing its trademark rights in country B, as the trademark rights in one country, 'A', do not automatically apply in another country, 'B'. To safeguard the trademark in country B, a separate application with its own rules and criteria is necessary. Even if the trademark matches one in country A, acceptance isn't guaranteed in country B. Without registering in country B, enforcing rights after an infringement can be intricate. International agreements like the Paris Convention⁷³ and WTO's TRIPS of 1995⁷⁴, offer cross-border protection, but success relies on coordinated efforts. Varied trademark laws, standards, and enforcement procedures across countries impact how infringements are handled. Under such ambiguities, INTA declares the territorial jurisdiction for trademark laws for metaverse as a subject to "borderless," courts⁷⁵. Thus, when it comes to the virtual world of the metaverse where representation and replication of trademark becomes the most vulnerable subject for infringement in the global arena, the

⁷³ WIPO, Paris Convention for the Protection of Industrial Property. World Intellectual Property Organization. 2020.

⁷⁴ WTO, *Overview of TRIPS Agreement of 1995*. The World Trade Organization. 2020.

⁷⁵ INTA, 2023, p. 39

decisions on trademark laws get severely complicated, especially in terms of deciding its restrictions as per territorial jurisdiction.

However, it is essential to understand here that all the trademark rights are maintained under the territorial jurisdictions and in the case of metaverse there is no space for any kind of restricted jurisdiction. Due to the lack of territorial boundaries or the lack of a specific marketplace or platform, the metaverse creates tremendous insecurity in maintaining brand protection in the metaverse.

2.7 Summing up of Core Concerns

In conclusion, the evolving metaverse poses challenges for trademark laws, with ongoing debates about how to regulate virtual images and address issues like infringement. The complexities of applying traditional trademark laws to the metaverse are evident in various real-life cases, highlighting the need for a nuanced and context-aware approach. The INTA's white papers emphasize the importance of standardized trademark classification and international cooperation to navigate the complexities of metaverse trademark enforcement. Despite the relevance of physical-world trademark laws, there is a growing conundrum in effectively addressing the unique concerns of the metaverse, especially with the surge in trademark applications for NFTs and virtual goods. The ongoing legal clashes, such as the Roblox Corporation v. WowWee Group Ltd case, underscore the need for updated and tailored trademark protection strategies in the dynamic landscape of the metaverse.

Chapter 3: Effectiveness of Trademark Policies by the USPTO and the EUIPO in Metaverse

3.1 Introduction

Having explained the Metaverse conundrum in Chapter 2 this chapter analyses the trademark policies of the USPTO and EUIPO. The chapter discusses how far these two bodies have managed to address the problems discussed so far. The understanding of these laws will be assessed as per their relevance and complexities. Further, the trademark provisions of the USPTO and the EUIPO will be analysed as per the recognized factors creating the metaverse conundrum. Added to these will be the need for initiatives and reformations to be adopted by the USPTO and the EUIPO to meet the current limitations of trademark laws in the US and the EU.

3.2 Trademark Provisions of USPTO

Though there are limited cases in terms of alleging issues on trademarks in the virtual world of the metaverse, the severity of the small cases is noted in 1.3. Cases against metaverse are the instances, which cannot be ignored.

For example, Linden Research, the maker of the "Second Life" metaverse platform faced many infringement suits by trademark owners. For example, in the case of Taser Int'l, Inc. v. Linden Rsch, Inc.,⁷⁶ the "Second Life", a metaverse platform referred to the control of the online "residents" as 3D avatars for simulating real-life activities. This platform faced innumerable counts of infringement suits by many trademark owners. For instance, Taser sued Linden Research as the company discovered that the residents were using the "Taser" trademark in various ads and related promoting leading to Eros, LLC v. Linden Rsch, Inc.⁷⁷ The cases of Taser Int'l, Inc. v. Linden Rsch, Inc and Eros, LLC v. Linden Rsch, Inc highlight trademark infringement challenges in "Second Life," with Linden Research facing multiple lawsuits as users within the virtual platform utilized trademarked names, prompting debates on applying traditional trademark regulations to virtual environments

⁷⁶ Megan L. McKeown&William J. Snyder, *Brand Protection and Enforcement Considerations for Trademark Owners in the Metaverse*, December 2022, <https://www.jonesday.com/en/insights/2022/12/brand-protection-and-enforcement-considerations-for-trademark-owners-in-the-metaverse> accessed August 08, 2023

⁷⁷ Ibid.

and raising questions about the distinction between real and virtual worlds. These cases highlight trademark owners considering standard USPTO regulations to combat virtual infringement concerns, sparking debate and conflict regarding distinctions between the real and virtual worlds.

When it comes to the virtual products, the content and even services made available in the Metaverse, there are two core concerns to be handled by USPTO:

- Firstly, the limitless nature of virtual world products means they are accessible to a wide range of users, increasing the risk of infringement⁷⁸. These products are open to others, making infringement more likely.
- Secondly, those who haven't paid (free riders) will also have easy access to public goods in the virtual world⁷⁹. This accessibility challenge poses significant difficulties and expenses for trademark laws in preventing brand infringement. Addressing free rider issues may impede the private market and hinder the production of goods overall.

In simple terms, when we enter the digital world of the Metaverse, our personal information gets compromised by the virtual world⁸⁰. Now, even though we can apply intellectual property (IP) rights, like trademarks, in the Metaverse following current USPTO rules, there are two differences to address. Brand owners can get trademark rights through USPTO as usual, but dealing with issues like under-identification (as noted in *Taser Int'l, Inc. v. Linden Rsch, Inc.*) and similarity replication (as in *Eros, LLC v. Linden Rsch, Inc.*) get things complicated. These issues can confuse buyers and harm a brand's reputation. The USPTO considers a historical case, *Minneapolis & St. Louis Ry. Co. v. Beckwith*⁸¹, where corporations were recognized as individuals under the 14th Amendment to the US Constitution⁸², which also prevailed for Metaverse. Even though trademarks aren't people,

⁷⁸Barton Beebe, *Intellectual Property Law and the Sumptuary Code* (2010) 123 Harvard Law Review 809, 889.

