

Timothy Rose

Convenient Pigeon Holes?

The Classification of Trade Marks in Historical Perspective

Bournemouth University 2005

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Prof. Martin Kretschmer (mkretsch@bournemouth.ac.uk);

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About the Author

Timothy Rose graduated from the University of Leeds in 2002 with a LLB Honours degree in Law, and from Bournemouth University with a LLM in "Intellectual Property Management" (2004). He is currently embarking on a career as a trade mark attorney with the UK based firm Barker Brettell.

Abstract

The Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks was signed on 15 June 1957. It sets out the procedural requirements for the Nice Classification, a system limited in its substantive requirements towards harmonisation. This has directly resulted in differences in its scope and meaning, within the context of national registrations, between States party to, or making use of, the Agreement.

The history of classification of trade marks places the origins and gradual conceptualisation of classification alongside the development of substantive trade mark law. The legal analysis on the Nice Agreement, together with the case studies of Mexico, Turkey, Japan, Canada and the UK highlights the differences in its interpretation by economically disparate countries. It is argued that the intended function of trade mark classification has become lost in the translation of the Nice Agreement into diverse legal systems.

“But when all has been said, it is not easy in any human activity to lay down a rule so well grounded on reasoned argument that Fortune fails to maintain her rights over it.”¹

Michel De Montaigne (1533-1592)

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¹ De Montaigne M, *The Complete Essays*, translated by Screech MA, 1991, London: The Penguin Press

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Introduction

The classification of trade marks can be considered as a dichotomy that cuts to the very heart of the process and meaning behind the registration of trade marks. This situation has arisen because of the two contrasting views on the classification system that has been adopted on a global scale. This is the Nice Classification, as set out in the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, 1957. One point of view considers this classification system to be a purely procedural guideline in the registration process but, in contrast, it could be deemed as being wholly substantive in its effect. The Nice Agreement itself does not constitute substantive law and does not issue its contracting states with more than one specific obligation². It is in the interpretation of the Nice Agreement into substantive national trade mark law that clear waters have been muddied.

A rational discussion of these two approaches to the classification of trade marks must take the form of a cause and effect argument. A State's interpretation of the Nice Classification into national law has a direct effect on the registration process. This type of cause and effect is better demonstrated in a table, where the cause is the perceived function of the Nice Classification at national level and the effect is its legal status within the trade mark registration procedures of the State.

	Function	Legal Status
1	Classification is a procedural requirement only and should not determine substantive issues in the registration process.	The indexing and searching of applications and registrations is facilitated on a national and international level.
2	Classification has the same rationale as substantive trade mark law: At a national level classification and the law developed together and at an international level the objective is one of harmonisation.	The choice of classes in an application for registration and in the registration itself determines, or contributes to, the scope of protection afforded to the trade mark, and the class specification and boundaries are perceived as black letter law.

² Article 2(3) of the Nice Agreement requires members of the Special Union to include the classes of the goods or services concerned in all official documents and publications relating to the registration of the relevant marks.

There is a third alternative which sits between these two positions on classification. This third position is grounded in dilution theory, which was first championed by Schechter in 1927³.

Schechter convincingly argued that the law of trade mark protection should not solely be concerned with the designation of origin of goods and services:

To describe a trademark merely as a symbol of good will, without recognizing in it an agency for the actual creation and perpetuation of good will, ignores the most potent aspect of the nature of a trademark and that phase most in need of protection.⁴

He went on to state that, because of this adherence to trade marks having only one function at law, in cases of infringement brought on grounds of confusion and/or association, the classification of goods and service marks was being interpreted too literally:

Under the ‘source or origin’ theory of a function of a trademark, and the vague doctrine of ‘related goods’, courts are still giving a most literal and rigid reconstruction to the phrases ‘of the same class’ or ‘of the same descriptive qualities’...An equally apparent failure of the courts to keep pace with the necessities of trade and the functional development of trademarks...is the rule that a trademark is only coextensive with its use and may be used by different firms in different localities.⁵

Earlier to this Schechter had drawn on the Supreme Court’s⁶ backing of the doctrine that the same trademark could be used on different classes of goods which was said to be akin to the principle that “there is no property in a trade-mark apart from the business or trade in connection with which it is employed”⁷.

Based on these observations Schechter thought it necessary to advocate for well-known or distinguished marks to be given broader protection, i.e. those marks into which a lot more time and investment had been placed other than to warrant a mere

³ Schechter FI, “The Rational Basis of Trademark Protection”, (1927) 40 *Harv LR* 813

⁴ *op. cit.* at 818

⁵ *op. cit.* at 824

⁶ *American Steel Foundries v. Robertson* 269 US 372, 380 (1926)

⁷ Schechter FI, “The Rational Basis of Trademark Protection”, (1927) 40 *Harv LR* 813 at 822

distinguishing of origin of the goods or service rendered, so that the classification divides should not be strictly adhered to.

Commencing with the assumption that a trademark designates either origin or ownership...the law, even at its most liberal interpretation at the present time, will prevent the misuse of that mark only where there is an actual confusion created by such misuse, resulting in either a diversion of trade or other concrete financial liability or injury to trade repute. However, we have intimated the possibility that the use of trademarks on entirely non-related goods may of itself concretely injure the owner of the mark...⁸

As well as being grounded in sound legal judgement, Schechter's conclusion is basically common sense. Why should a business that has spent possibly millions on advertising have to put up with another firm, which may not even be a rival and operating in another marketplace, from "free-riding" on the goodwill that has cost it so much money to establish?

The fact that Schechter tackled the issue of dilution in 1927 does not mean that the issues he raised are out of date or have been resolved. In discussing the EC Trade Marks Directive (Council Directive 89/104/EEC) Dr. Bornkamm stated:

The gist of traditional unfair competition for famous and well-known marks in those Member States, which have been familiar with such a concept, has always been that it was available, even if the infringing sign was used for non-similar goods and services. In the wording of the Directive, however, it is a condition for this kind of protection that the goods or services are *not* similar. This would mean that under the Directive well-known marks did not enjoy this special protection against dilution and encroachment of their distinctive character or repute if the sign was used for similar goods and services.⁹

Dr. Bornkamm went on to discuss how such a problem could be rectified but the point is that dilution theory is still a potent issue. It was Directive 89/104/EEC that was translated into the United Kingdom's substantive law as the Trade Marks Act 1994.

⁸ op. cit. at 825

⁹ Bornkamm J, "Harmonising Trade Mark Law in Europe", The Stephen Stewart Memorial Lecture (March 4, 1999), [1999] *IPQ* 283 at pp. 293-294

The third position of classification therefore does not go as far as promoting the class specifications and boundaries into black letter law having a substantive effect on the scope of protection for trade marks. However, this alternative position, by the very nature of the “special” protection afforded to famous or well-known trade marks, is not nearer to the first position of classification as merely an administrative aid.

	Function	Legal Status
1	Classification is a procedural requirement only and should not determine substantive issues in the registration process.	The indexing and searching of applications and registrations is facilitated on a national and international level.
2	Classification boundaries determine the amount of similarity between trade marks, with regard to the goods and services to which they are applied, in cases of potential confusion (as in position 2 in the previous table).	Well-known trade marks are given protection from identical or similar marks in different classes as well as those in the same class.
3	Classification has the same rationale as substantive trade mark law: At a national level classification and the law developed together and at an international level the objective is one of harmonisation.	The choice of classes in an application for registration, and in the registration itself, <i>determines in all cases</i> the scope of protection afforded to the trade mark, and the class specification and boundaries are perceived as black letter law.

These different approaches to the classification of trade marks, having different legal effects on the registration process, in turn effect the various players in the market place.

A large and diversifying multi-national company, perhaps involved in promoting life-style brands across many classes, would certainly prefer the second approach due to the protection it would gain from smaller firm free-riders, which become more of a threat the more well-known the trade mark becomes and the larger the company’s marketing area is, both geographically and economically. However, the first approach would definitely be favoured by existing trade mark owners, who would be frightened of the scope of protection on their mark being limited by the introduction of either of the other two positions. This is Canada’s stance on the matter and is the

reason why it has not opted to sign up to the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks, 1989, and implement the Nice Agreement. Conversely, the third approach would perhaps only be favoured by newcomers to a market who would require absolute certainty with regard to the scope of protection of their own mark and those of their competitors. It is very often the cost of litigation that keeps the big players in and the small, new entrants into a market out.

This is hypothetically sound but in reality there is no set use of classification across the board by countries party to the Nice Agreement or simply just utilising the Nice Classification, not to mention countries that do not accept any form of classification system. This is due to the procedural nature of the Nice Agreement. The best approach is to start at an extreme and assess the relevant facts and opinions regarding the different approaches to the classification of trade marks in relation to such a fixed point. The simplest and most straightforward place to start at is that put forward by the first position of classification as an administrative convenience.

Is Classification Just About Pigeonholing?

In the recent case of *Altecnic Ltd.'s Trade Mark Application*¹⁰ Laddie J stated an interesting opinion, obiter dicta, in reasoning towards his conclusion. Namely that the primary function of classification was one of administrative convenience, with classes representing

convenient, but loosely defined, pigeon holes into which applications can be put.¹¹

This essay attempts to explain how such a legal opinion has come about, why it is important, and whether or not it should be accepted or criticised.

