International Report

Ingrīda Kariņa-Bērziņa

Ingrīda Kariņa-Bērziņa

E-mail: **ingrida.karina-berzina@juridicum.su.se**

1. Introduction

This report examines the following question: What mechanisms exist to avoid over-broad trademarks and address concerns that the trademark registers are clogged (e.g. bad faith in *Sky v SkyKick*; requirements for evidence of use), and are these mechanisms effective? The report is based on National Reports from Austria, Brazil, Belgium, France, Hungary, Italy, Malta, Romania, Sweden, the United Kingdom and the United States.[[1]](#footnote-1)

Trademark owners understandably want to protect their brands as broadly as possible. However, filing to register trademarks for goods and services for which the marks are not used can lead to cluttered trademark registers which increase the cost (deadweight loss) of launching a new brand, and may restrict dynamic competition particularly from smaller players.

Different jurisdictions have taken a range of approaches, which have evolved and changed over time: from requirements of use (and/or evidence of use) to potential revocation for non-use; from requirements of filing by class and limiting scope within class to requirements that filings are not made in bad faith. For example, bad faith has been an issue in recent cases in Europe (from *Hasbro* through *Sky v SkyKick* which is, at the time of this Report, pending a decision from the United Kingdom Supreme Court).

The purpose of this contribution is to explore how the 11 contributing countries have balanced the freedom of registration against limiting abusive or competition-restrictive trademark registrations. While all countries reported mechanisms to forestall or eliminate such registrations, we can observe significant variance in the degree to which this is considered to be a problem and what types of measures are available to prevent or remove them.

The report will proceed as follows: first, we will discuss the availability of signs, specifications of goods and services, and the requirement of use. Next, we will discuss the functioning of the reporting countries’ trademark registries and the perceptions (or lack thereof) of clutter. Finally, we will discuss measures available to ensure the integrity of the trademark registration system and close with proposed conclusions regarding the state of the trademark registration system and possible measures to improve it.

1. Background

Of the roughly 106 million intellectual property rights in force, over 75 million are trademark registrations, making them the most numerous form of IPR.[[2]](#footnote-2) There has also been significant growth in the number of trademark applications and registrations.[[3]](#footnote-3) While there may not be formal obstacles to the use of unregistered trademarks, registration offers several advantages. A registration is *prima facie* evidence of rights, which means that it may be enforced against third parties without the requirement of proving rights. On a practical level, a registered mark is easier to monetize through licensing, to pledge as collateral, to list on a balance sheet, or to wield against a cybersquatter to recover a domain name. While acknowledging the robust protections for unregistered marks in countries such as the United States, the desirability of registration is nevertheless demonstrated clearly by the ever-larger number of marks registered anew and those remaining in force.

* + 1. Availability of Signs

The steady growth in applications demonstrates that trademarks are desired and desirable. But are marks available to new entrants? The National Reports echo these concerns. For example, the French report notes that “in certain classes, it is extremely difficult to find a sign available. For instance, in class 3 (cosmetics and perfumery, 25 (fashion items) or 35 (advertisement).”[[4]](#footnote-4)

The focus of this International Report is the phenomenon of marks that are registered for goods and services that extend beyond the actual scope of the registrant’s activities. Taking a step back, however, it is worth noting that the size of the initial pool of potential signs is finite. Not every sign can become a trademark. Article 15 of the TRIPS Agreement sets out the overall definition of what may serve as a trademark:

Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.[[5]](#footnote-5)

In other words, to be eligible for registration as a trademark, the object must be a sign that can distinguish. Not every sign meets this requirement. We can look to the case law to illustrate how the “sign” requirement works. In Europe and the United Kingdom, for instance, two aspects are noteworthy. First, a “sign” must have only one permutation. For this reason, the shape of the transparent Dyson vacuum cleaner canister could not be a trademark in Europe, because it was “capable of taking on a multitude of appearances.”[[6]](#footnote-6) Similarly, in the United Kingdom, the appearance of the Scrabble game tile (which has a letter and a number in various combinations) did not meet the requirements of a “sign.”[[7]](#footnote-7) Second, the sign must be capable of being represented in a way that is, to quote the Court of Justice of the European Union, “clear, precise, self-contained, easily accessible, intelligible, durable and objective.”[[8]](#footnote-8) In this way, for example, a non-traditional sign such a scent could, in principle, be registered if it could be represented on the register in the proper way.

Turning to the availability of signs that may serve as trademarks, some scholars voice concern that the “good” marks are all taken. Registration has been described as a zero-sum game: “If, however, we take the view that some signs are better than others and the pool of available marks is limited, then the costs to other traders of one trader being granted ownership of a particular mark may be significant. As the better marks are used up, a trader will have to invest more and more money in establishing and building suitable associations with their signs.”[[9]](#footnote-9)

The available data indicates that word marks are indeed becoming scarcer. In a 2018 empirical study of marks registered at the United States Patent and Trademark Office (USPTO), the authors concluded that trademark depletion is a serious issue: “the data present compelling evidence of substantial word-mark depletion, particularly with respect to the sets of potential marks that businesses prefer most: standard English words, short neologisms that are pronounceable by English speakers, and common American surnames.”[[10]](#footnote-10) In 2022, the same authors surveyed the European trademark system and concluded that the situation there was even worse.[[11]](#footnote-11)

It might be pointed out that, even if many desirable marks are unavailable at the moment, sooner or later at least some of those registrations will lose force and the marks will once again become available to new registrants. Not all brands are forever, and every trademark is vulnerable to a cancellation action if it is not used for the relevant statutory period, or if there was some defect in the mark or the intent of the filing party. As we shall see, however, the mechanisms for cleaning up the registry may be quite burdensome and are not always that effective. For that reason, the state of the registries has drawn considerable attention, and concern, in several of the reporting countries.

* + 1. Specifications of Goods and Services

Of the countries surveyed for this report, none reported that an “overly broad trademark” was specifically defined within the normative framework, though several reported that the concept was recognized by the courts or within the trademark office at the examination stage.

For the European Union member state countries, Article 39 of the Trademark Directive sets out the parameters for the specification of goods and services:

 2. The goods and services for which protection is sought shall be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that sole basis, to determine the extent of the protection sought.

3. For the purposes of paragraph 2, the general indications included in the class headings of the Nice Classification or other general terms may be used, provided that they comply with the requisite standards of clarity and precision set out in this Article.