⁷⁹Ibid

⁸⁰Petar Radanliev, David De Roure, Peter Novitzky, & Ivo Sluganovic, *Accessibility and Inclusiveness of New Information and Communication Technologies for Disabled Users and Content Creators in the Metaverse* (2023) Disability and Rehabilitation: Assistive Technology 1-15.

⁸¹*Minneapolis & St. Louis Ry. Co. v. Beckwith* (1889) 129 US 26.

⁸²Robert A. G. Monks and Nell Minow, *Corporate Governance* (4th edn, John Wiley & Sons, Ltd 2008).

they're still important in the Metaverse⁸³. But, the exact rights they should have are still up for debate. For now, the USPTO is cautious and examines Metaverse-related trademark registrations carefully.

3.3 Traditional Trademark Laws of USPTO & Metaverse

The execution of trademark laws in the United States attained its relevance in the year 1946. In 1946, the then government led by Congress made a declaration regarding the Lanham Act also known as the Trademark Act of 1946⁸⁴. Under the implication of the Lanham Act, the Government of the US defined the status of protection for federal trademarks and established the rules for trademark registration. The Lanham Act was implemented by granting the US Patent and Trademark Office (or the USPTO) the administrative authority in the process of registration, protection, and enforcement of trademarks for different brands⁸⁵. However, it is significant to understand these laws to gain insight into their relevance in the context of protecting trademarks in the metaverse.

3.3.1 Madrid Protocol

Following the Lanham Act, there was the Madrid Protocol, whereby the US came in an international treaty whereby the provision of the trademark allowed scopes to seek protection under multiple nations by appealing through a single application⁸⁶. Since November 3, 2003, under the scopes of Article 3ter: Request for “Territorial Extension” of Article 3: International Application, and Article 4: Effects of International Registration⁸⁷, WIPO refers to the Madrid Protocol for generating ease to cross-border trademark laws⁸⁸. This protocol is a multinational treaty that provides the companies with an international

⁸³Bryant Smith, *Legal Personality*. *Yale Law Journal* Vol.37 283, 299 1928.

⁸⁴U.S. Trademark Law, Federal Statutes, U.S. Patent & Trademark Office, 15 U.S.C. §§ 1051–1127

⁸⁵Irene Calboli and Jane C. Ginsburg (Eds.), *The Cambridge Handbook of International and Comparative Trademark Law* in *The Cambridge Handbook of International and Comparative Trademark Law* (Cambridge Law Handbooks, pp. 635-658, Cambridge University Press 2020).

⁸⁶ Ibid, 639

⁸⁷Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (adopted at Madrid as amended on November 12, 2007), <https://www.wipo.int/wipolex/en/text/283484>, accessed August 10,2023

⁸⁸ibid

alternative to local to international trademark registration systems. However, in the case of USPTO, this registration remains applicable only to very limited nations, selected during registration. As such, this regulation stands ineffective for determining trademark regulations for any virtual world, and metaverse in particular.

3.3.2 Trademark Dilution Revision Act (TDRA)

Further, the US developed the Trademark Dilution Revision Act (TDRA) in the year 2006. Under this Act, there was an amendment made to the Lanham Act for generating adequate protection against the status of trademark dilution⁸⁹. Trademark dilution is a legal concept that refers to the lessening of the distinctive or unique quality of a famous or well-known trademark due to the use of a similar or identical mark by another party, even if the goods or services are not directly competitive or related. These marks are often associated with well-established brands. Trademark dilution can weaken the distinctiveness and commercial strength of a famous trademark, potentially harming its reputation and value. For example, if a new company used the name "Apple" for a line of clothing, it could blur the distinctiveness of the famous "Apple" trademark associated with electronics.

Thus, this regulation on trademark dilution stands relevant in the market for physical goods as it constitutes a type of trademark infringement in which the possessor of a widely recognized trademark possesses the authority to hinder the external employment of their trademark. However, with extensive scopes of replications and blurring of trademarks in the metaverse, this regulation cannot be applied to the metaverse platforms by USPTO.

3.3.3 Trademark Electronic Application System (TEAS)

Soon there was the introduction of the Trademark Electronic Application System (or TEAS)⁹⁰. Though TEAS has never been recognised as a law, still it is an online system that is capable of offering systematic provisions to USPTO in terms of trademark application, registration, and maintenance⁹¹. However, since TEAS is liable to collect and further save

⁸⁹*Trademark Dilution Revision Act of 2006* Public Law 109–312—Oct. 6, 2006.

⁹⁰ USPTO. *Log in to TEAS and TEASi*. United States Patent and Trademark Office. 2023. <https://www.uspto.gov/trademarks/logine> accessed 18 Aug. 2023

⁹¹ Ibid

all kinds of sensitive data of the user and his business⁹², it is an unsafe approach to deal with metaverse businesses. Through TEAS, there is an increased possibility of cybersecurity breaches and data theft in the metaverse.

3.3.4 Trademark Trial and Appeal Board (TTAB)

The USPTO also maintains a Supplemental Register for all those registered marks that are not found to be eligible for the Principal Register but comprise the relevant amount of protection. Trademark Trial and Appeal Board (or the TTAB) holds legal significance by providing a specialized forum for resolving trademark disputes and establishing legal precedents. Its economic significance lies in its role in protecting trademarks, reducing confusion in the marketplace, and fostering a conducive environment for businesses to invest in branding and innovation. It was under the TTAB, that the administrative tribunal was established for hearing and making judicial decisions to resolve trademark disputes in the process of applications and registrations, whereby TTAB in the metaverse becomes vital for protecting virtual trademarks, ensuring fair competition, and maintaining brand integrity in this digital realm.

