

TRADE MARKS ACT 1994

IN THE MATTER OF:

TRADE MARK APPLICATION No. 2528977

IN THE NAME OF

THE CHARTERED INSTITUTE OF PATENT ATTORNEYS

D E C I S I O N

1. This is my decision on the appeal brought by the Chartered Institute of Patent Attorneys (“CIPA”) against the refusal of the Registrar of Trade Marks to register the denomination **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.

2. CIPA’s application for registration was refused for the reasons given in a written decision issued by Dr. Trott on behalf of the Registrar under reference BL O-059-10 on 12 February 2010. His decision is reported at [2010] RPC 30, p.803.

3. I considered it necessary to make an Order for Reference to the CJEU under Art. 267 TFEU for the purpose of obtaining authoritative guidance as to the correct approach to adopt in relation to a number of matters of Community law which appeared to me to be of decisive importance with regard to the determination of CIPA’s appeal. The Order for

Reference was published on the UK IPO website under reference BL O-215-10 and is reported at [2010] RPC 31, p.814.

4. I shall assume for the purposes of this decision that the reader is familiar with the facts and issues to which the request for guidance related as set out in the Schedule to the Order for Reference and I shall continue to use the abbreviations used in that Schedule.

5. The Order for Reference proceeded before the CJEU as Case C-307/10 Chartered Institute of Patent Attorneys v. Registrar of Trade Marks. The oral hearing took place in Luxembourg on 11 October 2011. Advocate General Bot delivered his Opinion on 29 November 2011. The Judgment of the Grand Chamber was delivered on 19 June 2012: [2012] ECR I-0000; [2012] ETMR 42.

6. The questions referred and the answers provided were as follows:

Questions

In the context of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 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).

Answers

Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that it requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark.

Directive 2008/95 must be interpreted as meaning that it does not preclude the use of the general indications of the class headings of the Classification referred to in Article 1 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, concluded at the Nice Diplomatic Conference on 15 June 1957, last revised in Geneva on 13 May 1977 and amended on 29 September 1979, to identify the goods and services for which the protection of the trade mark is sought, provided that such identification is sufficiently clear and precise.

An applicant for a national trade mark who uses all the general indications of a particular class heading of the Classification referred to in Article 1 of the Nice Agreement to identify the goods or services for which the protection of the trade mark is sought must specify whether its application for registration is intended to cover all the goods or services included in the alphabetical list of that class or only some of the those goods or services. If the application concerns only some of those goods or services, the applicant is required to specify which of the goods or services in that class are intended to be covered.

7. It is relevant to point out that these answers were given by the Court in response to its re-formulation of the questions in paragraph [35] of the Judgment rather than directly in response to the three questions successively set out in the Order for Reference. The re-formulation in paragraph [35], with numbering added by me in bold in order to correlate it with the three-point response of the Court, was as follows:

By its three questions, which should be considered together, the referring court essentially asks **[1]** whether Directive 2008/95 must be interpreted as meaning that it requires that the goods and services for which protection by a trade mark is sought should be identified with a certain degree of clarity and precision. If so, the referring court seeks to know whether, given those requirements of clarity and precision Directive 2008/95 must be interpreted as meaning that it **[2]** precludes an applicant for a national trade mark from identifying those goods and services by means of the general indications of the class headings of the Nice Classification and **[3]** precludes the use of all the general indications of the heading of a particular class of the Nice Classification from being considered to be a claim with regard to all the goods and services in that particular class.

8. The Court confirmed in response to point [1] of the re-formulation that there is a legal requirement for the various goods or services covered by a trade mark application to be identified by the applicant with clarity and precision. In order to satisfy that requirement, the goods or services must be identified with sufficient clarity and precision to enable the competent authorities and economic operators to determine the extent of the protection conferred by registration of the trade mark by reference to the terms in which the goods or services have been identified '*on that basis alone*'. As noted in paragraph [37] of the Judgment, the extent of protection is determined by the nature and the number

of goods or services identified in the application. It follows that the requirement for clarity and precision applies across the full width of the request for protection.

