

O-059-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2528977
BY THE CHARTERED INSTITUTE OF PATENT ATTORNEYS IN
CLASS 41:**

IP TRANSLATOR

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 2528977 TO REGISTER A TRADE MARK BY The Chartered Institute Of Patent Attorneys IN CLASS 41

Background

1. On 16th October 2009, The Chartered Institute of Patent Attorneys, 95 Chancery Lane, London, WC2A 1DT ("the applicant") applied to register trade mark application number 2528977, consisting of the word mark IP TRANSLATOR for the following services:

Class 41: Education; providing of training; entertainment; sporting and cultural activities.

2. It is germane to note here that this list of services corresponds exactly to the so-called "class heading" of class 41 of the Ninth Edition of the Nice Agreement which entered into force on January 1, 2007. The IPO is bound under s.34 of the Trade Marks Act 1994 (as amended) and r. 7 of the Trade Mark Rules 2008 (as amended) to use the Nice Classification as the prescribed system of classification for the purposes of the registration of trade marks. S.34 and r. 7 reflect the obligations upon the UK as a signatory to the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957 (as amended))*.
3. On 22nd October 2009, the UK Intellectual Property Office issued an examination report in response to the application. In the report, objection was raised under section 3(1)(b) and (c) of the Trade Marks Act 1994 ("the Act") on the following basis:

"The application is not acceptable as there is an objection under Section 3(1)(b) and (c) of the Act. This is because the mark consists exclusively of the abbreviation IP (Intellectual Property) and the word TRANSLATOR, being a sign which may serve in trade to designate the nature of the services e.g. translation services in the fields of Intellectual Property".
4. A period of two months from the date of the examination report was given for reply (i.e. up to 22nd December 2008), with the Registrar confirming that "...the application would be refused if the applicant did not reply by the relevant date requested".
5. In the event, the applicant responded to the objection raised in a letter dated 11th November 2009, stating:

The objection you have raised under Section 3(1)(b) and/or (c) of the Act is invalid and should be waived. Both of the cited subsections allow objection to registration in respect only of the goods and/or services listed in the application as filed. Your objection under Section 3(1)(b) and (c) is stated to be

“... because the mark consists exclusively of the abbreviation IP (Intellectual Property) and the word TRANSLATOR, being a sign which may serve in trade to designate the nature of the services e.g. translation services in the fields of Intellectual Property”.

Translation services are not listed within the list of services as filed, neither explicitly nor through genus/species significance, as you concede.

No objection is raised in respect of the listed services, correctly in our view. Your objection regarding translation services relies upon adoption of a practice confirmed by OHIM in a Communication of the President of that Office of dated 16th June 2003 (No 4/03), that

“the use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within this particular class”,

effectively that an IC class XX heading used as the list of goods or services in an application means the same as "All goods/services in class XX". This is often referred to as the "class heading-covers-all" approach and in our submission it has no basis in UK or EU law, notably having regard to the 2002 judgment of the ECJ in the *Sieckmann* case C-273/00. In that judgment the ECJ concluded that an application must provide a precise identification of the mark to enable users to ascertain the extent of the rights applied for. The Court applied to that the now well-known seven *Sieckmann* criteria requiring that the representation of the mark must be “clear precise, self-contained, easily accessible, intelligible, durable and objective”.

The scope of the rights obtained from an application are defined by two claims, one to the mark and the other to the listed goods/services. It is evident that the seven *Sieckmann* criteria apply equally to both claims, and therefore that the list of goods/services should also be “clear precise, self-contained, easily accessible, intelligible, durable and objective”. The "class covers-all" approach denies third parties a precise and fixed list of goods/services by reading into the scope of the application goods/services not apparent from its list of goods/services contrary to the requirements of the ECJ in *Sieckmann*.

We request reconsideration and waiver of the objection. If the Office is minded nonetheless to maintain its stated objection under Section 3(1)(b) and/or (c) the applicant requests a formal refusal so that a Form TM5 may be filed as a precursor to an appeal”.