3.3.5 Trademark Manual of Examining Procedure (TMEP)

The USPTO also offers the Trademark Manual of Examining Procedure (TMEP) as determined guidelines in terms of examining the applications for trademarks and registrations⁹³. When it comes to trademark regulations, the USPTO refers to trade dress as the distinctive visual appearance of the determined product or the kind of packaging adopted by the product; and thereby receives the necessary trademark protection⁹⁴. Under

⁹²United States Patent and Trademark Office, *TEAS* (2022), <https://www.uspto.gov/trademarks/apply/initial-application-forms>, accessed August 10, 2023

⁹³United States Patent and Trademark Office, *Trademark Manual Of Examining Procedure (TMEP)*, Eighth Edition, October 2011, <https://www.uspto.gov/sites/default/files/documents/TM-TMEP-8th-edition.pdf>, accessed August 11, 2023

⁹⁴Calboli and Ginsburg (Eds.) The Cambridge Handbook of International and Comparative Trademark Law, in *The Cambridge Handbook of International and Comparative Trademark Law* (Cambridge Law Handbooks, pp. 635-658, Cambridge University Press 2020).

the administration of USPTO, trademark law maintenance is identified as incontestability; which refers to the practice whereby the registered trademark under USPTO remains for five years & becomes eligible for the status of incontestability. Here, "Incontestability" in trademark law refers to a legal status that a registered trademark can achieve after a certain period of continuous and exclusive use without successful challenge, which is yet to be implied for the metaverse or the virtual world in general.

3.4. Trademark Provisions of EUIPO

The inception of the EU Trade Mark concept can be traced back to 1964 when it was first introduced in a preliminary version of the "Convention on European Trademark Law."⁹⁵ Nevertheless, it was only in 1980 that the initial proposal for a regulation governing the EU Trade Mark was put forth. The regulation finally took effect with Council Regulation (EC) No 40/94 on 20 December 1993, establishing the framework for the Community trade mark⁹⁶.

Currently, firms seeking trademark registration in the EU use the EUIPO's appointed Register⁹⁷, with trademarks valid for 10 years and indefinitely renewable. EU trademark provisions are influenced by various IP rights, and EU Trademarks are preferred over National Trademark Registration due to EU harmonization efforts.

- National Trademark Registration: This is to register a trademark in a specific EU country to gain trademark protection within that specific country. If you want trademark protection in multiple European countries, you would need to file separate trademark applications in each of those countries' national trademark offices.
- European Union Trademark (formerly known as Community Trademark): If you want trademark protection across multiple European Union (EU) member states, you can apply for an EU-wide trademark. This option protects all EU member states as a single unitary right and saves time and money by preventing separate application filings for each member state.

⁹⁵ RBC. *Royal Brand Corporation*. European Union. 2023.

⁹⁶Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark. [1994] OJ L11/1.

⁹⁷EUIPO. *Trademarks in the European Union*. European Union Intellectual Property Office.

Thus, the European Union Trademark harmonised a directive that aligns national laws and a regulation that establishes a cohesive EU-wide trade mark system⁹⁸. The Court of Justice has played a pivotal role in offering substantial guidance on interpreting both major and minor legislative stipulations⁹⁹.

The EUIPO oversees a comprehensive trademark framework for various goods and services, including individual, collective, guarantee, and certification marks registered in the EU or Benelux Office¹⁰⁰, as well as internationally registered ones affecting EU countries. During the trade, trademark owners can't limit details like names, addresses, or product/service features, ensuring transparent consumer information about origin and purpose. EUIPO trademarks can also be fully or partially licensed, offering flexibility for different business arrangements. This Directive safeguards proprietors' rights and promotes clear commercial practices involving trademarks.

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EUIPO relies on Implementing Regulation (EU) 2018/626 for trademark law implementation. This regulation outlines trademark application requirements and procedures, including addressing opposition during registration. The Boards of Appeal at EUIPO are responsible for deciding cases related to trademark infringement and issuing orders for trademark cancellations.

Moreover, the EU trade mark law departs from the more restrictive stance on trade mark registration that some national systems had previously upheld¹⁰¹. Early stages of implementation were also marred by ambiguities in the legislation, leading to initial frustration. The body of case law has subsequently expanded significantly¹⁰².

As the system matured, understanding improved, and core provisions became clearer. The EU unitary trademark has become popular alongside national systems. However, it's

⁹⁸ EU Lex. *Harmonisation of trade mark law in the European Union*. Summaries of EU Legislation. EUR-Lex. 2014.

⁹⁹ Justine Pila. Chapter 1: Introduction to Seville's EU Intellectual Property Law and Policy, in Seville's *EU Intellectual Property Law and Policy*, pp. 1–8. 15 Nov 2022.

¹⁰⁰ EU Lex. *Harmonisation of trade mark law in the European Union*. Summaries of EU Legislation. EUR-Lex. 2014.

¹⁰¹ Justine Pila, 2022.

¹⁰² Ibid 7

unlikely to replace national systems soon, as proving eligibility for EU-wide protection remains complex.

3.5 Traditional Trademark Laws of EUIPO & Metaverse

In assessing trademarks that may apply in the virtual world, the proceedings of EUIPO concentrate on interpreting the ‘Common Communication over the Common Practice of Distinctiveness’, which is used as the basis for assessing the three-dimensional trademarks in the member states of the EU¹⁰³.

Furthermore, EUIPO's IT-based tool, the Anti-Counterfeiting Rapid Information System (ACRIS), designed to combat counterfeit products by tracking and sharing information about genuine products, is not legally recognized; its inapplicability to the Metaverse, a digital space devoid of traditional physical products, renders it ineffective in this distinct context. Thus, ACRIS facilitates the provision to exchange necessary data under customs rights and authorities and rights to prevent counterfeiting and infringement of IP rights¹⁰⁴, it is yet to make necessary adjustments as per the flexibility criteria of Metaverse.