9. Wording which fails to define a distinct category of goods or services may, consistently with the aim of the legal requirement for clarity and precision, be found to have resulted in an itemisation which does not allow the question whether any particular goods or services are identical or similar to those of the itemisation to be determined: Case T-571/11 El Corte Inglés SA v. OHIM [2013] ECR II-0000 at paragraphs [12] and [51] to [55]; Case T-162/08 Frag Commercial Internacional SL v. OHIM [2009] ECR II-0000 at paragraphs [9] and [31]. It remains to be seen whether that is an approach which ought to be generally and rigorously applied to vague wording as a consequence of the Judgment in Case C-307/10.

10. It is debatable whether the validity of a registration granted within the framework of the TM Directive or the CTMR can be challenged upon the basis that the application did not comply with the legal requirement for clarity and precision and should have been rejected by the relevant competent authority in accordance with its obligation to ensure that *'the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered'*: Case C-51/10P Agencja Wydawnicza Technopol sp z o.o v. OHIM [2011] ECR I-0000 at paragraph [77]. Legislation at the Community level would seem to be necessary or at least desirable in order to alleviate ongoing concerns about the scope and effect of such registrations on a Community-wide basis. The matter was not addressed either in the questions or in the

answers to which the Judgment of the Court was directed in Case C-307/10 because it does not arise for determination in the present case.

11. Point [2] of the re-formulation relates to the capacity of the general indications of the Class Headings of the Nice Classification to provide the degree of clarity and precision mandated by the legal requirement confirmed in response to point [1].

12. It can be seen from paragraphs [54] to [56] of the Judgment of the Court that the general indications of the Class Headings do not necessarily provide the required degree of clarity and precision:

54. In that connection, it must be observed that some of the general indications in the class headings of the Nice Classification are, in themselves, sufficiently clear and precise to allow the competent authorities to determine the scope of the protection conferred by the trade mark, while others are not such as to meet that requirement where they are too general and cover goods or services which are too variable to be compatible with the trade mark's function as an indication or origin.
55. It is therefore for the competent authorities to make an assessment on a case-by-case basis, according to the goods or services for which the applicant seeks the protection conferred by a trade mark, in order to determine whether those indications meet the requirements of clarity and precision.
56. Accordingly, Directive 2008/95 does not preclude the use of the general indications of the class headings of the Nice Classification to identify the goods and services for which the protection of the trade mark is sought, provided that such identification is sufficiently clear and precise to allow the competent authorities and economic operators to determine the scope of the protection sought.

13. The Court thus appears to have endorsed the approach envisaged by Advocate General Bot in paragraphs [83] to [85] of his Opinion delivered on 29 November 2011:

83. It must be conceded that some of those general indications are, in themselves, sufficiently clear and precise to enable the competent authorities and economic operators to determine the scope of the protection conferred by the trade mark. Such is the case, for example, of the indications ‘soaps’ or ‘cutlery’ taken from class headings 3 and 8 respectively of the Nice Classification.

84. On the other hand, other general indications do not meet those requirements and only indicate in a general manner the fields to which the goods or services in principle belong. The general indications in, for example, Classes 37 (‘Building construction; repair; installation services’) and 45 (‘personal and social services rendered by others to meet the needs of individuals’) of the Nice Classification are much too general and cover goods and services which are much too varied to be compatible with the function of the trade mark, which is to serve as an indication of origin. Without further details, they do not enable the competent authorities to fulfil their obligations in relation to the prior examination of registration applications or economic operators, to find out, with clarity and precision, about registration applications or economic operators, to find out, with clarity and precision, about registrations or applications for registration made by their current or potential competitors. That is why the Court, in the Judgment in *Praktiker Bau- und Heimwerkermärkte*, required the applicant to specify the goods or types of goods to which the services related by means of particulars not included in the class headings.

85. In the light of these considerations, I therefore consider that the Directive and the Regulation are to be interpreted as not precluding an applicant from identifying the goods or services for which he seeks protection by using the general indications of the class headings of the Nice Classification, provided that that identification satisfies the necessary requirements of clarity and precision.