6. By letter dated 9th December 2009, the Registry maintained objection under section 3(1)(b), stating:

“I have considered your comments but regret that I am not persuaded to waive the objection raised under Section 3(1). The objection was raised because I consider the mark to be descriptive of translation services in the fields of Intellectual Property. Although you say that the application does not cover translation services I do not agree. In this respect below I have included an extract from our work manual giving our practice in relation to class headings. I refer you in particular to the following: "... applications made to the Registrar that specify the class heading and consist of a mark that designates a characteristic of a good or service in that class but not overtly covered by terms in the class heading, will face an objection."

In respect of this application the specification covers the class heading for class 41 and is therefore deemed to cover all those services covered by that class, including translation services.

You refer to the Sieckmann case (C-273/00) and the seven Sieckmann criteria. Those criteria state that the sign must be clear, precise, self-contained, easily accessible, intelligible and durable. It is arguable that these factors relate to the graphical representation of the mark and not to the specification.

In view of the above the objection must be maintained. I remind you of your right to a hearing. If you do not reply by the date requested above, the application will be refused under the provisions of section 37(4) of the Trade Marks Act 1994.”

7. The applicants signalled their intention to appeal the continued objection by correspondence dated 6th January 2010, asking that their application be formally refused. Notice of refusal was issued on 15th January 2010 and a Request for a Statement of Reasons for Registrar’s Decision was submitted on 27th January 2010. Under Section 76 of the Act and Rule 69(2) of the Trade Mark Rules 2008 the Registrar is required to state in writing the grounds of decision and the materials used in arriving at it.

The Law

8. Section 3 of the Act reads as follows:

“3.-(1) The following shall not be registered –

(a)

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of

production of goods or of rendering of services, or other characteristics of goods or services,

(d)

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

9. The above provisions mirror Article 3(1)(b) and (c) of First Council Directive 89/104 of 21 December 1988. The proviso to Section 3 is based on the equivalent provision of Article 3(3).

Relevant authorities – general principles

10. The European Court of Justice (ECJ) has repeatedly emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation (EC) No. 207/2009 of 26 February 2009 (formerly Council Regulation (EC) 40/94 of 20 December 1993) on the Community Trade Mark, in the light of the general interest underlying each of them (Case C-37/03P, *Bio ID v OHIM*, paragraph 59 and the case law cited there and, more recently, Case C-273/05P *Celltech R&D Ltd v OHIM*).
11. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to Section 3(1)(b) (and the equivalent provisions referred to above) the Court has held that “...the public interest ... is, manifestly, indissociable from the essential function of a trade mark” (Case C-329/02P, SAT.1 *SatellitenFernsehen GmbH v OHIM*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function. Section 3(1)(c) on the other hand pursues an aim which reflects the public interest in ensuring that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM (Doublemint)*, C-191/0P paragraph 31.
12. In terms of the relationship as between sections 3(1)(b) and (c), a mark which is subject to objection under section 3(1)(c) as designating a characteristic of the relevant goods or services will, of necessity, also be devoid of distinctive character under section 3(1)(b) – see to that effect para 86 of Case C-363/99 *Koninklijke KPN Nederland NV v Benelux – Merkenbureau (Postkantoor)*. But plainly, and given the public interest behind the two provisions, they must be assessed independently of each other as their scope is different, that is to say that section 3(1)(b) will include within its scope marks which, whilst not designating a characteristic of the relevant goods and services, will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin.

13. The factors which must be considered when applying these two provisions of the Act are set out as follows. In relation to s. 3(1)(c):

- subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark – *Wm Wrigley Jr & Company v OHIM – (Doublemint)*, paragraph 30;
- there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics – *Ford Motor Co v OHIM, Case T-67/07*;
- a sign's descriptiveness may only be assessed, first, in relation to the goods or services concerned and, secondly, in relation to the perception of the target public, which is composed of the consumers of those goods or services – *Ford Motor Co v OHIM*;
- it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word "exclusively" in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question – *Koninklijke KPN Nederland NV and Benelux-Merkenbureau, Case C-363/99 (Postkantoor)*, paragraph 57;
- it is in principle irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary – *Postkantoor*, paragraph 102.

