

Clear and precise definition of goods and services and implications in relative grounds proceedings

Consistency Circle Goods and Services

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1 Introduction

- 1 This report is a compilation of case-law from the Court of Justice (CJ), the General Court (GC) and the Boards of Appeal (the BoA), drawn up with the aim of identifying and analysing the relevant case-law and trends on the topic.
- 2 The purpose is to further support the work of the BoA with a view to maintaining and enhancing the **consistency** of decision-making practice with the case-law of the EU Courts and among the BoA. As such it contributes to improving the **predictability** of decisions and legal certainty in general. Through divulging relevant legal information, it also serves to increase **knowledge, awareness and transparency** among the various BoA stakeholders.
- 3 It is a working document that reflects existing case-law and the result of discussions within the Consistency Circles and the General Consistency Meeting of the BoA at the given date of the report. **It does not have any binding effect on the BoA.** It has been made available to the staff of the BoA and the public in general for information purposes only.
- 4 The application of the requirement of clarity and precision of the goods and services in restrictions and partial surrenders is the subject of a separate report on *Acceptability of restrictions of goods and services (substance)*.

2 Legal Framework

- 5 It is appropriate to analyse the case-law in light of the developing legislation, in particular, the changes brought about by Regulation (EU) 2015/2424⁽¹⁾ as of 23/03/2016 (legal reform).

2.1 EU law prior to the legal reform

- 6 '*A trade mark may consist of any sign ... capable of distinguishing the goods or services of one undertaking from those of other undertakings*'. This definition of a trade mark is a key element both in the legislation for the EUTM (Article 4 CTMR⁽²⁾, now Article 4 EUTMR) and for national marks within the European Union (Article 2 of Directive No 2008/95⁽³⁾, now Article 2 of Directive No 2015/2436⁽⁴⁾).

⁽¹⁾ Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs).

⁽²⁾ Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark prior to its amendment by Regulation (EU) 2015/2424.

⁽³⁾ 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.

⁽⁴⁾ Directive (EU) 2015/2436 of the European Parliament and of The Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks.

7 As a general principle of European trade mark law, the list of goods and services must be worded in the register with **sufficient clarity and precision** to enable the competent authorities, such as the Office, as well as economic operators (particularly competitors) to determine, on that basis alone, the extent of the protection sought (**POSTKANTOOR, PRAKTIKER, IP TRANSLATOR, POLLO and NETTO MARKEN DISCOUNT**⁽⁵⁾).

8 According to **Article 26(1)(c) CTMR**, ‘*An application for a Community trade mark shall contain ... a list of the goods or services in respect of which the registration is requested*’.

9 **Rule 2 CTMIR**⁽⁶⁾ provided:

- (1) *The common classification referred to in Article 1 of 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, shall be applied to the classification of the goods and services.*
- (2) *The list of goods and services 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.*
- (3) *The goods and services shall, in principle, be grouped according to the classes of the Nice classification, each group being preceded by the number of the class of that Classification to which that group of goods or services belongs and presented in the order of the classes under that Classification.*
- (4) *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.*

10 **Rule 9(3)(a) CTMIR** provided that ‘*Where, although a date of filing has been accorded, the examination reveals that the requirements of Rules 1, 2 and 3 or the other formal requirements governing applications laid down in the Regulation or in these Rules are not complied with, the Office shall invite the applicant to remedy the deficiencies noted within such period as it may specify*’. Further, according to **Rule 9(4) CTMIR**, ‘*If the deficiencies referred to in paragraph 3(a) are not remedied before the time limit expires, the Office shall reject the application*’.

11 According to **Article 43(1) CTMR**, ‘*The applicant may at any time ... restrict the list of goods or services...*’. Further, according to **Article 50(1) CTMR**, ‘*A Community trade mark may be surrendered in respect of some or all of the goods or services for which it is registered*’.

⁽⁵⁾ 12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 115; 07/07/2005, C-418/02, Praktiker, EU:C:2005:425, § 50; 19/06/2012, C-307/10, IP Translator, EU:C:2012:361, § 49; 08/05/2014, C-411/13 P, Representación de un pollo (fig.) / Representación de un pollo (fig.), EU:C:2014:315, § 48; 10/07/2014, C-420/13, Netto Marken Discount, EU:C:2014:2069, § 42.

⁽⁶⁾ Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark.

2.2 EU law after the legal reform

12 The principles established in case-law regarding the clarity and precision of the goods and services and the literal interpretation of goods and services have been codified during the legal reform.

2.2.1 Clarity and precision of the goods and services

13 **Recital 28 of the EUTMR's Preamble** states: '*EU trade mark protection is granted in relation to specific goods or services whose nature and number determine the extent of protection afforded to the trade mark proprietor. It is therefore essential to lay down rules for the designation and classification of goods and services in this Regulation and to ensure legal certainty and sound administration by requiring that the goods and services for which trade mark protection is sought are identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on the basis of the application alone, to determine the extent of the protection applied for. [...].*'

14 **Article 33(2) EUTMR** provides: '*The goods and services for which the protection of the trade mark is sought shall be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that sole basis, to determine the extent of the protection sought.*' Furthermore, Article 33(4) provides: '*The Office shall reject an application in respect of indications or terms which are unclear or imprecise, where the applicant does not suggest an acceptable wording within a period set by the Office to that effect.*'

15 **Article 193(2) EUTMR** provides, regarding international registrations: '*Where an international registration designating the EU is found to be ineligible for protection pursuant to Article 33(4) or Article 42(1) of this Regulation for all or any part of the goods and services for which it has been registered by the International Bureau, the Office shall issue an ex officio provisional notification of refusal to the International Bureau, in accordance with Article 5(1) and (2) of the Madrid Protocol.*'

2.2.2 Literal interpretation of the goods and services

16 **Recital 28 of the EUTMR's Preamble** states: '*[...] The use of general terms should be interpreted as only including all goods and services clearly covered by the literal meaning of the term. Proprietors of EU trade marks, which because of the practice of the Office prior to 22 June 2012 were registered in respect of the entire heading of a class of the system of classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, should be given the possibility to adapt their lists of goods and services in order to ensure that the content of the Register meets the requisite standard of clarity and precision in accordance with the case-law of the Court of Justice of the European Union.*'

17 Article 33 EUTMR provides:

'(5) The use of general terms, including the general indications of the class headings of the Nice Classification, shall be interpreted as including all the goods or services clearly covered by the literal meaning of the indication or term. The use of such terms or indications shall not be interpreted as comprising a claim to goods or services which cannot be so understood.'

[...]

'(8) Proprietors of EU trade marks applied for before 22 June 2012 which are registered in respect of the entire heading of a Nice class may declare that their intention on the date of filing had been to seek protection in respect of goods or services beyond those covered by the literal meaning of the heading of that class, provided that the goods or services so designated are included in the alphabetical list for that class in the edition of the Nice Classification in force at the date of filing.'

The declaration shall be filed at the Office by 24 September 2016, and shall indicate, in a clear, precise and specific manner, the goods and services, other than those clearly covered by the literal meaning of the indications of the class heading, originally covered by the proprietor's intention. The Office shall take appropriate measures to amend the Register accordingly. The possibility to make a declaration in accordance with the first subparagraph of this paragraph shall be without prejudice to the application of Article 18, Article 47(2), Article 58(1)(a), and Article 64(2).

EU trade marks for which no declaration is filed within the period referred to in the second subparagraph shall be deemed to extend, as from the expiry of that period, only to goods or services clearly covered by the literal meaning of the indications included in the heading of the relevant class.'