14. The litmus test, from that perspective, is not whether goods or services have been identified in terms which replicate general indications used in the Nice Classification, but whether the terms of the general indications in which they have been identified '*cover goods and services which are much too varied*' to satisfy the legal requirement for clarity and precision '*without further details*' specifying the '*types*' of goods or services for which protection has been sought. Disparate '*types*' of goods and services should be separately identified rather than subsumed within indeterminate wording. That objective is easier to state than it is to achieve (not least because of the need to act consistently with international treaty obligations relating to filing procedures). Which is why the competent authorities have been working together with user organisations in the context of the OHIM Convergence Programme to reach a common position as to those of the general indications of the Class Headings which can and those which cannot be regarded as acceptable for the purpose of satisfying the legal requirement for clarity and precision.

15. I think it is appropriate at this stage to make four general observations in the light of the responses to points [1] and [2] of the re-formulation.

16. First, there is no temporal limit on the effect of the Judgment delivered by the Court: the legal requirement for clarity and precision continued to apply in relation to applications for registration filed under the TM Directive before and after codification and under the CTMR before and after codification.

17. Second, the legal requirement for clarity and precision as defined by the Court leaves no room for the operation of any deemed or inferred identification of goods or services on the basis of any rule or theory of interpretation of the kind prescribed by

Communication No. 4/03 (now rescinded). The terms in which goods or services have been identified in an application for registration should, in principle, be taken to mean what they say, with the concern in that connection being whether ‘*on that basis alone*’ they say what they say with enough clarity and precision to satisfy the relevant legal requirement. That is initially a matter for the competent authorities to consider and determine as part of their registration procedures.

18. Third, the legal requirement for clarity and precision creates an obligation with regard to the filing and examination of applications for registration which the competent authorities have no discretion to waive or dispense with: cf Case C-440/93 The Queen v. Licensing Authority of the Department of Health and Norgine Ltd ex parte Scotia Pharmaceuticals Ltd [1995] ECR I-2851 at paragraphs [19] to [25].

19. Fourth, the Registrar as the competent authority in the United Kingdom has the power under Section 32(2)(c) of the 1994 Act and Rule 8(2)(b) of the 2008 Rules (and OHIM as the competent authority at the Community level has the power under the equivalent provisions of Art. 26(1)(c) of the CTMR and Rule 2(2) of the CTMIR) to ensure that applications for registration comply with the legal requirement for clarity and precision.

20. Against that background I turn to consider paragraphs [57] to [63] of the Judgment of the CJEU, in which the Court responded to point [3] of its re-formulation of the questions referred to it. The principal matter for determination in the context of the submissions addressed to me on behalf of CIPA is whether the reasoning in those

paragraphs is either unclear or inconsistent with the reasoning of the Judgment in response to points [1] and [2] of the re-formulation.

21. CIPA contends that the reasoning in paragraphs [57] to [63] of the Judgment is unclear and moreover irreconcilable with the reasoning in response to points [1] and [2] of the re-formulation with the result that it is liable to create (and has already created) uncertainty as to what the Judgment as a whole should be taken to have decided. In support of that contention, CIPA pointed to the existence of various significant differences of approach in the practice statements published by OHIM and other competent authorities for the purpose of explaining their respective procedures for implementing the Judgment in Case C-307/10. It is said, with justification, that the practice statements show that there is now a divergence of views among the competent authorities which is standing in the way of the correct implementation of the legal requirement for clarity and precision across the EU. The problem is said to have arisen as a result of misconceptions on the part of some competent authorities as to the true nature and extent of the obligation to give effect to that legal requirement. The solution to the problem is said to be another Order for Reference for the purpose of obtaining further guidance from the CJEU as to how the competent authorities ought to be proceeding in that connection.

22. I do not find it necessary to go into the details of these submissions because I do not accept that the Judgment of the Court is unclear or inconsistent with regard to any of the matters on which there appear to be differences of approach between and among the competent authorities. Nor do I accept that it would be appropriate for me to make

another Order for Reference in the present case with a view to obtaining guidance that might help to reduce or eliminate such differences. The task of this tribunal is to interpret and apply the Judgment in accordance with the principle of sincere co-operation referred to in Art. 4(3) of the Treaty on European Union for the specific purpose of determining the present appeal on a correct legal basis. I am satisfied for the reasons that I shall now go on to explain that there is nothing in paragraphs [57] to [63] of the Judgment which gives rise to any real difficulty in the application of the guidance that the Court has provided.