¹⁰ [2001] EWCA Civ 1928; [2002] RPC 34

¹¹ [2002] RPC 34 at para. 21

The Modern View of a Trade Mark as Intellectual Property

Before a rational discussion of classification with regard to trade marks can begin it is necessary to distinguish trade marks from the other forms of intellectual property which also have their own classification systems with specific rationales.

The most obvious way in which a trade mark right differs from a patent, copyright or design right is that it is not specifically limited in its duration. As long as the mark has been obtained in the correct way and is maintained as it should be, with renewal fees and avoidance of revocation by interested third parties, then the mark will remain valid. This initial overview is very brief but the most important aspect of modern trade marks to appreciate is that a trade mark gives its owner exclusive rights which enables the mark to be used to differentiate a product from other goods or services in the market place¹². However the owner of such a registered mark does not then have an exclusive monopoly on the word, or words, of which the mark consists:

The word is not taken out of the language. The only right is to prevent the use, in trade, of an identical or similar sign as a trade mark.¹³

This fact is evidenced in the Trade Marks Act 1994 (TMA 1994) at s.10 which deals with infringement of registered marks where it is stated that a registered trade mark is infringed if a third party uses “in the course of trade” an identical or similar mark. Section 11 TMA 1994 also underlines the principle that the word or words making up the trade mark are not removed from the language upon registration, as there are limits as to the legal effect of registration which s.11 TMA 1994 sets out.

This modern day view of trade mark law is important in the context of the history of classification, which is in fact closely associated with the understanding of the word “monopoly”, which has changed in its legal significance throughout the history of the classification of trade marks. Indeed Annand & Norman go on to state that

¹² s.1(1) Trade Marks Act 1994, hereafter referred to as TMA 1994

¹³ Annand R & Norman H, *Blackstone's Guide to the Trade Marks Act 1994*, 1994, at p. 9

Because of the nature of the trade mark right, the arguments which may justify patents and copyright are of little relevance. The rationale of trade mark law lies in the economics of consumer society. Judicial failure to perceive the difference between trade marks and other forms of intellectual property has led to a lack of understanding of trade marks.¹⁴

The fact that trade mark law is governed more by economics than by legal necessity is demonstrated by two aspects of trade marks. Firstly, at law a trade mark can theoretically exist forever but in reality they never do as eventually they can be, and arguably must be, declared invalid via a revocation action, possibly due to a simple lack of use¹⁵. If no individual economic phenomenon exists from conception to eternity then neither can its denoting trade mark. Of course *Coca-Cola* may yet prove this assumption wrong, but even if we are still all drinking it in the year 3000, the trade mark may not be recognisable in the form it is in at present. This underlies the second point, which is that a trade mark has a function. In fact there are four functions as outlined by Frank Schechter in 1927¹⁶:

- (a) to signify that all goods or services bearing the trade mark come from a single source (the indication of origin function)
- (b) to identify one seller's goods or services and distinguish them from goods or services sold by others (the product differentiation function)
- (c) to signify that all goods or services bearing the trade mark are of an equal level of quality, thus guaranteeing consumer satisfaction with the product (the guarantee function)
- (d) to promote the goods or services (the advertising function).¹⁷

Not all of these functions are utilised or recognised in trade marks coming under the critical eye of the law. For example, the advertising function has never been recognised at law in the UK, or even in the EU jurisdiction, however it still cannot be ignored as an essential economic function of a trade mark.

A trade mark is governed by the economics of the market place, as well as by legal input via statute and the common law, which is arguably swayed by public opinion moved by economic necessity. This is also true of patents, design and copyright,

¹⁴ op. cit. at p. 9

¹⁵ s.46(1) TMA 1994

¹⁶ Schechter FI, "The Rational Basis of Trade Mark Protection", (1927) 40 *Harv LR* 813

¹⁷ Annand R & Norman H, *Blackstone's Guide to the Trade Marks Act 1994*, 1994, at p. 14

however, trade marks are more the property of their commercial concern. A trade mark cannot exist as a patent does. A patent can be owned by anyone who has successfully attained one for a novel invention, and paid the registration and renewal fees, and it lasts for twenty years. A trade mark however is both meaningless and subject to revocation if it is not “attached” to a tangible good or service on offer in the market place¹⁸:

...because of the function of a trade mark and its vulnerability to revocation, the trade mark has to relate in some way to the business activity of its owner.¹⁹

It is classification that directly evidences this relationship between the mark and the “goodwill” of the business venture concerned.

¹⁸ s.46(1)(a) & (b) TMA 1994

¹⁹ Annand R & Norman H, *Blackstone's Guide to the Trade Marks Act 1994*, 1994, at pp. 10 & 11

Methodology

This essay is a critical appraisal of the legal phenomenon that is the classification of trade marks on an international level and how this is interpreted into substantive trade mark law from a national perspective. The emphasis is therefore on an interpretivist approach because the law, whether procedural or substantive, is a socially constructed entity and in itself is rarely objective, based as it is on the concerns on the day of its conception, whether that be by the legislature or a judge in a court of law. However, many of the conclusions drawn from such an interpretivist outlook are done so with hindsight; the history of trade mark classification is necessary to understand the present perspective of classification in the correct context. This being the case, it could be argued that a certain amount of objectivism has been employed in reasoning towards the conclusions of this essay. For a conclusion to have any meaning the premises must have at least some kind of objectivity. Such an objective stance takes the form of a history of trade mark classification, including the provisions set out in the relevant Treaties and Agreements, which, for the sake of argument and legal rationale in general, must be seen as a definitive statement of the rationales in question. This means that there is also a positivist aspect to the conclusions drawn.

The research for what follows has been based on secondary information, although to balance out the bias involved in such an approach, more than one case study has been employed to put across the present issues concerning trade mark classification. The countries of Mexico, Turkey, Japan, Canada and the United Kingdom have all been considered using the secondary sources available, but with the intent of demonstrating the primary importance of their positions regarding classification at the time of writing.

The chapter on “A History of Classification” is an important starting place in an interpretivist discussion on the classification of trade marks. This is because it provides an objective, or positivist, reference point for the conclusions on how trade mark classification fits with international, and national law, concerning trade marks in general, and more specifically their registration. Without an understanding of how

classification might have developed within the confines of the law one cannot appreciate how the two concepts, one procedural and the other substantive, fit together to produce a holistic view of trade marks and their use from a legal perspective.

Studying classification history posed a problem as to obtaining the necessary information. Despite extensive research in the area of the classification of trade marks it became apparent that nobody to the author's knowledge and powers of resource had written specifically on the subject, if at all. Indeed, only one person had extensively tackled, in a holistic sense, the history of trade marks in general. This person was Frank Schechter and he completed his seminal work in 1925²⁰. Arguably, Schechter did such a good job of determining the somewhat obscure history of this particular branch of law that no one has since reattempted what he achieved. In fact, almost every piece of work that touches on the history of trade marks since has prominently referenced Schechter. It is for this reason that the chapter of this work on the history of classification has relied so heavily on Schechter's work, despite the fact that Schechter does not focus on, or even specifically mention in his book, classification, as understood in this essay. Not only is *The Historical Foundations of the Law Relating to Trade-Marks* a well written and concise work of secondary information from which a history of classification can be worked out, but no where else can there be found in one place the sheer volume and quality of relevant primary, and other secondary, sources upon which the first part of this essay has heavily relied for authority.

The following chapter discusses the Nice Agreement and the relevant Treaties that gave rise to its existence and denote the importance of the Nice Classification on an international level. A study of the Nice Classification in respect of these Treaties is necessary to determine its rationale and what it attempts to achieve at an international level. This approach involves a collage of the two research paradigms. On the one hand the law, as set out in Treaties, legislation and cases, and any conclusions drawn from it, can be viewed as interpretivist as it can not be objectively measured and predicted in any strict sense. However, in order for the Treaties etc. to have any

²⁰ Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925

meaningful input into the argument what they state must be read objectively, i.e. seen in a positivist way.

Once the international objectives of the Nice Classification have been asserted, in light of the surrounding legislation, the case studies of Mexico, Turkey and Japan are considered in order to observe generally how the Nice Agreement has been interpreted at national level. The reasoning behind choosing three different, and economically diverse, countries for this purpose was so that the rationale of the Nice Agreement, as an international document, could be critically appraised without losing the international flavour of the argument at this point. An international agreement, like Nice, would be meaningless if it did not affect the individual countries party to it. The only way to determine the effectiveness of the Nice Agreement is to consider its effect at a national level. The use of case studies to achieve an appraisal necessitates a positivist approach to be used. However, the three case studies are independent of each other in that they have been composed by three different authors with three different objectives. The information on Mexico was obtained from an article by De Santiago and Villasenor²¹, and both men are natives of Mexico. Whereas the information on Turkey²² and Japan²³ came from articles, both of which were written by non-nationals of the countries, and sought to make points relative to their own national classification system. This raises the issue of bias brought about by the authors' individual interpretivist approaches. In effect, the sources had to be scrutinised and as much as possible only the objective facts and conclusions were extracted from them in order that a positivist stance could be assumed on the national effects of the Nice Agreement.

The following case study of Canada is designed to act almost as a control. It sets out the extreme case of not employing a classification system for trade marks and as such it can be viewed as a positivist element. The information for this chapter was

²¹ De Santiago JI & Villaseno JC, "Problems of Reclassification", *MIP*, February 2004, Issue 136, iv-vi

²² Keyder VB, "Turkey: Trade Marks – Classification System – Matters of Which to be Wary", *EIPR*, [1997] 19 (12), 308-309.