14. In terms of the issues before me in this case I derive the following main guiding principles from the cases noted below in relation to s. 3(1)(b):

- an objection under Section 3(1)(b) operates independently of objections under Section 3(1)(c) – (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);
- for a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
- a mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Postkantoor* paragraph 86);

- a trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public's perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);
- the relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

15. It is clear from these principles that the distinctiveness of a mark must be assessed, whether under s. 3(1)(c) or s. 3(1)(b), by reference to the goods and services applied for and, secondly, according to the perception of the average consumer for those goods or services. As to the latter, regarding the wording against which the objection has been raised, we are concerned here with a specialist average consumer and not the general public. The average consumer in this case is likely to be represented by the level of knowledge shared by a legal professional or an academic. I must keep this finding in mind as I proceed with this decision.

16. As to the second point, the nature of the goods and services, it is important that I am convinced that the objection applies to *all* the services applied for. If there are services specified which are free of objection then they must be allowed to proceed. In the case of European Case of Justice Case *C-239/05 BVBA Management, Training en Consultancy v Benelux-Merkenbureau* the question being referred to the court was whether the Directive, on which the Act is based of course, must be interpreted as meaning that the competent authority is required to state its conclusion separately for each of the individual goods and services specified in the application. The court answered (para. 38), saying that the competent authority was required to assess the application by reference to individual goods and services.

17. As indicated in paragraph 1 above, the applicant's listed services are as follows:

Class 41: Education; providing of training; entertainment; sporting and cultural activities.

18. Central to this decision is coverage represented by the goods listed. This was at the heart of the debate in correspondence between the Registry and the applicant. It seems appropriate that I consider, first, the nature of the services at issue and then the policy imperatives that drive the IPO to take the view it has in relation to the ambit of the specification in this case.

Services included in the class heading

19. The objection was raised on the basis that the mark does not have the necessary distinctiveness in relation to s. 3(1)(b) – and, under s. 3(1)(c) – it exclusively designates a characteristic of the services specified.

20. WIPO lists for Class 41 a number of detailed services that, for administrative purposes, fall under within the class. This list, which is not long relative to some of the other classes, includes “Translation”. It is not clear to the Office that this activity is included in any of the broader “general indications” (to use WIPO’s terminology) of the applicant’s listed services and the Nice Classification class heading as set out above. The only candidate might be ‘Cultural Activities’, but it would be stretching the meaning of this phrase to breaking point to include translation services within its scope. Culture is defined, *inter alia*, as follows:

- (1) the ideas, customs, and art of a particular society;
- (2) a particular civilization at a particular period; and
- (3) a developed understanding of the arts.

(Collins English Dictionary)

21. An ‘activity’ is defined as any specific action or pursuit: for example: ‘he was engaged in various political activities abroad’. Thus a cultural activity is a pursuit, or more particularly in the context of trade, an *event* involving any aspect of the ideas, customs, and art of a particular society at a particular period – for example religion, film, theatre, music and dance. However, there is no sense in which translation can be seen as a cultural activity of a specific nation state or culture. I can think of no example of the latter that might embrace “translation” that would be celebrated in some sort of event or activity – and certainly not in the UK, a famously monoglotal nation.

22. Nevertheless, the Office deems that this particular service is included as part of the applicant’s claimed services in class 41 for the following reasons.

Class Headings and Registry Practice

Registry Practice can be effectively summarised by the following extract from the Examination Guide of the Work Manual, under “SPECIFICATION – CLASS HEADINGS”:

“The international standard for the classification of goods and services as followed by the United Kingdom is set out under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957 (as amended)). The latter was developed, and is managed, by WIPO for administrative purposes, classifying goods and services under 45 separate classes, consisting of a class heading and a detailed, alphabetical list of items in each class. The system is mandatory for signatories to the agreement (like the UK). This is also the case for the OHIM under its implementing regulations (COMMISSION REGULATION (EC) No 2868/95, rule 2(1)).