4. The office shall reject an application in respect of indications or terms which are unclear or imprecise, where the applicant does not suggest an acceptable wording within a period set by the office to that effect.[[12]](#footnote-12)

Accordingly, countries reporting from European Union member states reference EU jurisprudence on the issue. The Austrian National Report, for example, notes that, in accordance with European Union jurisprudence, the Austrian Patent Office “refuses protection for certain notions which are considered overly broad, like ‘machines’ in class 7.”[[13]](#footnote-13) The Belgian National Report notes that

It is probably impossible, nor desirable, to define the concept, as the qualification of what constitutes an overly broad trade mark depends on the concrete circumstances of each case, taking into account, in particular, of the subjective intentions of the applicant and the commercial logic of a filing. Case law has repeatedly stressed that it is ‘legitimate for an undertaking to seek registration of a mark, not only for the categories of goods and services which it markets at the time of filing the application, but also for other categories of goods and services which it intends to market in the future.”[[14]](#footnote-14)

The national courts in European countries have also ruled on this issue. The Hungarian National Report references a Bucharest Court of Appeal case in which the court held that “where the products and services for which a trademark is registered are not expressly and exhaustively identified, the rights conferred are insufficiently clear and delimited and thus the enforcement of those rights can lead to abuse or equivocal determinations of the scope of those rights.”[[15]](#footnote-15) The National Reports for Sweden and Malta note national legislation reflecting the requirements of the Trademark Directive concerning the clarity and precision of trademark specifications.

Outside the European Union, reporting country Brazil notes that the Brazilian Patent and Trademark Office applies an active approach to managing specifications of goods and services. During substantive examination, “the BPTO will be able to promote changes in the terms of the specification to the point of becoming sufficiently clear and precise.”[[16]](#footnote-16)

A final issue concerning the specification of goods and services is the use of class headings in a registration. In the European Union (and the United Kingdom as a former European Union Member States), since the decision of the Court of Justice in the *IP TRANSLATOR* case in 2012, [[17]](#footnote-17) if the application contains class headings from the Nice Classification,[[18]](#footnote-18) the goods and services thereby included in the application are only those literally listed in the application. Previously, if the specification of goods and services included a class heading, the registration would then be interpreted as encompassing all the goods and services included in that class. In the United States, as shall be discussed in more detail below, the specification of goods and services has always been limited to the literal meaning of the words.

* + 1. The Requirement of Use of a Trademark

One of the key differences between trademarks and other types of intellectual property rights is that registrations are always granted in respect of specified goods and services, thereby not creating an absolute monopoly on the sign.[[19]](#footnote-19) While it is beyond the scope of this report to debate the enhanced protection afforded well-known marks,[[20]](#footnote-20) the specifications of goods and services can generally be thought of as defining the boundary of the exclusive rights enjoyed by the trademark holder.

Trademarks, therefore, do not exist in a vacuum; they are tightly bound to the goods and services for which they are registered. Scholars debate the tension between the functions of a trademark as an indication of source, a legal basis to control the use of the mark, a form of property, and/or a value in its own right.[[21]](#footnote-21) In the European Union, the source-identifying function has been recognized as primary by the Court of Justice, which has held that “the identity of the origin of the trade-marked product to the consumer or ultimate user, by enabling him without any possibility of confusion to distinguish that product from products which have another origin.”[[22]](#footnote-22)

Trademarks indicate source by being used in commerce, meaning they are affixed to or communicated with goods and services in a way that they are available to the public. For right holders and trademark professionals, this is a foundational and obvious statement, and all the contributors noted that, in their jurisdictions, trademarks must be used to maintain validity. Countries differed in relation to whether and how use must be attested to or proved at registration or thereafter, but in every case use of the mark is required. At the least, a trademark for which its proprietor cannot provide evidence of use may be subject to cancellation.

It is quite interesting that the international treaty framework does not mandate use of a trademark. The Paris Convention does not mention a requirement of use at all; the TRIPS Agreement states use as an optional requirement to acquire or maintain a registration.[[23]](#footnote-23) Nevertheless, such requirements (at least in respect of maintenance) are in force in all countries surveyed. It should be noted that the contributors were not asked to specify the details of the types of activities that constitute “use” of a mark in their jurisdiction, and the National Reports did not reveal any striking peculiarities in the contributing countries. Nevertheless, it may be useful to consider a very general definition of “use” that is offered by the World Intellectual Property Organization:

…use of a registered trademark in the legal sense refers to the use of the trademark exactly as it is registered. […] The use of the trademark should be on or in relation to the products or services for which it is registered. […] Use must be serious use; token use is not sufficient in most countries to constitute use.[[24]](#footnote-24)

For the purposes of this Report, the focus is on the formal requirements of use relevant to the acquisition and maintenance of a trademark registration. The following table summarizes the findings in respect of these requirements. We can note quite a bit of variance even within our small number of reporting countries:

Figure 1: Requirements of Use of Registered Trademarks[[25]](#footnote-25)

|  |  |  |  |  |
| --- | --- | --- | --- | --- |
| **Jurisdiction** | **Declaration of intent to use at filing?** | **Proof of use required to register?**  | **Duty to provide evidence of use to maintain registration?** | **Duration of permissible non-use post-registration?** |
| **Brazil** | Yes | No | No | 5 years |
| **United Kingdom** | Yes | No | No | 5 years |
| **United States** | Yes, if not already actually using in commerce.  | **Yes. Pertains to each good/service listed.** | **Yes** | **3 years** |
| **EU countries (Benelux, France, Hungary, Italy, Malta, Sweden, Romania)** | **No, such intention is presumed** | No | No | 5 years |

1. The Functioning of National Trademark Registries

The national reports reflect quite different views on the degree to which clutter is perceived as a problem, and accordingly different views on the necessity and efficacy of measures intended to curb it.

* 1. Perceptions of Clutter

At the outset, we should note that the National Reports revealed rather different views on the functioning of the national trademark registration systems. Considering the framing of Question B, this result is perhaps contrary to our initial expectation. However, seven of the 11 reporting countries did not report significant concerns with clogging or a lack of availability of measures to address overbroad trademarks. Relevant quotes from the National Reports are summarized below.

Figure 2: Qualitative Description of the Trademark Registration System

Neutral to Positive Assessments

|  |  |
| --- | --- |
| **Country** | **Description of the Effect of Overly Broad Trademarks on the Functioning of the Trademark Registration System** |
| Austria | “…a thoroughly functioning system…”[[26]](#footnote-26) |
| Belgium | “The system is balanced and works quite well.”[[27]](#footnote-27) |
| Brazil | “The BPTO application procedure proves to be quite efficient in preventing trademarks, a priori, from being used in bad faith to restrict competition (which also makes the procedure for registering a trademark very quick and efficient.”[[28]](#footnote-28) |
| France | “The French system seems to us to be quite efficient.”[[29]](#footnote-29)  |
| Hungary | “…we do not consider the trademark register to be clogged.”[[30]](#footnote-30) |
| Malta | “The mechanisms in Malta which are in place to address the filing of overly broad trademarks are generally effective.”[[31]](#footnote-31) |
| Sweden | “…a fair balance between, on the one hand, the interest in preventing a cluttered regiser, and on the other, the interest in enabling actors in Sweden to protect its intellctual property from improper exploitation at an earlier stage.”[[32]](#footnote-32) |

The four remaining countries reported a rather less laudatory assessment of the state of the trademark registration system, as is summarized in the below table.