18 Article 33(8) EUTMR thus regulates a homogeneous application of the literal approach. The proprietors of EUTMs applied for before 22/06/2012 and registered in respect of an entire class heading were given the chance to specify what scope of protection was sought for their marks, extending the list by adding further items from the alphabetical list of the Nice Classification class to comply with the literal approach.

19 Article 33(8) EUTMR allowed holders of registered trade marks to include all those goods and services that were not covered by the literal meaning of the general indications of the relevant class heading in the scope of protection of their marks. The declaration basically ensured the observance of the intention of the trade mark holder at the time of filing.

2.3 Other instruments ⁽⁷⁾

20 [Communication No 3/01 of the President of the Office of 12 March 2001](#) concerning the registration of Community trade marks for retail services introduced a change in Office practice to accept 'retail services' in classification. While the Office considered that it was not legally necessary, it recommended that those services were limited to the field of activity. Nevertheless, the Office would not raise a classification objection if this was not done. That Communication was subsequently repealed by [Communication](#)

⁽⁷⁾ The 'other instruments' listed in this section never had any binding effect on the BoA.

No 7/05 of the President of the Office of 31 October 2005 concerning the registration of Community trade marks for retail services in order to implement the **PRAKTIKER**⁽⁸⁾ judgment.

- 21 **Communication No 4/03 of the President of the Office of 16 June 2003** concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations established the practice of accepting the use of Nice class headings in applications. This specification was deemed to cover all the goods or services in that class, even beyond the literal meaning of the general indications of the class heading.
- 22 That communication was repealed by **Communication No 2/12 of the President of the Office of 20 June 2012** concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations with effect from 21 June 2012. This essentially replaced the previous Office practice of interpreting class headings as covering all the goods and services in the relevant class by the new practice of affording only the literal meaning of general indications in EUTM applications filed from 21 June 2012. EUTMs registered before that date for the entire class heading are interpreted as covering the general indications of the class heading in their literal meaning and, in addition, the goods and services that were contained in the alphabetical list of the relevant class in the version of the Nice Classification in force at the time of filing.
- 23 **Communication No 1/13 of the President of the Office of 26 November 2013** concerning a new administrative tool for classification purposes (taxonomy) and the use of class headings of the Nice Classification stated that '*a general statement, by which the applicant declares its intention to cover all the goods or services included in the alphabetical list of this class, will not be accepted*'.
- 24 **Communication No 1/16 of the President of the Office of 8 February 2016** concerning the implementation of Article 28 EUTMR (currently Article 33 EUTMR) set out the detailed rules of processing the declarations submitted by EUTM proprietors within the 6-month transitional period prescribed in that provision to clarify the scope of protection of their marks.
- 25 The European Trade Mark and Design Network's **Common Communication on the CP 1 Common Practice on the acceptability of classification terms**, dated 20 February 2014, laid down the following guidelines to determine whether a given term is sufficiently clear and precise with the aim of harmonising European trade mark practice:
 - I. A description of goods and services is sufficiently clear and precise when its scope of protection can be understood from its natural and usual meaning.*
 - II. If this scope of protection cannot be understood, sufficient clarity and precision may be achieved by identifying factors such as characteristics, purpose and / or identifiable market sector. Elements that could help to identify the market sector may be, but are not limited to, the following*

⁽⁸⁾ 07/07/2005, C-418/02, Praktiker, EU:C:2005:425.

- *consumers and/or sales channels*
- *skills and know-how to be used/produced*
- *technical capabilities to be used/produced*

26 The European Trade Mark and Design Network's [**Common Communication on the CP 1 Common Practice on the general indications of the Nice class headings**](#), dated 20 November 2013, determined 11 general indications of the Nice class headings that were not considered sufficiently clear and precise for classification purposes. Six of them were removed from the class headings in the 2016 version of the 10th edition⁽⁹⁾, and one additional in the 12th edition of the Nice Classification. Accordingly, only four terms remain in the class headings that are not accepted for classification purposes.

Deleted from class headings	Still in class headings
Class 6 – Goods of common metal not included in other classes	Class 7 – machines
Class 14 – goods in precious metals or coated therewith, not included in other classes	Class 37 – repair
Class 16 – goods made from these materials [paper and cardboard]	Class 37 – installation services
Class 17 – goods made from these materials [rubber, gutta-percha, gum, asbestos and mica]	Class 40 – treatment of materials
Class 18 – goods made of these materials [leather and imitations of leather]	
Class 20 – goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics	
Class 45 – personal and social services rendered by others to meet the needs of individuals⁽¹⁰⁾	

27 The European Trade Mark and Design Network's [**Common Communication CP 2 on the Implementation of 'IP Translator'**](#) of 20 February 2014 provided an overview of the EUIPO's and national IP offices' interpretation of the Nice class headings in marks filed before and after IP TRANSLATOR.

⁽⁹⁾ Reflected in the 28 October 2015 update of the European Trade Mark and Design Network's [**Common Communication on the CP 1 Common Practice on the general indications of the Nice class headings**](#).

⁽¹⁰⁾ This general indication will be replaced by 'dating services, online social networking services; funeral services; babysitting' in the 12th edition of the Nice Classification that will enter into force on 01/01/2023.

- 28 The Common Communication of the European Union Intellectual Property Network on **CP 1 Common Practice** on the acceptability of classification terms and the general indications of the Nice class headings (March 2022) merged and updated the previous two CP 1 Common Practices on (i) the acceptability of classification terms and (ii) the general indications of the Nice class headings.
- 29 The Common Communication of the European Union Intellectual Property Network on **CP 2 Common Practice** on the interpretation of the scope of protection of Nice class headings (March 2022) updated the previous CP 2 Common Practice. The new version takes into account the important legislative development that, since 25 September 2016 (expiry of the transitional period pursuant to Article 33(8) EUTMR), the general indications of class headings in **all** EUTMs, whether filed before or after **IP TRANSLATOR**, must be interpreted in the literal sense. It also takes into account any national legislative development brought about by the implementation of Article 39(5) of the new Trade Mark Directive (Directive No 2015/2436).
- 30 Finally, the **Office's Guidelines** deal with the topic of clarity and precision in the list of goods and services in Part B, Examination, Section 3, Classification, Chapter 4, Building a List of Goods and Services, Subchapter 4.3, Terms lacking clarity and precision, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 2, Comparison of Goods and Services, paragraph 1.5.2.2 Unclear and imprecise terms, and Part C, Opposition, Section 7, Proof of Use, paragraph 6.3.4.1.

3 Case-law Analysis

3.1 The concept of 'clear and precise' and the principle of legal certainty

- 31 The description of the goods and services defines the scope of protection of trade marks and constitutes the starting point for all core proceedings before the Office⁽¹¹⁾. Rule 2(2) CTMIR already provided that '*The list of goods and services 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*'.
- 32 In **PRAKTIKER**⁽¹²⁾, a preliminary ruling that concerned the conditions for registering a trade mark for services provided in connection with the retail trade in goods, even though the requirement of clarity and precision was not expressly mentioned, the CJ found that specifying the goods subject to the retail service would facilitate the application of the relative grounds for refusal and the assessment of genuine use in the context of a revocation on the ground of non-use (§ 51).
- 33 In **IP TRANSLATOR**⁽¹³⁾, a preliminary ruling that concerned the question of whether a mark sought to be registered for all the general indications of a Nice class heading could

⁽¹¹⁾ 09/07/2015, R 863/2011-G, Malta Cross International Foundation (fig.) / Maltese cross (fig.), § 54.

⁽¹²⁾ 07/07/2005, C-418/02, Praktiker, EU:C:2005:425.

