

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**TRADE MARK APPLICATION No. 2528977 IN THE NAME OF  
THE CHARTERED INSTITUTE OF PATENT ATTORNEYS**

**BEFORE THE APPOINTED PERSON ON APPEAL FROM  
THE DECISION OF THE REGISTRAR OF TRADE MARKS  
DATED 12 FEBRUARY 2010**

---

**ORDER FOR REFERENCE  
TO THE COURT OF JUSTICE  
OF THE EUROPEAN UNION**

---

UPON the Appeal of The Chartered Institute of Patent Attorneys from the decision of the Registrar of Trade Marks dated 12 February 2010 refusing to register the trade mark **IP TRANSLATOR** in Class 41 pursuant to Trade Mark Application No. 2528977

AND UPON READING the documents mentioned in the Schedule to this Order

AND UPON CONSIDERING the submissions made orally and in writing on behalf of The Chartered Institute of Patent Attorneys and the Registrar of Trade Marks

IT IS ORDERED BY THE APPOINTED PERSON THAT:

1. The Questions arising in relation to the matters summarised and set out in the Schedule to this Order be referred to the Court of Justice of the European Union for a preliminary ruling pursuant to the provisions of Article 267 of the Treaty on the Functioning of the European Union (OJ 2008 C.115 p.47).

2. All proceedings in the Appeal are stayed pending the preliminary ruling of the Court of Justice of the European Union upon the Questions set out in the Schedule to this Order or further Order in the meantime.
3. The costs of the proceedings (including the costs of the reference) are reserved.
4. The parties have permission to apply.

---

**Geoffrey Hobbs Q.C.**

**The Appointed Person**

27 May 2010

## SCHEDULE

### Abbreviations

1. In this Schedule:

- ‘the UK Act’*** refers to the Trade Marks Act 1994 (as amended)
- ‘the 2008 Rules’*** refers to the Trade Marks Rules 2008 (SI 2008 No.1797)
- ‘the TM Directive’*** refers to codifying Directive 2009/95/EC of the European Parliament and of the Council of 22 October 2009 to approximate the laws of the Member States relating to trade marks (OJ 2008 L.299 p.25) which, with effect from 28 November 2008, replaced First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 p.1)
- ‘the CTMR’*** refers to codifying Council Regulation (EC) No. 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78 p.1) which, with effect from 11 March 2009, replaced Council Regulation (EC) 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L. 11 p.1)
- ‘the CTMIR’*** refers to Commission Regulation 2868/95/EC of 13 December 1995 (OJ 1995 L. 303 p.1) (as amended) implementing Council Regulation (EC) No. 40/94 on the Community trade mark

- ‘OHIM’*** refers to the Office for Harmonisation in the Internal Market established under Article 2 of the CTMR
- ‘Communication No. 4/03’*** refers to Communication No. 4/03 of the President of OHIM of 16 June 2003 concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations (OJ OHIM 2003 p.1647)
- ‘the Paris Convention’*** refers to the Convention for the Protection of Industrial Property signed in Paris on 20 March 1883, last revised at Stockholm on 14 July 1967 and amended on 28 September 1979
- ‘the Nice Agreement’*** refers to the Agreement concerning the International Classification of Goods and Services for the purposes of the Registration of Marks concluded by the Nice Diplomatic Conference on 15 June 1957 (as amended and revised)
- ‘the Nice Classification’*** refers to the common classification of goods and services established under Article 1 of the Nice Agreement (as amended and revised from time to time)
- ‘the Class Heading(s)’*** refers to the words used as general indications of the classes of the Nice Classification to which goods and services belong.

***‘the Alphabetical List’*** refers to the list of goods and services established under Article 1(2) of the Nice Agreement (as amended and revised from time to time)

***‘the Registrar’*** refers to the Comptroller-General of Patents, Designs and Trade Marks acting as the competent authority for registration of trade marks under the UK Act

***‘CIPA’*** refers to the Chartered Institute of Patent Attorney’s, a body corporate established by the grant of a Royal Charter.

#### Legal context

2. The provisions of the UK Act are in many respects expressed in terms which, at the national level, mirror the effect of corresponding provisions of the CTMR at the Community level.