Figure 3: Qualitative Description of the Trademark Registration System

Neutral to Negative Assessments

|  |  |
| --- | --- |
| **Country** | **Description of the Effect of Overly Broad Trademarks on the Functioning of the Trademark Registration System** |
| Italy | “The Italian trademark register could be defined as clogged.”[[33]](#footnote-33) |
| Romania | “…revoking trademarks for non-use is a long and expensive endeavor, only seldomly being undertaken…”“…the case-law of the High Court seems to impose too high a threshold for a finding of fraudulent intent…”[[34]](#footnote-34) |
| United Kingdom | “…strong evidence to suggest that the phenomenon of trade mark cluttering existed in the UK.”[[35]](#footnote-35) |
| United States | “The abuse of the trademark registration system has reached a crisis level in the United States. ”[[36]](#footnote-36) |

Of the reporting countries, the two that noted the greatest problems on the registries are the United States and the United Kingdom.

The United Kingdom was the only country that reported definitions for the relevant terminology. The National Report points us to government-commissioned research on clutter in which an over-broad trademark is defined as “applications and registrations for marks not used nor likely to be used for some or all of their claimed goods/services,”[[37]](#footnote-37) whereas clutter is the “existence of marks on these registers that are partly or wholly unused by their owners.”[[38]](#footnote-38) The United Kingdom National Report further breaks down clutter into two subcategories: “volume clutter” (the growing number of registrations in an increasing number of classes of goods and services) and “non-use clutter” (registered marks that are registered too broadly and/or are not used).[[39]](#footnote-39) Both types of clutter are described in the Report as prevalent, for two primary reasons. First, there is no requirement that the applicant provide proof of use at registration (as in the United States). Second, trademark attorneys customarily draft applications with broader specifications of goods and services than might be “strictly necessary,” as the Report terms it, for the purpose of helping their clients.[[40]](#footnote-40)

The author of the UK National Report was granted access to UKIPO registration data, which revealed a 43.5% rise in trademark filings in 2021 (as compared to the previous year), with the number of registrations awarded rising by 77.5% in the same period. The total number of classes filed and registered grew by 54.8% and 87.9%, respectively.[[41]](#footnote-41) While empirical data for trademark clutter was not available, the author of the United Kingdom National Report infers from the volume and type of filings that over-broad filing and unused trademark registrations are present and most likely increasing. Such a conclusion is also supported by the previously cited 2015 report commissioned by the UKIPO on a quantitative and qualitative analysis of marks effective in the UK (at the time including marks registered at the UKIPO and in the EU). This report analysed the goods and services stated in the specifications. The research revealed that “non-use is far more extensive than previous work suggested…the report strengthens the case for those arguing that clutter is pervasive in European trade mark registers.”[[42]](#footnote-42)

A rather more positive view of the European Union trademark system is found in a 2012 study, in which the authors acknowledged a certain amount of “cluttering” on the EU trademark registry, creating challenges for new market entrants: “Searches to identify potential conflicts in advance of new registrations are as a result subject to uncertainties, and the scope for the choice of new trade marks is tending to become narrower.”[[43]](#footnote-43) Despite this shortcoming, the authors point to two reasons that significant changes, such as a requirement that registrants issue a statement of use, would not be needed. First, only 29% of right holders surveyed felt that registrations of unused or partly used marks were a problem. Second, the statistical rate of oppositions at OHIM (the predecessor to today’s European Intellectual Property Office) remained steady even as the number of applications grew.[[44]](#footnote-44)

In contrast to the United Kingdom and European countries, where there is no requirement of use of the mark at the time of registration, the situation, as discussed, is very different in the United States. Under the Lanham Act[[45]](#footnote-45) (the federal trademark statute), a mark may not be registered unless the applicant verifies that the mark is being used in commerce for all the goods and services identified in the trademark application. The applicant must provide at least one “specimen of use” for each class, though the duty to use the mark (and the obligation to furnish proof thereof if requested by the USPTO) remains in respect of all the goods and services listed.[[46]](#footnote-46) As the National Report describes, this requirement to furnish specimens of use extends to maintenance filings required at five and ten-year intervals following registration.

Given these strict requirements, it would seem that clutter could hardly be possible in such a system. However, the situation is reportedly far from ideal. In fact, the United States National Report describes the problem of clutter as significant and describes “extraordinary abuses in the historically dull world of trademark prosecution and maintenance certainly ‘clog’ the United States trademark registers, although the implications go much further.”[[47]](#footnote-47) There are two primary problems identified by the National Report. One is fraud. The USPTO is cited as reporting that bad actors file “tens of thousands of applications containing improper submissions that include false signatures, false addresses, and false claims of use required to obtain and maintain a registration, and false or hijacked U.S. attorney credentials.”[[48]](#footnote-48) Additionally, there is a problem of “false or inaccurate use claims and submission of fake or digitally altered specimens that do not actually show use of the mark in U.S. commerce in the ordinary course of trade as required by law.”[[49]](#footnote-49) Bloomberg Law reports that the USPTO is “overwhelmed” by scams.[[50]](#footnote-50) Such a situation might be described as demonstrating “volume clutter”—many filings and excess classes of goods and services.

Even where overt fraud may not be in evidence, the United States National Report states that there is a significant compliance gap for trademark registrations. The National Report cites 2014 audit of 500 trademark registrations found that 50% of the registrations included goods and services for which use could not be confirmed.[[51]](#footnote-51) In other words, these registrations could be termed overbroad and indicate non-use clutter, to borrow the British terminology, because they are registered beyond the use of the mark in commerce.

Among the reporting countries, the United Kingdom and United States stand apart in the extent and depth of the reported problems with the trademark registries. Even if the majority of the other reporting countries described their trademark registration systems as functioning well, the existence of overbroad claiming and non-use is acknowledged. The report from Malta states that that overbroad registrations are increasing bureaucratic load: “In spite of Malta’s small size, these risks and dangers are still very much present on a local level. As a result, local examiners are being forced to apply a more stringent approach to reviewing applications in order to preserve the integrity of our trademark system.”[[52]](#footnote-52)

The National Report of Sweden identifies a uniquely Swedish issue, namely, the discrepancy in the legal protections for trademarks and company names. One scenario identified in the national report is where a trademark (or company name) is refused registration on relative grounds due to a company name that is “barely used or used only for part of its registered objects.”[[53]](#footnote-53) The requirements to show genuine use for a company name are less strict than the analogous requirements for a trademark. The result is that company names are in practice afforded greater protections than trademarks, as there is no mechanism to seek a partial cancellation of a company name for non-use in Sweden.

The Romanian report noted that its national courts had recognized the concept of “blocking trademarks, the existence of which hampers the choice and registration of new marks.”[[54]](#footnote-54) The report states that “the Bucharest Court of Appeals held that a blocking trademark is an abuse of the right to register a trademark by diverting the right from the purpose for which it was established, which is to distinguish products and services, to an illegitimate one, i.e. to block other persons’ access to a certain trademark.”[[55]](#footnote-55) The concept of blocking trademarks is an interesting one that did not explicitly appear in the other countries’ reports but certainly goes directly to the heart of the issue of trademarks taking up space on the registry for improper purposes. An area for further investigation would be the recognition of this concept in other jurisdictions.