⁽¹³⁾ 19/06/2012, C-307/10, IP Translator, EU:C:2012:361.

be held to be descriptive of goods or services not covered by the literal meaning of any of those general indications (¹⁴), the CJ found that:

- (49) *'...the goods and services for which the protection of the trade mark is sought must 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'.*
- (61) *'...the class headings of the Nice Classification can be used to identify the goods and services for which the protection of the trade mark is sought, provided that they are sufficiently clear and precise, and provided that the applicant specifies whether its application for registration is intended to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services. If the application concerns only some of those goods or services, the applicant must specify which of the goods or services in that class are intended to be covered'.*
- (62) *'...an application for registration which does not make it possible to establish whether, by using a particular class heading of the Nice Classification, the applicant intends to cover all or only some of the goods in that class cannot be considered sufficiently clear and precise'.*

- 34 The CJ indicated that the existence, in parallel, of two approaches, namely (i) 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 that particular class, and (ii) the literal approach, which seeks to give the terms used in those indications their natural and usual meaning, was liable to affect the smooth functioning of the system for the registration of trade marks in the EU. The CJ indicated that a situation that does not take into account the actual intention of the applicant runs the risk of undermining **legal certainty** both for the applicant as well as the competitors (§ 58-60).
- 35 **IP TRANSLATOR** dealt with a national trade mark **application**, and, hence, did not address the issue of trade marks that had already been registered for unclear goods and services or class headings. To address that problem, the legislator allowed a 6-month transitional period, in accordance with the procedure laid down in Article 33(8) EUTMR, to specify any goods and services in a class that were not covered by the literal meaning of a general indication of the relevant class heading. As a consequence, after 24 September 2016, EUTM proprietors can no longer rely on any goods or services not clearly covered by the literal meaning of a general indication of a class heading. However, they can still limit or partially surrender their trade marks to specify their scope of protection.
- 36 According to the Court, the need to guarantee legal certainty is a fundamental reason for the requirement of clarity and precision of the specification of goods and services and the literal interpretation of the scope of the list of goods and services.

(¹⁴) Specifically, whether the mark, sought to be registered for 'education; providing of training; entertainment; sporting and cultural activities' in Class 41, could be considered to be descriptive in relation to 'translation services' not covered by the literal meaning of any of the general indications listed, albeit contained in the alphabetical list of that class.

- 37 For instance, in **AXICORP ALLIANCE**⁽¹⁵⁾, the GC referred to the principle of legal certainty in the context of the literal interpretation of the specification of goods.
- 38 In **MONTURA**⁽¹⁶⁾, the BoA stated that the mechanism set by Article 33(8) EUTMR (namely, the 6-month transitional period) ensured legal certainty in the transition from the comprehensive to the literal approach of interpreting the scope of the list of goods and services.
- 39 To conclude, it follows from the case-law that the **clarity and precision** of the terms in the list of goods and services is a fundamental requirement to **ensure the observance of the principle of legal certainty** concerning the extent of protection afforded to a trade mark.

3.2 Temporal scope of application of IP TRANSLATOR and PRAKTIKER

- 40 The authority derived from **PRAKTIKER** and **IP TRANSLATOR** regarding the clarity and precision of the list of goods and services and the literal interpretation of general terms used in the list of goods and services raised the question of the temporal scope of application of these judgments.
- 41 In **LAMBRETTA**⁽¹⁷⁾, the CJ clarified that the literal interpretation of general indications of class headings did not apply to trade marks registered before the **IP TRANSLATOR** judgment (19 June 2012). The CJ reiterated this in **CACTUS**⁽¹⁸⁾ and in **SKY**⁽¹⁹⁾.
- 42 In consequence of these judgments, trade marks registered before 19 June 2012 for all the general indications of a class heading would be deemed to be protected for all the goods or services included in that class⁽²⁰⁾. However, these judgments are no longer relevant for determining the scope of protection of **EU trade marks** registered for class headings before **IP TRANSLATOR**. Pursuant to Article 33(8) EUTMR, last paragraph, introduced during the last legislative reform of the EUTMR, if no declaration clarifying their scope of protection was submitted within the prescribed 6-month transitional period, then the protection of those marks would only be deemed to extend (after the expiry of that transitional period on 24 September 2016) to those goods or services covered by the literal meaning of the general indications of the relevant class heading. As to the interpretation of the scope of protection of **national marks** registered for class headings, see the [CP 2 Common Practice](#) of the European Union Intellectual Property Network on the Interpretation of Scope of Protection of Nice Class Headings.
- 43 Concerning the temporal scope of application of the **PRAKTIKER** judgment, the CJ clarified in **CACTUS** that the requirement laid down in that judgment to specify the subject of retail services did not apply to trade marks registered before that judgment

⁽¹⁵⁾ 17/10/2019, T-279/18, AXICORP ALLIANCE / ALLIANCE et al., EU:T:2019:752, § 44-45, 47.

⁽¹⁶⁾ 04/12/2018, R 678/2018-2, Montura, § 30.

⁽¹⁷⁾ 16/02/2017, C-577/14 P, LAMBRETTA, EU:C:2017:122, § 29-31.

⁽¹⁸⁾ 11/10/2017, C-501/15 P, CACTUS OF PEACE CACTUS DE LA PAZ (fig.) / CACTUS, EU:C:2017:750, § 38-43, 48.

⁽¹⁹⁾ 29/01/2020, C-371/18, SKY, EU:C:2020:45, § 61.

⁽²⁰⁾ Beyond the goods or services falling within the literal meaning of those general indications and even beyond the goods or services contained in the alphabetical list of the relevant class.

(7 July 2005) (§ 44-48). The CJ reiterated this in **BURLINGTON**⁽²¹⁾. Furthermore, the GC clarified in **ALTISPORT**⁽²²⁾, by reference to **CACTUS**, that the requirement laid down in **PRAKTIKER** also applied to EU trade marks filed before, but registered after, the date of that judgment and not just to new applications filed after the judgment.

44 The GC also clarified in **ALTISPORT** that the requirement arising from **PRAKTIKER** applied equally to **IRs designating the EU**. A different interpretation would be tantamount to conferring wider protection to IRs than that offered to EUTMs (§ 40-41). Concerning the temporal scope of application of **PRAKTIKER** in relation to IRs designating the EU, the GC clarified that the requirement arising from the judgment applied to IRs in respect of which 'registration was effected' after the judgment, even if the 'date of filing of the application for registration' of those trade marks predated the judgment and even if the protection conferred by the registration was retroactive to the date of the application⁽²³⁾ (§ 42-44).

3.3 Implications of an unclear and imprecise specification of goods and services

3.3.1 Right holders should not gain from an unclear or imprecise specification of goods and services

45 According to established case-law, the right holder should not gain from an unclear or imprecise specification of the goods and services. The GC first applied this principle in **GREEN BY MISSAKO**⁽²⁴⁾ (concerning 'retail services in shops' in Class 35, without any further specification, of an earlier national mark) and, subsequently, the CJ in **CLUB GOURMET**⁽²⁵⁾ (concerning an unclear description of services in Class 35 of an earlier national mark that read '*An advertising phrase. It will be applied to the products covered by the trade marks.*'). In **NANA FINK**⁽²⁶⁾ (concerning 'goods of leather and imitations of leather, and goods made of these (included in Class 18)'), the GC stated that '*the proprietor of the trade mark should not gain from the infringement of its obligation to draw up the list of goods with clarity and precision. 'The wording concerned cannot, in any event, be interpreted in such a way as including, for the benefit of the applicant, actual 'imitations of leather' also*'.

