Reports of Cases

OPINION OF ADVOCATE GENERAL
BOT
delivered on 29 November 2011 [1]

Case C-307/10

Chartered Institute of Patent Attorneys
v
Registrar of Trade Marks

(Reference for a preliminary ruling brought by the Person Appointed by the Lord Chancellor under Section 76 of the Trade Marks Act 1994, on Appeal from the Registrar of Trade Marks, submitted by the High Court of Justice of England and Wales (United Kingdom))

(Trade marks — Directive 2008/95/EC — Regulation (EC) No 207/2009 — Scope of protection of the trade mark — Identification of the goods or services for which trade mark protection is sought — Degree of clarity and precision required — Use of class headings of the Nice Classification — Communication No 4/03 of the President of OHIM)

1. The two essential components of the registration of a trade mark are (a) the sign and (b) the goods and services which that sign is to designate. Each of those components makes it possible to define the precise subject-matter of the protection conferred by the registered trade mark on its proprietor.

2. In the judgment in *Sieckmann*, [2] the Court defined the conditions which a sign must satisfy in order to constitute a trade mark. This case now gives it the opportunity to define the rules governing the identification of the goods or services for which trade mark protection is sought and, indirectly, to assess the scope of the rules applied up to now by the Office for Harmonisation in the Internal Market (Trade marks and designs) (OHIM). This is particularly important when the national trade mark offices and OHIM develop different practices leading to varying requirements for registration contrary to the objectives pursued by the Union legislature.

I – Legal framework

A – *The Nice Agreement*

3. The Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, [3] was adopted in accordance with Article 19 of the Convention for the Protection of Industrial Property, [4] which governs trade mark law at international level. Article 1 provides that the purpose of the Nice Agreement is to facilitate registration of trade marks by means of the Nice Classification.

1 — Original language: French.

2 — Case C-273/00 [2002] ECR I-11737.

3 — 'The Nice Agreement'. According to the database of the World Intellectual Property Organisation (WIPO), only the Republic of Cyprus and the Republic of Malta are not parties to the Nice Agreement. Nevertheless, they use the common classification of goods and services for which a trade mark is registered ('the Nice Classification').

4 — Convention signed in Paris on 20 March 1883, last revised in Stockholm on 14 July 1967 and amended on 28 September 1979 (*United Nations Treaty Series*, Vol. 828, No 11851, p. 305, 'the Paris Convention').

4. Article 2 of the Nice Agreement defines the legal effect of the Nice Classification and also its use. It reads as follows:

‘(1) Subject to the requirements prescribed by this Agreement, the effect of the Classification shall be that attributed to it by each country of the Special Union. In particular, the Classification shall not bind the countries of the Special Union in respect of either the evaluation of the extent of the protection afforded to any given mark or the recognition of service marks.

(2) Each of the countries of the Special Union reserves the right to use the Classification either as a principal or as a subsidiary system.

(3) The competent Office of the countries of the Special Union shall include in the official documents and publications relating to registrations of marks the numbers of the classes of the Classification to which the goods or services for which the mark is registered belong.

…’

5. The Nice Classification is maintained by the International Bureau of the WIPO. It consists of a list of classes, together with explanatory notes, where necessary, and an alphabetical list of the goods and services in each class. At the present time, the Classification comprises a list of headings of 34 classes of goods and 11 classes of services. The indications of products or services in the class headings indicate in a general manner the fields to which the goods and services referred to in principle belong.[5] The ninth edition of the Nice Classification, which came into force on 1 January 2007, contains an alphabetical list of 11 600 entries.

6. The Classification must be used in applications for and the registration of Community trade marks.

B – *Directive 2008/95/EC*

7. Directive 2008/95/EC[6] was adopted in order to abolish the disparities between the laws of the Member States which might impede the free movement of goods and freedom to provide services and might distort competition within the common market. The Directive limits approximation to those national provisions of law which most directly affect the functioning of the internal market. Among those provisions are those which define the conditions governing registration of a trade mark and those which determine the protection enjoyed by duly registered marks. In the light of the international undertakings concluded, those provisions must be in complete harmony with those of the Paris Convention and they must not affect the obligations of the Member States under that convention.

8. Article 2 of the Directive defines the signs of which a trade mark may consist in the following way:

‘A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.’

9. Article 3 of the Directive lists the grounds for refusal or invalidity which may be raised against the registration of a trade mark. For example, the following are not to be registered or, if registered, are liable to be declared invalid: trade marks which are devoid of any distinctive character or trade marks which consist exclusively of signs which may serve, in trade, to designate the intended purpose of the goods.

5 — See the general remarks and Point 1 of the Guidance for the User of the Nice Classification, available on the WIPO internet site.

6 — 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, ‘the Directive’).

10. Article 4 of the Directive lists the further grounds for refusal or invalidity in the event of a conflict with a trade mark filed earlier.

11. Finally, under Article 5(1)(a) of the Directive, '[t]he registered trade mark shall confer on the proprietor exclusive rights therein' and permits him, for example, to prevent third parties from using in the course of trade any sign which is identical with the trade mark in relation to goods or services identical with those for which it is registered.