23. In response to point [3] of its re-formulation of the questions, the Court stated as follows:

The extent of the protection resulting from the use of all the general indications of a particular class heading

- 57 It must be recalled that the Court has held that it is possible to apply for registration of a mark either in respect of all the goods or services falling within a class, or in respect of only some of those goods or services (see, to that effect, *Koninklijke KPN Nederland*, paragraph 112).
- 58 According to the order for reference and to the observations submitted to the Court there are currently two approaches to the use of the general indications of the class headings of the Nice Classification, namely the approach corresponding to that derived from Communication No. 4/03, according to which 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 that particular class, and the literal approach, which seeks to give the terms used in those indications their natural and usual meaning.

- 59 In that regard, most of the parties present at the hearing pointed out, in reply to a question put by the Court, that the existence, in parallel, of those two approaches was liable to affect the smooth functioning of the system for the registration of trade marks in the Union. In particular, it was emphasised that the two approaches may lead to a difference in the extent of the protection of a national trade mark if it is registered in several Member States, but also of the protection of the same mark if it is also registered as a Community trade mark. Such a difference might affect, *inter alia*, the outcome of an action for infringement, as such an action may have greater success in the Member States which follow the approach of Communication No. 4/03.
- 60 Moreover, a situation in which the extent of the protection conferred by the trade mark depends on the approach to interpretation adopted by the competent authority and not on the actual intention of the applicant runs the risk of undermining legal certainty both for the applicant and for third party economic operators.
- 61 Accordingly, in order to respect the requirements of clarity and precision mentioned above, an applicant for a national trade mark who uses all the general indications of a particular class heading of the Nice Classification to identify the goods or services for which the protection of the trade mark is sought must specify whether its application for registration is intended to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services. If the application concerns only some of those goods or services, the applicant is required to specify which of the goods or services in that class are intended to be covered.
- 62 An application for registration which does not make it possible to establish whether, by using a particular class heading for the Nice Classification, the applicant intends to cover all or only some of the goods in that class cannot be considered sufficiently clear and precise.

63 Thus, in the case in the main proceedings, it is for the referring court to determine whether, when it used all the general indications of the heading of Class 41 of the Nice Classification, CIPA specified in its application whether or not it covered all the services in that class and, in particular, whether or not its application was intended to cover translation services.

24. It cannot be doubted that these paragraphs of the Judgment set out the required approach to interpretation of an application for registration (such as that filed by CIPA in the present case) in which the general indications of a Class Heading have been used to identify the goods or services of interest to the applicant. They do not purport to enable the competent authorities to waive or dispense with the legal requirement for the goods or services covered by such applications to be identified with clarity and precision. On the contrary, they postulate that such applications should be regarded as ambiguous (hence deficient for the purpose of ensuring that the goods or services of interest to the applicant are all identified in the application with the required degree of clarity and precision) because the parallel approaches referred to in paragraphs [58] and [59] have given rise to a situation in which use of the general indications of a Class Heading might or might not be intended to identify less than 100% of the goods or services falling within the relevant class.

25. With reference to paragraph [61] of the Judgment, it is necessary to mention that the alphabetical list cannot be taken to provide an exhaustive itemisation of all of the goods or services capable of falling within a particular class of the Nice Classification. However, that does not appear to me to detract from the need for compliance with the mandatory legal requirement. That is to say, the ambiguity must be resolved whether or

not the alphabetical list omits to mention some or all of the goods or services of interest to the applicant in the relevant class.

26. Unless and until the ambiguity is resolved, it will be uncertain for the purposes of the regime for protection of trade marks by means of registration at the national and Community level whether the applicant is seeking to apply for registration in respect of all or only some of the goods or services falling within the relevant class: paragraph [57]. The ambiguity cannot be resolved by an approach based on *'interpretation adopted by the competent authority and not on the actual intention of the applicant'*: paragraph [60]. Therefore in keeping with the principle of sound administration and for the attainment of legal certainty, the applicant *'must specify whether its application for registration is intended to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of the those goods or services. If the application concerns only some of those goods or services, the applicant is required to specify which of the goods or services in that class are intended to be covered'*: paragraphs [61] and [63].