46 This principle was subsequently reiterated by the GC in **CAMELE'ON**⁽²⁷⁾, concerning the terms 'parts' and 'accessories or fittings' in Class 9 of the earlier marks, in **NUUNA**⁽²⁸⁾, regarding the general indication 'materials for artists' in Class 16, in **AXICORP ALLIANCE**⁽²⁹⁾, concerning the earlier marks' specification 'pharmaceutical preparations but not including infants' and invalids' foods and chemical preparations for

⁽²¹⁾ 04/03/2020, C-155/18 P, C-156/18 P, C-157/18 P & C-158/18 P, **BURLINGTON / BURLINGTON ARCADE** et al., EU:C:2020:151, § 132-133.

⁽²²⁾ 29/01/2020, T-697/18, **ALTISPORT** (fig.) / ALDI et al., EU:T:2020:14, § 30, 38-39.

⁽²³⁾ The 'date of filing of the application for registration' normally being the date of international registration, while the date of 'effecting the registration' is the date of acceptance of the IR for protection in the designated country.

⁽²⁴⁾ 11/11/2009, T-162/08, **Green by missako**, EU:T:2009:432, § 31.

⁽²⁵⁾ 06/02/2014, C-301/13 P, **Club Gourmet**, EU:C:2014:235, § 67.

⁽²⁶⁾ 06/04/2017, T-39/16, **NANA FINK** (fig.) / **NANA**, EU:T:2017:263, § 48.

⁽²⁷⁾ 27/09/2018, T-472/17, **Camele' on** (fig.) / **CHAMELEON**, EU:T:2018:613, § 29.

⁽²⁸⁾ 18/10/2018, T-533/17, **nuuna** (fig.) / **NANU** et al., EU:T:2018:698, § 58-62.

⁽²⁹⁾ 17/10/2019, T-279/18, **AXICORP ALLIANCE / ALLIANCE** et al., EU:T:2019:752, § 60.

pharmaceutical purposes' in Class 5 and in **BERGSTEIGER**⁽³⁰⁾, concerning the term 'means of transport' in Class 12.

47 Furthermore, in **MALTA CROSS**⁽³¹⁾, the Grand Board stated that the mere fact that the Office did not object to the wording of the specification did not exempt the applicant from the consequences of an unclear and imprecise specification of the goods and services. *'It is the applicant's final responsibility to comply with these requisites. An ambiguous, vague and broad specification cannot be interpreted in a way favourable to the applicant'* (§ 55).

48 To conclude, case-law establishes that **unclear and imprecise terms in a trade mark application or registration should not be interpreted in favour of the right holder** who must draw up the list of goods and services with sufficient clarity and precision in order to enable the competent authorities and economic operators, on the basis of the application or registration alone, to determine the extent of the trade mark protection.

3.3.2 Attributing a meaning to an unclear and imprecise term

49 According to the case-law, the decision-taking bodies first attempt to attribute a meaning to a term that is unclear and imprecise, or where doubts arise in that respect. The purpose is to attribute a 'workable' meaning to the term, so that any further assessment can be based on a term that is not (no longer) unclear or imprecise.

50 The principle that the proprietor of the trade mark should not gain from the infringement of its obligation to draw up the list of goods with clarity and precision means that unclear and imprecise terms in the list of goods and services of an earlier mark should be interpreted narrowly, as held by the GC in **NANA FINK**⁽³²⁾ and in **CAMELE'ON**⁽³³⁾.

51 In **EMBERTON**⁽³⁴⁾, the earlier mark covered '*retail and wholesale services including retail and wholesale of floor covering materials and accessories and building products.*' The BoA found that the terms *retail and wholesale services* as such must be considered vague and **the scope of protection conferred by these terms must be interpreted to the detriment of the right holder, hence interpreted narrowly**. The Board concluded that the examples listed (floor covering materials and accessories and building products) must, therefore, be interpreted as the only goods the retail services and wholesale services relate to (§ 20). This solution reflects a narrow interpretation of the list of goods and services, against the general principle that items listed after 'including', 'in particular' and similar expressions must normally be considered as mere examples that do not restrict the term preceding those expressions.

52 In **SCANDIC BAR**⁽³⁵⁾, the BoA endorsed the position taken by the Opposition Division that interpreted the services '*retail services such as retailing of printed matter, sanitary articles, razors, clothing, toys, foodstuffs, bags, umbrellas and alarm clocks*' of the earlier

⁽³⁰⁾ 28/11/2019, T-736/18, Bergsteiger / BERG (fig.) et al., EU:T:2019:826, § 79-80.

⁽³¹⁾ 09/07/2015, R 863/2011-G, Malta Cross International Foundation (fig.) / Maltese cross (fig.).

⁽³²⁾ 06/04/2017, T-39/16, NANA FINK (fig.) / NANA, EU:T:2017:263, § 48.

⁽³³⁾ 27/09/2018, T-472/17, Camele'on (fig.) / CHAMELEON, EU:T:2018:613, § 29.

⁽³⁴⁾ 15/11/2019, R 1100/2019-5, Emberton / Embelton.

⁽³⁵⁾ 03/05/2022, R 2135/2021-1, Scandic bar / SCANDIC et al.

EUTM narrowly, restricted to the retail services for the groups of goods expressly indicated only. The Board held that given that the wording 'such as' suggested that the goods listed were only examples of the goods in relation to which the retail services were provided, it did not meet the clarity and precision requirement. Therefore, the specification of the opponent's services was interpreted in its most natural and literal sense – designating the retail services for the goods explicitly indicated (§ 23).

53 In **HOLUX**⁽³⁶⁾, the GC dealt with the clarity and precision of the term '*metal goods, especially metal doors and windows*' in Class 6 covered by the earlier mark (IR designating France). The applicant submitted that the term 'metal goods' was too vague for the purposes of comparison. However, the GC found that, although the term 'metal goods' was capable of including a large number of goods, this term in the earlier mark's registration was specified to a certain extent by the wording 'especially metal doors and windows'. Referring to the Court's findings in **B**⁽³⁷⁾, the GC concluded that, **if a vague term was followed by another term which expressly identified the goods or services by way of example, it was then possible to carry out a comparison with that specific term**, as the specification of goods in Class 6 showed the intention on the part of the proprietor of the earlier mark to seek protection in respect of 'metal doors and windows'. That specification was sufficiently clear and precise to enable the BoA to carry out a comparison of the goods in question.

54 In **GO!**⁽³⁸⁾, the BoA took the absence of semicolons into account when interpreting the services '*business mediation in purchasing and sales, import and export, and wholesaling and retailing, in relation to foodstuffs for animals and bedding for animals, clothing, footwear, headgear, saddles, whips and saddlery, horseshoes, care preparations for horses and ponies*' in Class 35. The BoA held that the list of services could not be interpreted as claiming 'business mediation', 'wholesaling and retailing' and 'import and export' per se without a restriction to any specific goods (§ 32). It was, therefore, possible to interpret the specification so that it did not lack the required clarity and precision. The BoA also considered that any ambiguity must go to the detriment of those who caused it, the EUTM applicant in this case (§ 33). Therefore, the expression 'business mediation in purchasing and sales, import and export' was limited to the goods that were mentioned afterwards, and the contested application did not cover 'business mediation' per se (§ 34).

55 In **NANA FINK**⁽³⁹⁾, the GC held that the earlier mark's specification '*goods made of leather and imitations of leather, and goods made of these materials (included in Class 18)*' could be interpreted in two different ways: (1) covering 'goods made of leather and imitations of leather' as end products only, or (2) both 'goods made of leather and imitations of leather' and 'imitations of leather' as non-finished products. The description of the goods was, therefore, ambiguous. The GC concluded that the proprietor should not gain from the infringement of its obligation to draw up the list of goods with clarity and precision. The wording concerned could not be interpreted as including, for the benefit of the proprietor, 'imitations of leather' too.