Before turning to the availability of counter-measures, we may briefly consider the issue of mass filings. As has been discussed, United States report mentions the phenomenon of large numbers of fake trademark filings; the United Kingdom report notes the phenomemon of “volume clutter.” In light of this, it is quite interesting to note that the infamous “trademark troll” Michael Gleissner, who is reported to have filed around 6,800 marks around the world since 2016, is reported to have pursued his activities of mass filings and spurious opposition actions at least four of the reporting jurisdictions: Belgium, Brazil, the United Kingdom and the United States.[[56]](#footnote-56) The National Reports from Brazil, the United Kingdom and the United States do not mention Mr. Gleissner at all; the National Report from Belgium states that, in response to Mr. Gleissner’s activities, the available “sanctioning mechanisms have so far provided adequate remedy, albeit taking their time.”[[57]](#footnote-57) Notably, this report notes that “these rather isolated cases are insufficient to speak of any ‘significant’ effects.”[[58]](#footnote-58) We may perhaps observe that, in Belgium (Benelux) and Brazil the system is sufficiently robust to handle the scale of filings it has received. The situation in the United Kingdom and United States may simply be that Mr. Gleissner, while notorious, is by now one among many bad actors.

1. Legal Bases and Measures to Combat Overbroad Registrations

This section of this Report will first explore two possible alternate legal bases for limiting overbroad trademark registrations: bad faith and non-use. Next, we will discuss measures to limit overbroad trademark registrations, which fall into several categories based on the procedural stage at which they are available: *ex officio* measures taken by national trademark offices, and measures taken at or subsequent to registration, such as opposition and cancellation actions. Our aim is to understand the reasons for and against relying on one or the other legal basis, and the procedural possibilities to do so.

* 1. Legal Bases to Address Trademark Clutter

In all the reporting countries, trademarks may be limited (by which we should understand either not registered or removed from the trademark registry) on the basis of so-called absolute grounds (a defect in the mark itself, most commonly lack of distinctiveness) or relative grounds (the mark is identical or confusingly similar to another’s earlier rights).[[59]](#footnote-59) In this section, we will first consider bad faith. After that, we will contrast such a basis with applications to cancel based on non-use of an existing trademark.

* + 1. Bad Faith

As a basis for refusal or invalidation of a registration, bad faith is technically an absolute ground, which means that it is not directly dependent on the existence of third-party rights, though it is clear from the cases that an interested third party is usually involved somehow in the proceedings. As we shall discuss, it is not necessarily an easy and straightforward way of combatting overbroad trademarks, as a petitioner must prove that the party filing the trademark acted with the requisite ill intent. Bad faith, in fact, is a close cousin of the Paris Convention prohibition on unfair competition, namely:

Any act of competition **contrary to honest practices** in industrial or commercial matters constitutes an act of unfair competition.[[60]](#footnote-60)

The case law on bad faith in trademark registrations is very broad, and most of the reporting countries reported that the number of such cases has been increasing. For purposes of trying to predict whether bad faith will serve as a reliable basis for challenging overbroad trademark registrations, however, it is worth noting that the jurisprudence is heavily fact-dependent, and it is quite challenging to identify overarching rules.

The governing law in all our reporting countries provides that trademarks filed in bad faith are subject to removal from the trademark registry. While the details may differ slightly across these countries, a generally useful definition of “bad faith” may be found in the jurisprudence of the Court of Justice of the European Union.

In 2019, the Court of Justice stated that “in accordance with its usual meaning in everyday language, the concept of ‘bad faith’ presupposes the presence of a dishonest state of mind or intention, that concept must moreover be understood in the context of trade mark law, which is that of the course of trade.”[[61]](#footnote-61) In a landmark 2008 case concerning the revocation of an EU trade mark, the Court of Justice had provided a non-exhaustive list of “relevant factors” that the national court must consider in finding bad faith:

– the fact that the applicant knows or must know that a third party is using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought;

– the applicant’s intention to prevent that third party from continuing to use such a sign; and

– the degree of legal protection enjoyed by the third party’s sign and by the sign for which registration is sought.[[62]](#footnote-62)

In a 2013 case, the Court of Justice extended this approach to marks registered in EU Member States under the Trademark Directive, thereby identifying bad faith as an autonomous concept of European Union law, meaning that the concept must be interpreted and applied in a similar fashion across the European Union.[[63]](#footnote-63). As a basis for trademark opposition or invalidation, bad faith can take various forms. In the most obvious cases, an applicant files a mark with knowledge that another party has rights in an identical or confusingly similar mark, with the intention to take advantage of or to harm the earlier mark. Other examples of conduct that have been found to demonstrate dishonest intention: speculative filings, a prior relationship between the parties, or requests for compensation.

The dispute in *Sky v. SkyKick*, which inspired this Question, involves a totally different kind of scenario. This dispute began as an action brought in English court by British broadcaster Sky plc against Skykick UK Ltd. (a company that offers cloud services) for infringement of its European Union and United Kingdom SKY marks. SkyKick counterclaimed for invalidity, claiming that the specifications of goods and services of Sky’s trademarks lacked clarity and precision, and/or that the marks had been filed in bad faith as Sky had not had the intention to use the marks for all the goods and services for which it was filed. The High Court referred to the Court of Justice of the European Union questions concerning whether an overly broad specification could form the basis for an invalidation based on bad faith. In its highly anticipated ruling in [Case C-371/18](https://curia.europa.eu/juris/document/document.jsf?docid=222824&mode=lst&pageIndex=1&dir=&occ=first&part=1&text=&doclang=EN&cid=17953924) of 29 January 2020 the Court of Justice affirmed the following:

* A trademark cannot be declared wholly or partially invalid on the basis that the specification of goods and services lacks clarity and precision;
* A trademark filed without intent to use the mark in relation to the goods/services specified may be found to have been filed in bad faith (in respect of those goods/services for which there is no intent to use) if one of the following conditions is met:
* the applicant had the intention of undermining the interests of third parties,
* the applicant had the intention of obtaining exclusive rights for purposes other than those falling within the functions of a trademark.

Based on this, in 2018, the High Court of England and Wales invalidated (in part) the SKY registration.[[64]](#footnote-64) However, the Court of Appeal subsequently overturned this ruling.[[65]](#footnote-65) The decision has been appealed by SkyKick to the Supreme Court of the United Kingdom, where the hearing took place at the end of June 2023.[[66]](#footnote-66)

*Sky vs. Skykick* is being closely followed within and outside the United Kingdom for at least two reasons. First, the case is among a substantial and growing body of decisions in which trademark registrations are challenged based on bad faith, a phenomenon that has been noted in jurisdictions around the world.

In some recent cases, however, bad faith has been the basis of trademark invalidation even where the conduct in question is not directed to harming the rights of third parties. For example, the General Court of the European Union invalidated a registration for MONOPOLY filed by Hasbro.[[67]](#footnote-67) There was no question that Hasbro had rights to the MONOPOLY mark. Rather, the basis for the bad-faith finding was that Hasbro had re-filed its own mark for procedural reasons related to an opposition proceeding. In MONOPOLY, the General Court extended bad faith to encompass cases of where a mark was filed for an improper procedural advantage.