3. Article 32 of the CTMR provides that a Community trade mark application which has been accorded a date of filing shall, in the United Kingdom and all other Member States, *‘be equivalent to a regular national filing’*.

4. An application for registration of a trade mark at the national level must comply with the requirements of Section 32 of the UK Act (equivalent to Article 26 of the CTMR) in order to qualify for a filing date under Section 33 of the UK Act (equivalent to Article 27 of the CTMR).

5. Under Sections 32(2)(c) and (d) of the UK Act (equivalent to Articles 26(1)(c) and (d) of the CTMR) the application for registration must, in particular, contain:

- “(c) a statement of the goods or services in relation to which it is sought to register the trade mark; and
- (d) a representation of the trade mark.”

6. Under Section 34(1) of the UK Act in combination with Rules 7 to 9 of the 2008 Rules and under Article 28 of the CTMR in combination with Rules 1(1)(c) and 2 of the CTMIR, it is obligatory for the various goods and services covered by a trade mark application to be classified for the purposes of registration in accordance with the Nice Classification.

#### The Nice Classification

7. The Nice Agreement was established on the basis of Article 19 of the Paris Convention, which reserves for the countries of the Union the right to make separately between themselves special agreements for the protection of industrial property.

8. Article 1 of the Nice Agreement states:

- (1) The countries to which this Agreement applies constitute a Special Union and adopt a common classification of goods and services for the purposes of the registration of marks (hereinafter designated as “the Classification”).
- (2) The Classification consists of:
  - (i) a list of classes, together with, as the case may be, explanatory notes;

(ii) an alphabetical list of goods and services (hereinafter designated as “the alphabetical list”) with an indication of the class into which each of the goods or services falls. [...]

9. Article 2 of the Nice Agreement states:

- (1) Subject to the requirements prescribed by this Agreement, the effect of the Classification shall be that attributed to it by each country of the Special Union. In particular, the Classification shall not bind the countries of the Special Union in respect of either the evaluation of the extent of the protection afforded to any given mark or the recognition of service marks.
- (2) Each of the countries of the Special Union reserves the right to use the Classification either as a principal or as a subsidiary system.
- (3) The competent Office of the countries of the Special Union shall include in the official documents and publications relating to registrations of marks the numbers of the classes of the Classification to which the goods or services for which the mark is registered belong. [...]

Communication No. 4/03

10. Communication No. 4/03 clarified OHIM’s approach to the use and consequences of using the general words of the Class Headings of the Nice Classification in trade mark applications and registrations.

11. The Communication stated that it was acceptable for the goods or services covered by an application or registration to be identified by means of wording which used *‘the general indications or the whole class headings provided for in the Nice Classification’*.

In addition, it confirmed that OHIM proceeds upon the basis of a *'rule that the use of the class headings constitutes a claim to all the goods or services within the relevant class, and that the use of a general indication constitutes a claim to all the particular goods or services falling under the general indication'*. This 'rule' appears to have been adopted by OHIM as a rule of interpretation in relation to words which form part of the list of classes established under Article 1(2)(i) of the Nice Agreement.

Trade Mark Application No. 2528977

12. On 16 October 2009, CIPA applied under Section 32 of the UK Act to register the designation **IP TRANSLATOR** as a trade mark for use in relation to *'Education; providing of training; entertainment; sporting and cultural activities'* in Class 41 of the Nice Classification.

13. The application was refused for the reasons given in a written decision issued on behalf of the Registrar under reference BL O-059-10 on 12 February 2010: [2010] ETMR 32, p.579.

14. In summary, the Registrar decided as follows:

(1) on the basis that the wording *'Education; providing of training; entertainment; sporting and cultural activities'* adopted the general words of the Class Heading for Class 41 of the Nice Classification, it could and should be interpreted in accordance with Communication No. 4/03 of the President of OHIM of 16 June 2003;

- (2) in accordance with that approach to interpretation, the application could and should be taken to cover not only services of the kind specified by CIPA, but also every other service falling within Class 41 of the Nice Classification;
- (3) the application therefore covered translation services in Class 41 for which the trade mark **IP TRANSLATOR** could not be registered under Sections 3(1)(b) and (c) of the UK Act (equivalent to Articles 3(1)(b) and (c) of the TM Directive and Articles 7(1)(b) and (c) of the CTMR) without evidence establishing that the mark had acquired a distinctive character through use so as to qualify for registration in respect of such services under the proviso to Section 3(1) of the UK Act (equivalent to Article 3(3) of the TM Directive and Article 7(3) of the CTMR).