⁽³⁶⁾ 08/06/2022, T-738/20, Holux / Holux et al., EU:T:2022:343, § 33-38.

⁽³⁷⁾ 25/06/2020, T-114/19, B (fig.) / b (fig.), EU:T:2020:286, § 52.

⁽³⁸⁾ 18/06/2020, R 1035/2019-4, GO! (fig.) / GO Outdoors (fig.) et al.

⁽³⁹⁾ 06/04/2017, T-39/16, NANA FINK (fig.) / NANA, EU:T:2017:263, § 46-49.

56 In **AXICORP ALLIANCE**⁽⁴⁰⁾, the GC found that if two possible literal interpretations of the mark's specification exist, but one of them would lead to an absurd result regarding the extent of its protection, the BoA must resolve the difficulty by opting for the **most plausible and predictable interpretation of that specification** (§ 51). If both possible literal interpretations of the list of goods and services designated by an earlier EU trade mark are equally plausible and predictable, then the principle derived from **NANA FINK** (namely, that the proprietor of an EU trade mark should not gain from the infringement of its obligation to indicate the goods and services with clarity and precision) should be applied to determine the extent of protection of that mark (§ 60).

57 To conclude, decision-taking bodies first attempt to attribute a meaning to a term that is unclear and imprecise so that the further assessment of the case can be based on a term that is not (no longer) unclear and imprecise. In particular, the court and the BoA case-law establishes the principle that unclear and imprecise terms in a trade mark application or registration should not be interpreted in favour of the right holder. Regarding **earlier** marks, this implies that unclear and imprecise terms should be **interpreted narrowly**. Should the attempt to attribute a 'workable' meaning to an otherwise unclear and imprecise term fail, then the question of how to deal with an unclear and imprecise term in the further assessment of the case arises. The following sections address this issue.

3.3.3 Unclear and imprecise terms in a registered mark

58 In the case of an unclear and imprecise term contained in a registered mark⁽⁴¹⁾, there are limited possibilities to remedy the situation, precisely because it is a registered right. The following subsections provide an overview of the possible solutions applied in case-law to deal with this situation.

3.3.3.1 *No ground for cancellation*

59 It is not possible to solve the problem of having an unclear and imprecise term in a registered mark by requesting the cancellation of the mark in relation to that term.

60 In **SKY**⁽⁴²⁾, the CJ ruled that an EUTM or a national trade mark **cannot be declared wholly or partially invalid on the ground that terms used to designate the goods and services in respect of which that trade mark was registered lacked clarity and precision**. In other words, a lack of clarity and precision of the goods and services **cannot be considered a ground for invalidity**. Article 7(1) EUTMR and Article 59 EUTMR must be interpreted as meaning that they provide an exhaustive list of the absolute grounds for invalidity of an EUTM (§ 56-60).

61 The CJ also examined whether the lack of clarity and precision would fall within the scope of one of the **available absolute grounds** for invalidity (§ 62). Regarding the requirement of graphic representability [Article 7(1)(a) EUTMR], the CJ stated that it only

⁽⁴⁰⁾ 17/10/2019, T-279/18, AXICORP ALLIANCE / ALLIANCE et al., EU:T:2019:752.

⁽⁴¹⁾ EU, national and international registrations accepted for protection in the EU or in Member States, either in the role of an earlier mark or, in cancellation, even a contested mark.

⁽⁴²⁾ 29/01/2020, C-371/18, SKY, EU:C:2020:45.

applies when identifying the **signs** of which a trade mark may consist and the requirement of clarity and precision of the **goods and services** cannot be inferred from it (§ 64). The CJ also noted that the concept of 'public policy' within the meaning of Article 7(1)(f) EUTMR cannot be construed as relating to characteristics concerning the trade mark application itself, such as the clarity and precision of the goods and services (§ 66). In conclusion, it held that a mark **cannot be declared wholly or partially invalid on the ground that the terms used to designate the goods and services in respect of which that trade mark was registered lack clarity and precision** (§ 71).

3.3.3.2 *Goods and services cannot be compared*

62 In **GREEN BY MISSAKO**⁽⁴³⁾, the GC, referring to **PRAKTIKER**, held that the services in Class 35 covered by the mark applied for could not be compared with 'retail services in shops' covered by the earlier Spanish mark. Since no details had been provided as to the goods or types of goods to which the services covered by the earlier mark related, the GC found the BoA was correct in finding that the services covered by the earlier mark were too vague to enable a proper comparison with those of the mark applied for.

63 In **CLUB GOURMET**⁽⁴⁴⁾, the CJ confirmed the GC's conclusion that the description of the services designated by the earlier mark **did not enable a comparison with the goods designated by the mark applied for**. The goods for which registration was sought fell within Classes 16, 21, 29, 30, 32 and 33, whereas the earlier Spanish mark covered services in Class 35, namely '*An advertising phrase*', which would be applied to products covered by the indicated trade marks. The CJ upheld the GC's judgment in that, based on the wording of the description of the services designated by the earlier mark (and the submissions of the opponent during the procedure before the EUIPO), the **scope of protection of the earlier mark could not go beyond that strict wording and encompass goods or services other than those falling within Class 35**. The specific features of Spanish law, which would allegedly have helped clarify the meaning of the description of these services, could not be taken into account, in the absence of supporting evidence (§ 66-67). Accordingly, since the goods covered by the mark applied for belonged to classes other than those to which the earlier mark was limited, they **could not be regarded as similar or identical** and, thus, no likelihood of confusion could exist.

64 The BoA followed the approach that an unclear and imprecise term in an earlier mark cannot be compared with the contested goods or services, for instance, in **PARMI 1**⁽⁴⁵⁾, **WORKS**⁽⁴⁶⁾ and **LEONICA CONCERIA**⁽⁴⁷⁾.

3.3.3.3 *Specifying the term through proof of use*

65 In **SKY**, the CJ noted that the requirement of proof of use [under Article 58(1)(a) EUTMR] could in any event lead to a partial revocation of a mark covering unclear and imprecise

⁽⁴³⁾ 11/11/2009, T-162/08, Green by missako, EU:T:2009:432, § 31.

⁽⁴⁴⁾ 06/02/2014, C-301/13 P, Club Gourmet, EU:C:2014:235, § 67.

⁽⁴⁵⁾ 03/10/2018, R 2304/2017-1, PARMI1 (fig.) / PARA MI et al. § 20.

⁽⁴⁶⁾ 03/09/2019, R 101/2019-2, WORKS (fig.) / iWork (fig.), § 21.

⁽⁴⁷⁾ 03/01/2020, R 547/2019-2, LEONICA CONCERIA (fig.) / Leone et al., § 21.

terms and maintaining it on the register only for the specific goods and services for which genuine use had been shown (§ 68-70).

66 In **BURLINGTON**⁽⁴⁸⁾, the CJ held, in relation to '*the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from a range of general merchandise retail stores*' [referred to as '*shopping arcade services*' in the judgment and held to be included in the concept of '*retail services*' in Class 35 (§ 130)]:

134 '*... it cannot be inferred from the considerations in the judgment in Praktiker ... that, when a trade mark covering retail services, registered after that judgment's delivery, is relied on in support of the ground of opposition referred to in Article 8(1)(b) [EUTMR], that ground of opposition may be rejected from the outset, simply by invoking the absence of any precise statement of the goods to which the retail services covered by the earlier trade mark may relate.*'

135 '*To act in such a manner would mean that the earlier trade mark is precluded from being relied upon in opposition in order to prevent the registration of an identical or similar mark in respect of similar goods or services and, consequently, refuse to recognise it as having any distinctive character, even though that mark is still registered and it has not been declared invalid....*'

136 '*In addition, ... it is possible, by means of a request seeking proof of genuine use of the earlier trade mark, within the meaning of Article 42(2) of Regulation No 207/2009, to determine the precise goods covered by the services for which the earlier trade mark was used and, therefore, pursuant to the last sentence of that paragraph, to take into account, for the purposes of the examination of the opposition, only those goods.*'

67 The CJ concluded that the GC had erred in law when finding that '*the absence of any precise statement of the goods which may be sold in the various shops comprising a shopping arcade, such as the shopping arcade referred to by the earlier trade marks, precluded any association between those shops and the goods of the mark applied for*' (§ 137).