C – *Regulations (EC) No 207/2009 and (EC) No 2868/95*

12. In order to complete the internal market, Regulation (EC) 207/2009[7] aims to establish, side by side with national trade marks, a Community mark which is acquired by means of one procedural system, which has uniform protection within the Union and which produces effect throughout the territory of the Member States. The Community mark does not replace the national protection systems, which remain in place. The registration and administration of that mark falls within the terms of reference of OHIM.

13. The Regulation contains, in Articles 4 and 7 to 9, provisions similar to those of Articles 2 to 5 of the Directive.

14. However, Article 26(1)(c) of the Regulation provides that an application for a Community trade mark is to contain a list of the goods or services in respect of which the registration is requested. Under Rule 2(2) of Regulation (EC) No 2868/95,[8] '[that] list … shall be worded in such a way as to indicate clearly the nature of the goods and services and to allow each item to be classified in only one class of the Nice Classification'.

15. Furthermore, under Article 28 of the Regulation, read in conjunction with Rule 2(1) of the Implementing Regulation, the goods and services for which a trade mark is filed are classified according to the Nice Classification. Rule 2(4) of the Implementing Regulation provides, finally, as follows:

'The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.'

D – *Communication No 4/03 of the President of OHIM*

16. Communication No 4/03 of the President of OHIM[9] is intended, according to point I thereof, to explain and clarify the practice of OHIM 'regarding the use of class headings and the consequences of such use when Community trade mark applications or registrations are restricted or partially surrendered or are involved in opposition or cancellation proceedings'.

17. According to the second paragraph of Point III of Communication No 4/03, the use of the general indications or the whole class headings provided for in the Nice Classification constitutes a proper specification, classification and grouping of goods and services in a Community trade mark application.

18. In particular, it is stated, in that point, that '[OHIM] does not object to the use of any of the general indications and class headings as being too vague or indefinite, contrary to the practice which is applied by some national offices in the European Union and in third countries in respect of some of the class headings and general indications'.

7 — Council Regulation of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1, 'the Regulation').

8 — Commission Regulation of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1, 'the Implementing Regulation').

9 — Communication of 16 June 2003 concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations.

19. Moreover, Point IV of that communication provides:

'The 34 classes for goods and the 11 classes for services comprise the totality of all goods and services. As a consequence of this, the use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within this particular class.

Similarly, the use of a particular general indication found in the class heading will embrace all of the individual goods or services falling under that general indication and properly classified in the same class. …'

20. Finally, Point V.2 of that communication states:

'As regards opposition and cancellation proceedings, the rule that the use of the whole class heading of a particular class means that all the goods within that class are included has the consequence that when the later application or registration contains goods or services properly classified in that same class, the goods or services are identical with the goods or services in the earlier mark. When the specification does not include all of the general indications of a particular class heading, but only one or some of them, identity will be found only when the particular item falls under the general indication. ...'

E – *National law*

21. The Trade Marks Act 1994 ('the 1994 Act'), which transposed the Directive into the national law of the United Kingdom, provides, in Section 32(2)(c), that the application for registration must contain a statement of the goods and services for which it is sought to register the trade mark.

22. Under Section 34(1) of the 1994 Act, goods and services are classified according to the prescribed system of classification.

23. That Act is supplemented by the Trade Marks Rules 2008 ('the 2008 Rules') which deal with practice and procedure before the UK Intellectual Property Office. Under Rule 8(2)(b) of those rules, the applicant must specify the goods or services for which the national trade mark is sought in such a way as to indicate clearly the nature of those goods or services.

II – The dispute in the main proceedings and the questions referred for a preliminary ruling

24. The Chartered Institute of Patent Attorneys ('CIPA') applied to the Registrar of Trade Marks ('Registrar'), on 16 October 2009, for registration of the designation 'IP TRANSLATOR' for the products in Class 41 of the Nice Classification, headed 'Education; providing of training; entertainment; sporting and cultural activities'.

25. The Registrar examined that application on the basis of Communication No 4/03 and refused it. Since the application referred to the heading of Class 41 of the Nice Classification, the Registrar examined whether there were absolute grounds for refusing to register having regard to all the services in that class, including translation services. The Registrar considered that the trade mark 'IP TRANSLATOR' was descriptive in relation to those services and therefore refused to register it.

26. CIPA appealed against that decision, contending that its application for registration did not specify and was not intended to cover the translation services in Class 41 of the Nice Classification. According to the Person Appointed by the Lord Chancellor under Section 76 of the Trade Marks Act 1994, on Appeal from the Registrar of Trade Marks, United Kingdom, those services are not normally regarded as a subcategory of 'education', 'providing of training', 'entertainment', 'sporting and cultural activities'.

27. According to the documents submitted to the Court, in addition to the alphabetical list which contains 167 listings for the itemisation of services falling within Class 41 of the Nice Classification, the database maintained by the Registrar for the purposes of the 1994 Act contains more than 2 000 listings for the itemisation of services falling within Class 41 and the Euroace database maintained by OHIM for the purposes of the Regulation contains more than 3 000 listings.