²³ Tessensohn JA, "Japan – Retail Services Denied Protection Under Japan's Trademark Law", *TW*, 154 (9).

obtained from the Canadian government, at the website for their trade marks office²⁴, and from a Canadian author²⁵. The use of the case study to make the extreme point of, and rationale behind, a total lack of a classification system meant that the issue of bias is not as prevalent here. The reasoning was provided by the Canadian government and so, although subjective from a Canadian point of view, it can be taken as an objective approach in the confines of this essay.

The final case study concerns the United Kingdom and directly deals with the legal case that is used to introduce the problem confronted by this essay: *Altecnic Ltd.'s Trade Mark Application*²⁶. Everything that has been stated in the essay up to this point, and having been put into perspective by the case study of Canada, is now brought to bear on the issues that this case gives rise to. The United Kingdom was chosen to be the definitive case study for the discussion as to how the international Nice Classification affects national substantive trade mark law for the reason that it is the author's native legal system, and therefore the first one to provide a relevant case of interpretive law that can be understood from a positivist perspective, thereby allowing for meaningful conclusions.

The Community Trade Mark (CTM) is a relevant area of discussion in a work concerning trade mark classification. It is mentioned here as a motive behind the Madrid Protocol and shares the same goal of harmonisation. While the Nice Classification certainly applies to the CTM it has not been specifically mentioned as a case study in its own right. The UK serves as an example of a European Union member state that benefits from the CTM and its jurisdiction. The focus of this essay is the effect of the Nice Agreement leading to the legal effect of the Nice Classification at a national level. It is outside the scope of this work to address the European Union, and thus the CTM, as a whole in this context. This is not to say that the CTM is irrelevant to this essay as its existence should be borne in mind throughout the concluding chapters.

²⁴ Troicuk A, *Legal and Technical Implications of Canadian Adherence to the Madrid Protocol*, Canadian Intellectual Property Office, at http://strategis.ic.gc.ca/sc_mrksv/cipo/tm/madrid_index-e.html

²⁵ Bloom GA, "The Selection and Registration of Trade-marks" in *Trade-Marks Law of Canada*, Ed. Henderson GF et al., 1993

²⁶ [2001] EWCA Civ 1928; [2002] RPC 34

A History of Classification

A discussion of the history of trade mark classification should commence at the point at which trade marks were first discussed as a legal phenomenon, a period in history that has been arbitrarily settled on as being the case of *Southern v How* (1618)²⁷. This date has to be arguable as to its authority in trade mark law for two reasons. Firstly, it is well documented that “trade marks” were in use in ancient times, as Greek inscriptions found on Etruscan vases dated 800 to 400 BC act as testament to this²⁸. Rogers states with regard to the existence of trade marks:

...few human institutions can boast a more respectable antiquity. The use of trade marks dates from the very earliest times of which we have any knowledge.²⁹

Rogers goes on to show this with a list of articles from the past, which bear evidence to trade mark use, the Etruscan vases being a part of this list. Secondly, it is not surprising that *Southern v How* is the first recorded “trade mark” dispute even though trade marks were in use for centuries beforehand. This is because only a few documents have survived from so long ago in relation to the vast amount there would have been upon their conception.

That no trace of such an action [in trade marks] is found in the commentaries of the Roman jurists is not surprising considering the fragmentary condition of those commentaries at present, especially as it is certain, from existing writings and inscriptions, that there were many legal institutions of the Roman Empire, concerning which we have no juristic commentaries.³⁰

Although on this basis a history of classification will not begin with *Southern v How* it is worth noting Chancellor Kent’s observation at the time that the case was “an action against a clothier by another clothier”³¹. This quote takes on a greater

²⁷ *Popham’s Reports*, Trinity Term, 15 Jac. I

²⁸ Rogers ES, “Some Historical Matter Concerning Trademarks”, 9 *Michigan Law Review* 29, at p. 30

²⁹ *op. cit.* at p. 29

³⁰ Kohler, “Das Recht des Markenschutzes”, Wurzburg 1884, as quoted in Rogers ES, “Some Historical Matter Concerning Trademarks”, 9 *Michigan Law Review* 29, at p. 32

³¹ 2 *Kent’s Commentaries*, 7th ed., p. 446, note b, as quoted in Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925, at p. 9

significance to classification with the case of *Blanchard v Hill* (1742)³², more than a century later, in which the Lord Chancellor of the time denied relief to the plaintiff “on the ground that protection of trade marks would create or protect monopolies”³³.

The object of this brief history is to explain how a system of trade mark classification gradually arose based on trade marks originally only having meaning between members of the same industry (as exemplified in *Southern v How*) and how a historical fear of monopoly helped create such a system.

In his seminal work “The Historical Foundations of the Law Relating to Trade-Marks”³⁴ Schechter tells the inquisitive readers where they might find primary information on the germs of modern trade mark law:

Any approach to such a study must be through channels and from sources that will be regarded as most unorthodox from a legal standpoint.³⁵

He then goes on to assess all the obvious legal references and their input into the history of trade mark law³⁶.

The Year Books “are concerned mainly with land tenures, feudal dues, crimes of violence and defamation”³⁷ and no commercial issues are broached. Likewise the medieval jurists, such as Bracton, Glanvil, Britton and Fleta, do not even mention trade marks, neither do local court proceedings. Although the Leet Courts redressed and settled private disputes they only rarely touched upon issues of trade mark enforcement, and even then it was to impose the odd fine provided for in the statutes for the compulsory use of marks by bakers and coopers. The Borough Courts do not help at all either. It might be thought that the courts dealing with merchant law, the Borough Piepowder Courts, might be of use in determining early trade mark law but these records are also to be searched for in vain. The Maritime Courts, although they had to touch on the use of marks by merchants, being concerned as they were with

³² 2 Atkyns 484

³³ Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925, at p. 10

³⁴ Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925

³⁵ op. cit. at p. 13

³⁶ op. cit. at pp. 13-16

³⁷ op. cit. at p. 13

mercantile disputes, show no interest in the marks themselves, only in the fact that they indicated ownership. Finally, statutes of the time requiring makers to set marks upon the goods to be sold, do not throw any light upon the evolution of a system of trade mark law by virtue of the fact that they are statutes passed for a past purpose and they did not constantly undergo change as the common law does.

Schechter argues that the beginnings of a system of trade mark law are to be found in the medieval economic structure that was the guild. The guilds ran their own hearings and tribunals for disputes and severely frowned on legal action taken by their members against each other in any form outside of the guild's jurisdiction:

These are the tares of different wares ordained and assented to by the old company the eighteenth day of August, the year aforesaid, to stop and prevent all disputes which might arise between the mystery of Grocers in the case where the purchaser and vendor are of the same company or where the purchaser be of the company of Grocers and where no express agreement has been made in express terms at the time of the bargain.³⁸

This explains the lack of trade mark disputes in the actual courts of law but also gives rise to a two-fold consequence. Firstly, it demonstrates that trade marks, although legally protected are in fact an economic entity. Secondly, although Schechter himself does not broach the subject, it is the thesis of this history that it was the guild system that actually, quite unintentionally sewed the seeds for a trade mark classification system.

Upon beginning a study of the rationale behind the guild economy of the Middle Ages it is necessary to consider the nature of a "trade mark" as it was understood in the medieval economy. The trade mark was seen as denoting origin and/or ownership of the good to which it was attached. This is still true to a certain extent but, as mentioned previously, modern trade mark law recognises three other functions besides.

³⁸ Dated 1379, *Ms. Archives of the Company of Grocers of London* (ed. J. A. Kingdon), pt. i, p. 56, as quoted in Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925 at p. 17

Two types of mark were existent in the medieval economy: the merchant's mark, which was a proprietary mark designating ownership of the goods, and the production mark, which designated the origin of the goods. In the nature and function of the guilds, the one mark often served both purposes, but the distinction is an important one as it is the production mark that is most like our modern trade mark of today. Indeed, the designation of origin was considered the only real function of a trade mark until just less than 100 years ago:

The orthodox definition of "the primary and proper function of a trademark" is that given by the Supreme Court of the United States in the leading case of *Hanover Star Milling Co. v Metcalf*: "to identify the origin or ownership of the goods to which it is affixed" [240 US 403, 412 (1916)].³⁹

Merchants' marks were mainly used in assisting the merchant, the owner, to reclaim his goods that had been lost through shipwreck, piracy or other mishap as evidenced by Dunant (*Traite des marques de fabrique*) and Braun (and Capitaine, *Les marques de fabrique*)⁴⁰. The authorities in the latter half of the fourteenth century recognised merchants' marks as evidence of ownership and the fact that a mark existed on the "lost" goods evidenced the assumption of ownership. Braun notes a book, dated 1420, which belonged to a Danzig merchant and which lists a large number of Dutch, English and Genoese merchants along with their marks⁴¹. Another example of such rudimentary registration of marks is the "Book of Entries for the Corporation of Great Yarmouth"⁴². Such documents came into existence mainly because of the statute of 27 Edward III (1353):

Item, We will and grant, That if any merchant, Privy or Stranger, be robbed of his goods upon the Sea, and the Goods so robbed come into any Parte within our Realm and Lands, and he will sue to recover the said Goods, he shall be received to prove the said goods to be his own, or by good and lawful Merchants, Privy or Strangers; and by such Proofs the same goods shall be delivered

³⁹ Schechter FI, "The Rational Basis of Trade Mark Protection", (1927) 40 *Harv LR* 813, at pp. 813 & 814

⁴⁰ Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925 at p. 26

⁴¹ *op. cit.* at p. 26

⁴² *op. cit.* at p. 27

to the Merchants, without making other suit at the Common Law...⁴³

This is remarkably similar to the legal standing of modern registration, the rationale of which is that once a trade mark is placed on the register everyone has notice of its existence at law, i.e. the register itself is proof of ownership of the mark. This is s.10 TMA 1994, which, in dealing with infringement of registered marks, at no time mentions there having to be notice of the mark to the infringing third parties. It is in effect a strict liability offence to infringe a registered trade mark.

