

World Trademark Review Daily

Questions on class headings referred to ECJ
United Kingdom - McDermott Will & Emery UK LLP

Examination/opposition
National procedures

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In *Chartered Institute of Patent Attorneys' Application* (BL O-215-10, May 27 2010), Geoffrey Hobbs QC, sitting as the appointed person in an appeal against the refusal by the UK Intellectual Property Office to register the mark IP TRANSLATOR, has referred questions to the Court of Justice of the European Union (ECJ) as to whether the class headings from the [Nice Classification](#) constitute a sufficiently precise specification of goods or services in a trademark application and, if so, whether such a specification should be interpreted to cover all of the goods or services under that heading.

Communication 4/03 of the Office for Harmonisation in the Internal Market (OHIM) 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. The communication confirmed that the use of the class heading constituted a claim to all the goods or services within the relevant class, and that the use of a general indication constituted a claim to all the particular goods or services falling under the general indication. This approach has been adopted by OHIM.

In the present case, the [Chartered Institute of Patent Attorneys](#) (CIPA) applied to register the mark IP TRANSLATOR for "education; providing of training; entertainment; sporting and cultural activities". Since this description adopted the general words of the class heading for Class 41, the registrar concluded that the specification of services could, and should, be interpreted in accordance with Communication 4/03 and, therefore, could, and should, be taken to cover translation classes, for which the mark could not be registered under Section 3(1)(b) of the [Trademarks Act 1994](#).

Since CIPA did not adduce evidence of acquired distinctiveness, or request that translation services be excluded from its specification of services, the mark was refused. CIPA appealed to the appointed person on the grounds that its application did not specify (and, therefore, did not cover) translation services in Class 41. Furthermore, it submitted that translation services were not services of the kind that would normally be regarded as "education", "providing of training", "entertainment", "sporting activities" or "cultural activities".

Following the judgment of the ECJ in *Sieckmann* (Case C-273/00), a trademark 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. However, the appointed person noted that the ECJ had not yet ruled on whether the same criteria should be applied to the particular goods or services for which registration is requested. The particular degree of clarity and precision with which the various goods or services covered by an application must be identified, so as to satisfy the requirements of Community law, remained unresolved.

The appointed person held that the general words of the class headings may not be sufficiently specific to identify the various goods or services covered by the mark with the degree of clarity and precision required. He found some support for this view in *Praktiker Bau-und Heimwerkermärker AG* (Case C-418/02), in which the ECJ held that an application to register a trademark for retail services in Class 35 was required to specify the goods or types of goods to which the services related.

The appointed person noted that, if the general words of the class headings were to be used and interpreted in accordance with Communication 4/03, then the coverage of an application would extend to goods and services not mentioned in the application or in any resulting registration. In his judgement, this would appear to be incompatible with even the most basic requirement for the various goods and services covered by a trademark application to be identified with clarity and precision.

Accordingly, the appointed person referred three questions to the ECJ:

- the degree of clarity and precision required in a specification of goods and services;
- whether it is permissible to use the general words of the class headings for the purposes of identifying goods or services in a trademark application; and
- if so, whether the class headings should be interpreted in accordance with Communication 4/03.

A reference to the ECJ on this point is clearly overdue. A survey conducted in 2008 by [MARQUES](#), the Association of European Trademark Owners, indicated an inconsistency between the practices of member states, with some authorities applying the approach in Communication 4/03 and others declining to do so.

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This creates significant uncertainty in circumstances where the protection of trademarks by registration at the national level under the [EU Trademarks Directive](#) (2008/95/EC) is intended to be synchronised with protection at the Community level under the [Community Trademark Regulation](#) (207/2009). The vice president of OHIM has indicated that OHIM would welcome an explicit ruling from the ECJ to resolve the differences in approach.

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