28. The national referring body points out that, if the Registrar's approach is correct, all such itemisations, which include translation services, would be covered by CIPA's application for registration. In that case, the coverage of the application would extend to goods and services not mentioned in the application or in any resulting registration. The national referring body takes the view that that interpretation is incompatible with the requirement for the various goods and services covered by a trade mark application to be identified with clarity and precision.

29. The national referring body also refers to a survey conducted in 2008 by the Association of European Trade Mark Owners (Marques), which indicated that practice varies among the Member States, with some competent authorities applying the approach to interpretation envisaged by Communication No 4/03 and others declining to do so.

30. In order to dispel those doubts, the Person Appointed by the Lord Chancellor under section 76 of the Trade Marks Act 1994, on Appeal from the Registrar of Trade Marks, decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

'In the context of the Directive:

(1) Is it necessary for the various goods or services covered by a trade mark application to be identified with any, and if so what particular, degree of clarity and precision?

(2) Is it permissible to use the general words of the class headings of the [Nice Classification] for the purpose of identifying the various goods or services covered by a trade mark application?

(3) Is it necessary or permissible for such use of the general words of the Class Headings of [the Nice Classification] to be interpreted in accordance with Communication No 4/03 ...?'

31. Observations have been lodged by the parties to the main proceedings and by the United Kingdom, Czech, Danish, German, Irish, French, Austrian, Polish, Portuguese, Slovak and Finnish Governments, OHIM and the European Commission.

III – My analysis

32. By the questions it has referred for a preliminary ruling, the national court is essentially asking the Court of Justice to establish the requirements related to the identification of the goods or services for which the applicant for a national trade mark seeks protection.[10] In that regard, it raises the issue of the relevance of the general indications in the class headings of the Nice Classification and of the scope of the interpretation adopted by the President of OHIM in Communication No 4/03.

A – *Preliminary observations*

33. I would observe, to begin with, that the Directive contains no provision concerning the identification of the goods or services for which registration of a trade mark is sought. Therefore, the attainment of the objectives pursued by the Directive calls for an approximation of the national laws in that respect.

10 — In my analysis, I shall refer to the opinion of Advocate General Ruiz-Jarabo Colomer in Case C-40/01 *Ansul* [2003] ECR I-2439, and to points 57 to 82 of the opinion of Advocate General Léger in Case C-418/02 *Praktiker Bau- und Heimwerkermärkte* [2005] ECR I-5873.

34. Recital 4 in the preamble to the Directive states that the approximation of the laws of the Member States concerns those 'national provisions of law which most directly affect the functioning of the internal market'. According to the Court, the aim of the Directive is to achieve harmonisation in relation to substantive rules of central importance in this sphere,[11] including, in my view, those which serve to determine the scope of the protection of a trade mark.

35. Further, it is stated, in recital 8 in the preamble to the Directive, that the 'attainment of the objectives at which this approximation [of the national legislations] is aiming requires that the conditions for obtaining and continuing to hold a registered trade mark are, in general, identical in all Member States'. However, the Court has held that the requirements relating to the determination of the goods and services do indeed constitute a substantive condition for acquiring the right conferred by the trade mark.[12]

36. Finally, recital 10 in the preamble to the Directive states that '[i]t is fundamental, in order to facilitate the free circulation of goods and services, to ensure that henceforth registered trade marks enjoy the same protection under the legal systems of all the Member States'. The protection of the trade mark is ensured essentially by its registration.[13] Consequently, uniform protection of the trade mark over the whole of the territory of the Union precludes variable conditions for registration and requires an approximation of the national legislations relating to the identification of goods or services.

37. Second, it is essential to define a common approach regarding the identification of goods or services, depending on whether the application concerns the registration of a national trade mark or of a Community trade mark.

38. Admittedly, as the Court has recently pointed out, the Community trade mark regime is an autonomous system with its own set of objectives and particular rules.[14] However, the fact remains that the national trade mark and Community trade mark regimes are based on common basic principles, as is apparent from the identical nature of the objectives and the substantive rules. The rules relating to the definition and acquisition of the trade mark and also those which determine its effect are, in essence, identical whether they concern a national trade mark or a Community trade mark, as is evident from a comparison of the wording of Articles 2, 3 and 5 to 7 of the Directive and 4, 7, 9, 12 and 13 of the Regulation. Moreover, the Court has not hesitated to apply the interpretation of certain provisions of the Directive, in particular the interpretation of Article 5 of the Directive to Article 9 of the Regulation.[15]

39. Furthermore, although the national trade mark and Community trade mark regimes are independent of each other, the fact remains that, in the life of a trade mark, those two regimes interact. A series of examples may clarify this.

40. Thus, under Article 16(1)(a) of the Regulation, for example, the Community trade mark is regarded as a national trade mark registered in the Member State in which the proprietor has his seat. If the competent authority of that Member State adopts a more restrictive approach than OHIM in respect of the substantive scope of the trade mark, it is clear that it is more in the trade mark proprietor's interest to apply for registration of a Community trade mark than to apply for registration of a national trade mark.

