

Translating IP Translator for U.S. Mark Holders Filing in Europe

At a discussion on “Alternatives available to U.S. mark holders when registering their marks in Europe” at the recent International Trademark Association’s annual meeting, one of the issues raised was the case of *Chartered Institute of Patent Attorneys v. The Registrar of Trademarks* known as IP Translator (judgment at <http://bit.ly/15SZzrG>). The case continues to cause problems for Community trademark filers seeking a community trademark (CTM) in the European Union (EU).

Stimulated by the discussion and generally aware that IP Translator may not be well known to American practitioners, the following is a summary of the case, its background, the opinion by the Court of Justice of the European Union (CJEU), the response by the Office for Harmonization in the Internal Market (OHIM) and the questions and problems that response raises for mark applicants.

BACKGROUND

The IP Translator case deals with how specific your goods and services description must be in your CTM application. In the past CTM applicants who sought broad protection had taken advantage of OHIM’s “class-heading-covers-all approach.” Under it OHIM interpreted a goods/services description that covers a complete class heading to mean everything in that class. (A class heading contains a representative selection of goods or services in that class.)

But some of the IP national offices in the EU (including Germany) interpreted the class headings literally. For instance, if an applicant sought protection for music stands under class

15, that item would not be covered under the heading for class 15 which is musical instruments. That’s because music stands are not instruments that play music and therefore the class heading is not literally general enough to cover the stands.

THE CASE

Now for the IP Translator case. The UK Chartered Institute of Patent Attorneys (CIPA) brought a test case to determine whether OHIM’s class-heading-covers-all approach or the more literal approach adopted by some national IP offices should be the practice in the EU.

CIPA sought to register the trademark IP Translator under class 41 whose class heading is “Education; providing of training; entertainment; sporting and cultural activities.” The UK Intellectual Property Office (IPO) following OHIM’s “everything in the class approach” rejected the application. The IPO stated that, because translation services are included within the alphabetical listing for class 41, the mark IP Translator is descriptive of those services. The WIPO alphabetical lists are found at <http://bit.ly/13J0bC3>.

CIPA appealed to the appointed person (the appeals tribunal for the IPO) who in turn referred the case to the CJEU.

THE CJEU OPINION

The CJEU opinion is internally inconsistent. The court first held that CTM applicants must describe the goods/services covered by the application “with sufficient clarity and precision

to enable the competent authorities [the national trademark offices and the courts] and economic operators [third party mark holders and mark applicants] on that basis alone to determine the extent of protection.”

The CJEU then backtracked. It allowed OHIM's everything-in-the-class approach to continue with some minor tweaks. The court stated that an applicant who uses the class headings to identify the goods or services for which protection is sought “must specify whether its application is intended to cover all the goods or services included in the [WIPO] alphabetical list of the particular class concerned or only some of those goods or services.”

If an applicant explicitly makes clear its intention to cover every item in the class, the application will extend to the entire alphabetical list for that class.

That list can be painfully long. Although the CJEU stated in IP Translator that third-parties examining an application should be able to understand the scope of goods or services protected by the class heading description “on that basis [or from that heading] alone,” third-parties will need more. When examining a potentially problematic application, third-parties must also have in hand the Nice alphabetical list (after checking to ensure that the list was in effect at the time of filing of the application at issue).

OHIM'S RESPONSE

OHIM's response to IP Translator continues to change. At first OHIM required applicants to attach to their applications a “declaration of intention” stating that they either wish the class headings to cover all the goods or services in the alphabetical list of that class or only those expressly specified.

But in October 2012 OHIM switched gears and adopted a tick box scheme. Under this scheme when an applicant selects a particular class the field is pre-populated with the class headings. If

the applicant then ticks the box confirming that it intends to cover all the goods or services in this category, a warning appears stating:

Any previous indication of goods/services will be replaced by class heading of the selected class and all goods/services of the alphabetical list of this class

Immediately thereafter the full alphabetical list is inserted in the application.

If the applicant does not tick the box, the class headings are given their natural meaning which in some cases may not be apparent. For example the heading for class 9 includes “teaching apparatus and instruments.” Reasonable minds may differ re the meaning of that phrase.

THE APPLICANT'S DILEMMA

So what is the applicant to do? By ticking the box (however tempting) an applicant simply increases the likelihood of an opposition, cancellation or an infringement proceeding from an adversely affected mark holder in one of the 27 countries in the EU. In the past trademark holders may have opted to do nothing in response to applications covering class headings when the applicant was engaged in a non-competing business. But when specific goods or services are now expressly part of the application, competing trademark holders may feel compelled to act.

Further an applicant may be overreaching by seeking protection for the alphabetical list if the applicant only requires protection for a few of those items. For example a supplier of amplifiers seeking protection under class 9 who imports the whole alphabetical list (containing about 850 items) will also be attempting to protect fire blankets.

And for those who do not check the box but rely instead on the class headings there may also be confusion depending on the class selected. In certain classes, such as class 25 for clothing,

the scope of protection is fairly clear. But for other classes (such as class 9), it may not be.

The best course of action is less is more: narrow your description of goods/services to what you want to protect now and reasonably in the future and you will thereby comply with the CJEU's direction in IP Translator to draft your description "with sufficient clarity and precision."

For more information on the topic discussed, contact **Andrew Berger** at berger@thsh.com.

Andrew Berger is counsel to the firm and specializes in copyright and trademark litigation and licensing. His blog, IP In BRIEF, is at www.ipinbrief.com.

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