Even though merchants' marks are not directly to be associated with any form of classification rationale, as they showed only direct ownership of marked goods, they do underpin the proprietary nature of modern trade marks in that original "ownership" of the property by the manufacturer is assured. This is the modern day goodwill function, or guarantee function, of a trade mark. It is this link between the manufacturer and the goods sold that is evidenced by classification. So although proprietary marks do not tell us much about how a classification system may have developed they do, to an extent, demonstrate how a classification system fits in historically with modern trade mark law. If Laddie J is to be believed, a classification system is of administrative utility if a registration system is in use, perhaps even if it is a fourteenth century one. (It must be assumed at this point that even as far back as the fourteenth century some form of classification was in use as a random collation of merchants' marks would not have been a very efficient tool, thereby undermining the purpose of recording such marks.)

The function and structure of the medieval guild system highlights a different type of mark to the proprietary mark. This is the production mark, which at the time had the function of indicating source or origin. An important distinction between the production mark of medieval times and a modern day trade mark is that traders today have the option to mark their goods or services however they desire, if at all. Back in the Middle Ages the mark was seen as a "police mark"⁴⁴ and the owner or manufacturer would have had little, if any, choice in its use and design. Whereas

⁴³ From the Statute of 27 Edward III (1353) as quoted in Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925 at p. 30

⁴⁴ Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925 at p.38

today's marks are definitely an asset to their owners in medieval times they were a distinct liability. It should be remembered that quite often the same mark would fulfil both roles of proprietary and production mark, but in cases where this was not normal the production mark was usually less complex or decorative. In the case of bakers' marks, some would stamp ordinary merchants' marks on the bread whereas others would merely use prick marks to establish the origin of the product⁴⁵.

The guilds in the Middle Ages effectively ran the production mechanisms and heavily influenced the economic theories of the time. Schechter nicely encapsulates this economic phenomenon in three points⁴⁶:

1) Up to the fifteenth century and possibly later the guild system ran the manufacturing work of the country. Even when such manufacturing became a national phenomenon the Crown and Parliament relied on the guilds as supervisors.

2) Guild charters regularly introduced the concept of grants of monopoly. The enforcement of such a monopoly necessarily entailed high standards of production which the guilds desired in order to upkeep their reputation. These monopolies were probably allowed for the sake of efficiency, and a "good" monopoly is surely a contained and easily controlled one:

Work must be good and 'legal' ..., an infraction of the regulations must be reported that the gild may not secure a bad reputation.⁴⁷

Dawson⁴⁸ points out that the twentieth century idea of monopoly, as generating consumer preferences which in turn inhibit the entry of newcomers into a particular market, does not apply here: "This was not a sense in which 'monopoly' was understood in 1742"⁴⁹, nor earlier to this.

⁴⁵ op. cit. at p. 39

⁴⁶ op. cit. at pp. 40-42

⁴⁷ Evans AP, "The Problem of Control in Medieval Industry" in *Political Science Quarterly*, vol. Xxxvi, pp. 615-16 as quoted in Schechter (1925) at p. 40

⁴⁸ Dawson N, "English Trade Mark Law in the Eighteenth Century: *Blanchard v Hill* Revisited- Another 'Case of Monopolies'?", *Legal History*, Vol. 24, No. 2 (August 2003), p. 111-142

⁴⁹ op. cit. at p. 120

The supervision exercised by the guilds over the work carried out in their names was greatly simplified at this time by the fact that nearly everything used by the consumer was bought from the manufacturer; there was no retail chain. Also, where manufacture of an object was overseen by several guilds, the relevant craftsmen would literally be in the next street from one another. This would not only have enabled a very high level of supervision by the guilds but would also have put across a strong corporate bond amongst the members of the guilds. This in itself would have two effects. Firstly, the consumers would have personally been able to inspect the goods at the manufacturer's door before purchase. Secondly the manufacturers would have found it next to impossible to compete with one another on an individual level within the confines of a guild set up.

Also if ther be eny brother or syster that takeyth eny custemar owt of eny brothers handys without so be that the parties that he serveth wille no lengar have his service and that the said brother seith that he be content of his diewte that he shold have or ellis he to take no mannys custymer owt of hys hands under the payne of [...], be hit brother or syster⁵⁰

The “goodwill” denoted by modern trade marks would have been an alien concept to all concerned on an individual level, consumers and producers alike. This repression of individual goodwill by the guilds in favour of a collective goodwill of the guild is also demonstrated in the guilds actively seeking to prevent one manufacturer using a mark of more significance than another within the guild:

Here was Edward Park for yt hr hath written upon his Surgeons signe the skoller of St. Thomas of Wallingforde and the said Edward Parke is comaunded by the aucthoritie of this worsshyphfull Courte That he the said Edward Parke shall with all expedicion put out of his said Signe the said writing & to sett his signe as other Surgeons do without any superscription yt upon and not else otherwise as he wyll answeare to the contrarye.⁵¹

⁵⁰ In the ordinances of the Brotherhood of St. Christopher of the Waterbearers of the City of London (1496); from Coote HC, “Ordinances of Some Secular Guilds of London”, in *Trans. London and Middlesex Archaeol. Soc.*, vol. iv, p. 56, as quoted in Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925 at p. 43

⁵¹ Young S, *Annals of the Barber-Surgeons of London*, p. 316. Entry dated March 16, 1568; as quoted in Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925 at p. 44

3) Unfair competition would have been partly curbed by guild supervision, as outlined above, but in addition to this the guilds were actively attaining and maintaining a strict monopoly of the trade under their direction. This meant that they were positively preventing merchants from even just the next town a few miles away from competing with their own guild trade. As Schechter states:

But within the gild itself - at any rate, according to the theory of their legislation – there was no such thing as competition, solely co-operation.⁵²

The major issue here is that a modern trade mark classification system allows for the direct competition between traders within a certain class of goods or service. The way in which the guild system was divided and set up means that with little imagination it can be seen as forming a classification of goods and services, but not in this modern sense. Each craft or guild lived in its own community near other communities of craftsmen contributing to the trade, for example, for the production of cloth the weavers, fullers and dyers would have lived within a stone's throw of each other⁵³. If there was no competition within guilds and no competition between the guilds then how could a modern classification system as we know it, i.e. one that divides competing manufacturers into classes, arise from a guild structure?

The answer is that it could not and the crucial change came about with the decay of the guilds and the natural increase in the geographical area and nature of the market place. The guilds had effectively classified themselves into manufacturing groups because this worked from a supervisory point of view given the exceedingly close proximity of manufacturer and consumer. The guilds did not need, and were certainly not trying, to attain a classification system; the significance is that they were arguably the foundation stone for a modern classification system.

The other crucial difference, which helps to explain the guilds' set up, is that they were not operating in a capitalist environment but a feudalist one. The manufacturers were working under the guilds jurisdiction and would be punished severely if they brought the name of the guild into bad repute.

⁵² Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925 at p. 42

⁵³ *op. cit.* at pp. 40 & 41

The Elector Palatine in the Fourteenth Century issued an edict which, after reciting that the sale of spurious wine was the most outrageous form of deceit, punished by hanging any innkeeper who sold ordinary wine as Rudesheimer.⁵⁴

There were in fact various ordinances requiring manufacturers to place their production mark on their goods so that the perpetrators of badly made or imitated goods could be discovered. An example of this is the ordinance of Amiens (1374), which required every smith to mark his metal differently to all others “so that * * * it may be known who made it”⁵⁵. Rogers goes on to make the point that such

...acts seem to have been special, applying only to particular trades and resulted in the anomaly of making infringement when committed in one trade a felony and in another a civil-wrong.⁵⁶

This in itself would have had the effect of highlighting, not only at the level of the “law” as administered by the guilds but also in the minds of the individual manufacturers and consumers, the differences between the guilds themselves. It could have been this potential pigeonholing effect on the guilds that cemented such boundaries between the manufacturing disciplines, which have subsisted and have been carried through to the present day concept of classification.

How did a modern classification system arise from this medieval economy? The answer to this lies in the ultimate recognition of individual goodwill amongst traders in the same guild, i.e. intra-guild competition has to be recognised before the guild, as a partitioned entity of a manufacturing process, can be seen as a classificatory phenomenon.