11 — Case C-482/09 *Budějovický Budvar* [2011] ECR I-8701, paragraph 30 and the case-law cited. That judgment concerned the interpretation of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), those provisions being, in essence, identical to those of the Directive.

12 — *Praktiker Bau- und Heimwerkermärkte*, paragraph 31.

13 — *Sieckmann*, paragraph 37.

14 — *Budějovický Budvar*, paragraph 36 and the case-law cited.

15 — See, *inter alia*, Case C-323/09 *Interflora and Interflora British Unit* [2011] ECR I-8625, paragraph 38 and the case-law cited.

41. Also, under Article 34 of the Regulation, the proprietor of an earlier national trade mark may claim the seniority of that trade mark when he files an application for an identical Community trade mark for goods or services which are identical to those for which the earlier trade mark has been registered. Finally, under Articles 41 and 42 of the Regulation, the proprietor of an earlier national trade mark may oppose the registration of a Community trade mark if this is identical and if the goods and services for which the trade mark has been sought are identical to those in respect of which the earlier trade mark is protected. In these last two examples, the examination of the validity of these claims depends on the identity of the goods or services concerned, which requires the competent national authority and OHIM to adopt a uniform interpretation of the rules governing the identification of those goods or services.

42. These examples show that it is therefore essential to define a uniform approach with regard to the goods or services for which trade mark protection is sought, to be applied both by the national offices and by OHIM. Otherwise, the trade mark registration scheme in the Union may suffer, as a result of inconsistencies, significant legal uncertainty and may also encourage forum-shopping. It is, *inter alia*, to respond to these concerns that the Commission indicated, at the hearing, that a legislative reform of the Directive and of the Regulation would soon be undertaken.

43. In the light of all these factors, I therefore propose that the Court of Justice adopt a uniform interpretation of the requirements relating to the identification of the goods or services whether the application concerns the registration of a national trade mark or of a Community trade mark and, for that purpose, take as a starting point the rules laid down in the Regulation.

B – *The identification of goods or services in an application for registration*

44. By its first question, the national court asks the Court of Justice, in essence, whether, for the purposes of the Directive, the applicant is required to identify with clarity and precision the goods or services for which he seeks protection and, if so, seeks the view of the Court as to the degree of clarity and precision required.

45. For the reasons I have just stated, I shall base my analysis on the first principles at my disposal in the Regulation.

46. The identification of the goods or services for which the registration of a Community trade mark is requested must not be confused with their classification. The identification of goods or services is governed exclusively by Article 26(1)(c) of the Regulation and by Rule 2(2) of the Implementing Regulation. Under those provisions, the applicant must draw up a list of the goods and services, which must be worded in such a way as to indicate clearly the nature of the goods and services.

47. Therefore, there is nothing to indicate that the applicant is required to use the words in the class headings of the Nice Classification. That fact is significant because, by Communication No 4/03, the President of OHIM seeks to attribute to the Nice Classification a legal value which its does not have for that purpose.

48. Indeed, Article 2(1) of the Nice Agreement provides that the Nice Classification has no legal scope in respect of the evaluation of the extent of the protection afforded to a mark except that attributed to it by each country of the Special Union. [16]

49. Under the Community trade mark regime, the classification of goods and services in accordance with the Nice Classification is carried out for exclusively administrative purposes. This is expressly clear from a combined reading of Article 28 of the Regulation and Rule 2(1) and (4) of the Implementing Regulation. [17]

16 — This rule is also included in Article 4(1)(b) of the Protocol relating to the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 27 June 1989, to which the European Community acceded under Council Decision 2003/793/EC of 27 October 2003 (OJ 2003 L 296, p. 20).

17 — Under those provisions, the classification of goods and services according to the Nice Classification is not binding on the examiner as regards the evaluation of the identity or similarity of goods and services, since goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification or dissimilar on the ground that they appear in different classes under that classification. That rule is also included in Article 9(2)(a) and (b) of the Trademark Law Treaty, adopted in Geneva on 27 October 1994.

50. The Nice Classification therefore has an essentially practical value.[18] It facilitates registration of trade marks, as the Court recognised in *Koninklijke KPN Nederland*,[19] and searches for prior marks. Since goods and services are classified in the same way in all the States party to the Nice Agreement, the Nice Classification facilitates the preparation of applications for registration. Also, by establishing a single classification system, it helps the competent authorities and economic operators to carry out searches for prior marks which could give rise to opposition to registration of a new trade mark. Finally, under Rule 4 of the Implementing Regulation, it is in the light of the number of classes in which the goods and services covered are included that the registration fee is calculated.

51. Consequently, the classification of goods and services in accordance with the Nice Classification is only a formal requirement, which must be satisfied for obvious reasons of administration and convenience.

