



FULL TEXT

IP TRANSLATOR CHANGES THE RULES OF THE GAME

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Good Morning to everyone and to Ruta who gave me the chance to expose my French point view on the IP translator case that I will name IPT case during my speech.

Let me thank the ECTA, Peter Müller and the members of the bureau which made my intervention here possible and hope the Jury will still be out

I am now in front of a very prestigious audience filled with experts to evoke a British case with you through my European point of view and with a French touch.

My firm was only created in 1995 I am rather a practitioner close to the files and to the clients with an eye on the strategy than a speaker amongst the “microcosm” of conferential experts that I fully respect.

Nevertheless I always wanted to continuously extend my business Lawyer vision over my usual activities despite this present risky exercise.

This is indeed one big achievement as:

- first of all the interventions of French law firms are so quite rare , and I truly regret that there are so few of my colleagues on occasions like this;
- second of all, it is my first attempt in the context of professional events like ECTA , and probably my last as my aim here is to enlighten the French youngest and the bravest of us.

In the initial title the ECTA suggested: “Rules of the Game” but it has been slightly changed by me into “Rules of the games” as you will see on the slide.

That’s a clear illustration of the fact that there has always been different rules applied by the national offices and not only on a one single game within the European union as we are about to see it.

This poster will certainly look familiar to you given the hit the movie has been.

The attitude of the main character reflects the situation I will describe in my presentation on 3 levels:

1. it reflects my situation during my stay in my Tokyo hotel trying to fight against jet lag during my first two nights

But more seriously

2. it reflects the fact that the OHIM lost its way as of 2003 at least;
3. it reflects the way the national offices have been feeling uncomfortable about this communication during the 10 years after that.



I also wanted to support the CIPA for their slogan which totally reflects the IPT case.

They have indeed achieved their goal and perfectly fulfil their mission.

In the light of their portfolio they applied different strategies as you will notice it.

A strategy based on a global approach (class headings) to overcome the risk of non-distinctiveness if translation services were claimed by IP Translator and another strategy based on a more literal approach (along with additional specific items to describe the services themselves !) for CPA/PA to obtain the registration of non-distinctive signs.

How could we logically explain that at the same time signs with absolute lack of distinctiveness such as IP Translator and CPA/PA could be either registered or refused as their only difference is the drafting of their illogical specification?

Let me remind you of the steps that have led to the IPT case starting with a classical distinctiveness case ruled by a national office which brought the examiner to take a stand somewhat contradictory with his local practice.

As far as I know, the mirror effect of the OHIM 2003 communication has not been nationally, regularly or widely applied by the UK examiner nor by the French examiners.

Further to this decision, we attended an unresolved contradiction in the following order:

- the resurgence of the 2003 communication which by extension would prove that the trademark indeed lacked distinctiveness;
- a real contradiction between the claimed services and particularly the lack of any relation between these services and the translation services;

This absurd situation led to refer to the CJ for a preliminary ruling which for the most part tried to redefine the position of the OHIM without a full success as we will see later.

I'd like to put stress on the fact that the OHIM and the Commission became disengaged from the preliminary ruling, that the OHIM has apparently refrained to give its full and arguable reasons and has even claimed the confidentiality of their observations. That's quite surprising !

IN ONE WORD :A supposedly non detrimental ruling since it is beneficial as not prejudicial to the acceleration of the convergence

The IPT case is interesting on several levels as it generated at the same time:

- A rationalization of the criteria organized on 4 axes which duly reminded what an appropriate trademark should claim in its specification.

DETAILS OF THE 4 AXES WITH A FOCUS ON SIECKMAN CASE

The Sieckman case had actually provoked the same effect regarding the sign per se requesting a clear representation, precise, self-contained, easily accessible, intelligible sustainable and objective.

- The challenging of the administrative practice around 3 ideas.

EXPLAINS THE 3 IDEAS WITH A FOCUS ON THE COMPROMISE



In fact an attempt to make the national offices and the OHIM practices coexist through a compromise has placed the owner in front of a difficult choice in terms of responsibility when selecting the list of products and services.

It turns out that if this ruling has indeed opened doors for a better comprehension of the rules to be applied, it is still incomplete.

It has brought convergence around the rules instead of setting up a real harmonization and agreement on the only reasonable and the only smart rule: the literal approach.

IN ONE WORD : A debatable ruling since the qualitative necessity is still tied to the quantitative approach and so appears to be not enough completed and matured ruling .

After two communications raised by the OHIM, a regrettable one made in 2003 duly released and another one hastily made in 2012 under the pressure of managing the intermediate period, we can however notice that in less than 1 year, the OHIM and the national offices have been able to find a common solution.

As of 2013 the future trademark applications will be appreciated according to the literal approach even if a regrettable option remains enabling the applicant to claim "All list of goods and services" when selecting the class heading.

However this communication will not settle the fate of the trademarks which have been registered before IPT.

IPT Case has made the situation evolve from a controversial issue in 2003 towards a convergent approach in 2012 for landing on a harmonized communication in 2013 but certainly not a common view in term of approaches and scopes of protection yet.

At least let's wait until the end of the year for the establishing of a clear and precise class heading for each item named Class Heading Breakthrough which had not been defined by the CJ yet, knowing that this principle will be applied by the National offices in Europe on a voluntary basis. But what about the destiny of the isolated terms Wait and see !

Before IPT Case most of the countries were not following the OHIM and its 2003 communication... even the United Kingdom !

After IPT Case it seems that only Italy has adopted a neutral position

As a stress test in last April we have interrogated 2 law firms per each European country and you will note that there is a clear division between the professionals who have and those who have not changed their daily way of working and their strategy.

It has been a 50/50 sharing since the CJ decision came to their attention but we reasonably suppose obviously this flash situation has changed since April I hope .