To summarise, the guilds were only interested in production marks being on the manufactured goods from the perspective of maintaining the collective goodwill of the guild and allowing for “outside” goods to be traced and the monopoly upheld. The marks were a liability and not an asset for the craftsmen of a guild. However, this aspect of production marks had to change with an increase in the geographical

⁵⁴ Rogers ES, “Some Historical Matter Concerning Trademarks”, 9 *Michigan Law Review* 29, at p. 33; Based on a report of M. de Marafy to the Congress of Industrial Property. Paris 1878, p. 83

⁵⁵ Rogers ES, “Some Historical Matter Concerning Trademarks”, 9 *Michigan Law Review* 29, at p. 33

⁵⁶ op. cit. at p. 34

area of the market place, which first occurred in the manufacture of cloth and the cutlers' trade. Under such circumstances the same "police marks" could attain the status as a symbol of excellence because the consumer, which could now be at the other end of the country and perhaps further, had only the production mark by which to identify the goods that he had become accustomed to purchasing. In effect the production mark began to acquire modern trade mark characteristics upon the breakdown of the consumer/producer interface and as a result individual goodwill on the part of the craftsmen within a guild became recognised and intra-guild competition became possible.

The industries of cloth and the cutlers' trade can be studied to ascertain the point at which the mandatory production mark imposed by guild regulations became the asset that trade marks are deemed to be in their modern sense.

In these trades is clearly noticeable the evolution of the trade-mark from a mark of origin to a mark of quality and hence from a liability to an asset, of distinct value to the owner of the mark.⁵⁷

Schechter goes on to state that in tracing "the systems of trade-mark law developed by the cutlers of London and Sheffield":

...while the rivalry between the cutlers of London and Sheffield was very great, the rivalry between the members themselves in each of these centres of industry appears to have been no less keen, with a consequent emphasis upon the importance of individual cutlers' marks. On the other hand, in the cloth trade, the trade-marks which became of importance and the subject of protection were not only those of individual clothiers but, to a more considerable degree, the collective marks of the centers of the cloth industry.⁵⁸

These observations concerning the two trades are very important to a history of classification, albeit Schechter is discussing the trade mark law in general and not classification specifically.

⁵⁷ op. cit. at p. 78

⁵⁸ op. cit. at pp. 78 & 79

Firstly, both trades are dealing on a nationalised level and so, as mentioned above, the marks are more of an asset to the individual craftsmen.

The extent of use of trade marks is an accurate index of commercial conditions. When trading was face to face, the purchaser of a commodity dealing directly with the producer, a trade mark was not used because none was necessary. The purchaser necessarily knew whose product he bought. The minute, however, that a particular maker, by the excellence of his manufacture, acquired a reputation outside of his immediate locality, in order to visualize and perpetuate that reputation, he adopted and used a mark to distinguish his product from others.⁵⁹

In the case of the cloth trade, the marks are more relevant to the centre where the cloth was manufactured and this leads directly to a situation of *inter-guild* competition within a manufacturing pigeonhole. This in fact would equate to the modern day concept of geographical indications:

Afore the seid fest [of St. Michael the Archangel] by the Treasurer of England be provided and ordeigned Seales to be impressed in lede having [the Royal] Armes of Englund on the oon side and on the other side the Armes signe or tokyn of every Citee Burgh or Towne within this Realme when the Cloth is made, having any such armes signe or tokyn, for a merke and evident tokyn and knowledge of the Clothe made within every suche Citee Burgh and Town of this Realme; and over that Seales for every Shire of this Realme for the sealyng of all manner Cloth made within every Shire...⁶⁰

Secondly, in both trades the marks are more relevant to the individual manufacturers than previously in history and other trades and this directly leads to *intra-guild* competition. Intra-guild competition is what is needed for a classification system, as introduced by the guilds, to become a viable concept. However, this concept was not embraced by the guilds themselves because the modern day classification system, as grounded in the law of trade mark registration, came about over a period of time based on the factual and economic phenomenon of guild jurisprudence, to coin the term employed by Stubbs⁶¹.

⁵⁹ Rogers ES, "Some Historical Matter Concerning Trademarks", 9 *Michigan Law Review* 29, at p. 39

⁶⁰ I Ric. III (1483-4) c. 8. *Stat. Of the Realm*, ii, 486; as quoted in Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925 at p. 84

⁶¹ Stubbs W, *Constitutional History of England* (4th ed.) iii, p. 592

Within the cloth industry, the crucial historical fact that allowed individual makers' marks to be seen as signs of excellence regarding their product was the decay of the guild system and the regulation of the trade by the legislature. This occurred earlier in the cloth trade than in any other, and the supervision of the trade by the Crown was split between officials of the Crown and guild officials as a pragmatic approach:

It was the nature of things inevitable that the dealers, who traded in cloth, should organize the different branches of the woollen industry under their own control. The guild system broke down earlier in the weaving industry than in any other direction. The rapid growth of the cloth trade was incompatible with the old restrictions, and the manufacture overflowed from the towns into the suburbs and country districts, where it ran its course free from impediment or restraint.⁶²

A further development is that the obligatory production mark had become an individual asset by the end of the Middle Ages. This meant a mark could then be seen as having two functions: Firstly, as an indication of origin, and secondly, as a sign of the individual manufacturer's goodwill. This dual function is displayed in a proclamation from the time of Charles I:

Every weauer shall to euery Cloth that hee shall weaue, set the first two letters of his name of Baptisme and Surname, or at the least the first letter of his Surname, and no other marke...⁶³

This is *prima facie* a police regulation but by requiring the obligatory inclusion of the manufacturers' initials the mark is not just a liability, under which faulty goods can be traced back to source, but also an asset such as a modern trade mark is conceived as being:

In other words, the proclamation not merely conceives of a trademark as an asset, but also regards it as symbolizing the good-will, not of the actual maker or craftsman of the goods, but of the capitalist who furnishes the material or tools for the production of the article.⁶⁴

⁶² Lipson E, as quoted in Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925 at p. 81

⁶³ *Proclamation*, Charles I, April 13, 1633 (Brit. Mus. 506. h. 12 [19]) as quoted in Schechter (1925) at pp. 94 & 95

⁶⁴ Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925 at p. 95

So, the regulation of the cloth trade by the State enabled the manufacturers within it to move from a feudal environment to a capitalist one and hence receive individual recognition for good work that a classification system recognising individual competition within a class caters for.

A study of the cutlers' trade shows, along similar lines to the cloth trade, the progression of a production mark from a liability to an asset. However, it also points to the development of an important necessity concerning trade marks in general and more specifically to this essay, a classification system. If intra-guild competition at an individual level is necessary for a classification system then it is also equally necessary for the marks involved in such a system to be owned, as property, by someone such as the manufacturer of the goods to which the mark is affixed. If a classification system is in fact evidence of the intangible connection between a mark and its related business then the mark must be the property of the business in question, otherwise what does a classification system show or mean? It is the cutlers' trade that puts this last piece of the jigsaw into place⁶⁵.

The term "property" in relation to trade marks is intended in its legal sense, i.e. a property in the mark enables it to be bought, sold or transmitted. Schechter argues, with convincing use of primary sources that it was advances within the cutlers' trade that first saw the guild tribunals recognising "an individual's right to the protection of his mark and damages for its infringement, his right to sell or lease his mark and, notably, his widow's right to a life estate in his mark and his son's claim to a reversion in his mark"⁶⁶.

In 1452 a case came before the Mayor and Aldermen of London concerning a mark used by a man called Robert Hynkeley who had died in 1450 and had been a citizen

⁶⁵ The cutlers started out as a separate branch of industry, with their own guild, but in the same trade as the bladesmiths and sheathers. "Every knife is prepared separately by three different crafts, viz.: first the blade by the smiths called 'Bladsmaythes', the handle and the other fitting work by the cutlers, and the sheath by the sheathers; and that if the articles are good, commendation is the result, but if bad, then blame and scandal falls and is charged upon the said trade of the Cutlers." (Ordinance between the Cutlers and Sheathers of London in 1408 in Welch C, *History of the Cutlers' Company of London*, i, p. 283, as quoted in Schechter (1925) at p. 103). This situation was eventually remedied upon the amalgamation of the three guilds under the Cutlers' Company in the middle of the fifteenth century.

⁶⁶ Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925 at p. 101

and bladesmith in London. After his death his wife had married a man called John Leylond, who was a citizen and skinner in London. Despite the opposition from the Mistery of Bladesmiths, it was decided that John Leylond should have restored to him the use of Robert Hynkeley's mark (a double crescent) and that a bladesmith under the name of John Morth was to be forbidden from any further use of the mark on his goods at risk of a penalty⁶⁷.

Schechter states the importance of this case as being that, firstly, cutlers' marks were deemed valuable enough to bring an action at law for their restoration, and secondly, that property as a concept relating to marks had developed far enough that a widow, as long as she stayed in business, could retain use of a mark once owned by her deceased husband, even after remarriage⁶⁸. By the seventeenth century there are a large abundance of records of the company court that indicate the huge amount of import that marks had to their owners. These records are full of ways and means for transmitting and protecting marks⁶⁹.