52. However, it lacks binding legal force with regard to the evaluation of the substantive scope of the trade mark. The scope of the protection conferred by the trade mark must be examined only in the light of the details expressly referred to by the legislature in Article 26(1) of the Regulation and Rule 1(1) of the Implementing Regulation relating to the conditions with which the application must comply. These details include *inter alia* the representation of the trade mark and the list of the goods or services in respect of which the registration is requested, that is, the two essential components of a trade mark registration. Like the representation of the sign, the list of goods and services therefore defines the subject-matter of the protection conferred by the trade mark. Accordingly, under the speciality rule, the registered trade mark is protected only in respect of the goods and services covered by the application for registration.

53. That said, the requirements relating to the identification of goods or services must be precisely defined.

54. To that end, it is necessary to rely on the principles laid down in Article 26(1)(c) of the Regulation and Rule 2(2) of the Implementing Regulation, referred to above, and to take account of the rules governing the grant of a trade mark.

55. First, the registration of the trade mark must fulfil the basic function of the mark, which is to enable the consumer to distinguish, without any possibility of confusion, the goods or services of one undertaking from those of another undertaking.[20] Consequently, the products or services must be identifiable.

56. Second, a trade mark must be registered in accordance with the speciality principle. This principle seeks to reconcile the exclusive rights conferred by a trade mark on its proprietor with the principles of the free movement of goods and the freedom to provide services. It requires the rights conferred by the trade mark to be defined with precision in order to limit the exclusive rights to the actual function of the trade mark.

57. Third, the description of the goods and services covered by the trade mark is needed to enable the competent authorities to assess whether the absolute grounds for refusal set out in Article 3 of the Directive and Article 7 of the Regulation are present.[21]

58. Under Article 3(1)(c)(i) of the Directive and Article 7(1)(e)(i) of the Regulation, signs consisting exclusively of the shape which results from the nature of the goods themselves are not to be registered or, if registered, are liable to be declared invalid. The product therefore must be described.

18 — See points 42 and 43 of the opinion of Advocate General Léger in *Praktiker Bau- und Heimwerkermärkte*.

19 — Case C-363/99 [2004] ECR I-1619, paragraph 111.

20 — See Article 2 of the Directive and Article 4 of the Regulation. See, also, Cases C-104/01 *Libertel* [2003] ECR I-3793, paragraph 62 and the case-law cited, and *Interflora and Interflora British Unit*, paragraph 37 and the case-law cited.

21 — Case C-517/99 *Merz & Krell* [2011] ECR I-6959, paragraph 29, and *Koninklijke KPN Nederland*, paragraphs 33 and 34.

59. Likewise, the goods and services for which registration of the mark is sought must be taken into account to determine whether registration should be refused pursuant to Article 4 of the Directive and Article 8 of the Regulation, on the ground that the mark is identical with, or could present a likelihood of confusion with, an earlier mark. Accordingly, under Article 4(1)(a) of the Directive and Article 8(1)(a) of the Regulation, a trade mark is not to be registered or, if registered, is liable to be declared invalid on the ground that the mark is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected. Under Article 4(1)(b) of the Directive and Article 8(1)(b) of the Regulation, a likelihood of confusion arises from interdependence between the similarity of the marks to each other and the similarity of the goods and services respectively designated by the marks.

60. Finally, specification of the goods or services covered by the mark makes it possible to apply the grounds of revocation or invalidity and enables national offices, in accordance with Article 13 of the Directive, and OHIM, in accordance with Articles 51 to 53 of the Regulation, to limit the scope of revocation or invalidity of a mark strictly to the goods or services to which those grounds apply.

61. Fourth, registration must contribute, in respect of both Union law and the different national laws, to legal certainty and sound administration. [22]

62. Thus, in the judgment in *Sieckmann*, relating to the possibility of registering an olfactory mark, the Court called for the graphic representation of the sign required under Article 2 of Directive 89/104 and Article 4 of the Regulation to be clear, precise, self-contained, easily accessible, intelligible, durable, unequivocal and objective so that it can be precisely identified. [23]

63. Those requirements reflect two specific objectives. The first is to enable the competent authorities to know with clarity and precision the nature of the signs of which a mark consists in order to carry out the prior examination of applications for registration and to publish and maintain an appropriate and precise register of trade marks.

64. The Court requires the national offices and OHIM to carry out a strict, thorough and full examination of the grounds for refusal to register, in order to ensure that trade marks are not improperly registered. [24] Accordingly, in order to assess whether or not there is a distinctive character, the Court requires an examination in concreto in relation to each of the goods or services for which registration is sought [25] and, if the competent authority refuses to register a mark, the decision must, as a general rule, be reasoned in respect of each of the goods or services. [26] Those requirements are justified having regard to the nature of the review, which is first and foremost a review *a priori*, and having regard to the number and detailed nature of the obstacles to registration laid down in Articles 2 and 3 of the Directive and Articles 4 and 7 of the Regulation. Furthermore, those requirements are justified in the light of the wide range of appeals available to applicants where the competent authorities refuse to register a mark. As the Court has recently pointed out, that obligation to state reasons must ensure effective judicial protection of the rights accorded to applicants. [27]

65. The second objective is to enable economic operators 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.

22 — *Sieckmann*, paragraph 37.