IN ONE WORD : Are we faced on an indication or a presumption of a Lost in Translation syndrome ? Who knows



As of now, protecting a trademark should take into account 2 main criteria:

- a qualitative one : the right principle of literal approach .
- and a quantitative one : the unfortunate option of all alphabetical list

Strictly associated only to bring the isolated items back in the global scope of protection.

This un-matured and compromised solution is indeed issued from the unresolved situation of Isolated items until now / that do not fall within the natural and usual meaning of the general indication of class heading

IN ONE WORD : the principle of literal approach is still objectively dangerous for the possible lack of protection for the isolated items AND the subjective risk of lack of clarity and precision which do not reply to the isolated terms issue need to urgently define through to the subcategories of products and services or an another mean .

This table shows the overview effect of the interpretation of the Nice classification by a national office, here the French TM office and the OHIM.

You will notice that in most of the cases, there has been a mutual respect between the two offices as it comes to the interpretation of the French and Community trademarks after or before IPT case.

Mentioned in red, you will however see an exception for the Community trademarks which have been filed before the IPT case

In that case there has been a difference in the scope of protection granted by the two offices .

As for the opposition, France has always applied the literal approach before and after the IPT case, so nothing changed.

However, still in the field of opposition, the OHIM position regarding the 2003 communication has evolved before and after the IPT case and not only by adopting the literal approach as the principle .

Indeed its application of this Communication by the OHMI had the tendency to be even partial before the IPT and by the book after IPT, which is quite ironic!

Here is the proof by examples that the OHIM did not believe themselves in their own communication 2003 that I highly suggest to collapse in its content asap and not only to formerly release!!.

This table shows the difficulties experienced in the handling of opposition matters including Community trademarks and caused by the appreciation of their scope of protection.

The scope of protection of the same CTM actually evolves and differs depending on crossed and mixed criteria :

1. the date of filing of the CTM trademark
2. before or after IPT case ,
3. and/or the date the office has issued its decision



In other words claiming the all alphabetical list unfortunately maintained as a possible “easy” option will increase :

1. difficulties related to the comparison between two list of CTMS;
2. and the costs charged by the agents as their professional responsibility will grow.

As for the filing applications, if the rule to be commonly applied by the offices and the OHIM is now the literal approach, we generally recommend opting for a double cumulative protection including the specific items and the products and services from the class headings,/ bearing in mind that both should be drafted clearly and precisely.

In the same time if the Community TMS is protected under the concept of the all list of products and services, we will face mainly two issues:

1. when we will have to extend such TMS outside the European Union as the specification will not be automatically adapted to the local practices of foreign countries.
2. When such TMS also who will serve as base for International applications, they will without any doubt cause objections from the designated countries and this will also incur additional costs.

IN ONE WORD we urgently expect the OHMI to provide us with their list of the isolated terms to put this option render harmless.

As for the renewal applications, there will be two-tier trademarks unless the owners of trademarks filed before IPT case are going to be obliged to specify their intention in the 4-month period if this becomes an official request as read in the Commission proposals .

As for this request by the way,/ we hope this will become compulsory also for trademarks filed after IPT when the applicant has chosen the famous “ ticky box” if the rule of All list of goods and services is going to be withdrawn Unfortunately not yet .

As for the conversion of Community trademarks into national trademarks, there will also be a difference of treatment as no same scope of protection will be retained for each country .

As for the researches, we are supposed to be extra cautious for the Community trademarks filed before IPT and which would be cited or detected as risky for our client’s project.

We will also have to be careful about the CTM filed after IPT case / when the applicant would have chosen the option of All list of Goods and services.

IN ONE WORD watch out when the clients intends to file CTM AND at least if one of its goods of interest is an isolated item .

As for the actions for forfeiture of trademarks, there is a really need to think about the sole class heading or the alphabetical list uphill from the initial decision for the filing.

Nevertheless it should be resolved by the convergent program and the taxonomy to have not only clear and precise categories of products and services in the class BUT also of the products and services in the different subcategories.

IN ONE WORD there is a necessary balance to find for replying to a possible contradiction between the strategy at the date of the filing and the date when the same TM is submitted to the use requirement.



The IPT case is a clear progress in the necessary harmonization between the national offices and the OHIM / but is certainly just a first step.

The second step would be to establish a legal federation for creating a strong trademark on the Community level around 3 criteria:

an administrative one with the literal interpretation as main and sole option only

,
a legal one on the basis of precision and clarity as being in process to be finalized for each product and service

and an economic one to give a valuation to the brand / TM.

The first 2 criteria are on their way But the last of these criteria has been partially left aside by leaving the unfortunate option of whole alphabetical list.

Shouldn't we evolve towards a North American administrative approach which has demonstrated its effectiveness when it comes to strategy over specifications?

This process coming from the USA is certainly attractive but I'm not talking about the prosecuting and litigating part of the US proceedings for which I give less enthusiastic reception.

This is a plausible option especially as our colleagues consider the IPT case as a progress in this way.

There is a real convergence in the appreciation of these American agents.

I let you read more particularly the sentences in bold letters .

Why let Mr David Cameron conclude, will you ask me?

At least for 2 reasons:

1 Because this is a British case for a start, with unpredictable effects on the European IP scene and led to the conclusion that if the national scene should not be detrimental to the progress of Europe, the other way around is especially true.

2 Second of all, because I realized that, what's at stake here on a European level has been formerly and repeatedly demanded by the national offices without concrete success until the CJ decision .

If you forget the British context of his speech, substitute the mention of Europe by OHIM and Commission and add an IP approach of the content you will understand the message delivered within the IP Translator Context .

If not doesn't matter!

GO to start with the video