

## CITMA response to SkyKick consultation: Case C-371/18

- 1. Can an EU trade mark or a national trade mark registered in a Member State be declared wholly or partially invalid on the ground that some or all of the terms in the specification of goods and services are lacking in sufficient clarity and precision to enable the competent authorities and third parties to determine on the basis of those terms alone the extent of the protection conferred by the trade mark?**

CITMA believes that the answer to this question should be no. If a specification of goods or services is deemed to be lacking sufficient clarity and precision, this should properly be dealt with during examination. In cases where the specification of goods or services of a registered trade mark may be deemed to lack sufficient clarity and precision, this should be addressed at the point in time when this is identified and the registered proprietor invited to amend the specification to wording which is sufficiently clear and precise, provided the amended wording cannot be seen to extend the scope of protection beyond what would reasonably be understood to have been protected by the natural and usual meaning of the original wording. To wholly or partially invalidate a registered right due to a specification being deemed unclear or imprecise would likely have an disproportionately negative impact on unrepresented proprietors.

In the context of the facts relevant to this referral, it is the view of CITMA that the breadth of protection afforded by a term, e.g. 'computer software', does not detract from it having a very clear and precise meaning.

- 2. If the answer to question (1) is yes, is a term such as 'computer software' too general and covers goods which are too variable to be compatible with the trade mark's function as an indication of origin for that term to be sufficiently clear and precise to enable the competent authorities and third parties to determine on the basis of that term alone the extent of the protection conferred by the trade mark?**

Despite the response to the first question as no, and that a term such as 'computer software' is sufficiently clear and precise, CITMA believes that in some cases very broad terms should require further definition to allow for easy application of Articles 4(1), 5(1) and 12(1) of Directive (EU) 2015/2436. This corresponds with the principles set out in *Praktiker* Case C-418/02, paragraph 51, in relation to retail services. In view of the significant technological developments in the field of computer software, resulting in the considerable expansion of goods which would be deemed to fall into this category, a requirement to specify the types of products more narrowly is desirable. This position is considered to be broadly aligned with the conclusions of the IPO in the report "Cluttering and Non-Use of Trade Marks in Europe" published on 24 August 2015.

- 3. Can it constitute bad faith simply to apply to register a trade mark without any intention to use it in relation to the specified goods or services?**

CITMA believes that the answer to this question should be yes, where national law requires an intention to use. While the EUTMR, EUTMDR and/or EUTMIR do not impose a requirement of intention to use on an applicant of an EUTM, CITMA would welcome further clarity on the extent to which the principles established in *Lindt* Case C-529/07 on bad faith apply.

However, in so far as an applicant has applied to register a specification term which may be deemed unduly broad, CITMA believes that this should not constitute bad faith as long as there was a genuine intention to use the trade mark in relation to any of the goods or services which fall within the category applied for. Instead, the applicant should be invited to amend the specification as set out in the response to question 1.

- 4. If the answer to question (3) is yes, is it possible to conclude that the applicant made the application partly in good faith and partly in bad faith if and to the extent that the applicant had**

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### **an intention to use the trade mark in relation to some of the specified good or services, but no intention to use the trade mark in relation to other specified goods or services?**

CITMA believes that it may be possible to conclude that the application was made partially in bad faith. However, this should only be in cases where the specification clearly distinguishes two or more different categories of goods/services and there is clear evidence that the proprietor did not have an intention to use in relation to one or more of those clearly defined categories (e.g. due to a contractual obligation which prevents the applicant from such use).

As set out in relation to questions 1 and 3, where a term is merely considered to be too broad this should not constitute bad faith and the applicant should be invited to amend the specification as set out in the response to question 1.

### **5. Is section 32(3) of the UK Trade Marks Act 1994 compatible with Parliament and Council Directive 2015/2436/EU and its predecessors?**

CITMA believes that the requirement to make a statement of use or bona fide intent to use is compatible with the Directive.