23 — Ibidem, paragraphs 46 to 55.

24 — *Koninklijke KPN Nederland*, paragraph 123 and the case-law cited.

25 — See Case C-239/05 *BVBA Management, Training en Consultancy* [2007] ECR I-1455, paragraph 31 and the case-law cited.

26 — Order in Case C-282/09 P *CFCMCEE* v *OHIM* [2010] ECR I-2395, paragraph 37 and the case-law cited, and, with regard to Article 7(1)(b) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), *inter alia*, Joined Cases C-468/01 P to C-472/01 P *Procter & Gamble* v *OHIM* [2004] ECR I-5141, paragraph 36.

27 — Order in *CFCMCEE* v *OHIM*, paragraph 39 and the case-law cited.

66. These requirements have subsequently been applied by the Court to registrations of a colour, of a combination of colours [28] and of sounds. [29]

67. Clearly, those objectives cannot be attained and those requirements would have no practical effect if the goods and services for which the applicant seeks protection could not be clearly identified. As Advocate General Léger pointed out in point 63 of his opinion in *Praktiker Bau- und Heimwerkermärkte*, the two inseparable elements of registration, which make it possible to determine the precise subject-matter of the protection conferred by the trade mark, are, on the one hand, the sign, and, on the other, the goods and services which the sign must serve to designate.

68. Therefore, we cannot apply *stricto sensu* the requirements laid down in respect of the graphic representation of a sign, which is olfactory or denotes a sound, to the identification of goods or services. Clearly, the graphic representation of a sign which is not in itself capable of being perceived visually raises very different problems from those we may find in connection with a verbal description of goods and services.

69. It is obvious that that description must be clear and precise so that the goods or services may be identified accurately by the competent authorities and economic operators. That clarity and precision naturally require the expressions used to be intelligible and unambiguous.

70. We therefore cannot risk significantly limiting the protection which the trade mark confers on its proprietor by requiring him to go into detail for each of the goods and services concerned.

71. To fulfil those requirements there are, in my view, two options.

72. The first consists in listing specifically each of the goods or services for which the applicant seeks protection. According to the case-law, that identification clearly must be understood to include goods or services which are integral to the make-up or structure of the goods and services specifically designated, such as parts, or directly related to them. [30]

73. Nevertheless, it must be conceded that a specific list may be tricky in view of the very different ways in which certain goods or services may be described and may even risk significantly limiting the protection which the trade mark affords to its proprietor. It is not a question of requiring the proprietor of the registered trade mark to make a fresh application for registration each time he describes the product in respect of which he has a trade mark, by altering, for example, to a very small degree, its composition or by targeting other categories of person. Thus, the proprietor of a registered trade mark for cleansing milk should be able to describe that product according to whether it is intended for small children or adults, without making fresh applications for registration.

74. That is why, without going as far as drawing up an individual list of each of the goods and services concerned, the second option consists in identifying the basic goods or services, in order that the competent authorities and the economic operators may identify precisely *the essential objective characteristics and properties* [31] of the goods and services covered.

75. That criterion should make it possible to identify objectively the nature of the goods, in accordance with Rule 2(2) of the Implementing Regulation. Furthermore, it should enable the competent authorities and economic operators to determine the similar goods which may be protected by the trade mark. This system, which is already applied in the field of customs classification of goods, seems to me to meet the objectives of clarity and precision without limiting the protection which must be conferred on the proprietor of the registered trade mark.

28 — In the judgment in *Libertel*, the Court considered that the colour orange, although it is a simple property of things, was nevertheless capable, in relation to a product or service, of constituting a sign (paragraph 27). That precedent was confirmed by the Court in the judgment in Case C-49/02 *Heidelberger Bauchemie* [2004] ECR I-6129, paragraph 23, concerning a combination of colours.

29 — See Case C-283/01 *Shield Mark* [2003] ECR I-14313, concerning the registration of 14 sound marks, 11 of which consisted of the first notes of the musical composition 'Für Elise' by L. van Beethoven and the other 3, of a 'cockcrow'.

30 — *Ansul*, paragraphs 41 to 43.

31 — Emphasis added.

76. For example, an application for registration must satisfy those requirements where the applicant seeks protection for 'Bougies d'éclairage' ('lighting candles'). That expression should be able to cover dining candles, church candles or similar articles having the same essential characteristics as the basic product, that is to say, made up of a wick and wax. In this example, it is, on the other hand, necessary to specify the function for which the product is intended, so that the competent authorities and economic operators may distinguish 'bougies d'éclairage' from the 'bougies d'allumage' ('spark plugs') used in the motor industry.

77. That interpretation is in line with the Court's judgment in *Praktiker Bau- und Heimwerkermärkte*, relating to the registration of a trade mark in the area of retail trade services. In that case, the Court required the applicant to specify the goods or types of goods to which those services relate by referring specifically to the 'retail trade in *building, home improvement, gardening* [32] and other consumer goods *for the do-it-yourself sector* [33]'. For the Court, that degree of precision made it easier to evaluate the identity or similarity of the goods or services for which a trade mark was requested or already registered without those details appreciably limiting the protection afforded to the trade mark. [34]

78. In any event, the clarity and precision required must be assessed on a case-by-case basis, according to the goods or services for which the applicant seeks protection, whether it is a national or a Community trade mark.