Finally, it is worth noting an ordinance enacted in 1624:

no man from hensforth shall have a proper marke vnlesse he be a forger and be able of him self to fforge & temper his stuff as a worckman sholde do.⁷⁰

This meant that members of the guild could not acquire rights in gross in their trade marks and required them to maintain a high standard of workmanship so that they might retain their marks⁷¹. Schechter also makes an interesting aside at this point in referring to a decision of the Supreme Court of the United States: *United Drug Co. v Rectanus Co.*⁷². In this case the court stated, in relation to a whether a trade mark was a right in gross or at large, that

⁶⁷ Welch C, *History of the Cutlers' Company of London*, i, p. 329 as cited in Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925 at p. 108

⁶⁸ Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925 at p. 109

⁶⁹ op. cit. at p. 110

⁷⁰ Welch C, *History of the Cutlers' Company of London*, ii, p. 344 as quoted in Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925 at p. 111

⁷¹ Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925 at p. 111

⁷² (1918) 248 U.S. 90

There is no such thing as property in a trade-mark except as a right appurtenant to an established business or trade in connection with which the mark is employed.⁷³

This relates to the fundamental issue under discussion, that due to the nature of a classification system for trade marks, i.e. competing businesses within a class, the marks themselves must be directly owned by the competing businesses, as conceptualised by an intangible line between a mark and its business.

In summary, this history of classification has shown three crucial developments towards a modern trade mark classification system:

1) In looking at the structure and economic set up of the guilds it can be seen how the manufacturing disciplines have a history of being separate and pigeonholed depending upon the goods produced and services provided to the consumer.

2) Upon the growth of the marketplace and intervention into guild proceedings by the state, leading to the separation of consumer and producer and a lengthening of the retail chain, it can be seen how intra-guild competition developed. This paved the way for a classification system that is split into manufacturing products and services with intra-class competition.

3) In considering the cutlers' trade it can be seen how trade marks began to acquire property characteristics which are essential to a classification system. There is not much point in classifying marks into areas of competing businesses if they do not belong to those businesses in a direct, if intangible, manner. A classification system is arguably the tangible evidence for this essential proprietary intangible connection between business and trade mark.

In conclusion, this history points to a very important and necessary detail concerning classification systems for trade marks. It cannot be ignored that the development of classification has more than closely followed the development of trade mark law in general. Classification has not, and never has been, a concept developed over night

⁷³ *United Drug Co. v Rectanus Co.* (1918) 248 U.S. 90, at p. 97

to deal with a complex system of laws developed over centuries. The classification of trade marks was in fact being developed as a concept long before it took on its black letter, statutory form. Although the classification of trade marks as conceived of in modern times could not actively occur, or have any meaning, until somebody wrote down a definitive list of classes and pigeonholed the trade marks of the day into them, this in itself could not have happened, to the point where it would be deemed necessary or have meaning in itself, had the history detailed above not preceded such an act.

In effect, the modern day classification system and rationale, as outlined below, appears to take for granted its roots in the Medieval economy, from whence trade mark law as we know it also came, and the origins of which have also been duly ignored:

...nowhere is the obscurity of the origins and at the same time the “touching absence of curiosity” concerning these origins more apparent than in the field of the law of trade-marks.⁷⁴

⁷⁴ Schechter FI, *The Historical Foundations of the Law Relating to Trade-Marks*, 1925 at p. 4

The Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks 1957 (The Nice Agreement)

The present classification of trade marks for many countries is set out under the Nice Agreement. This is by no means the first example of a classification system involving trade marks, as marks were put into registers and records as long ago as the fifteenth century, with the “Book of Entries for the Corporation of Great Yarmouth”⁷⁵. The importance of the Nice Agreement is that it sets out the accepted classification system for trade marks in goods and services for 70 countries party to the Agreement itself and a further 71 countries, and three organisations, which also use the Nice Agreement whilst not being party to it⁷⁶.

The previous part to this essay set out to explain how such an international agreement could come about, whereas this part tries to establish why it came about, what its rationale is and what the ultimate legal effects of such a classification system are.

The World Intellectual Property Organisation (WIPO) states:

The Nice Classification consists of a classification of goods and services for the purpose of registering trademarks and service marks.⁷⁷

The Nice Agreement is a multilateral treaty administered by WIPO and it sets out the Nice Classification. It was signed on 15 June 1957 at the Nice Diplomatic Conference and has since been revised at Stockholm in 1967 and Geneva in 1977. The countries and states party to the Nice Agreement constitute a Special Union, under Article 1(1) of the Nice Agreement, and in so doing these members adopt and apply the Nice Classification for the purposes of the registration of marks. The Nice

⁷⁵ Some form of classification/index must have been in use with such early tomes but it may not have been a classification of trade marks per se, perhaps merely just an alphabetical list of merchants with the relevant marks shown alongside.

⁷⁶ WIPO at <http://www.wipo.int/classifications/en/nice/about/nice.html> quotes figures for 2003; for a list of relevant countries in 1996 see <http://classifications.mszh.hu/nice/html/nice/ennpre.htm>

⁷⁷ WIPO at <http://www.wipo.int/classifications/en/nice/about/nice.html>

Classification is mandatory in the registration of marks in countries party to the Nice Agreement. The Nice Classification is also obligatory to the International Bureau of WIPO, which is involved with the international registration of marks, and to members of the Paris Convention for the Protection of Industrial Property 1883 (the Paris Convention), the Madrid Agreement Concerning the International Registration of Marks 1891 (the Madrid Agreement), and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks 1989 (the Madrid Protocol), as well as for the registration of marks by the African Intellectual Property Organisation (OAPI) and the Benelux Trademark Office⁷⁸. These countries, states and institutions are required to include the numbers of the classes of goods and/or services, as set out in the Nice Classification, in all official documents and publications.

The Nice Classification is not the first such classification system for trade marks. It is in fact based on the classification prepared by the predecessor of WIPO, the United International Bureau for the Protection of Intellectual Property (BIRPI), in 1935⁷⁹.

The Paris Convention of March 20, 1883, as administered by WIPO and revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at the Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967, and as amended on September 28, 1979, is the Treaty on which all the Conventions and Agreements already mentioned have been based. The main rationale behind the Paris Convention is set out in Article 1:

- (1) The countries to which this convention applies constitute a Union for the protection of industrial property.

Today approximately 100 countries are members of the Paris Convention⁸⁰.

The Madrid Agreement of the 14 April 1891 directly emanated from the Paris Convention. It is a special arrangement under the Paris Convention and can only be

⁷⁸ <http://classifications.mszh.hu/nice/html/nice/ennpre.htm>

⁷⁹ <http://classifications.mszh.hu/nice/html/nice/ennpre.htm>

⁸⁰ For a list of countries party to the Paris Convention see WIPO at <http://www.wipo.int>

signed up to by member states of the Paris Convention. It was revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Nice on June 15, 1957, and at Stockholm on July 14, 1967, and amended on September 28, 1979. On coming into force in 1892 it had only five member states and by 1990 it had only increased its membership to 29⁸¹. The rationale behind the Madrid Agreement is found in Article 1:

- (1) The countries to which this Agreement applies constitute a Special Union for the international registration of marks.

The Madrid Agreement takes the principles of the Paris Convention and extends them specifically to trade and service marks. Therefore, any person or legal entity that has registered a mark in his or its home country can get protection for that mark in any or all of the States party to the Madrid Agreement. Moreover, this can be accomplished with a single application for registration filed in one language and is less expensive in total than it would be to make a national filing in all of the desired countries relevant to the Agreement. As a result, international filing *prima facie* reduces costs, especially translation fees and agents' fees⁸².

Article 3 of the Madrid Agreement states:

- (2) The applicant must indicate the goods or services in respect of which protection of the mark is claimed and also, if possible, the corresponding class or classes according to the classification established by the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. If the applicant does not give such indication, the International Bureau shall classify the goods or services in the appropriate classes of said classification. The indication of classes given by the applicant shall be subject to control by the International Bureau, which shall exercise the said control in association with the national Office. In the event of disagreement between the national Office and the International Bureau, the opinion of the latter shall prevail.

⁸¹ For a list of countries party to the Madrid Agreement see WIPO at <http://www.wipo.int>

⁸² Kaufman IJ, "Madrid Agreement: Will Reform Proposals Attract More Members?" [1990] 11 *EIPR* 407 at 408

Article 3 clearly puts across that class identification is considered absolutely necessary and that the international regulating body (WIPO) has the final say with regard to class distinction for a particular mark. This indicates that the rationale behind the Madrid Agreement is a drive toward the harmonisation of trade mark law between its member states and that a single classification system is a necessary means of achieving this. Indeed Kaufman states:

As a step towards ‘harmonisation’ the international classification of goods and services for the registration of marks was established by the Nice Agreement of 1957...and is adopted by all the members of the Madrid Agreement.⁸³

Article 4 of the Madrid Agreement makes provision for what becomes a crucial issue in discussion of the legal extent and effect of the Nice Agreement in that:

(1) From the date of the registration so effected at the International Bureau..., the protection of the mark in each of the contracting countries concerned shall be the same as if the mark had been filed therein direct. The indication of classes of goods and services provided for in Article 3 shall not bind the contracting countries with regard to the determination of the scope of the protection of the mark.

The reason why the Madrid Agreement had so few members as opposed to its parent treaty, the Paris Convention, was because of provisions such as Article 6 of the Madrid Agreement. Subsection 3 of Article 6 sets out that if within five years of international registration a mark is revoked in its country of origin then it will cease to be recognised internationally as well, even if the reasoning behind the revocation is not legally recognised in the domestic law of one or all of the other countries involved. This legal phenomenon is known as “central attack” and it is only possible because of a provision for a home, or “basic”, registration, i.e. a mark cannot be registered internationally without having first been registered nationally in its country of origin⁸⁴. Such a provision has resulted in some of the most commercially important nations refusing to sign up to the Treaty, although they are members of the Paris Convention, such as the United Kingdom, Japan and the United States.