3.5.1 EU Trademark Regulation (EUTMR)

The most effective trademark law maintained by EUIPO is the European Union Trade Mark Regulation (EU) 2017/1001¹⁰⁵. This law governs the registration and protection of EU trademarks, previously known as Community trademarks, covering the entire process from registration to enforcement across EU nations¹⁰⁶. It enables the registration of a single trademark valid throughout all member states. Currently, this law applies to real-life situations, but it should also be adapted for metaverse platforms operating in the EU, allowing users to create and sell virtual products¹⁰⁷.

¹⁰³Geiregat, Simon. *Trade Mark Protection for Smells, Tastes and Feels – Critical Analysis of Three Non-Visual Signs in the EU*. IIC 53, 219–245 (2022).

¹⁰⁴EUIPO. *Anti-Counterfeiting Technology Guide*. EUIPO. 2021.

¹⁰⁵Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark.[2017] OJ L154/1.

¹⁰⁶Ibid.

¹⁰⁷Christian Tenkhoff, et al. Brands in the Metaverse: The Concept of ‘Interdimensional Confusion’ Between the Physical and the Virtual Space under EU Trade Mark Law, *GRUR International*, Volume 72, Issue 7, July 2023, Pages 643–649. <https://doi.org/10.1093/grurint/ikad045> accessed 12 August 2023

3.5.2 Directive 2015/2436/EU

Then there is the Directive (EU) 2015/2436, which has been structured to harmonise trademark laws within the laws of the EU member states. The objective of this law is to maintain efficient and consistent implementation of trademark laws in the EU. It is important to note that the Directive (EU) 2015/2436 focuses on harmonizing trademark laws within the EU and streamlining trademark registration procedures. In contrast, the Directive for trademark infringement deals specifically with legal measures and remedies to address trademark violations, such as unauthorized use of trademarks or counterfeiting. Under this Directive for trademark infringement, trade mark proprietors hold exclusive rights to their marks. They can prohibit similar signs that could confuse consumers. However, this control doesn't apply when indicating specific trade details like names, addresses, goods' features, or service purposes and that complicates its implementation in the metaverse.

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3.5.3 EU Customs Enforcement Regulation (EU) No 608/2013

The EU Customs Enforcement Regulation (EU) No 608/2013¹⁰⁸, allows customs authorities to seize and destroy goods suspected of infringing trademark rights when they cross EU borders¹⁰⁹. However, this law also stands weak in the world of Metaverse which is beyond any jurisdictional control.

3.5.4 Parody Trademark 2017

The EUIPO's stance on Parody Trademark 2017 is shaped by the *Lego Juris A/S v. Mega Brands Inc.* Case, establishing criteria for assessing parody as a valid defence against trademark infringement, no unjust impact on the trademark holder's commercial interests, recognizable distinct parody character to avoid confusion, conveying humour or criticism to differentiate from mere imitation, and preventing the misconception of commercial

¹⁰⁸ Olivier Vrins, 'Regulation (EU) No 608/2013 of 12 June 2013 Concerning Customs Enforcement of Intellectual Property Rights and Repealing Regulation 1383/2003', pp.1-431 in Hendrik Vanhees (ed.), *IEL Intellectual Property*, Kluwer Law International BV, Netherlands. 2017.

¹⁰⁹ European Parliament. Regulation (Eu) No 608/2013 Of The European Parliament And Of The Council of 12 June 2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) No 1383/2003. *Official Journal of the European Union*. 2013.

association or endorsement by the trademark owner¹¹⁰. In fact, "Lego Juris A/S v. Mega Brands Inc." stands as a pivotal legal case that influenced the European Union Intellectual Property Office's (EUIPO) approach to the concept of parody concerning trademark law. The case set criteria for valid parody defences against trademark infringement, including avoiding undue impact on the trademark holder's interests, distinct parody identity to prevent confusion, conveying humour or critique to differentiate from imitation, and averting any hint of commercial association. These principles have influenced how EUIPO assesses trademark-related parody in the EU. The challenge of Parody Trademark 2017 in the metaverse is handling trademark parodies, which involves balancing freedom of expression with trademark protection in virtual environments, which can be violated by random users who can create content that comments on or parodies trademarks and can harm the brand image and value. Thus, the implementation of Parody Trademark 2017 stands vague under the current establishment of EUIPO.

3.5.5 Geographical Indications (GI) Regulation Projectsdeal.co.uk

While not exclusively a trademark law, still Geographical Indications (GI) Regulation is still responsible for protecting geographical indications for agricultural products and foodstuffs¹¹¹. On a specific note, in the metaverse, it's relatively easy to create digital representations of objects, including Feta cheese. These digital replicas may not be subject to the same geographic restrictions as physical Feta cheese production in Greece. Enforcing GI protections in the metaverse can be challenging due to its decentralized and global nature. It's difficult to monitor and regulate digital representations of products across various virtual platforms and servers.

Thus, if a user in the EU offers virtual agricultural products and foodstuffs with a trademarked logo for sale within a virtual world, the trademark owner can face concerns whereby the logo can be a subject of confusion in terms of originality. This regulation might be relevant in the Metaverse context, but there is no policy specified in terms of restricting infringement under such indications.

¹¹⁰Vlotaliakatou and Spyros Maniatis. *Lego Juris A/S v. Mega Brands Inc.* Thomson Reuters (Professional) UK Limited. 2010.

¹¹¹ European Commission. *Geographical indications for craft and industrial products. Internal Market, Industry, Entrepreneurship and SMEs.* European Commission. 2023.