79. In the light of all these considerations, I therefore consider that the Directive and the Regulation are to be interpreted as meaning that the identification of the goods or services for which the applicant seeks protection must satisfy the requirements of sufficient clarity and precision to enable the competent authorities and economic operators to determine accurately the scope of the protection conferred by the trade mark.

80. Those requirements may be satisfied by a specific list of each of the goods and services for which the applicant seeks protection. They may also be fulfilled by identification of the basic goods or services enabling the competent authorities and economic operators to determine the essential characteristics and objective properties of the goods and services concerned.

C – *The use of the class headings of the Nice Classification*

81. By its second question, the national court asks the Court of Justice whether the Directive precludes the applicant from referring to the general indications of the class headings of the Nice Classification in order to identify the goods or services for which he seeks protection.

82. As I have pointed out, the Nice Classification is a practical instrument and the class headings, in themselves, have no inherent value. Nevertheless, nothing precludes the applicant from identifying those goods or services by using the general indications of those class headings. For that reason, that identification must satisfy the requirements of clarity and precision required. However, the assessment must be made on a case-by-case basis.

83. It must be conceded that some of those general indications are, in themselves, sufficiently clear and precise to enable the competent authorities and economic operators to determine the scope of the protection conferred by the trade mark. Such is the case, for example, of the indications 'soaps' or 'cutlery' taken from class headings 3 and 8 respectively of the Nice Classification.

84. On the other hand, other general indications do not meet those requirements and only indicate in a general manner the fields to which the goods or services in principle belong. [35] The general indications in, for example, Classes 37 ('Building construction; repair; installation services') and 45 ('personal and social services rendered by others to meet the needs of individuals') of the Nice Classification are much too general and cover goods and services which are much too varied to be

32 — Emphasis added.

33 — Idem.

34 — *Praktiker Bau- und Heimwerkermärkte*, paragraphs 50 and 51.

35 — See Point 1 of the Guidance for the User of the Nice Classification.

compatible with the function of the trade mark, which is to serve as an indication of origin. Without further details, they do not enable the competent authorities to fulfil their obligations in relation to the prior examination of registration applications or economic operators, to find out, with clarity and precision, about registrations or applications for registration made by their current or potential competitors. That is why the Court, in the judgment in *Praktiker Bau- und Heimwerkermärkte*, required the applicant to specify the goods or types of goods to which the services related by means of particulars not included in the class headings.

85. In the light of these considerations, I therefore consider that the Directive and the Regulation are to be interpreted as not precluding an applicant from identifying the goods or services for which he seeks protection by using the general indications of the class headings of the Nice Classification, provided that that identification satisfies the necessary requirements of clarity and precision.

D – *The interpretation adopted by the President of OHIM in Communication No 4/03.*

86. It is stated in the second paragraph of point III of Communication No 4/03 that '[OHIM] does not object to the use of any of the general indications and class headings as being too vague or indefinite'. Moreover, Point IV of that communication states that the use of all the general indications listed in the class heading of a particular class constitutes for OHIM *a claim to all the goods or services falling within this particular class*.[36] Similarly, the use of a particular general indication found in the class heading will embrace *all of the goods or services falling under that general indication*[37] and properly classified in the same class.

87. By its third question, the national court asks, in essence, whether the Directive precludes an interpretation such as that used by the President of OHIM in Communication No 4/03.

88. That communication was adopted by OHIM in connection with its tasks under the Community trade mark legislation. It is not a legislative text and has no binding legal value. It is an internal organisational document intended, according to Point I of the communication, to explain and clarify the administrative practice of OHIM. Communication No 4/03 thus seeks to afford legal certainty to interested parties by establishing a clear and predictable framework regarding the manner in which it interprets the expressions used in registration applications. That communication is therefore informative and explanatory. However, there is a fine line between providing explanations and creating actual rules of law. The Court must therefore make sure that that document does indeed guarantee respect for the rules laid down in the Regulation, as also interpreted by the Court, and for the rights conferred on the interested parties.

89. In the present case, I think that this is not so.

90. First, the interpretation adopted by Communication No 4/03 contradicts the principles laid down in the Regulation.

91. Rule 2(2) of the Implementing Regulation requires that '[t]he list of goods and services[be] worded in such a way as to indicate clearly the nature of the goods and services and to allow each item to be classified in only one class of the Nice Classification'. I would make two observations. Firstly, it is difficult to satisfy that requirement if OHIM does not object, as indicated by the second paragraph of Point III of Communication No 4/03, to the use of any of the general indications and class headings as being *too vague or indefinite*.[38] Secondly, it is necessary to refer to the explanatory notes relating to the Nice Classification which show that certain goods and services may, in the absence of any explanation, come under several classes.

36 — Emphasis added.

37 — Idem.