⁸³ op.cit. at 408

⁸⁴ Article 1(2) & (3) Madrid Agreement

The Protocol Relating to the Madrid Agreement was signed by 28 countries, including the UK, on 27 June 1989. Its purpose was to iron out the problems associated with the Madrid Agreement and so to achieve a more commercially viable membership:

The States party to this Protocol..., even where they are not party to the Madrid Agreement Concerning the International Registration of Marks...shall be members of the same Union of which countries party to the Madrid (Stockholm) Agreement are members⁸⁵.

The driving force behind the Madrid Protocol was the impending arrival of the Community Trade Mark. The Madrid Protocol is designed to be a self-contained treaty, even though in parts its text is identical to that of the Madrid Agreement, so that future users that are not members of the Madrid Agreement can rely exclusively on the Madrid Protocol⁸⁶. The Madrid Protocol directly tackled issues such as “central attack” and the effect of registration and smoothed away the ructions in Article 6, amongst others, of the Madrid Agreement. However, with regard to classification Article 3(2) of the Madrid Protocol is identical ad verbatim to Article 3(2) of the Madrid Agreement (see above).

The relationship between the Madrid Agreement, its Protocol and the Paris Convention can be summed up in one word: “harmonisation”. In one form or another this is what all these Treaties are striving to attain and it is just as important a word with the Nice Agreement. To demonstrate that the Nice Classification, as based on the 1935 BIRPI classification and set out in the Nice Agreement, did in fact directly emanate from the Paris Convention, via the Madrid Agreement, Article 10 of the Nice Agreement should be considered:

This Agreement shall have the same duration as the Paris Convention for the Protection of Industrial Property.

The Nice Agreement and its rationale are therefore intricately bound up with the Paris Convention, the Madrid Agreement, the Madrid Protocol and their rationale of

⁸⁵ Article 1 Madrid Protocol

⁸⁶ Kunze GF, “The Madrid System for the International Registration of Marks as Applied under the Protocol” [1994] 6 *EIPR* 223 at 223

harmonisation. Indeed, if the dates of revision are compared for the Paris Convention and the Madrid Agreement it can be stated that the Madrid Agreement is an extension and a part of the Paris Convention, and likewise the Nice Agreement can be seen as an extension, or a limb of, the Madrid Agreement. (See Appendix)

Prima facie the Nice Classification has the same rationale in its structure and function as the Madrid Agreement. Its use by national offices means that applications can be filed with reference to a single classification system, directly leading to a simplification of preparation of applications, as goods and services relating to a mark will be identically classified in all the countries which have adopted the Nice Classification. Also, because the Nice Classification exists in several languages, a lot of time and effort is saved in filing a list of goods and services in a language other than that of the country of origin of the mark⁸⁷.

The best description of the structure of the Nice Classification as a working tool is outside of the Nice Agreement itself, which provides an abstract procedural guideline, and is appropriately set out by WIPO:

The Nice Classification comprises the Class Headings accompanied by Explanatory Notes and an Alphabetical List of Goods and Services, with the class in which each product or service is placed. The *Class Headings* describe in very broad terms the nature of the goods or services contained in each of the 34 classes of goods and 11 classes of services. They are accompanied, where appropriate, by *Explanatory Notes* which describe in greater detail the type of product or service included in the classes concerned. The *Alphabetical List* is a list of goods and services set out in alphabetical order. It comprises about 10,000 indications referring to goods and 1,000 indications referring to services.

The Nice Agreement

Article 1: “Establishment of a Special Union; Adoption of an International Classification; Definition and Languages of the Classification”

⁸⁷ WIPO at <http://www.wipo.int/classifications/en/nice/about/nice.html>

- (1) The countries to which this Agreement applies constitute a Special Union and adopt a common classification of goods and services for the purposes of the registration of marks.⁸⁸

Article 2: “Legal Effect and Use of the Classification”

- (1) Subject to the requirements prescribed by this Agreement, the effect of the Classification shall be that attributed to it by each country of the Special Union. In particular, the Classification shall not bind the countries of the Special Union in respect of either the evaluation of the extent of protection afforded to any given mark or the recognition of service marks.
- (2) Each of the countries of the Special Union reserves the right to use the Classification either as a principal or as a subsidiary system.

The drafting of the Agreement is attempting not to come across as too narrow and restrictive or draconian as this could reduce the amount of potential entrants into the Agreement and therefore undermine the rationale behind it. This was most likely a lesson learnt from the lack of adoption of the Madrid Agreement, realising the desire of the drafting states to protect their national sovereignty.

Article 3: Committee of Experts

- (1) A Committee of Experts shall be set up in each country of the Special Union represented.
- (3) The Committee of Experts shall:
 - (i) decide on changes in the Classification;
 - (ii) address recommendations to the countries of the Special Union for the purpose of facilitating the use of the Classification and promoting its uniform application;
 - (iii) take all other measures which, without entailing financial implications for the budget of the Special Union or for the Organization, contribute towards facilitating the application of the Classification by developing countries...

From these articles alone the Nice Agreement can be seen to be striving towards a goal of harmonisation in an attempt to facilitate the registration of trade marks on

⁸⁸ This Article should be compared with Article 1(1) of the Madrid Agreement for a further example of the identical rationale shared by the Treaties.

both a national and international level. This is an important necessity with the indication of origin for goods and services, and the reduction of potential consumer confusion, in an increasingly global market.

Mexico

Mexico signed on to the Nice Agreement and adopted the Nice Classification on 10th September 2002. It had already changed its classification system a few times before this. The result of changing to the Nice Classification was therefore one of some legal confusion.

All the previous changes to the law in Mexico made it necessary for a lot of trade marks to be reclassified upon their renewal when the Nice Classification was eventually adopted. This was a problem as some of the goods and services registered under the old system now found themselves under the scope of different classes in the new system: Headings had changed and incorporated different goods or services and obviously with this the numbering of the classes had also been shifted around. Added to this was the issue of the old Mexican law not allowing multi-class applications: A trade mark can only apply to goods or services under one specific class. The result was the government having to allow for trade marks originally falling under one class to now fall in two or more classes of the Nice Classification.

The problem is that under the new multi-class registration some marks may not protect the precise goods or services they were originally applied to in practice. This could lead to cancellation actions for non-use by interested third parties. In fact, the reclassification did not always place a trade mark with its relevant goods or services at all. For example, the old Mexican class 19 was for vehicles (except their motors). This is now reclassified under classes 6, 12 and 22 of the Nice Classification.

This leads on to a second problem in that, under a strict interpretation of Mexico's Industrial Property Law, if a trade mark registration covering the complete heading of a class is in practice applied to specific products that, although pertaining to the same class, are not included in the class description, there could be a challenge of

non-use to the registration, i.e. a trade mark covering an entire class heading should not cover those products not included or contemplated in the description of the class.

Trade mark applicants should be advised to specifically state the goods or services to which the trade mark will be applied. It is not always sufficient to get protection for the whole heading of a class and, when necessary, protection should also be obtained for specific goods or services not included in the class description.

Another option would be to have the Industrial Property Law amended to clarify the fact that specific goods should be stated in an application, hence abandoning the practice of only indicating class headings. Alternatively, the law should provide specific indication that if a good or service is not covered by a class heading it should always fall under the scope of the heading if it pertains to the class, but this could result in potential conflict between marks of the same class.

The moral here is that, however it is approached, simply adopting a new classification system is not as easy or idealistically plausible as the potential benefits of doing so can make it appear, with there often being far reaching legal implications.

Turkey

On the 27th August 1996 the Turkish Patent Institute issued a list of sub-classifications pursuant to its accession to the Nice Agreement. The sub-classification contained specific provisions which in some instances differed from those of other members of the Special Union.

There were two main issues. Firstly, all the categories were noticeably more detailed than in the legislation of other countries. Secondly, key words and phrases used in Turkish applications for trade mark protection could have unintended legal effects. The sheer amount of detail in the sub-classifications and the need to protect exactly what an application intended to protect meant that the importance of wording in an application became greatly increased, with a necessity to get it absolutely correct.

Especially as post-registration disclaimers were not allowed as amendments to the registration.

Correct wording was also an important consideration due to the increasing amount of abusive trade marks and stockpiling in Turkey. This was due mainly to the fact that no proof of use, or intention to use, was required either upon original application or upon renewal. The stockpiling problem was also attributed to the potential for unusually broad classifications of goods and services.

Turkey is an example of how the implementation of a classification can have far reaching repercussions on the legal aspects of trade mark protection. It is important to get the classification system correct and to implement it effectively and this is not the easiest thing for the Nice Agreement to ensure or regulate. Ironically, Article 2(1) of the Nice Agreement protects Turkey's implementation of the Nice Classification from enforceable criticism on an international level, even if the implementation apparently adds nothing to the goal of harmonisation harboured by the Nice Agreement.

Japan

Japan joined the Special Union on 20th February 1990 and demonstrated that even the most successful and strongest economies can have problems when it comes to implementing a trade mark classification system.

The case at the centre of the confusion is *ESPRIT International v. Commissioner of Japanese Patent Office* Heisei 12 (gyoke) 105 31st January 2001. It was this case in the Tokyo High Court which underlined the Japanese Patent Office policy of denying registration for "retail services" in Japan and as such Japan is the only major industrial and service economy in the world not to allow the registration of retail services under its trade mark law. Hence retailers like MUJI, TAKASHIMAYA and MITSUKOSHI, which have stores in London and New York, will have trade mark protection in the US and Europe for their retail services but not in Japan.