3.6 To Sum-up

To sum up, it can be noted that the challenges surrounding trademarks in the metaverse for the USPTO¹¹² and the EUIPO¹¹³ encompass:

The convergence of virtual identities with real-world trademarks raises legal concerns, emphasizing the risk of confusion and infringement. Both the USPTO and the EUIPO have laws preventing trademark violations to safeguard the distinctiveness of trademarks and prevent consumer confusion. However, in terms of the metaverse, the cross-jurisdictional conflicts in the global virtual world complicate these regulations and thus demand legal frameworks to ensure consistency across varying trademark laws. Addressing infringement concerns in user-generated content involves content moderation mechanisms, with challenges stemming from the scale and real-time nature of the metaverse. Defining the trademark scope for virtual goods involves adapting legal systems to recognize and protect trademarks in virtual spaces. Balancing trademark use on virtual properties with real-world trademarks presents a complex dilemma, requiring clarification in legal frameworks.

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Moreover, there are hindrances in reconciling trademark protection with creative expression and parody rights. The dynamic nature of the metaverse poses challenges, requiring adaptable legal systems to keep pace with rapid developments. Further, introducing new symbols raises the legal problem of unintentional resemblance.

Eventually, serious legal initiatives and reformation are needed from the USPTO and the EUIPO for the establishment of determined norms to classify and register trademarks of digital offerings. Necessary regulations for meeting the challenges of geolocation and territorial expansions of the trademarks for internationalising goods, services and content in the online marketplaces; are subject to be established by the USPTO and the EUIPO at the earliest and hence, is the next chapter.

¹¹²Uspto Trademark Manual of Examining Procedure (Tmep). United States Patent And Trademark Office. Eighth Edition, October 2011.

¹¹³ European Parliament. Regulation (Eu) No 608/2013 Of The European Parliament And Of The Council of 12 June 2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) No 1383/2003. Official Journal of the European Union. 2013.

Chapter 4: What legal initiatives should be considered by the USPTO and the EUIPO to avail trademark protection policies in the metaverse?

4.1 Introduction

The critically evaluated proceedings as marked in the former chapters lead this research to the fact that to avail trademark protection policies in the metaverse, serious legal initiatives and reforms are needed from the USPTO and the EUIPO. Some of the common concerns are related to the means of implementing traditional trademark laws in the Metaverse due to the distinctive nature of the virtual environment. The identified reasons for these concerns are directly related to the existence of virtual assets in the metaverse, which is liable to create trademark infringement. Further, it has been marked that necessary regulations for meeting the challenges of geolocation and territorial expansions of the trademarks for internationalising goods, services and content must be established by the USPTO and the EUIPO at the earliest. In this chapter, the core focus is to discuss the legal initiatives to be considered by the USPTO and the EUIPO for the establishment of determined norms to classify and register trademarks of digital offerings and thereby protect their respective trademarks.

4.1.1 Status of the USPTO

According to LII (2020), the application for trademark registration and verification in the United States comes under the regulations of 15 U.S. Code § 1051¹¹⁴, which offers permission for the usage of a trademark for commercial purposes, verification of statements, the instances of amendments and/or abandonment, ownership verification, rights conferred by registration, and maintenance of trademark duration and renewal. However, as elaborated in 3.2 Trademark Provisions of USPTO, these scopes are yet to be modified in terms of dealing with the presence of trademarks in the metaverse, and there is no guidance on what constitutes a distinctive trademark in virtual environments and how the likelihood of confusion is assessed when similar trademarks are used within the metaverse. As marked in Figure 5 International Trademark Application Process¹¹⁵, WIPO

¹¹⁴ LII. 15 U.S. Code § 1051 - Application for registration; verification. Legal Information Institution. 2020

¹¹⁵ WIPO, Madrid System: Filing International Trademark Applications – The Process. World Intellectual Property Organization. 2021

is the gateway for gaining permission to trade in the metaverse¹¹⁶¹¹⁷, still a lack of specific instructions for managing trademark infringement cases. In the current scenario, the USPTO has rejected certain trademark applications centred on the Metaverse, citing concerns about potential confusion with previously registered marks¹¹⁸. However, ambiguity surrounds applications linked to brands that have yet to venture into the metaverse or secure trademarks to safeguard against future squatting.

4.1.2 Status of the EUIPO

Under the regulations of the EUIPO, the policy concerns with Metaverse and the laws for trademarks are all related to the regulating characteristic features noted within the virtual space. Following the US case of *Hermes v. Rothschild* of 2021, though there were some clarifications to safeguard trademark infringement; the UK IPO also raised concerns regarding the need for trademark laws for Metaverse. The role of EUIPO is subject to get restricted to only those products that are within the periphery of the European Economic Area (EEA), whereby the virtual world of Metaverse with non-geographical reality, becomes very challenging for restricting it within the EEA¹¹⁹. Further, the Board of Appeal (BoA) has determined that trademarks featuring the term "Metaverse" face challenges in obtaining registration for online-offered goods and services due to a perceived lack of distinctiveness. A notable issue arises as certain trademarks with the "Metaverse" element have already been successfully registered by the EUIPO for specific goods, including, "Metaverse" applied to items like backpacks, school bags, and suitcases (classified under

¹¹⁶ INTA, International Trademark Association Releases White Papers on Trademarks in the Metaverse and Non-Fungible Tokens. Press Releases. April 14, 2023

¹¹⁷ Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (adopted at Madrid as amended on November 12, 2007), <https://www.wipo.int/wipolex/en/text/283484> , accessed August 10,2023

¹¹⁸ Uspto Trademark Manual of Examining Procedure (Tmep). United States Patent And Trademark Office. Eighth Edition, October 2011.

¹¹⁹ Ibid

class 18¹²⁰). Thus, as of now, EUIPO has failed to address the concerns on the legal regimes to virtual world goods and services¹²¹.

