



## **The Court clarifies the requirements for the identification of the goods and services for which the protection of a trade mark is sought**

*Those goods and services must be identified by the applicant with sufficient clarity and precision to allow the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark*

The two essential elements of the registration of a trade mark are, on the one hand, the sign and, on the other, the goods and services which that sign is to designate. Those elements together allow the precise subject and the extent of the protection conferred by the registered trade mark on its proprietor to be defined.

Having identified in its case-law<sup>1</sup> the conditions which a sign must fulfil in order to constitute a trade mark, the Court turns to consider, in the present case, the requirements for the identification of goods or services for which the protection of a trade mark is sought. This question is of particular importance when national trade mark offices and OHIM (the Community trade Mark Office) develop divergent practices leading to variable conditions for registration, contrary to the objectives pursued by the Trade Mark Directive<sup>2</sup>.

At international level, trade mark law is governed by the Paris Convention for the Protection of Industrial Property<sup>3</sup>. That convention served as a basis for the adoption of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks<sup>4</sup>. Since 1 January 2002 the Nice Classification has contained 34 classes of products and 11 classes of services. Each class is designated by one or more general indications, commonly called 'class headings', which indicate in a general manner the fields to which the goods and services in principle belong. The alphabetical list of goods and services contains approximately 12 000 entries.

On 16 October 2009, the Chartered Institute of Patent Attorneys (CIPA) applied to register the designation 'IP TRANSLATOR' as a national trade mark. To identify the services covered by that registration CIPA used the general terms of the heading of a class of the Nice Classification, that is to say, 'Education; providing of training; entertainment; sporting and cultural activities'.

The Registrar of Trade Marks refused that application, by decision of 12 February 2010, on the basis of the national provisions transposing the Trade Mark Directive. The Registrar interpreted the application, taken overall, in accordance with a Communication from OHIM<sup>5</sup>, and concluded that it

<sup>1</sup> Case [C-273/00 Sieckmann](#).

<sup>2</sup> 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).

<sup>3</sup> 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 (United Nations Treaties Series, No 11851, vol. 828, p. 305). All the Member States are parties to that Convention.

<sup>4</sup> 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 28 September 1979 (United Nations Treaty Series, Vol. 1154, No I 18200, p. 89).

<sup>5</sup> Communication No 4/03 of the President of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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).

covered not only services of the kind specified by CIPA, but also every other service falling within that class of the Nice Classification, including translation services. Accordingly, for these latter services the designation IP TRANSLATOR lacked distinctive character and was descriptive in nature. Moreover, there was no evidence that the word sign 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 its trade mark application.

CIPA appealed against that decision, contending that its application for registration did not specify, and therefore did not cover, translation services. For that reason, it submitted, the Registrar's objections to registration were misconceived and CIPA's application for registration had been wrongly refused.

The High Court of Justice, hearing the case, has asked the Court of Justice to clarify the requirement of clarity and precision for the identification of the goods and services for which the protection of the trade mark is sought and whether it is possible to use, for that purpose, the general indications of the class headings of the Nice Classification.

In today's judgment, the Court emphasises, first, that the Trade Mark Directive 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 sought.

On the one hand, the competent authorities must know with clarity and precision the nature of the signs of which a mark consists in order to be able to fulfil their obligations in relation to the prior examination of applications for registration and the publication and maintenance of an appropriate and precise register of trade marks. On the other hand, economic operators must be able to acquaint themselves, with clarity and precision, with registrations or applications for registration made by their actual or potential competitors, and thus to obtain relevant information about the rights of third parties.

Second, the Court holds that the directive 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. However, such identification must be sufficiently clear and precise to allow the competent authorities and economic operators to determine the scope of the protection sought. In that connection, the Court observes that some of the general indications in the class headings of the Nice Classification are, in themselves, sufficiently clear and precise, while others are too general and cover goods or services which are too varied to be compatible with the trade mark's function as an indication of origin. Accordingly, it is 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.

Finally, the Court points out that 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 that class 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.

Thus, it is for the referring court to determine whether, when it used all the general indications of the heading of a class of the Nice Classification, CIPA had 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.

**NOTE:** A reference for a preliminary ruling allows the courts and tribunals of the Member States, in disputes which have been brought before them, to refer questions to the Court of Justice about the interpretation of European Union law or the validity of a European Union act. The Court of Justice does not decide the dispute itself. It is for the national court or tribunal to dispose of the case in accordance with the Court's decision, which is similarly binding on other national courts or tribunals before which a similar issue is raised.

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The [full text](#) of the judgment is published on the CURIA website on the day of delivery.

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