



# **Register clogging and goods/services designation: US versus the European models**

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- Definitions of register clogging.
- Is the CTM register congested?
- Is it a problem?
- Does it affect the scope of protection?
- What are the solutions?



# Definitions

What is meant by “register clogging”?

- A “successful” system.
- “Dead wood”.
- Legal rights exceeding commercial realities.



# Is the CTM register congested?

Does cluttering exist?

- The system inevitably involves a certain amount of cluttering but this must be balanced against other factors (MPI).
- The evidence is imperfect (MPI).



# Is the CTM register congested?

Evidence against cluttering:

- There is no evidence from the CTM register suggesting that access to CTMs is severely hampered (MPI).
- Stable opposition rate, despite increasing number of CTMs (MPI).



# Is the CTM register congested?

Evidence of cluttering:

- Searching: clearance is “difficult”, and register searches often need to be supplemented by commercial reviews.
- Oppositions: the effect of a 17% opposition rate.



# Is it a problem?

- Trade mark clearance – cost, delay, uncertainty.
- Trade mark oppositions – cost, delay, uncertainty.
- Are there advantages of ‘cluttering’?
- What are the particular issues for US applicants?



# Does it affect the scope of protection?

- Similarity of marks.
- Similarity of goods/services.
- Confusion.
- Detriment and unfair advantage.





# What are the causes?

Filing practices:

- Bona fide intention to use requirements.
- Acceptance of class headings.
- Low filing fees.
- “3 classes for the price of one”.



# What are the causes?

## Post-filing practices:

- Approach to non-use revocation and proof of use:
  - genuine use;
  - geographical extent;
  - breadth of specification.
- Automatic renewal without proof of use.



# Applying US practice in the EU

Is a US solution workable in the EU?

- Examining on bona fide intention to use.
- Proving use before registration.
- The presumption of abandonment.
- Periodical proof of use.
- The concept of fraud.



# Applying US practice in the EU

How does the scope of protection compare?

- Comparing marks.
- Comparing goods/services.
- Confusion.



Questions?





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