38 — Emphasis added.

92. Second, the interpretation adopted by OHIM, described by academic lawyers as a '"class-heading-covers-all" approach',[39] does not guarantee observance of the speciality principle since it does not make it possible to determine with accuracy the substantive scope of the protection conferred by the trade mark.

93. That interpretation is tantamount to affording the applicant almost unlimited exclusive rights over the goods and services in a class. For example, where an applicant refers only to the general indications of the heading of Class 45 of the Nice Classification and, consequently, requests registration of a trade mark for 'personal and social services rendered by others to meet the needs of individuals', the registration of that trade mark may grant him the exclusive use of a sign for extremely varied services, which cover not only 'dating services' and 'horoscope casting' but also 'detective agencies' and 'crematorium services'.[40] In other words, countless services which do not have, *a priori*, any common characteristics. In that situation, the scope of the protection conferred by the trade mark is indeterminable, almost invisible, to the detriment of the principles of the free movement of goods and the freedom to provide services. However, under the speciality principle, a trade mark is never protected in the absolute.

94. Third, such an interpretation does not ensure genuine use of the trade mark within the meaning of Article 10 of the Directive and Article 15 of the Regulation. Indeed, the proprietor of the trade mark will not necessarily use the sign in relation to all the goods and services for which he has sought protection. As Advocate General Léger stated in point 80 of his opinion in *Praktiker Bau- und Heimwerkermärkte*, to initiate proceedings for revocation of the rights of the proprietor is inappropriate where it is established at the outset that the mark will be used for certain goods or services only. Moreover, this system appears to contradict the objectives expressed in recital 9 in the preamble to the Directive and recital 10 in the preamble to the Regulation, under which the Union legislature requires that registered trade marks must actually be used, on pain of revocation. As Advocate General Ruiz-Jarabo Colomer rightly pointed out in point 42 of his opinion in *Ansul*, trade mark registers are not simply repositories for signs, but, on the contrary, they must faithfully reflect the reality and the indications used by undertakings in the market.

95. Consequently, although the interpretation adopted by OHIM appears, on the face of it, to facilitate the registration of trade marks in the public registers, it leads ultimately to an increase in the total number of trade marks registered and protected in the Union and, accordingly, in the number of conflicts which arise between them. Far from ensuring sound administration, it also does not guarantee undistorted competition in the market.

96. Fourth, that interpretation does not guarantee legal certainty. As pointed out *inter alia* by the United Kingdom, German, Irish and French Governments in their observations, the Nice Classification is an evolving instrument. The tenth edition of that classification, which will come into force on 1 January 2012, includes, under unchanged class headings, new goods and services.[41] Now, we cannot limit the substantive scope of the trade mark to a text which may be amended at the whim of an evolving market.

97. Consequently, and in the light of all these considerations, I consider that Communication No 4/03, by which the President of OHIM indicates that OHIM does not object to the use of any of the general indications and class headings as being too vague or indefinite and that the use of those indications constitutes a claim to all the goods or services falling within the class concerned, does not guarantee the clarity and precision required for the purposes of the registration of a trade mark, whether a national or a Community trade mark.

39 — See Ashmead, R., 'International Classification class headings: illustrative or exemplary? The scope of European Union registrations', *Journal of Intellectual Property Law & Practice*, 2007, vol. 2, No 2, p. 76.

40 — See, also, Class 37 of the Nice Classification, headed 'Building construction; repair; installation services', which covers the 'exterminating vermin', or Class 26 of that Classification, headed 'Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers', which includes 'false hair'.

41 — See, *inter alia*, Class 42 of the Nice Classification which, from 1 January 2012, will include eight additional services.

IV – Conclusion

98. In the light of the foregoing considerations, I propose that the Court of Justice reply as follows to the questions referred for a preliminary ruling by the Person Appointed by the Lord Chancellor under section 76 of the Trade Marks Act 1994, on Appeal from the Registrar of Trade Marks, submitted by the High Court of Justice of England and Wales:

(1) (a) 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 and Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark are to be interpreted as meaning that the identification of the goods or services for which the applicant seeks protection must satisfy requirements of clarity and precision which are sufficient to enable the competent authorities and the economic operators to determine accurately the scope of the protection conferred by the trade mark.

(b) Those requirements may be satisfied by a specific list of each of the goods and services for which the applicant seeks protection. They may also be fulfilled by identification of the basic goods or services enabling the competent authorities and economic operators to determine the essential characteristics and objective properties of the goods and services concerned.

(2) Directive 2008/95 and Regulation No 207/2009 are to be interpreted as not precluding the applicant from identifying the goods or services for which he seeks protection by using the general indications of the class headings of the common classification of goods and services for which a mark is registered, provided that that identification satisfies the necessary requirements of clarity and precision.

(3) 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, by which the President indicates that OHIM does not object to the use of any of the general indications and class headings as being too vague or indefinite and that the use of those indications constitutes a claim to all the goods or services falling within the class concerned, does not guarantee the clarity and precision required for the purposes of the registration of a trade mark, whether a national or a Community trade mark.