In *Sky v Skykick,* there is similarly no dispute over whether Sky plc is the proper right-holder of the SKY mark. The issue is rather over the permissible breadth of the goods and services stated in the trademark registration.

At the heart of *Sky v Skykick* is the relationship between the requirement to use a mark in commerce and the specification of goods and services and the intent, or lack thereof, to use the mark for all those goods/services. While future-proofing a trademark application to encompass activities that the right holder would reasonably expect to undertake does not appear to be under threat, the question is where the line may properly be drawn. Observers around the world are waiting for the decision in *Sky v SkyKick*, which promises to influence practice in trademark registrations far beyond the United Kingdom.

* + 1. Non-Use

Non-use may be commented quite briefly, as the basis is straightforward: where a mark has not been used in commerce for the statutory period for the goods and services listed in the registration, it is subject to cancellation. Other than in the United States, where non-use is also a basis for opposition (due to the fact that trademarks must be used in commerce in order to qualify for registration), non-use is available only as a measure following registration and the expiry of the grace period.

The reporting countries confirmed that cancellation for non-use, described in greater detail in Section 4.2.5. below, generally speaking, could be directed at only part of the goods and services in the registration. The amount or nature of use was described as anything beyond token use; the threshold is quite low. Therefore, this legal basis could be considered a useful tool for “cleaning up” registries. The exception, again, is the United States, where a failure to use the mark in respect of any one of the goods or services could lead to the cancellation of the entire registration, even without any intent to commit fraud.[[68]](#footnote-68)

A related question for further exploration is the extent to which the mark must be used for each and every good and service listed in the registration. The United States is the only reporting jurisdiction for which the answer is very clear: yes. The other countries did not report that such a bright line rule existed.

* 1. Measures Available to Address Overbroad Filings

The measures available can be grouped according to when they may be deployed during the life-cycle of a trademark registration.

* + 1. Early-Stage Measures

Several countries reported examples of measures intended to prevent the registration of overly broad marks. The first type could be termed structural measures—setting up the registration system in a particular way or organizing the fee structure to discourage speculative filings. The second type refers to the role of the trademark examiner during the substantive examination of a trademark application.

With respect to structural measures, the National Report for Brazil reports the trademark application system guides applicants to select from predetermined options when stating goods and services.[[69]](#footnote-69) In Malta, the trademark registration system features a “goods and services builder” containing pre-approved terms that applicants are encouraged to adopt.[[70]](#footnote-70) In France, the fee structure was modified. Whereas previously a single fee covered up to three classes of goods or services, following reforms the fees were broken out by class.[[71]](#footnote-71) In the United Kingdom, a fee structure charging separately for additional classes was also considered a contributing factor to the prevalence of applications in one or two classes only.[[72]](#footnote-72)

With respect to the role of the examining attorney, the National Report for Sweden reports that it is “quite common” for the examining attorney to issue a preliminary refusal so that an applicant may clarify terms.[[73]](#footnote-73) Similarly, the National Report for Austria reports that “the competent clerks of the Austrian Patent Office very often question the specific list of goods and services, which is filed together with the trademark application.”[[74]](#footnote-74)

The report for the United States highlights both types of measures. The USPTO has drafted (and encourages applicants to use) the “Acceptable Identification of Goods and Services Manual.” The inducement is that applicants may hope that using these terms will speed processing times.[[75]](#footnote-75) Following the 2019 adoption of new rules designed to improve the integrity of the registration process, however, a 2021 internal audit revealed that, in practice, the USPTO was “not effective in preventing inaccurate trademark registrations.”[[76]](#footnote-76) For example, examining attorneys were not exercising their authority to question specimens of use submitted by trademark applicants. As a result, a randomly audited sample revealed that 37% of trademark applications contained specimens of use that were “digitally altered or mocked-up.”[[77]](#footnote-77) The audit proposed that steps be taken by the USPTO including automating some part of the application verification process at the examination stage.[[78]](#footnote-78)

* + 1. Measures Available Subsequent to Filing a Trademark Application

There are four possible stages at which overbroad or unused trademark registrations may be refused or cancelled. The national reports reveal procedural differences as far as availability of measures, standing to bring an action, the possible role and involvement of third parties, etc. As the objective of this International Report is to get a sense of the possible universe of measures and identify which, if any, appear to be especially effective, we will not here attempt a full-scale explication of the procedures available in each of our 11 reporting countries. Instead, we will summarize the relevant information and attempt to observe overall patterns and trends.

* + 1. *Ex Officio* Refusals to Register

Procedurally, the first type of measure is the *ex officio* refusal of a trademark office to register a mark at the examination stage. It should be noted that, for purposes of this study, we will not explore all the possible absolute and relative grounds of refusal. Instead, we will focus on three issues: an unclear specification of goods, overbroad claims, and bad faith of the applicant. For the United States, moreover, there is the additional ground of failure to use the mark in commerce.

For purposes of this Report, we can consider that an unclear specification of goods is one that employs terminology that lacks the required specificity to identify the goods or services for which the exclusive trademark rights are being sought. For instance, as has been discussed, the term “machines” may not be registered in the European Union Member States in class 7.[[79]](#footnote-79) In the United States, the USPTO will not register the term “computer programs;” it will require the applicant to state for which purpose the computer programs are intended.[[80]](#footnote-80) It should be noted that, in case of refusal for an unclear specification of goods, the reporting countries stated that the relevant trademark office would permit the applicant to attempt to remedy the specification prior to issuing a refusal.

For this report, the term “overbroad claims” is used to indicate specifications of goods and services that are remote from the applicant’s actual field of activity. While there is a certain amount of overlap between these concepts, the question we pose is whether the trademark office plays any role in filtering out applications that may be filed for the purpose of obstructing a competitor or in some other way seeking an undue advantage. On that basis, therefore, the availability and relevant possible bases of this measure in our reporting countries may be summarized as follows:

Figure 4: *Ex Officio* Objections or Refusals to Register

|  |  |  |  |  |
| --- | --- | --- | --- | --- |
| **Country** | **Refusal or objection for unclear specification of goods?** | **Refusal or objection for overbroad claims?** | **Refusal for bad faith?** | **Role, if any, of third parties and their rights.** |
| **Austria** | Yes | No | No | -- |
| **Belgium** | Yes | No | No | -- |
| **Brazil** | Yes | **A link to applicant’s field of activity is mandatory** | No | -- |
| **France** | Yes | No | No | -- |
| **Hungary** | Yes | No | **Yes** | Third parties may file observations |
| **Italy** | Yes | No | **Yes** (where “manifestly fraudulent” intent) | -- |
| **Malta** | Yes | No | No | -- |
| **Sweden** | Yes | **Defensive registrations not permitted** | **Yes** | Third parties may file observations |
| **Romania** | Theoretically possible | No | No | -- |
| **United Kingdom** | Yes | Pending outcome in *Sky v. Skykick* | **Yes** (but not common) | A mark may be refused registration based on relative grounds. |
| **United States** | Yes | No general prohibition, but specimens of use required for each class | **Yes** (where false identity or false specimens, for example) | A mark may be refused registration based on relative grounds. |

* + 1. Oppositions

A general observation from the table in the previous section is that, for most of our reporting countries, the trademark office does not play an central role in gate-keeping the registry against marks that are filed in bad faith and/or for a long and possibly unwarranted list of goods and services. The exceptions are the United Kingdom and United States, where the trademark office plays a significant and active role.