In the IPO’s view, the headings to the classes convey general indications relating to the fields to which goods or services belong (see General Remarks, Nice Classification, 9th Edition). It follows that when determining the appropriate scope of protection to be afforded to a trade mark invoked in proceedings before the IPO, the question of what a class heading includes or does not include is irrelevant and interpretation of the

statement of goods or services may only be made by reference to the goods or services covered by that statement.

In contrast, the OHIM, and some other national EU trade mark registries, consider that the class heading does include all goods and services in a class. In a Communication of the President of the Office of dated 16th June 2003 (No 4/03), the OHIM set out the following policy in relation to class headings:

“The 34 classes for goods and the 11 classes for services comprise the totality of all goods and services. As a consequence of this the use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within this particular class”.

OHIM's stated view in this regard means that in opposition and cancellation proceedings at OHIM, a national or Community trade mark registered for a class heading will be deemed to cover all the goods and services in the class in question. In certain circumstances this practice is problematic for the UK Registry.

For example, the IPO, given its practice as set out above, might register a trade mark specifying the class heading where the mark applied for is descriptive of a good or service not included in the heading. It is possible that such a registration might be used in proceedings before the OHIM, as an earlier national right (see Article 8(2)(a)(ii) and Article 53(1)(a) of Council Regulation (EC) 207/2009 of 26th February 2009) even though the national office in the UK did not examine the trade mark for registrability on absolute grounds in respect of that product and the mark may not in fact be distinctive and therefore registrable for such goods.

This places the IPO in an invidious position. It would not be in the public interest for the Registrar to grant a national registration wider in scope than that determined by the UK Office itself when it could subsequently be prayed in aid as an earlier national registration in opposition or cancellation proceedings before the OHIM. Under the terms of the Community Trade Mark Regulation, the OHIM would be bound to accept the validity of the UK registration as an earlier national trade mark.

Given that this is the case, applications made to the Registrar that specify the class heading and consist of a mark that designates a characteristic of a good or service in that class but not overtly covered by terms in the class heading, will face an objection. The objection may be overcome by an appropriate amendment to the list of goods or services, provided the scope of the latter is not extended.

For example, take the application for the mark 4 SEASONS for the class heading in class 20:

Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

“Four Seasons” is the generic name for a type of sleeping bag. The IPO would raise an objection in this case which could be over come by specifying anything less than the class heading as a specific list of the goods of direct interest to the applicant, or an exclusion for sleeping bags.

23. I am not, of course, bound by the published practice and must make my own decision, which I have done. Despite the submissions made by the applicant, there remains a doubt in relation to the proper application of the law in these circumstances. This is not limited to the position taken by the OHIM on this issue, as set out above, which appears to be supported, to an extent at least, in case law. In particular, the decision *BMI Bertollo Srl v (OHIM)*, T-186/02, where it is stated (paragraph 42):

“As the intervener’s application for registration of its trade mark in Italy referred to the headings of all the classes, its national registration clearly covers all goods capable of being comprised within those classes. Similarly, its Community registration covers all goods capable of being comprised within the classes applied for at the Community level, that is to say Classes 11, 19, 20 and 21, given that the intervener referred to those classes in its application. Accordingly, the goods in question must be treated as identical for the purposes of assessing the likelihood of confusion.”

24. It is fair to say that the CFI was seemingly not exposed to any submissions on this point, and gave its Judgment before publication of the June 2003 Presidential Communication. It is likely too that the CFI was not made aware of the extensive discussion and debate on the point that was taking place between the IPO and the OHIM at that time. However, the trade mark registry of the IPO, as a tribunal for the purposes of the European Communities Act 1972, is required to take into account decisions of the European Courts, which includes those of the Court of First Instance (or the General Court as it is now known). Further, the practice of the UK Registry, as set out above, takes cognisance of the role that national registrations may play in opposition and cancellation proceedings before OHIM, where such registrations take on the mantle of earlier marks, the validity of which cannot be called into question before OHIM.