27. That being so I am, with respect, unable to agree with the approach which the General Court appears to have adopted in Case T-66/11 Present-Services Ullrich GmbH & Co. KG v. OHIM [2013] ECR II-0000 at paragraphs [29] to [36] and [50] to the effect that ambiguity resulting from inclusion of the general indications of a Class Heading in an application for registration can be resolved by means of 'off the register' explanations or by reference to practice statements which in either case purport to vary or add to the

natural and ordinary meaning of the words of identification as written and recorded in the application as filed.

28. The Judgment in Case C-307/10 is silent as to the manner in which the ambiguity should be resolved, no doubt because that is a matter of procedure which the competent authorities are expected to determine for themselves with full regard for the entirety of the responses to points [1], [2] and [3] of the re-formulation. I see no basis on which a competent authority can omit to put in place administrative procedures for the purpose of giving effect to all three responses.

29. The procedures adopted must inevitably take account of the legislative provisions which limit the scope for amendment of the list of goods or services in an application for registration which has been given a filing date in accordance with Art. 27 of the CTMR or its national equivalent (which, in the United Kingdom, is Section 33 of the 1994 Act). The limitations on amendment contained in Section 39 of the 1994 Act (equivalent to Art. 43 of the CTMR) prevent amendments which would have the effect of widening the coverage of the list of goods or services contained in the application for registration as filed. Similarly with regard to amendment post-registration, the only available option under Section 45 of the 1994 Act (equivalent to Art. 50 of the CTMR) is surrender of the registered trade mark *'in respect of some or all of the goods or services for which it is registered'*.

30. There will be no conflict with the limitations on amendment in cases where the procedure for giving effect to the responses to points [1], [2] and [3] of the re-formulation results in the words of identification recorded in the application for registration being

either specified according to their natural and ordinary meaning or replaced with wording which is of narrower scope according to its natural and ordinary meaning.

31. However, cases in which the procedure reveals that the words of identification are intended to cover more than they would be taken to cover according to their natural and ordinary meaning do appear to me to involve a conflict with the limitations on amendment. That is because the applicant must then file an enlarged claim for protection in which all of the goods or services of interest to it are identified with the required degree of clarity and precision. So far as I can see, the filing of an enlarged claim in the context of a pending application for registration can only take place within the framework of Sections 32(2)(c), 33 and 39 of the 1994 Act and Rules 8(2)(b) and 13 of the 2008 Rules (equivalent to Arts. 26(1)(c), 27 and 43 of the CTMR and Rules 2(2) and 9 of the CTMIR) if the filing date of the application is deferred to the date on which the enlarged claim is accepted.

32. The application for registration in the present case was avowedly made upon the footing that the general indications of the Class Heading for Class 41 (*Education; providing of training; entertainment; sporting and cultural activities*) were not intended to cover anything that did not fall within the natural and ordinary meaning of those words as written and recorded in the application. It follows that confirmation to that effect will be forthcoming in response to the necessary official request for clarification. On that basis: (1) the application for registration should be processed as it stands; (2) the objection to registration in the Hearing Officer's decision of 12 February 2010 must be taken to have proceeded upon the erroneous assumption that 'translation' services fell

within the scope of the words of identification recorded in the application for registration; (3) the decision must be set aside and the application for registration must be remitted to the Registrar for further processing in accordance with the Act and the Rules; (4) as part of the further processing the applicant must confirm and the Registrar must formally record that the words of identification used in the statement provided for the purposes of Section 32(2)(c) of the 1994 Act and Rule 8(2)(b) of the 2008 Rules were not intended to cover anything which did not fall within the natural and ordinary meaning of those words as written and recorded in the application; (5) also as part of the further processing the Registrar must consider and determine whether any part of the statement fails to identify the services for which registration has been requested with the required degree of clarity and precision.

Conclusion

33. The appeal is allowed and there will be an order to the effect summarised at (3) to (5) of the preceding paragraph. In accordance with the usual practice on appeal from refusals of registration, there will be no order for costs in respect of the appeal. The costs of the reference to the CJEU in Case C-307/10 will for that purpose be treated as costs of the appeal.

Geoffrey Hobbs QC
2 May 2013

Michael Edenborough QC appeared on behalf of the Appellant (the Chartered Institute of Patent Attorneys).

Nathan Abraham appeared on behalf of the Respondent (the Registrar of Trade Marks).