15. There was no evidence that the trade mark **IP TRANSLATOR** had acquired a distinctive character through use in relation to translation services prior to the date of the application for registration. There was also no request by CIPA for such services to be excluded from the specification of its trade mark application. The request for registration was therefore refused.

### The Appeal

16. On 25 February 2010, CIPA appealed to an Appointed Person under Section 76 of the UK Act contending: (1) that its application for registration did not specify (and therefore did not cover) translation services in Class 41; and (2) for that reason the Registrar's objections to registration were misconceived and should be set aside. It is clear that translation services are not services of the kind that would normally be regarded

as ‘education’, ‘providing of training’ ‘entertainment’ ‘sporting activities’ or ‘cultural activities’. That is common ground for the purposes of the present Appeal.

17. Article 13 of the TM Directive provides as follows:

**Grounds for refusal or revocation or invalidity relating to only some of the goods or services**

Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.

This requires the list of goods or services covered by a trade mark application or registration to be reduced to the extent necessary to confine it to goods or services for which the trade mark in question is fully registrable. In the present case, any necessary amendments to the wording of CIPA’s trade mark application could be made under Sections 39(1) and (2) of the UK Act (equivalent to Articles 43(1) and (2) of the CTMR).

18. As indicated above, the general words of the Class Heading for Class 41 of the Nice Classification are: ‘Education; providing of training; entertainment; sporting and cultural activities’. The text of the related Explanatory Note is as follows:

This class contains mainly services rendered by persons or institutions in the development of the mental faculties of persons or animals, as well as services intended to entertain or to engage the attention.

Includes, in particular:

- services consisting of all forms of education of persons or training of animals;

- services having the basic aim of the entertainment, amusement or recreation of people;
- presentation of works of visual art or literature to the public for cultural or educational purposes.

19. The Alphabetical List contains 167 listings for the itemisation of services falling within Class 41 of the current edition of the Nice Classification. Beyond that, the trade mark classification database maintained by the Registrar for the purposes of the UK Act contains more than 2,000 listings for the itemisation of services falling within Class 41 and the EUROACE database maintained by OHIM for the purposes of the CTMR contains more than 3,000 listings for the itemisation of services falling with that class.

20. All such itemisations (which include translation services) would be covered by CIPA's application for registration if the Registrar's approach to interpretation of the specification filed under Section 32(2)(c) of the UK Act (equivalent to Article 26(1)(c) of the CTMR) in accordance with Communication No. 4/03 is correct. In that situation it would be necessary for CIPA to exclude translation services from the scope of its application for registration, as envisaged by the provisions of Article 13 of the TM Directive.

21. However, it is possible for the Registrar's approach to interpretation based on Communication No. 4/03 to be wrong for reasons that may make it necessary to re-examine the acceptability of using the general words of the Class Headings of the Nice Classification for the purpose of identifying the various goods or services covered by a

trade mark application. In that situation CIPA's trade mark application might need to be amended, even if there was no need to exclude translation services from the scope of it.

22. The questions for consideration on a full assessment of the issues raised by CIPA's appeal are whether it is: (1) necessary for the various goods or services covered by a trade mark application to be identified with any and if so what particular degree of clarity and precision; (2) permissible to use the general words of the Class Headings of the Nice Classification for the purpose of identifying the various goods or services covered by a trade mark application; (3) necessary or permissible for such use of the general words of the Class Headings of the Nice Classification to be interpreted in accordance with Communication No. 4/03 of the President of OHIM of 16 June 2003.

#### Adherence to common standards

23. The TM Directive does not harmonise the procedural aspects of trade mark registration: Case C-246/05 Häupl v. Lidl Stiftung & Co KG [2007] ECR I-4673 at paragraphs 25 to 31. However, registration is not a procedural step. It is an act by means of which substantive legal rights are conferred upon the proprietors of trade marks which qualify for protection by registration.