68 The **BURLINGTON** judgment can be construed as meaning that the principle according to which vague terms should not be interpreted in favour of the proprietor **cannot preclude their comparison**, thus establishing a considerable limitation to that principle. Nevertheless, in light of the CJ's statement in § 136, the judgment is hardly conclusive in relation to cases where the earlier mark is still within the grace period for non-use.

69 In **AGRI PARTS**⁽⁴⁹⁾, the BoA held that the specification '*portal for ordering spare parts*', in Class 38 in the earlier EUTM constituted a rather unclear and imprecise term, as it could encompass almost everything, including spare parts for tractors or other agricultural machines marketed by the applicant (§ 48). The BoA noted that the comparison of the goods and services had to be based on the wording indicated in the actual lists of goods and/or services and not on the factual or intended use of the

⁽⁴⁸⁾ 04/03/2020, C-155/18 P, C-156/18 P, C-157/18 P & C-158/18 P, BURLINGTON / BURLINGTON ARCADE et al., EU:C:2020:151.

⁽⁴⁹⁾ 11/06/2020, R 146/2020-1, AGRI PARTS (fig.) / Agroparts.

services concerned (§ 46). Thus, the term 'portal for ordering spare parts' could not be construed as relating to specific spare parts when such characteristics were not identified in the specification of the earlier mark (§ 51). The uncertainty was further reinforced by the fact that a 'portal' may exhibit various offerings (§ 53). These considerations were not taken into account by the Opposition Division, who seem to have overlooked the vagueness of the earlier EUTM's specification when comparing these services with the goods designated by the contested application. This error of methodology could have been avoided if the Opposition Division had **defined an appropriate subcategory of the services in question after a thorough examination of the proof of use** (§ 54). Therefore, the BoA concluded that the most sensible and equitable approach was to annul the contested decision and **remit** the case to the Opposition Division for further prosecution in accordance with Article 71(1) EUTMR (§ 55).

70 In **ALDIANO**⁽⁵⁰⁾, the GC annulled the BoA decision that found that '*it [was] impossible to prove "retail services in all product areas" as long as these product areas [were] not defined*'. It held that that possibility existed not only in relation to an earlier mark that was registered before **PRAKTIKER** (and as such, exempt from the requirement of specifying 'retail services', see point 3.2 above), but also to an earlier mark registered subsequent to that judgment which, nevertheless, omitted to comply with the requirement set down there. It further added, by reference to **BURLINGTON**, that proof of genuine use is one of the ways to determine the precise goods covered by the retail services for which those goods were registered in the case of both those marks.

3.3.3.4 Specifying the term through partial surrender

71 In **AVMALL**⁽⁵¹⁾, the BoA confirmed, pursuant to **PRAKTIKER**, that the terms '*the bringing together for the benefit of others of retail goods (excluding their transport) enabling consumers to conveniently view and purchase them*' and '*store chain*' covered by the earlier mark were not acceptable in the absence of a specification of the goods to which they related. Since the earlier Romanian trade mark was registered on 20 January 2009 (i.e. after **PRAKTIKER**) and since Romania was already an EU Member State at that time (since 1 January 2007), the list of services in Class 35 of the earlier mark had to comply with **PRAKTIKER**. In view of that, the BoA invited the proprietor of the earlier mark to specify those services through a partial surrender at the competent national registration authority. In response, the opponent partially surrendered its mark. The restricted list of services enabled the comparison with the contested goods, leading, ultimately, to a finding of **similarity**. However, the term '*store chain*' was still not clarified by the opponent in the partial surrender, which led the BoA to conclude that **a comparison** of that term with the contested goods **could not be made**.

⁽⁵⁰⁾ 05/10/2022, T-429/21, ALDIANO / ALDI et al., EU:T:2022:601, § 113.

⁽⁵¹⁾ 24/02/2022, R 1753/2020-2, AVmall (fig.) / avstore (fig.) et al., § 24-26.

3.3.3.5 *Similarity or identity found*

72 In **ONCE**⁽⁵²⁾, the BoA had to deal with the comparison between, essentially, '*services of retail sale in commercial establishments*' covered by an earlier national mark registered before **PRAKTIKER**, without any specification of the goods to which they related, and the contested '*retail services relating to watches*'. The BoA disagreed with the solution of the first instance decision finding these services dissimilar on the ground that the earlier mark, interpreted in its natural and literal meaning, remained abstract since it did not reveal what type of goods those services related to. First, referring to **BURLINGTON**⁽⁵³⁾ and **VROOM**⁽⁵⁴⁾, the BoA recalled that the validity of an earlier national trade mark may not be called into question in proceedings for registration of an EUTM and that, consequently, a registered mark cannot be precluded from the outset from being relied upon in an opposition simply by invoking the lack of clarity and precision of the goods or services it covers (§ 31, 37-38). Second, the BoA considered two possible solutions in view of the constraints implied by those case-law principles. According to **one solution**, on the premise that the proprietor was not legally obliged to specify the retail services in the earlier mark since it was registered before **PRAKTIKER**, the broad category of '*services of retail sale in commercial establishments*' could also relate to watches and, consequently, encompassed the contested '*retail services relating to watches*'. It follows that the services at issue are **identical** (§ 54-56, 74). According to the **alternative solution**, on the premise that it could not be determined to which particular goods the earlier retail services related, the services at issue are still similar to '**a certain to a low degree**' given that their nature and purpose coincided and they could be provided to the same public (§ 57-60, 75). The BoA considered a finding of a likelihood of confusion warranted in either case, also underlining the applicant's inactivity throughout the procedure, including the absence of a request for proof of use.

 3.3.3.6 *No relevant coincidence in similarity factors*

73 In **ALTISPORT**⁽⁵⁵⁾, the GC confirmed the BoA's conclusion that it was not possible to establish similarity between '*retailing in all product areas; operating supermarkets, retail outlets and discount retail outlets*' covered by the earlier international registration designating the EU (registered after **PRAKTIKER**), and the contested goods in Class 28, in the absence of a specification of the goods to which those retail services related.

74 In **JOSS**⁽⁵⁶⁾, the BoA confirmed that the term '*goods made of these materials at issue (included in Class 18) [leather and imitations of leather]*' only indicated the material from which the goods are made and covers a wide range of goods. Therefore, it failed to satisfy the clarity and precision requirement. The BoA indicated that **in the absence of further information concerning the purpose or use of the goods, no similarity** to the goods of the contested mark **could be established** on the basis of the term '*goods*

⁽⁵²⁾ 28/10/2022, R 1954/2021-5, ONCE / ONCE et al.

⁽⁵³⁾ 04/03/2020, C-155/18 P, C-156/18 P, C-157/18 P & C-158/18 P, BURLINGTON / BURLINGTON ARCADE et al., EU:C:2020:151, § 132-136.

⁽⁵⁴⁾ 24/02/2021, T-56/20, Vroom / Pop & Vroom, EU:T:2021:103, § 28-31.