Instead, for all the reporting countries, inter partes proceedings, such as oppositions and cancellations, are perhaps the primary battleground against trademark filings made in bad faith and/or with overbroad specifications of goods and services.

In general terms, an opposition action is an administrative inter partes proceeding that takes place in the trademark office. It is a formal possibility for a third party to object to the registration of a trademark. While the period during which a mark is published for opposition most commonly takes place prior to registration, in some countries (including Austria), the opposition period begins to run at the moment of registration.

The availability of opposition proceedings and the requirements of standing are summarized in the next table. As in the previous table, we see that there is a fair amount of variance between countries. The first difference that we may observe is in the possible legal bases for the opposition action. In all countries, opposition based on relative grounds, filed by an earlier right-holder, is available. In a few countries, oppositions may be based additionally on other absolute grounds, such as a lack of distinctiveness. In a smaller number of countries, oppositions may additionally be based on based on bad faith. In absolute-grounds opposition cases, the standing requirements vary. Sweden, the United Kingdom and the United States have relatively open opposition procedures, based on absolute or relative grounds and with a larger pool of potential petitioners. France, Malta and Romania have quite a restrictive approach, limiting both the possible legal bases and the parties permitted to institute an opposition. In Sweden, in particular, the procedural availability of the opposition action for bad faith has recently been enlarged. Prior to 2021, bad faith was considered only a relative ground for cancellation (and for opposition). The effect was that such actions could previously only be brought by earlier right-holders. After the legislative amendments, bad faith cancellations were classified as absolute grounds actions, which can be brought by anyone.[[81]](#footnote-81)

The United States is the only reporting jurisdiction in which third parties may object to a registration based on non-use of the mark. This is due to the unique nature of the United States system under which, as earlier discussed, a mark must be used in commerce before it may be registered.

Figure 5: Opposition Actions

|  |  |  |  |
| --- | --- | --- | --- |
| **Country** | **May an opposition be based on absolute grounds generally?** | **Opposition based on bad faith?** | **Who has standing to bring an opposition action?** |
| **Austria** | **Yes** | No | Holder of a prior right  |
| **Belgium** | **Yes** | No | Holder of a prior right |
| **Brazil** |  | “Not commonly seen” |  |
| **France** | No | No | Holder of a prior right |
| **Hungary** | No | No opposition for bad faith.An observation based on absolute grounds (incl. bad faith) available  | Enumerated right holders (opposition)Anyone (observation) |
| **Italy** |  | **Yes**, where a prior relationship between parties. | Holder of a prior right |
| **Malta** | No | No | Holder of a prior right |
| **Romania** | No | No | Holder of a prior right (must be risk of confusion) |
| **Sweden** | **Yes** | **Yes** | If relative grounds—earlier right holder. If absolute—anyone. |
| **United Kingdom** | **Yes** | **Yes** | If relative grounds—earlier right holder. If absolute—anyone. |
| **United States** | **Yes** | **Yes** | “Any person who believes that he would be damaged by the registration of a mark.” Not consumers! |

* + 1. Post-Registration Procedures: Cancellations

A cancellation action is an inter partes action that is brought after registration with the effect of removing the trademark from the register. Typically, it may be brought either in court or in the trademark office. In European Union countries, there are two types of cancellation actions: a declaration of invalidity (effective retroactively, from the date of registration) and a revocation action (effective as of the date of the request.).[[82]](#footnote-82) Of particular interest to us are cancellation actions for non-use (which would correspond to a revocation action) and cancellation actions for bad faith (invalidity action).

In some of the reporting countries, new procedures have recently been introduced to streamline the cancellation process. In Italy, for example, reforms adopted in 2022 made cancellation actions available to larger pool of potential applicants.[[83]](#footnote-83) In Sweden, as above for opposition actions, bad faith is now considered an absolute ground and therefore not dependent on a finding that the registrant was targeting the applicant’s rights.[[84]](#footnote-84)

Figure 6: Cancellation Actions

|  |  |  |  |
| --- | --- | --- | --- |
| **Country** | **May cancellation be based on non-use?** | **May cancellation be based on bad faith?** | **Who has standing to bring a cancellation action?** |
| **Austria** | **Yes, after 5-year grace period** | **Yes** | An “everyman’s right”—no restrictions  |
| **Belgium** | **Yes, after 5-year grace period** | **Yes. An absolute or relative ground.** | Low requirements |
| **Brazil** | **Yes, after 5-year grace period** | “Not commonly seen” outside litigation |  |
| **France** | **Yes, after 5-year grace period** | **Yes** | No standing requirement in the trademark office, but standing required if in court |
| **Hungary** | **Yes, after 5-year grace period** | **Yes** | Depends on basis. If absolute grounds, anyone. |
| **Italy** | **Yes, after 5-year grace period** | **Yes** | “Interested parties” |
| **Malta** | **Yes, after 5-year grace period** | **Yes** | Holder of a prior right |
| **Romania** | **Yes, after 5-year grace period** | **No** | Holder of a prior right (Must be risk of confusion) |
| **Sweden** | **Yes, after 5-year grace period** | **Yes** | If relative grounds—earlier right holder. If absolute—anyone. |
| **United Kingdom** | **Yes** | **Yes** | If relative grounds—earlier right holder. If absolute—anyone. |
| **United States** | **Yes.** Cancellation in Trademark Trial and Appeal Board. A new expungement proceeding to challenge a mark for non-use in USPTO. | **Yes** | No standing requirement for expungement |

1. Summary and Draft Conclusions

The situation with clutter, or overbroad trademark registrations, appears to be far from homogenous. Of the 11 reporting countries, seven did not even find it particularly problematic, either because of the low volume of such trademark filings or because of the availability of effective means of preventing or remedying such registrations.

Of the four countries that found their systems challenged by trademark clutter, Romania and Italy referenced an imbalance between the volume of clutter and the efficiency of measures to address it. The United Kingdom and United States both are contending with sheer volume. In the United Kingdom, the primary issue is over-broad specifications of goods and services. In the United States, vast numbers of fraudulent filings or those that are sub-compliant with requirements of use.

In respect of bad faith cases, several jurisdictions noted that the overall number of such cases is increasing, though there were very few cases mentioned (with *Sky v SkyKick* a notable exception) where the sole basis of a claim of bad faith was the over-broad specification of goods and services. Relatively few countries had established measures to empower trademark offices to prevent such applications from reaching registration. Opposition proceedings for bad faith were not available everywhere. Additionally, the bar to prove that a trademark was filed in bad faith is quite high. In most cases, it is necessary for the challenging party to prove that the filing party was acting intentionally to abuse the trademark system.

