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European Patent & Trade Mark Attorneys

IP TRANSLATOR



The *IP TRANSLATOR* decision from the CJEU was eagerly awaited, by trade marks professionals at least, because it was hoped that it would resolve a major divergence in practice between offices across the EU. The fundamental issue was: what goods and services does a trade mark registration actually cover?

The *IP TRANSLATOR* case was set up to ask the CJEU to decide between the distinct UK and OHIM approaches to a specification of goods and services corresponding to the heading of a Class

in the Nice Classification. Despite initial hopes, the CJEU, given a choice between options A and B, has managed to choose option **C**. What is more, option C seems to be sufficiently flexible to cover option A and very nearly option B, too.

The UK Trade Marks Registry issued a Practice Amendment Notice using the *IP TRANSLATOR* decision to support a substantially unchanged policy: “If you want to cover something, say so”. OHIM issued a Communication, also based on *IP TRANSLATOR*, but reading it as *allowing* specifications worded as Class headings, if they are accompanied by a note that they are intended to mean “All goods in the Nice *alphabetical list* for this Class”. Existing CTM specifications will be treated as if such a note were present.

I think that OHIM’s new approach has two major drawbacks. We must refer to the full Nice alphabetical list to know what the specification protects. Also, the Nice Classification is reviewed and amended periodically – we are now on the 10th Edition. In each Edition, new items are added to Classes and items are transferred between Classes. We not only need a copy of the Nice alphabetical list to interpret a “Class heading” specification, but we must also determine which Edition of the Nice Classification was in use on the application date – or hang on, was that the registration date?

Trade mark professionals can probably just cope with this, although there are still opportunities for error. However, the trade mark system is not for the benefit of professionals (nor for the benefit of the trade mark offices!). Anyone with a business address in the EU can represent themselves at OHIM, but what might an unrepresented proprietor make of this new twist on an old policy (presuming he understood the *old* policy...)?

In my opinion, this unsatisfactory result is the fault of the CJEU. They rejected the old OHIM approach, because many Class headings did not determine the scope of protection with sufficient clarity or precision. However, they then had the brainwave that any Class heading

was nevertheless sufficiently clear and precise to equate to the entire Nice *alphabetical* list for that Class – but *only* if you said that this was what was intended.

Much of the CJEU's justification appears to come from its 2002 decision in the *Sieckmann* case, although this was about defining the mark, rather than goods/services. *Sieckmann* emphasised that the identity of a mark should be clear and accessible to the authorities; to business operators; **and** to the general public. *Sieckmann* requires a mark to be “clear, precise, self-contained, easily accessible, intelligible, durable and objective”.

By referring to the Nice alphabetical lists, and requiring the use of multiple Editions of the Nice Classification, the CJEU approach produces specifications that in my view are neither easily-accessible nor self-contained nor for many users even intelligible.

I therefore believe that the CJEU's *IP TRANSLATOR* decision is inconsistent with the *Sieckmann* decision, on which it purports to be based. The CJEU is not rigidly bound by its previous decisions, but this cuts both ways. *IP TRANSLATOR* has not given useful answers, and so I believe that sooner or later the same questions will have to be sent back to the CJEU again. They will be wrapped up in a different set of facts, but the underlying issues will still be there.

Worryingly, the next reference could be part of litigation, and someone's livelihood could be at stake (or worse, considering the criminal aspects of trade mark infringement). I view *IP TRANSLATOR* as a failure by the CJEU to face up to difficult questions and to take responsibility for the results of a dodged decision. This problem is not over.