4.2 Challenges for Physical Trademark Laws

In both the USPTO and the EUIPO, there are constant debates on the implementations of real-life trademark rules over the goods, content and services offered through the Metaverse. These debates are surrounded by the policies which must be reformed to prevent trademark infringement in the platform of the metaverse. The core challenges are identified in terms of differentiating the accessibility of virtual goods from physical goods. As for the traditional trademark laws at both the USPTO and the EUIPO, the challenges begin with the dealings of the digital form of all kinds of goods and services, which makes it difficult to apply the laws of the physical world. In this context, one of the major issues is the extensive possibilities of replication and modification of trademarked items in the metaverse. Then there is the concern of cross-border trading regulations of the physical trademark laws, which get limited in covering the trading operations in the virtual world of the metaverse. Traditional trademark laws are based on national or regional jurisdictions. Thus, the convenient operation of virtual goods and services across the world and the transcending of geographical boundaries without any restriction make it hard for the trademark laws of the physical world to cover the virtual world.

Implementation of trademark laws from the physical world also gets restricted in the metaverse as this virtual entity can create and manipulate content. As user-generated content blurs the differences, the process of determining the boundary between original content and trademark-infringing content becomes intricate in the metaverse. As against the traditional trademark laws, the dealings and transactions in the metaverse have been evolving consistently and continuously. As a result, the expansion of the virtual business arena is expanding rapidly, with new technologies, newer platforms, and frequent

¹²⁰ EUIPO. DECISION of the Fourth Board of Appeal of 1 September 2021, https://euiipo.europa.eu/copla/trademark/data/01808287/download/CLW/APL/2021/EN/20210901_R0067_2021-4.pdf?app=esearch&casenum=R0067/2021-4&trTypeDoc=NA

¹²¹ European Parliament Metaverse. STUDY: Requested by the JURI Committee. Policy Department for Citizens' Rights and Constitutional Affairs Directorate-General for Internal Policies PE 751.222 - June 2023. Available at: [https://www.europarl.europa.eu/RegData/etudes/STUD/2023/751222/IPOL_STU\(2023\)751222_EN.pdf](https://www.europarl.europa.eu/RegData/etudes/STUD/2023/751222/IPOL_STU(2023)751222_EN.pdf) accessed on November 12 2023

emergence of consumer behaviours. Under such rapid growth the traditional trademark laws not only get limited but also face extensive challenges in adapting to the evolution of the metaverse.

One of the major challenges to the restrictions in implementing traditional trademark laws is the intangible nature of the metaverse. Since every element in the metaverse is in the digital realm understanding of ownership and enforcement of infringement policies get questioned under the provisions of traditional trademark laws. This leads to the complicated challenge of establishing the value of virtual assets and assessing damages in trademark infringement cases in the metaverse. Further, with integrated usage of technologies, like blockchain augmented reality, the metaverse makes it impossible for traditional trademark laws to cover its legal peripheries.

Finally, the traditional trademark laws fail to address the issue of infringement due to the decentralised status of the metaverse led by blockchain. Without any central authority to regulate or enforce trademark rights, traditional trademark laws can't function. The scope to imply pseudonymity and anonymity by any users in the metaverse restricts the process of identifying or taking any kind of legal action against cyber hackers.

Based on the aforementioned identified complexities for implementing traditional trademark laws in the metaverse, this research offers legal initiatives to be considered by the USPTO and the EUIPO to avail trademark protection policies in the metaverse.

4.3 Reformation towards Legal Initiatives

Metaverse allows all its users to create and modify symbols and content, including trademarks, within virtual spaces. As a result, there is an obvious ground whereby the specification and uniqueness of trademark get blurred between original brand holders and user-generated symbols (trademarks) and content. The extensive scope of accessibility is the major factor that creates tremendous havoc on the possibilities of trademark infringement in the metaverse. Such a potential threat to trademark infringement is yet to be regulated by the USPTO and the EUIPO. Further, there is the concern of territorial jurisdiction which gets completely nullified by the borderless digital environment of the metaverse under the current trademark regulation of the USPTO and the EUIPO. Such a decentralised state of lawlessness establishes that Metaverse platforms often allow interoperability, where virtual items or characters can move between different virtual

worlds or experiences. As a result, complexities and complications persist while enforcing trademark rights, as the trademark laws from the physical world get limited in the metaverse. It is at this point that this research offers reformation suggestions towards legal proceedings of the USPTO and the EUIPO while managing trademark-related approaches in the metaverse.

4.3.1 Legal Initiatives for USPTO Trademark Laws for Metaverse

The recent cases of USPTO rejection of applications for trademark registration of the logos of "Gucci" and "Prada¹²²" by unrelated third parties for virtual goods confirm that though the USPTO are effective in addressing some of the trademark-related aspects in the metaverse, there are some challenges that need better provisions by amending the provisions as mentioned in 3.3 Traditional Trademark Laws of USPTO & Metaverse.

- One of the major legal initiatives is for the adaption of a single application¹²³ under 3.3.1 Madrid Protocol, which needs to be amended to gain explicit hold over the virtual goods and services, as in the case of "Gucci" and "Prada" in the international trademark registration process. With the necessary exchange of data, IP offices should combat metaverse trademark infringement under the scope of the Madrid Protocol.
- Extensive clarity in the terms and conditions of the 3.3.2 Trademark Dilution Revision Act (TDRA) is essential through the inclusion of provisions, which can identify the potential impact on the distinctiveness of trademarks in the metaverse.
- The modification of the 3.3.4 Trademark Electronic Application System (TEAS) can be initiated by accommodating the registration of trademarks under the categorical distribution of virtual goods and services, which must include necessary elements from the metaverse. Under this provision, the owners of the trademark must attain better legal protections with monitoring facilities of their virtual assets.
- 3.3.5 Trademark Trial and Appeal Board (TTAB) must be reformed through the establishment of features for handling metaverse-related trademark disputes. This

¹²²Stuart Irvin. Brands in the Metaverse Will Fight Old Battles on New Ground, BLOOMBERG LAW. Feb. 18, 2022. Available at: <https://news.bloomberglaw.com/tech-and-telecom-law/brands-in-the-metaverse-will-fight-old-battles-on-new-ground> accessed on November 14 2023

¹²³ Ibid, 639

is possible only when the USPTO allows training to the TTAB personnel on the functioning of metaverse trademarks for effective adjudication.