24. The TM Directive seeks (as stated in the eighth recital in the preamble) to ensure that the conditions for obtaining and continuing to hold a registered trade mark are, in general, identical in all Member States. The tenth recital in the preamble to the TM Directive further states that it is fundamental to ensure that registered trade marks enjoy the same protection under the legal systems of all the Member States. It follows that the

substantive conditions for the registration of trade marks cannot vary between the Member States: Case C-418/02 Praktiker Bau-und Heimwerkermärkte AG [2005] ECR I-5873 at paragraphs 30 to 33.

25. The Court of Justice has emphasised that the registration system for trade marks constitutes an essential element of their protection, which contributes, in respect of both Community law and the different national laws, to legal certainty and sound administration: Case C-273/00 Sieckmann v. Deutsches Patent-und Markenamt [2002] ECR I-11737 at paragraph 37. As a corollary of that, the substantive conditions for registration under the TM Directive depend upon adherence to common standards for the graphic representation of trade marks (as confirmed in Sieckmann) and also for identification of the particular goods or services for which they are registered (as confirmed in Praktiker Bau-und Heimwerkermärkte AG).

#### The need for clarity and precision

26. In accordance with the Judgment of the Court of Justice in Sieckmann at paragraphs 46 to 55, a trade mark must be graphically represented in a manner which is clear, precise, self-contained, intelligible, durable, unequivocal and objective in order to be acceptable for registration.

27. The Court has not yet ruled on the question whether the principles of legal certainty and sound administration likewise require the particular goods or services for which registration is requested to be identified in terms which are clear, precise, self-contained, intelligible, durable, unequivocal and objective.

28. The Judgment of the Court in Case C-239/05 BVBA Management, Training en Consultancy v. Benelux-Merkenbureau [2007] ECR I-1455 at paragraphs 30 to 36 confirms that an application for registration must identify the various goods or services to which it relates with enough clarity and precision to enable the competent authority to determine whether registration should, to any extent, be refused on absolute grounds under Section 3 of the UK Act (Article 3 of the TM Directive, Article 7 of the CTMR).

29. In addition, it is necessary for the rights conferred by registration of a trade mark under Sections 10(1) to (3) of the UK Act (equivalent to Articles 5(1) and (2) of the TM Directive, Articles 9(1)(a) to (c) of the CTMR) to be enforceable with a clear understanding of the extent to which the goods or services in issue can be characterised as *'identical'* or *'similar'* to those for which the protected trade mark is registered. Moreover, evidence of similarity is liable to be required if the goods or services in issue are not identical to those covered by the relevant registration: Case C-36/97 Canon KK v. Metro Goldwyn Mayer Inc [1998] ECR I-5507 at paragraph 22; Case C-196/06P Alecansan SL v. OHIM [2007] ECR I-36 at paragraph 37.

30. The question whether goods or services can be characterised as *'identical'* to those covered by the relevant registration must also be determined with a clear understanding of the commercial realities of the situation when evaluating an application for revocation on the ground of non-use under Sections 46(1)(a) or (b) of the UK Act (equivalent to Article 51(1)(a) of the CTMR).

31. It appears to be incontrovertible that the nature of the goods or services covered by a trade mark application must be clearly identified so that other persons whose rights and

liberty of action may be affected by registration of the trade mark are in a position to determine the subject-matter of the request for protection. That proposition was affirmed in the decision of the First Board of Appeal at OHIM in Case R 167/1998-1 San Francisco Challenge (24 March 1999) at paragraph 12. It is also reflected in the approach of the Court of Justice as stated in Case C-363/99 Koninklijke KPN Nederland NV v. Benelux-Merkenbureau (POSTKANTOOR) [2004] ECR I-1619 at paragraphs 114 to 117.

32. At present, however, the particular degree of clarity and precision with which the various goods or services covered by a trade mark application must be identified, so as to satisfy the requirements of Community law, remains unresolved.

#### The general words of the Class Headings

33. The general words of the Class Headings of the Nice Classification refer to categories of goods and services within which further itemisation is required in order to identify particular goods or services falling within the scope of them. It is possible that the general words may not be sufficiently specific to identify the various goods or services covered by a trade mark application with the degree of clarity and precision required by Community law. In which case CIPA's application to register the designation **IP TRANSLATOR** for '*Education; providing of training; entertainment; sporting and cultural activities*' in Class 41 might not be acceptable without more detailed identification of the services for which registration is requested.