Application of s. 3(1)(c) and s. 3(1)(b)

25. Given the above reasoning, for the purposes of absolute grounds examination, I must consider the nature of the instant trade mark application in relation to the services of translation. The latter includes all types of translation and thus technical translation services will be subsumed by that description. This will

include the translation of legal judgments and texts, for example (which one could reasonably assume is of main interest to the applicants). In this context, the initialism “IP” must be interpreted as “Intellectual Property”. The mark amounts to no more than “INTELLECTUAL PROPERTY TRANSLATOR”.

26. The mark applied for is therefore wholly descriptive of services properly within the scope of class 41, and also wholly descriptive of services deemed to be within the applicant’s claimed list of services, corresponding as it does to the Nice Classification class 41 class heading. I have considered the applicant’s comments regarding the judgment of the ECJ itself in the *Sieckmann* case (C-273/00) and the seven criteria laid down in that for the definition of a mark in an application for registration. I see the logic in that that the same precision should apply to both the definition of the mark and to the defining list of goods or services claimed in an application, but the comment in the *Bertollo* case not only specifically concerns lists of goods and services but also is routinely applied by OHIM as correct in law in the granting of registrations extending to the UK.
27. This places me in a difficult position: in essence whether to accept *Bertollo* or *Sieckmann* in this case. To follow *Sieckmann* out of its context would allow the applicant UK registration for the full claimed list of services, a national registration that should have been refused as a CTM by the OHIM and yet could be prayed in aid in proceedings before OHIM applying *Bertollo* as a valid earlier national registration covering “Intellectual Property Translation Services”.
28. My conclusion is that the public interest is best served by interpreting s. 3(1) of the Act as applying to all the services covered by the class for which the applicant has used the relevant heading. This means that the application is susceptible to the objections described above, which could only have been overcome if the applicant had removed “Intellectual Property Translation Services” from the application. The applicant has been given the opportunity to amend its application, but has not done so.
29. I am mindful in this of the April 2009 judgment of Geoffrey Hobbs QC sitting as a Deputy Judge of the High Court in *Daimler AG v. Sany Group Company Limited*, [2009] EWHC 1003 (Ch), in which an issue arose concerning the *Bertollo* case above and the interpretation of WIPO class headings in registrations. The judgment in that regard reads as follows:

“These divergent approaches to interpretation have given rise to debate and concern. I do not think that there is room for them to co-exist within the framework established for the co-ordinated protection of trade marks in the Member States and at the Community level. However, it is sufficient for present purposes to say that there is a real issue as to the effect, both upon the reach of the claims for infringement and the reach of the claim for part-cancellation, of permitting wording from the class headings for Classes 7 and 12 of the international classification to remain in the specifications of the Claimant’s registrations. That goes to the substantive effect of the

relevant entries in the relevant public registers. I do not accept that it is an issue which the Claimant can avoid simply by electing on an ad hoc basis not to rely on the broader approach to interpretation in support of its claims for infringement in the present *inter partes* proceedings”.

30. This wording encapsulates the invidious position referred to the Registry practice quoted above. If I am wrong in my conclusion above then it would appear that I may have given inadequate weight to the ECJ’s position in *Sieckmann* out of its mark-definition context, as against the CFI’s position in its directly relevant goods/services context. I have not found this an easy decision, but on balance I have come to the conclusion expressed in paragraph 28 above. As the applicant has not disputed the merits of the objection as it applies to translation services, it follows that the application must be refused.

Conclusion

31. In this decision I have considered all the documents filed by the applicants and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under s. 3(1)(b) and s. 3(1)(c) of the Act.

Dated this day of 12th February 2010

**Bill Trott
For the Registrar
The Comptroller-General**