- In terms of the 3.3.6 Trademark Manual of Examining Procedure (TMEP), this research recommends that the USPTO includes guidelines on examining and registering trademarks for virtual goods and services with extensive clarity in language and distinct marking of legal consequences.

4.3.2 Legal Initiatives for EUIPO Trademark Laws for Metaverse

Some of the recent cases of rejections of trademark registration for Metaverse were marked by the cases of OsheePolska Sp. z. o. o for its METAVERSE FOODS¹²⁴, McDonald's burgers and trademark application of BURBERRY. EUIPO has been strict against monopolistic control over generic names such as those of "DRINKS" "FOOD", and "Burger" in the Metaverse¹²⁵ under the regulation of being non-distinctive as mentioned in Article 7(1) of EU Trademark Regulations. However, some necessary reformations to be considered by EUIPO for the virtual world for regulations as in 3.5 Traditional Trademark Laws of EUIPO & Metaverse:

- This research marks that the 3.5.1 EU Trademark Regulation (EUTMR) should be amended to accommodate the trademark regulations for virtual goods and services within the scope of the metaverse. EUTMR needs to generate clear guidelines for addressing cross-border infringement issues in the metaverse.
- As for 3.5.2 Directive 2015/2436/EU, necessary updating to incorporate trademark regulation in the virtual environment must enforce legal and judicial criteria for the prevention of trademark infringement in the metaverse.
- Necessary modification in the 3.5.3 EU Customs Enforcement Regulation (EU) No.608/2013 should be inclined to prevent the importation and exportation of infringing metaverse-related products. It must develop functions for enhancing the

¹²⁴ AA Thornton. Trademarking in the Metaverse: From coined phrase to a descriptive word, a 30-year decline of distinctiveness. AA Thornton IP LLP. June 1 2023. Available at: <https://www.lexology.com/library/detail.aspx?g=117c33aa-8741-41e9-a6b7-3df4b8ddcf3b> accessed on November 14 2023

¹²⁵ Pascale Davies. Order your McDonald's in the metaverse? The company applies for NFT and virtual trademarks. Euronews. 11/02/2022. Available at: <https://www.euronews.com/next/2022/02/11/order-your-mcdonald-s-in-the-metaverse-the-company-applies-for-nft-and-virtual-trademarks> accessed on November 14 2023

exchange of information between customs authorities to combat metaverse trademark infringement on an international scale.

- Further, in terms of 3.5.4 Parody Trademark 2017, this research suggests that EUIPO needs to address the current challenges related to parodies within the metaverse and thereby consider determined scopes to balance freedom of expression with the protection of trademarks in virtual platforms.
- Finally, the regulation structured under the 3.5.5 Geographical Indications (GI) Regulation should address the use of geographical indications in the metaverse in consideration of different regulatory provisions for different trademark regulations as per the respective geographical location.

4.4 Conclusion

Conclusively, it can be critically stated that the current trademark regulations of EUIPO are managing virtual goods through the provisions of Class 9, Class 35, and Class 41, yet for an effective mode of addressing the Metaverse world. However, as in the case of USPTO, there are concerns about Virtual Currency and Transactions, Brand Dilution and Parody, Cross-Jurisdictional Issues, User-Generated Content etc. that need further enhancement in these regulations¹²⁶. It is at such juxtaposition that necessary reformations in the concerns related to territorial recognitions and the aspects recognised as trademarks stand highly effective. The suggestions made by this research paper are to be considered for transforming traditional trademark laws for the virtual world. Though legal initiatives are extensively necessary for this purpose, general awareness among all the stakeholders, especially the users is highly recommended.

¹²⁶ Maura O'Malley. *INTA Issues White Papers On Nfts And The Metaverse.*, The Global Legal Post. 2023

Chapter 5 Conclusion & Recommendations

5.1 Conclusion

While referring to the aforementioned 1.2. Problem Statement, this research critically evaluated the metaverse conundrum based on an in-depth comparative analysis of trademark infringement challenges in the US and EU established that in the evolving landscape of the Metaverse, it is the chief responsibility of the USPTO and the EUIPO to offer prevalent policies and laws for regulating Metaverse. Considering the consistent growth of the virtual platform of the metaverse, this research identified the core potential domains for reformations as virtual goods and services, cross-dimensional trademarks, avatar and identity protection, user-generated content, technological interventions, and most importantly the jurisdiction and enforcement in the virtual marketplaces.

5.1.1 Answers to the Research Questions

Based on the evaluation of the cases as mentioned in 1.3. Case Studies, this research derives an answer to the possible regulations to be adopted by both USPTO and EUIPO to prevent trademark infringement of virtual goods and content in the Metaverse and the way these provisions should be designed.

The research clarified that digital, intangible items like cosmetics, enhancements, and virtual currency, which hold economic significance for users and are actively traded within the digital realm are sans any regulation under USPTO and EUIPO. Following the path-breaking case as depicted in 2.3.2 Hermès Int'l v. Rothschild: The Breakthrough, this research established that the challenges in the metaverse are a real conflict between the virtual world versus the real world.

From the investigations over the usage of traditional trademark laws in the metaverse as specified through 3.3 Traditional Trademark Laws of USPTO & Metaverse and 3.5 Traditional Trademark Laws of EUIPO & Metaverse, it has been marked that while lacking a physical presence, virtual goods carry economic value to users and exhibit similar attributes to their tangible counterparts. Yet, assimilating virtual goods and services into existing intellectual property and trademark law definitions and constructs presents a formidable challenge.

Moreover, asserting exclusive rights over a virtual entity like a logo or design can be problematic due to the prevalence of identical virtual goods among multiple users. This

disconnection between trademark law and the Metaverse brings about a host of challenges and gaps within the existing intellectual property legal framework. To tackle this issue, the USPTO and EUIPO should establish new regulations that outline ownership and intellectual property rights concerning virtual goods. These regulations ought to furnish clear directives on the legal employment of these goods, thereby enabling their proper integration into trademark law and ensuring protection against potential infringements.