⁽⁵⁵⁾ 29/01/2020, T-697/18, ALTISPORT (fig.) / ALDI et al., EU:T:2020:14, § 47.

⁽⁵⁶⁾ 07/09/2021, R 2495/2020-2, Joss / Boss, § 24-25.

made of these materials at issue (included in Class 18)'. In contrast, the term 'small leather goods' was found sufficiently clear.

3.3.4 Unclear and imprecise terms in the contested EUTM application / IR designating the EU

75 In the case of an unclear and imprecise term contained in an **EUTM application**, in principle, it is still possible to remedy the situation by reopening the classification examination or exploring the possibility of a voluntary restriction, precisely, because it is a pending application. In the case of an **IR designating the EU**, the 18-month refusal period during which a provisional refusal can be issued⁽⁵⁷⁾ practically excludes the BoA's ability to request the reopening of classification examination. Nevertheless, a limitation or a voluntary partial cancellation by the holder remains an option. There may also be other solutions to overcome the problem of an unclear and imprecise term in an EUTM application or an IR designating the EU, as seen below.

76 In **MALTA CROSS**⁽⁵⁸⁾, the Grand Board applied the clarity and precision criteria in respect of the contested mark, basing its reasoning on the rule that any vague and broad specification cannot be interpreted in favour of the applicant (§ 55). It found that the term '*charity, religious, educational and scientific services rendered by others to meet the needs of individuals*' designated in Class 45 of the mark applied for was too generic and did not precisely describe the services rendered. According to the European Trade Mark and Design Network's Common Communication of 20 February 2014 on the CP 1 Common Practice on the acceptability of classification terms, the general indication '*personal and social services rendered by others to meet the needs of individuals*' was not sufficiently clear and precise for classification purposes. Considering also the Explanatory Notes of the Nice Classification and the alphabetic list of Class 45, the vague term '*charity, religious, educational and scientific services rendered by others to meet the needs of individuals*' **included** 'organisation of religious meetings', 'organisation of charity meetings', 'organisation of meetings having the primary aim of a social gathering'. Those specific services covered by the broad wording of the contested application could be compared with the earlier mark's services. Regarding '*educational services rendered by others to meet the needs of individuals*', educational services were generally classified in Class 41, but it could be assumed that the broad wording of the services applied for in Class 45 **included** the organisation of meetings with the primary aim of gathering socially, with additional educational elements. Regarding '*scientific services rendered by others to meet the needs of individuals*', scientific services were generally classified in Class 42, but those services could be of a rather informational nature or including services that implemented the results of scientific services in social meetings (§ 62-76). Eventually, the contested services, interpreted in this way, were **found to be similar** to the services of the earlier mark, leading ultimately to their **refusal**.

77 In **MYPARFUMERIE PASSION FOR LIFE**⁽⁵⁹⁾, the BoA found that the services '*retailing and wholesaling, including via the internet, in the fields of cosmetics and perfumes*'

⁽⁵⁷⁾ Article 5 of the Madrid Protocol and Rule 17 of Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

⁽⁵⁸⁾ 09/07/2015, R 863/2011-G, Malta Cross + International + Foundation (fig.) / Malteserkreuz (fig.).

⁽⁵⁹⁾ 24/02/2022, R 1663/2021-5, MYPARFUMERIE PASSION FOR LIFE (fig.) / DEVICE OF A HUMMINGBIRD (fig.).

designated in the EUTM application in Class 35 were not sufficiently clear and precise. The BoA emphasised that the wording '**in the fields of** cosmetics and perfumes' allowed divergent interpretations, since it was not clear whether such retail and wholesale related to only 'cosmetics' and 'perfumes' per se, or other things in those fields (e.g. cosmetic utensils, and thus 'fitted vanity and toiletry cases' or 'make-up bags sold filled'). By allowing divergent interpretations, the wording chosen by the applicant for the list of wholesaled and retailed goods was ambiguous and did not meet the clarity and precision requirement. The applicant itself created the ambiguity, and should not gain from the infringement of its obligation to draw up a clear and precise specification of goods and services. The wording concerned could not, in any event, be interpreted in such a way as to include, for the benefit of the applicant, only 'cosmetics' and 'perfume'. It should be interpreted in the sense of all goods falling 'in the fields' thereof. Since the ambiguous wording of the contested wholesale and retail services implies that they can also relate to 'fitted vanity and toiletry cases' or 'make-up bags, sold filled' (i.e. fitted or filled with cosmetics including perfumes), these were compared with the earlier 'vanity cases, not fitted' and 'toiletry and make-up bags sold empty' and a **low degree of similarity was found**. As a consequence, the EUTM application was **rejected for these services** (§ 79-83, 130). In summary, the BoA was able to identify specific items within the broad category of the contested services that were found to be similar to the earlier goods, ultimately leading to a refusal of the contested application for the unclear and imprecise term.

78 In **STABIL** ⁽⁶⁰⁾, the BoA found that the terms 'medical articles' and 'veterinary articles' designated in Class 5 of the contested EUTM application lacked clarity and precision in view of the vagueness of the term 'articles'. The BoA referred to **MALTA CROSS** indicating that, ultimately, it was the applicant's responsibility to comply with this requirement. It also referred to **GREEN BY MISSAKO** and **CLUB GOURMET** stating that an ambiguous, vague and broad specification could not be interpreted in favour of the applicant. The BoA concluded that 'medical articles' in Class 5 contained, for example, medicated sweets or medicinal infusions, that were at least similar to the earlier 'dietetic substances for medical use'. The same approach was taken regarding 'veterinary articles'. Thus, the BoA was able to identify specific items within the broad category of the contested application that were found to be similar to the earlier goods, ultimately leading to a refusal of the application for the unclear and imprecise terms.

79 If the BoA finds that certain goods and services of a contested EUTM application in an opposition lack clarity and precision, it can, in principle, invite the applicant to specify the term in accordance with Article 33(2) ETUMR through a restriction, or eventually, remit the case to the first instance department with a recommendation to reopen classification examination. For example, in **MICROBNK**⁽⁶¹⁾, in relation to '*promoting the sale of goods and services of others by {specify means, e.g., awarding purchase points for credit card use, distributing coupons, conducting promotional contests, etc.}*' in Class 35, the BoA annulled the contested decision and remitted the case for further prosecution by the first instance, including an invitation to the applicant to clarify the specification.

80 To conclude, where the contested application contains a term that lacks clarity and precision, but an item can be identified within it that is clear and precise, ultimately leading to the refusal of that item, this also entails the refusal of the broad category of

⁽⁶⁰⁾ 15/09/2022, R 319/2022-5, STABIL / RISTABIL et al., § 95-107.

⁽⁶¹⁾ 12/01/2017, R 2568/2015-1, MicroBnk / MICROBANK (fig.) et al., § 40-41.

the unclear and imprecise term⁽⁶²⁾. This solution is only feasible if it leads to the eventual refusal of the unclear and imprecise term. Where no such item can be identified, the applicant may be requested to clarify the unclear and imprecise term through a restriction, or the application may be referred back to the first instance with a recommendation to re-examine classification.

3.4 Unfounded claims of ‘unclear and imprecise term’

81 It is becoming more and more common that parties refer to a lack of clarity and precision in the goods and services of earlier marks. Often, however, those claims are unfounded.

