

European Union's Court of Justice Rules on the Future of Trade Mark Applications

Introduction

On Tuesday afternoon the EU's highest court, the Court of Justice of the European Union (CJEU), handed down a landmark judgment concerning how goods and services should be described in trade mark applications. Following the judgment, brandowners must work closely with their legal advisers to ensure that subsequent trade mark applications proceed to registration successfully and provide the sphere of protection they seek.

The Nice Classification

A trade mark application must make clear both the mark that is being applied for and the goods or services that the mark will cover. Reference is usually made to the Nice Classification which lists 45 separate categories of goods and services (34 of goods and 11 of services) known as "classes." Each class lists the exact goods or services covered by that class and is prefaced by a general description of those goods/services, known as the "class heading." For example, class 32 covers "*beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages*" and lists 62 separate products falling within this class, including "*cocktails (non-alcoholic), aperitifs (non-alcoholic) and smoothies*." All of the EU Member States use the Nice Classification in relation to national trade mark applications. It is possible to include only a class heading in a trade mark application by way of description of the goods/services that the mark is intended to cover.

OHIM

Applications for Community Trade Marks (CTMs) must be filed with the Office for Harmonization in the Internal Market (OHIM). In June 2003, OHIM issued an official communication (communication No 4/03) stating that where only a class heading is used in a CTM application then OHIM will take that to mean that the applicant wants the mark to cover all of the goods/services listed in that class in the Nice Classification.

Reference to the CJEU

OHIM's approach was adopted by the UK's Registrar of Trade Marks in respect of an application by the Chartered Institute of Patent Agents (CIPA) to register the word mark "IP TRANSLATOR" in class 41 covering "*education; providing of training; entertainment; sporting and cultural activities*." The application cited only the class heading by way of description of the services to be covered by the mark. The Registrar refused to register the mark on the basis that one of the services listed in class 41 was "*translation*," that IP TRANSLATOR would be descriptive in relation to these services, and so the Registrar found that the mark did not satisfy the criteria for registrability.

CIPA appealed. The case went to the High Court which made a reference to the CJEU for clarification of the law in this area. The question asked was, if in a trade mark application only a Nice Classification class heading is used to describe the goods/services that the mark should cover does that mean that all of the goods/services listed in that class are being applied for? This was an

important question. The goods/services covered by a trade mark define its sphere of protection and, if drawn too widely, could make a trade mark registration vulnerable to a later challenge to its validity.

The Judgment

The CJEU held that a trade mark application must identify the goods/services to be covered by the mark with “sufficient clarity and precision” to enable others, such as competitors, to determine the extent of the protection of the mark. A Nice Classification heading could be used for this purpose but, in relation to a national trade mark registration, the applicant must specify whether its application is intended to cover all the goods and services included in the Nice class or, if that’s not intended, the applicant must say so and indicate which of the goods/services are to be covered. If the applicant failed to do this, the application lacked the necessary clarity and precision and would be rejected.

Implications for Brandowners

Although the judgment made it clear that, in relation to national trade mark applications, applicants must indicate which of the goods/services in the Nice Classification they intend to be covered by the mark, the judgment did not address OHIM’s practice in relation to CTMs. However, at the time of writing, OHIM has just announced its intention to repeal Communication 4/03 and replace it with Communication 2/12, which indicates that OHIM will work with the national trade mark offices within the framework of the Convergence Program towards a common practice with respect to the acceptability of each of the general indications of the Nice Classification class headings. In the interim, OHIM will adopt a practice in line with the judgment of the CJEU and will ask applicants who use all the general indications of a particular class heading to expressly indicate whether or not it is their intention to cover all the goods and services covered in the class.

In light of these events, brandowners must ensure that their trade mark applications (national or CTM) mean what they say in relation to the goods/services to be covered. The goods/services must be set out in the application clearly and accurately. So this can be done, brandowners must be clear about the scope of protection they will need. Advice should be sought from specialist legal advisers about how to draft the application to ensure this protection is successfully obtained.

Squire Sanders lawyers are trusted trade mark advisers to some of the world’s best known brands. Please feel free to contact us to discuss your trade mark needs.

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