Thus, as answers to 1.6.1 Sub-questions, it has been noted that

- The current legal regulations of the USPTO and the EUIPO are not fully effective in preventing trademark infringement for virtual goods and content in the Metaverse due to a lack of explicit provisions addressing the unique challenges posed by digital, intangible assets.
- Factors contributing to the Metaverse conundrum in implementing trademark policies by the USPTO and the EUIPO include the digital nature of virtual goods, economic significance, and the absence of clear regulations governing ownership and intellectual property rights for these assets.

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- Legal initiatives to avail trademark protection policies in the Metaverse should include the adoption of new regulations by the USPTO and the EUIPO, specifically outlining ownership and intellectual property rights for virtual goods, and providing clear directives for their legal use and integration into existing trademark law.

5.2. Recommendations

To address the research problem on the challenges faced by the USPTO and the EUIPO in protecting trademarks in the metaverse, this research offers the following recommendations:

- Both the USPTO and the EUIPO should update their trademark laws to explicitly recognize virtual assets within the metaverse. This involves defining what constitutes a distinctive trademark in virtual environments and establishing criteria for assessing the likelihood of confusion in the metaverse.
- The USPTO and the EUIPO should collaborate to create regulations that address the challenges of geolocation and territorial expansion of trademarks in the

metaverse. This is crucial for internationalizing goods, services, and content, considering the borderless nature of the digital environment.

- Develop specific guidelines within the existing trademark application processes for metaverse-related trademarks. This includes updating WIPO as the gateway for gaining permission to trade in the metaverse and providing clear instructions for managing trademark infringement cases in virtual spaces.
- Clarify the registration process for trademarks related to virtual goods and services. This involves adapting existing systems such as the Madrid Protocol for explicit coverage of virtual offerings, ensuring that trademarks for virtual goods are adequately protected on an international scale.
- Revise existing trademark dilution laws to include provisions that explicitly consider the impact on the distinctiveness of trademarks in the metaverse. This can help prevent the dilution of well-known brands and maintain the integrity of trademarks in virtual spaces.
- Modify existing trademark application systems (e.g., TEAS for USPTO) to accommodate registrations specifically for virtual goods and services. This should include the categorical distribution of trademarks for virtual assets and provide trademark owners with better legal protections and monitoring facilities.
- Establish features within the Trademark Trial and Appeal Board (TTAB) to handle disputes related to trademarks in the metaverse. This includes providing training to TTAB personnel on the unique aspects of metaverse trademarks for effective adjudication.
- Update the Trademark Manual of Examining Procedure (TMEP) to include clear guidelines on examining and registering trademarks for virtual goods and services. Clarity in language and marking of legal consequences should be emphasized to assist trademark examiners.
- For EUIPO, consider amendments to the EU Trademark Regulation (EUTMR), Directive 2015/2436/EU, EU Customs Enforcement Regulation (EU) No. 608/2013, Parody Trademark Regulation 2017, and Geographical Indications (GI) Regulation. Ensure that these regulations comprehensively address trademark issues specific to the metaverse, including cross-border infringement, parody, and geographical indications.

- Encourage international collaboration between USPTO and EUIPO for the enforcement of trademark rights in the metaverse. This involves sharing information and coordinating efforts to combat metaverse trademark infringement on a global scale.

In conclusion, addressing the challenges in trademark protection within the metaverse requires a proactive and collaborative effort between the USPTO and the EUIPO. By implementing the suggested legal initiatives, both entities can adapt their existing frameworks to the unique aspects of the virtual world, thereby providing effective protection for trademarks in the metaverse.

5.3 Further Research

Future research in the metaverse must explore the psychological and consumer behaviour aspects of virtual identities mirroring real-world trademarks and how individuals perceive brands in virtual versus traditional settings. Additionally, research should focus on advanced detection techniques for trademark infringement in user-generated content, utilizing artificial intelligence and machine learning for proactive protection. Investigating the evolving distinctions between traditional and virtual trademarks and their implications on intellectual property rights. Research on adaptive legal frameworks responsive to the metaverse's rapid changes and the role of smart contracts is essential. Monitoring emerging symbols and metaverse-specific trademarks is necessary, proposing efficient strategies for their registration and protection. The challenges and opportunities of geolocation and territorial expansions of trademarks in the metaverse warrant exploration, requiring comprehensive regulatory frameworks. Lastly, research should analyze stakeholder input mechanisms, proposing improvements for more inclusive, adaptive, and effective legislative processes. Collectively, these research domains aim to enhance understanding and shape effective regulatory frameworks for trademarks in the dynamic metaverse environment.

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Glossary

Conventional trademark: A conventional trademark, also known simply as a "trademark," is a type of intellectual property protection granted to symbols, names, phrases, logos, or other distinctive elements that are used to identify and distinguish the goods or services of one business or individual from those of others. Trademarks play a crucial role in branding, as they allow consumers to associate certain qualities and characteristics with a particular product or service.

Non-conventional trademark: A non-conventional trademark, also known as a "non-traditional trademark," refers to a type of intellectual property protection that goes beyond the traditional concept of a symbol, word, or logo used to identify goods and services. Non-conventional trademarks cover distinctive elements that don't fall within the typical categories but still serve as source identifiers. These marks can include things like colours, sounds, shapes, smells, and even motions.

Trademark Infringement: Trademark infringement occurs when someone uses a trademark or a similar mark without permission from the trademark owner, leading to confusion among consumers regarding the source or origin of goods or services. Trademarks are symbols, names, phrases, logos, or other distinctive identifiers that help consumers identify and differentiate the products or services of one company from those of another. Infringement happens when another party uses a mark that is similar enough to an existing trademark to create confusion among consumers.

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