

Scope of protection of existing trade marks unaffected by *IP Translator*, says CJEU

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The European Court of Justice (CJEU) has confirmed that its 2012 landmark ruling in [IP Translator](#) does not have retrospective effect.

[The case](#) concerned an application by Ms Isabel Del Rio Rodríguez to register “CACTUS OF PEACE” and “CACTUS DE LA PAZ” as EU trade marks. Cactus SA opposed the application based on its earlier EU trade mark registrations for the word mark “CACTUS” (registered in 2002) and a figurative mark also incorporating the word “CACTUS” (registered in 2001). The opposition would only succeed if Ms Rodríguez’s application covered goods or services identical or confusingly similar to those covered by Cactus SA’s existing registrations. Assessing that depended on the proper interpretation of the CJEU’s ruling in *IP Translator*.

What was the ruling in *IP Translator*?

A trade mark registration covers the goods and/or services in one or more of the 45 classes found in the [Nice Classification](#). Each class lists the goods or services covered by that class and is prefaced by a general description of those goods/services, known as the ‘class heading’. 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, provided that the class heading is sufficiently precise for registration purposes. Indeed, Cactus SA had applied for its trade mark registrations citing only the class headings.

Prior to *IP Translator*, where only a class heading was used in an application, the EU Intellectual Property Office (or OHIM as it then was) deemed the resulting trade mark registration to cover all of the goods/services in that class. Subsequently, in *IP Translator*, 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 scope of protection provided by the mark. It held that a class heading could, in principle, be used for this purpose but an applicant was required to specify whether its application was, in fact, intended to cover all the goods/services included in that class or, if not, which goods/services were to be covered.

The decision in this case

Cactus SA had used only class headings in its application. Should its registrations, therefore, be interpreted in line with the pre *IP Translator* approach as covering all of the goods/services in those classes, or was Cactus SA bound by *IP Translator* and required to specify more precisely the goods/services covered? If the former, the scope of protection provided by Cactus SA's marks was likely to be broader, increasing the possibility of successfully opposing Ms Rodríguez's application.

The CJEU held that its ruling in *IP Translator* did not have retrospective effect. It did not affect the scope of protection of trade marks registered before the date of the judgment. Where they contained class heading, those marks would, in line with the practice which was in place at the time, cover all of the goods/services in those classes, without limitation to the alphabetical list. Accordingly, Cactus SA's trade marks, pre-dating as they did *IP Translator*, provided a broad scope of protection and covered all of the goods/services in the specified classes.

Comment

This ruling is not unexpected (and indeed backs up an earlier ruling to the same effect). However, it does appear to contradict the intention of the EU-legislator in Article 33(8) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (previously Article 28(8)). According to this provision, which was implemented in the recent overhaul of the EU trade mark regulation, owners of EU trade marks filed before *IP Translator* [were given six months](#) by the EU Intellectual Property Office to revise the specifications of goods and services for any marks using a class heading. Why would that be necessary if *IP Translator* had no impact on those marks?

The result of this ruling is that trade mark owners with national or EU trade marks predating *IP Translator* can rest assured that the scope of protection provided by their marks is still as broad as they have always believed it to be. This will strengthen their hand in future oppositions. Conversely, applicants for new national or EU trade marks will have little certainty over the scope of registrations predating *IP Translator* and using class headings. This will make it considerably more difficult for them to know if their application is likely to encounter opposition. Applicants must also ensure that they do not fall foul of the requirement that the goods/services to be covered by the marks are identified with sufficient clarity and precision. That requires careful drafting of the specification, with the benefit of professional advice, to ensure that the trade mark is wide enough to provide appropriate protection both now and if business expansion plans come to fruition, but not so wide as to increase the risk of the application being successfully opposed, or registration subsequently invalidated for non-use.

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