82 In **DORMILLO**⁽⁶³⁾, the IR holder unsuccessfully claimed that the opposing ‘mattresses’ in Class 20 were not sufficiently clear and precise (§ 25). In **ELUX**⁽⁶⁴⁾, the BoA found that, unlike in the case that gave rise to the **CHAMELEON** judgment⁽⁶⁵⁾ quoted by the applicant, the goods covered by the earlier mark in Class 7 namely *‘roller tracks (parts of machines) being battery change tables (tables for machines) with electric traction devices for drive batteries for floor conveyors’* were clear and precise, thus enabling a proper comparison of the goods in question (§ 58). In the same vein, in **HRG CRYSTAL**⁽⁶⁶⁾, the BoA found the term ‘data processing equipment’ in Class 9 (§ 26-27) to be clear and precise, and in **GESA INDUSTRY**⁽⁶⁷⁾, the term ‘electrical conductors and connections’ (§ 115-117). In **RICH**⁽⁶⁸⁾, the BoA dismissed the appellant’s claim that the term ‘non-alcoholic drinks’ in Class 32 of the earlier EUTM lacked clarity and precision. The BoA indicated that while this term covered more than one product, it was still considered to provide the clarity and precision required by the law. It unambiguously and immediately referred to a beverage to be consumed by humans and which did not contain alcohol (§ 25). In **TECHLIFE**⁽⁶⁹⁾, the terms ‘vehicles and conveyances; clutches for land vehicles’ in Class 12 of the earlier EUTM were also found sufficiently clear and precise (§ 22).

83 In **DEVICE OF A CIRCLE WITH TWO SHARP POINTS** ⁽⁷⁰⁾, the BoA dismissed the applicant’s argument that the category of goods ‘apparatus for recording, transmission or reproduction of sound or images’ in Class 9 covered by the earlier mark was unclear and imprecise. The BoA held that this category of goods could be compared with goods applied for that were encompassed in that broader category, finding them, therefore, identical. The same approach was taken by the BoA in **TRIX** ⁽⁷¹⁾, rejecting the applicant’s argument that part of the opponent’s goods in Class 9 and 28 consisted of general

⁽⁶²⁾ Applying the principle that the Office cannot *ex officio* dissect the broad specification of the contested application with the result that if only one item within that category is susceptible to refusal, the entire category has to be refused (07/09/2006, T-133/05, PAM-PIM’S BABY-PROP / PAM-PAM (fig.), EU:T:2006:247, § 29; 23/11/2011, T-483/10, Pukka, EU:T:2011:692, § 38).

⁽⁶³⁾ 26/06/2020, R 2846/2019-2, DORMILLO (fig.) / DORMILON El placer de dormir (fig.) et al.

⁽⁶⁴⁾ 04/08/2021, R 1974/2020-5, ELUX (fig.) / Elux.

⁽⁶⁵⁾ 26/03/2020, T-312/19, Chameleon / Chameleon, EU:T:2020:125.

⁽⁶⁶⁾ 24/02/2022, R 1213/2021-2, Hrg crystal / HRG.

⁽⁶⁷⁾ 09/03/2022, R 1128/2021-5, GESA INDUSTRY (fig.) / Gecsa et al.

⁽⁶⁸⁾ 11/03/2022, R 1350/2021-5, Rich / Rich secco rosé et al.

⁽⁶⁹⁾ 31/01/2022, R 1727/2021-4, TECHLIFE (fig.) / Life.

⁽⁷⁰⁾ 26/07/2022, R 246/2022-2, DEVICE OF A CIRCLE WITH TWO SHARP POINTS (fig.) / DEVICE OF A DROP (fig.), § 27-31.

⁽⁷¹⁾ 23/06/2022, R 415/2022-2, TRIX / TRIX, § 23-30.

indications of the Nice class heading and other unclear and unprecise terms on the basis of which a comparison of goods and services could not be made.

84 In Q⁽⁷²⁾, the cancellation applicant argued that terms such as 'catalogue and mail order' or 'the bringing together of a variety of goods' 'in the field of fashion, beauty, sports, leisure' were too vague and could not be taken into account for assessing genuine use of the mark. It requested a stay in the appeal proceedings for the wording of the contested EUTM to be clarified. The BoA rejected that request and referred to **PRAKTIKER** giving 'retail trade in building, home improvement, gardening and other consumer goods for the do-it-yourself sector' as an example. The BoA noted that **the use of commercial wording which refers to sufficiently specific product areas could satisfy the requirement for precision** (§ 28). Additionally, it held that such commercial wording was commonly used in trade to refer to sufficiently specific product areas, as it was also clear from the evidence (§ 29). Therefore, since the list of services in Class 35 indicated specific product areas covered by the EUTM proprietor's multichannel retail services, albeit using commercial wording, the services were described in a sufficiently clear and precise manner (§ 30).

4 Conclusions

85 The following conclusions can be drawn from the above case-law analysis in order to safeguard consistency in the BoA decision-making practice.

- (i) The clarity and precision of the specification of goods and services is a fundamental requirement to ensure the observance of the principle of legal certainty regarding the extent of protection afforded to the trade mark. Indeed, the description of the goods and services defines the scope of protection of trade marks and constitutes the starting point for examination in any proceedings before the Office.
- (ii) In the case of a mark containing an unclear and imprecise term, it must first be considered whether a meaning could be attributed to it, so that the further assessment of the case can be based on a term that is not (no longer) unclear and imprecise.
- (iii) Unclear and imprecise terms in a trade mark application or registration should **not be interpreted to the advantage of the right holder** as it is their obligation to draw up the list of goods and services with sufficient clarity and precision to enable the competent authorities and economic operators, on the basis of the application or registration alone, to determine the extent of the trade mark protection. The mere fact that the Office did not object to the wording of the specification does not exempt the right holder from the consequences of an unclear and imprecise specification of the goods and services.
- (iv) If the unclear and imprecise term is contained **in the contested application**, it may be possible to identify within it a specific item that is itself susceptible to refusal, and consequently, the entire broad category encompassing it. Otherwise,

⁽⁷²⁾ 12/12/2019, R 2024/2015-1, Q (fig.).

the applicant may be requested to clarify the term through a restriction or, eventually, the application may be referred back to the first instance with a recommendation to re-examine the classification pursuant to Article 33(2) and (4) and Article 41(4) EUTMR (Article 193(1), (2) and (6) EUTMR regarding international registrations designating the EU).

- (v) If the unclear and imprecise term is contained **in the earlier mark**, it should be **interpreted narrowly** (in its most natural and literal sense), in order to rule out, as much as possible, a conflict between the marks. An opposition or a request for a declaration of invalidity cannot be rejected from the outset simply by invoking the lack of clarity and precision of the goods or services covered by an earlier valid registration, and therefore, does not preclude a comparison of goods and services. This, however, does not prejudice as to the outcome of that comparison. If a term that lacks clarity and precision in the earlier mark does not sufficiently reveal, for that reason, the specific commercial nature and attributes of the goods or services covered, it may be justified to conclude that **no similarity** between the relevant goods and services can be found in the absence of any coincidence in the relevant similarity factors.
- (vi) If the earlier mark containing an unclear or imprecise term is **subject to proof of use** – either through the appropriate defence plea raised within the proceedings or in separate proceedings for revocation on the grounds of non-use – the precise scope of the goods and services may be determined through the evidence of use submitted. A clarification of the goods and services through proof of use has effect only in the particular proceedings. A clarification through revocation for non-use, as it is reflected in the Register, will also have effect in future cases.
- (vii) If an earlier mark, **not subject to proof of use**, covers an unclear and imprecise term and that term is relevant for the outcome of the case, the proprietor may be invited to specify it through a **partial surrender** at the competent registration authority. That invitation is in view of the right holder's initial obligation to identify the goods and services with sufficient clarity and precision pursuant to Article 33(2) EUTMR (in the case of national registrations and IRs designating Member States, Article 39(2) of Directive No 2015/2436), as well as the general principle that the parties are under a duty to cooperate during administrative proceedings.

Annex
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