Post-registration cancellation for non-use is procedurally easier and the evidentiary requirements are less complicated—the challenging party cannot prove a negative, so the burden lies on the trademark registrant to provide evidence of genuine use. The great disadvantage is that cancellation must (again, except in the United States) wait until the statutory period of non-use has expired. In nearly all countries this period is five years.

The picture, therefore, is quite fractured, and it would be difficult to articulate solutions that would suit (or even be needed in) all countries.

To improve the availability of marks, one proposal might be to minimize standing requirements for inter partes proceedings related to bad faith or non-use. It is quite difficult to imagine that a party without a commercial or other valid interest would go to the trouble of bringing an action to challenge a third-party mark without a good reason. The additional step of proving an interest in a proceeding might not be necessary. In particular, non-use actions are in the public interest of the integrity of the trademark system, and example of countries like Austria and Sweden might be emulated.

A second, more controversial proposal might be to institute the requirement to prove use of a mark to maintain a registration. Such measures are not a panacea, but might help clear away some of the deadwood, leaving a more open field for new entrants to file and register trademarks.

1. The author extends sincere thanks to the authors of the excellent National Reports. Austria: Andrea Zinober; Brazil: Lucas Bernardo Antoniazzi; Belgium: Jeroen Muyldermans; France: Sandrine Bouvier-Ravon, Jean-Christophe Guerrini and Sophie Micallef; Hungary: Zsófia Lendvai, Gusztáv Bacher, Máté Borbás, Mihály Budai and Bettina Kövecses; Italy: Elena Prandoni; Malta: Philip Mifsud and Sasha Muscat; Romania: Paul Buta; Sweden: Filip Kylvåg, the United Kingdom: Luminita Olteanu; and the United States: Larry Nodine. [↑](#footnote-ref-1)
2. Figures are available at the WIPO IP Statistics Data Center data at <https://www3.wipo.int/ipstats/key-search/search-result?type=KEY&key=205> (last visited September 15, 2023). The most recent specific figures for IPRs in force as of 2021 (updated in July 2023): 75,404,400 trademarks, 16,545,000 patents, 5,276,400 industrial designs, and 9,541,400 utility models. [↑](#footnote-ref-2)
3. WIPO reports that trademark applications rose 5% from 2021-2022, yet another year of steady growth. See WIPO Intellectual Property Indicators 2022, available at <https://tind.wipo.int/record/47082>. In the United Kingdom, for example, between 2020 to 2021, the number of trademark applications rose 43.5%, while the number of registrations granted increased by 75.7%. *See* the United Kingdom report, section 1, at notes 11-12. [↑](#footnote-ref-3)
4. French National Report, Section 2.3. [↑](#footnote-ref-4)
5. Agreement on Trade-Related Aspects of Intellectual Property Rights 1994. [↑](#footnote-ref-5)
6. *Dyson Ltd v Registrar of Trade Marks* [2007] Court of Justice of the European Union C-321/03. [↑](#footnote-ref-6)
7. *JW Spear & Sons Ltd & Others v Zynga, Inc* [2012] England and Wales High Court (Chancery Division) [2012] EWHC 3345 (Ch). [↑](#footnote-ref-7)
8. *Ralf Sieckmann v Deutsches Patent- und Markenamt* [2002] Court of Justice of the European Union C-273/00. [↑](#footnote-ref-8)
9. L. Bently, B. Sherman, D. Gangjee, and P. Johnson (ed), *Intellectual Property Law* (6th edn, Oxford University Press 2022), at 858. [↑](#footnote-ref-9)
10. Barton Beebe and Jeanne C. Fromer, ‘Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion and Congestion’ (2018) 131 Harvard Law Review 948, at 951. [↑](#footnote-ref-10)
11. Barton Beebe and Jeanne C. Fromer, ‘The Future of Trademarks in a Global Multilingual Economy: Evidence and Lessons from the European Union’ (2022) 112 The Trademark Reporter 905. [↑](#footnote-ref-11)
12. Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks. [↑](#footnote-ref-12)
13. Austrian National Report, Section 1. [↑](#footnote-ref-13)
14. See the Belgian National Report, Section 2.1, at note 4, citing to Judgment of 7 July 2016, *LUCEO*, T-82/14, ECLI:EU:T:2016:396, par. 29-31 and Judgment of 14 February 2012, *BIGAB*, T-33/11, ECLI:EU:T:2012:77, par. 25. [↑](#footnote-ref-14)
15. Hungarian National Report, Section 1, at note 2, citing Bucharest Court of Appeals, 4th Civil Chamber, Decision No. 242 of 10 March 2020, in *Sintact.* [↑](#footnote-ref-15)
16. Brazilian National Report, Section 1.1. [↑](#footnote-ref-16)
17. *Chartered Institute of Patent Attorneys v Registrar of Trade Marks* [2012] Court of Justice of the European Union C-307/10. [↑](#footnote-ref-17)
18. For example, the heading for Class 12 is “Vehicles; apparatus for locomotion by land, air or water.” See the Nice Classification at <https://www.wipo.int/classifications/nice/nclpub/en/fr/>. [↑](#footnote-ref-18)
19. L. Bently, B. Sherman, D. Gangjee, and P. Johnson (n 3), at 857. [↑](#footnote-ref-19)
20. Set forth in the Paris Convention for the Protection of Industrial Property 1979, Article 6bis. [↑](#footnote-ref-20)
21. See, for instance, the discussion of the debate on the purpose of a trademark in Mark McKenna, ‘The Normative Foundations of Trademark Law’ (2007) 82 The Notre Dame Law Review 1840. [↑](#footnote-ref-21)
22. See, for example, Case C-102/77, *Hoffmann-La Roche & Co. AG v Centrafarm Vertriebsgesellschaft Pharmazeutischer Erzeugnisse mbH,* ECR 1978 01139, at paragraph 7. [↑](#footnote-ref-22)
23. See, for instance, Article 15(3) of the TRIPS Agreement, which provides : «Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filing an application for registration.» Article 19 TRIPS states: «If use is required to maintain a registration, the registration may be cancelled only after an uninterrupted period of at least three years of non-use, unless valid reasons based on the existence of obstacles to such use are shown by the trademark owner. » [↑](#footnote-ref-23)
24. *Making a Mark: An Introduction to Trademarks for Small and Medium-Sized Enterprises*. WIPO Intellectual Property for Business Series Number 1 (2017), p. 58. Available at <https://tind.wipo.int/record/29006>. [↑](#footnote-ref-24)
25. Source: National Reports [↑](#footnote-ref-25)
26. Austrian National Report, Section 6. [↑](#footnote-ref-26)
27. Belgian National Report, Section 4. [↑](#footnote-ref-27)
28. Brazilian National Report, Setion 3. [↑](#footnote-ref-28)