34. There is some support for that view in paragraphs 40 to 52 of the Judgment of the Court of Justice in Praktiker Bau-und Heimwerkermärkte AG, where it was decided that an application to register a trade mark for retail services in Class 35 was required to specify the goods or types of goods to which the services related.

35. A functional requirement for the purpose and intended use of goods or services to be reflected in the wording by means of which they are identified would accord with the reasoning of the General Court in Case T-256/04 Mundipharma AG v. OHIM [2007] ECR II-449 at paragraphs 29 to 31.

36. At present, however, it remains open for determination by the Court of Justice whether Community law permits the general words of the Class Headings of the Nice Classification to be used for the purpose of identifying the various goods or services covered by a trade mark application.

#### Interpretation in accordance with Communication No. 4/03

37. If the general words of a Class Heading are used and interpreted in accordance with Communication No. 4/03 for the purpose of identifying the various goods or services covered by a trade mark application, the coverage of the application will extend to goods and services not mentioned in the application or in any resulting registration.

38. That would appear to be incompatible with even the most basic requirement for the various goods and services covered by a trade mark application to be identified with clarity and precision.

39. It also appears to be incompatible with the Judgment of the Court of Justice in Praktiker Bau-und Heimwerkermärkte. That is because use of the general words of the Class Heading for Class 35 of the Nice Classification (*‘Advertising; business management; business administration, office functions’*) would, if Communication No. 4/03 was correct, result in an application for registration covering retail services without any requirement to specify the goods or type of goods to which the services related.

40. A survey conducted by the MARQUES Association of European Trade Mark Owners in 2008 (supplemented by further responses in 2010) indicated that official practice varies among the Member States, with some competent authorities applying the approach to interpretation envisaged by Communication No. 4/03 in relation to lists of goods and services containing wording from the Class Headings of the Nice Classification and others declining to do so.

41. That creates significant uncertainty in circumstances where lists of goods and services often contain wording from the Class Headings and the protection of trade marks by registration at the national level under the TM Directive is intended to be synchronised with the protection of trade marks by registration at the Community level under the CTMR. In a letter published at ‘2009] CIPA Journal Vol. 38 p.289, the Vice President of OHIM indicated that the Community Office would welcome an explicit ruling of the Court of Justice to resolve the differences of approach.

42. In Case T-162/02 BMI Bertollo SRL v. OHIM [2004] ECR II-1887 at paragraph 42 the General Court proceeded in accordance with the approach to interpretation

indicated in Communication No. 4/03, but it appears to have done so without considering or ruling on any argument as to the correctness or otherwise of that approach.

43. At present, it is a contentious question whether Community law requires or permits use of the general words of the Class Headings of the Nice Classification to be interpreted in accordance with Communication No. 4/03 for the purpose of identifying the various goods or services covered by a trade mark application.

#### Reference under Article 267 TFEU

44. The Appointed Person is a court or tribunal within the meaning of Article 267 TFEU: Case C-259/04 Elizabeth Florence Emanuel v. Continental Shelf 128 Ltd [2006] ECR I-3089 at paragraphs 18 to 25.

45. In order to enable the present appeal to be determined in conformity with the requirements of Community law, it is considered necessary for the following questions to be referred to the Court of Justice for a ruling under Article 267 TFEU.

#### The questions referred

46. In the context of Directive 2009/95/EC of the European Parliament and of the Council of 22 October 2009 to approximate the laws of the Member States relating to trade marks (OJ 2008 L.299 p.25) is it:

- (1) necessary for the various goods or services covered by a trade mark application to be identified with any and if so what particular degree of clarity and precision;

- (2) permissible to use the general words of the Class Headings of the International Classification of Goods and Services established under the Nice Agreement of June 15, 1957 (as revised and amended from time to time) for the purpose of identifying the various goods or services covered by a trade mark application;
  - (3) necessary or permissible for such use of the general words of the Class Headings of the said International Classification of Goods and Services to be interpreted in accordance with Communication No. 4/03 of the President of the Office for Harmonisation in the Internal Market of 16 June 2003 (OJ OHIM 2003 p.1647).
-