29. French National Report, Section 4. [↑](#footnote-ref-29)
30. Hungarian National Report, Section 2.3. [↑](#footnote-ref-30)
31. Maltese National Report, Section 3. [↑](#footnote-ref-31)
32. Swedish National Report, Section 6. [↑](#footnote-ref-32)
33. Italian National Report, Section 2.3. [↑](#footnote-ref-33)
34. Romanian National Report, Section 3. [↑](#footnote-ref-34)
35. United Kingdom National Report, Section 1. [↑](#footnote-ref-35)
36. United States National Report, Section 9. [↑](#footnote-ref-36)
37. Georg von Graevenitz, Richard Ashmead, and Christine Greenhalgh, ‘Cluttering and Non-Use of Trade Marks in Europe’ (UK Intellectual Property Office 2015) 2015/48 <https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment\_data/file/568675/TM\_cluttering\_report.pdf>, cited in Section 1 of the United Kingdom national report. [↑](#footnote-ref-37)
38. Georg von Graevenitz, Richard Ashmead, and Christine Greenhalgh, ‘Cluttering and Non-Use of Trade Marks in Europe’ (UK Intellectual Property Office 2015) 2015/48 <https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment\_data/file/568675/TM\_cluttering\_report.pdf>. [↑](#footnote-ref-38)
39. See United Kingdom National Report, Section 1. [↑](#footnote-ref-39)
40. See United Kingdom National Report, Section 1. [↑](#footnote-ref-40)
41. See United Kingdom National Report, Section 1. [↑](#footnote-ref-41)
42. Georg von Graevenitz, Richard Ashmead, and Christine Greenhalgh, ‘Cluttering and Non-Use of Trade Marks in Europe’ (UK Intellectual Property Office 2015) 2015/48 <https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment\_data/file/568675/TM\_cluttering\_report.pdf>, at 2. [↑](#footnote-ref-42)
43. Roland Knaak, Annette Kur, and Alexander von Mühlendahl, ‘The Study on the Functioning of the European Trade Mark System’ (2012) No. 12-13 Max Planck Institute for Intellectual Property and Competition Law Research Paper <https://ssrn.com/abstract=2172217 or http://dx.doi.org/10.2139/ssrn.2172217>, at 5. [↑](#footnote-ref-43)
44. ibid. [↑](#footnote-ref-44)
45. 15 U.S.C. §§ 1051, *et seq.* [↑](#footnote-ref-45)
46. Please see the detailed explanation of the registration process in the United States National Report, Section 3, at notes 8-23. [↑](#footnote-ref-46)
47. United States National Report, Section 1. [↑](#footnote-ref-47)
48. See the United States National Report, Section 1 (at note 3), quoting the USPTO. [↑](#footnote-ref-48)
49. United States National Report, Section 1 (at note 5), quoting Congressional testimony by the Commissioner for Trademarks. [↑](#footnote-ref-49)
50. United States National Report, Section 1, at note 2. [↑](#footnote-ref-50)
51. United States National Report, Section 1, at note 7. [↑](#footnote-ref-51)
52. Maltese National Report, Setion 1. [↑](#footnote-ref-52)
53. Swedish National Report, Section 6. [↑](#footnote-ref-53)
54. Romanian National Report, Section 1, at note 6, referencing the Bucharest Tribunal, 4th Civil Chamber, Decision No. 759 of 10 April 2012, in *Lege5*. [↑](#footnote-ref-54)
55. Romanian National Report, Section 1, at note 5, referring to the Bucharest Court of Appeals, 4th Civil Chamber, Decision No. 335 of 24 June 2015, in *Lege5*. [↑](#footnote-ref-55)
56. “Gleissner: The Story So Far.” *World Trademark Review* Special Report 2021 Q1 (8 April 2021) available at <https://www.worldtrademarkreview.com/report/special-reports/q1-2021/article/gleissner-the-story-so-far>. [↑](#footnote-ref-56)
57. Belgian National Report, Section 2.2. [↑](#footnote-ref-57)
58. Belgian National Report, Section 2.2. [↑](#footnote-ref-58)
59. For example, absolute grounds of refusal are set forth in Article 7(1) of Regulation (EU) 2017/1001 of the European Parliament of 14 June 2017 on the European Union trade mark (EUTMR) and Article 4 of the Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade mark (Trade Mark Directive). Relative grounds—Article 8 of the EUTMR and Article 5 of the Trade Mark Directive. [↑](#footnote-ref-59)
60. Paris Convention for the Protection of Industrial Property, Article 10*bis*(2). [↑](#footnote-ref-60)
61. Case C-104/18 P, *Koton Magazacilik Tekstil Sanayi ve Ticaret AS v. EUIPO et al.,* 12 September 2019, para. 45. [↑](#footnote-ref-61)
62. Case C-529/07 *Chocaladefabriken Lindt & Sprüngli AG v. Franz Hauswirth GmbH* (11 June 2009). [↑](#footnote-ref-62)
63. Case C-320/12, *Malaysia Dairy Industries Pte. Ltd v. Ankanaevnet for Patenter og Varemaerker*, June 27, 2013. [↑](#footnote-ref-63)
64. *Sky Limited and others v SkyKick Ltd and others* [2018] England and Wales High Court (Chancery Division) [2018] EWHC 155 (Ch). [↑](#footnote-ref-64)
65. *Sky Limited and others v SkyKick UK Ltd and others* [2021] England and Wales Court of Appeal (Civil Division) [2021] EWCA Civ 1121. [↑](#footnote-ref-65)
66. The website of the United Kingdom Supreme Court offers a summary of the dispute and links to the oral hearings that took place in that court on 28 and 29 June, 2023. See <https://www.supremecourt.uk/cases/uksc-2021-0181.html>. [↑](#footnote-ref-66)
67. Case T-663/19, *Hasbro Inc. v. European Intellectual Property Office* (MONOPOLY mark, April 21, 2021). [↑](#footnote-ref-67)
68. United States National Report, Section 6.1. [↑](#footnote-ref-68)
69. Brazilian National Report, Section 1. [↑](#footnote-ref-69)
70. Maltese National Report, Section 1. [↑](#footnote-ref-70)
71. French National Report, Section 2.3. [↑](#footnote-ref-71)
72. United Kingdom National Report, Section 1. [↑](#footnote-ref-72)
73. Swedish National Report, Section 2.2. [↑](#footnote-ref-73)
74. Austrian National Report, Section 2. [↑](#footnote-ref-74)
75. United States Report, Section 4. [↑](#footnote-ref-75)
76. United States Report, Section 7.2. [↑](#footnote-ref-76)
77. United States National Report, Section 7.2. [↑](#footnote-ref-77)
78. United States National Report, Section 7.2. [↑](#footnote-ref-78)
79. Austrian National Report, Section 1. [↑](#footnote-ref-79)
80. See United States National Report, Section 4. [↑](#footnote-ref-80)
81. Swedish National Report, Section 5.1. [↑](#footnote-ref-81)
82. The EUIPO publishes a summary of the relevant legislation at <https://euipo.europa.eu/ohimportal/en/invalidity-and-revocation#:~:text=The%20difference%20is%20that%20revocation,trade%20marks%20with%20retroactive%20effect>. [↑](#footnote-ref-82)
83. Italian National Report, Section 3.3.1. [↑](#footnote-ref-83)
84. Swedish National Report, Section 5.1. [↑](#footnote-ref-84)