Japan's Legal Rationale for Denying Protection to Retail Marks

Activities conducted in correlation with and incidental to the transfer of products, while in and of themselves may be construed to be in the interests of others, are not objects of trade in the marketplace, and as such, do not correspond to the 'services' listed in the Trademark Law.

The goal of the retail service is, in the end, the sale of products, and the incidental services asserted by the plaintiff are no more than activities carried out to further the sale of products. In actuality, there is no separate price indicated or independently paid for these services, apart from the purchase price of the products, to indicate that they are independent objects of trade.⁸⁹

Later on the court stated:

Further, by the plaintiff's own admission, the International Classification of Goods based on the Nice Agreement have no restraining powers over the way they are handled by each member country.⁹⁰

This is a direct acknowledgement of the "power" given to states party to the Nice Agreement by Article 2(1) of the Agreement. This quote in itself underlines the impotence that Article 2 has given the Nice Agreement when it comes to enforcement in the name of harmonisation.

It is argued that Japan's opposition to the registration of retail marks creates a dichotomy when viewed alongside its movement to internationalise its trade mark system. Japan has adopted the Nice Agreement (1990), the Service Mark Registration System (1992), membership of WTO TRIPs agreement (1994) and has acceded to the Trade Mark Law Treaty 1997 and the Madrid Protocol 2000.

Well-known retailing brand names (e.g. Harrods) attract the public to them over other competing brands and it is strange that Japan will not protect their core activity

⁸⁹ *ESPRIT International v. Commissioner of Japanese Patent Office Heisei 12 (gyoke) 105 31st January 2001*, as quoted in Tessensohn, J. A., *Japan: Retail Services Denied Protection Under Japan's Trademark Law*, TW 145(9) (March 2002).

⁹⁰ *op. cit.*

on their own soil. Brands effectively become trade marks for the retail services comprised of the retailer's selection, range and display of goods.

However, it is easy to criticise with hindsight. Before the seminal case of *Giacomelli Sport SpA's Application*⁹¹ the UK had exactly the same stance on retail marks as Japan presently does. On 11th August 2000 the UK Registry announced that it intended to allow applications from retailers for protection of their core activity and the permissible service is:

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store.⁹²

Communication No 3/01 of the President of the Office of 12th March 2001 confirmed this position in Europe with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM).

It is worth noting an opinion that was aired concerning the harmonisation of trade mark law at the first meeting of the Committee of Experts. At the beginning of the conference there was considerable support for some degree of harmonisation but it could not be decided whether or not this should encompass both substantive and procedural trade mark law and how detailed it should be. The chairman apparently saw harmonisation as being more involved than merely finding common denominators. However, other delegates foresaw difficulties with wide spread harmonisation and for evidence looked to those difficulties already being experienced in harmonising the then twelve member states of the EEC. Indeed, the EEC Commission backed up this view and thought that allowing the substantive laws of its Member States to remain would be adequate:

The basic argument appeared to be that national systems are as they are because they suit the character and legal system of the appropriate nations.⁹³

⁹¹ [2000] ETMR 277

⁹² As quoted in Tessensohn, J. A., "Japan: Retail Services Denied Protection Under Japan's Trademark Law", *TW* 145(9) (March 2002).

⁹³ Davies I, "WIPO News: Harmonisation of Trade Mark Law", *EIPR* 1990, 12(3), D60

The Nice Agreement: Article 2

Article 2 could not afford to be too draconian in its regulatory authority as no state would have signed up to the Nice Agreement to affectively be told what to do with their existing trade mark registration provisions. The sovereignty of such states would have been severely impinged. However, perhaps Article 2 is too broad in its ambit and this is what has led to the problems with harmonisation as discussed above.

With EU Member States losing their sovereignty almost daily, and with international treaties and agreements, also affecting national sovereignty, playing a bigger role in modern political and economical society it may not be so much of an issue for the Special Union to return to Article 2 and reconsider the legal effect the Nice Classification is having on the harmonisation of trade mark registration. Perhaps if the Nice Agreement were to be revised with regard to Article 2 so that there was less freedom in the method of implementation employed by signatory states and the whole ethos behind the Agreement were to be made more enforceable then harmonisation would come more easily at a greater price to national sovereignty. The question is that in an increasing international marketplace within the confines of an economic global community is national sovereignty in trade an acceptable status quo? The desire to maintain such sovereignty appears *prima facie* to work against such a notion and therefore the answer must be that harmonisation of trade law should be the priority.

Laddie J's reasoning in *Altecnic Ltd.'s Trade Mark Application*⁹⁴, that a classification system is merely an administrative convenience, may not have been an entirely mistaken assertion. Under Article 2 of the Nice Agreement the adoption of the Nice Classification is a procedural requirement and not a substantive change to the law governing the registration of trade marks in the member states. This means that such procedural requirements, with little authoritative bite, can be seen as introducing a classification system that can be nothing more than an administrative convenience.

⁹⁴ [2001] EWCA Civ 1928; [2002] RPC 34

Canada

Canada provides an important aspect to a study of trade mark classification because it does not follow the international classification agreed upon at Nice. In fact its legislation does not apply any type of classification system to trade marks at all. Instead section 30(a) of the Canadian Trade-Marks Act sets out a requirement for:

A list “in ordinary commercial terms” of the specific wares or services in association with which the mark has been used or is proposed to be used.⁹⁵

This is the sole requirement, with the emphasis being on “specific” as it is this list which sets out the scope of the protection afforded to the trade mark upon successful registration.

There is no specific requirement under the [Canadian Trade-Marks Act] for the grouping or classification of goods or services; however, where the trademark has been used or made known, ss.30(b), (c) and (d) require certain information to be provided for each of the general classes of wares or services described in the application. The Act does not define what is meant by a general class of wares or services.⁹⁶

It is interesting to note the Canadian interpretation of the Nice Agreement and its legal effect at an international level because, as Canada is not party to the Nice Agreement, it provides the most objective consideration of it from a country with a mature economy looking from the outside in:

Pursuant to the Nice Agreement, the Nice Classification has no substantive effect and serves only administrative purposes. The only specific obligation imposed by the Agreement on contracting countries is found in Article 2(3):

“The competent Offices of the countries of the Special Union shall include in the official documents and publications relating to registrations of marks the numbers of the classes of the

⁹⁵ Bloom GA, “The Selection and Registration of Trade-marks” in *Trade-Marks Law of Canada*, Ed. Henderson GF et al., 1993, at p. 243

⁹⁶ The Canadian Trade-Marks Office, “V. Identification of Goods and Services” at http://strategis.ic.gc.ca/sc_mrks/cipo/tm/madrid_index-e.html

Classification to which the goods or services for which the mark is registered belong”.⁹⁷

This is enforced by the Trade-Mark Law Treaty, Article 9(2) of which, in the view of the Canadian Trade-Marks Office, clearly points out that the Nice Classification “has no substantive effect and only serves administrative purposes”⁹⁸:

- (a) Goods or services may not be considered as being similar to each other on the ground that, in any registration or publication by the Office, they appear in the same class of the Nice Classification.
- (b) Goods or Services may not be considered as being dissimilar from each other on the ground that, in any registration or publication by the Office, they appear in several classes of the Nice Classification.

With regard to the Madrid Protocol and its decision to remain non-party to it, with the effect that Canada is in no way obliged to adopt the Nice Classification, Canada has studied Articles 3(2) and 4(1)(b) of the Protocol⁹⁹. Particularly with Article 4(1)(b) of the Madrid Protocol in mind the Canadian Trade-Mark Office has stated that:

The purpose of classification in accordance with the Nice Classification would thus appear to be for searching and for the purpose of establishing fees.¹⁰⁰

The result of this is Canada’s conclusion that s.30(a) Canadian Trade-Marks Act “appears consistent with the Protocol”¹⁰¹. However, despite this Canada probably would not sign up to the Madrid Protocol tomorrow or any time soon, and thereby adopt the Nice Classification, as there would be disadvantages to doing so.

The Madrid Protocol provides for international applications only covering goods and services set out in the basic, or home, application or registration. Canada allows only

⁹⁷ op. cit.

⁹⁸ op. cit.

⁹⁹ These Articles are ad verbatim identical to their numerically corresponding Articles in the Madrid Agreement which have already been set out in this essay.

¹⁰⁰ The Canadian Trade-Marks Office, “V. Identification of Goods and Services” at http://strategis.ic.gc.ca/sc_mrks/cipo/tm/madrid_index-e.html

¹⁰¹ op. cit.

for a very specific list of goods and services but does provide registered trade marks with a broad ambit of protection and this would result in a loss of protection of the mark at an international level were such marks put under the Madrid Protocol. A way to avoid this could be providing a less specific list of goods and services, but without the kind of general structure that a classification system provides this could easily result in confusion and lack of knowledge as to where to draw the line.

Canada views a classification system, specifically the Nice Classification, as purely an administrative convenience and nothing more. This is perhaps most potently demonstrated by Canada's approach to trade mark searches. In 1979, it was decided by the Canadian Trade-Mark Office that searching would be greatly facilitated with the use of computer software that would allow for the automatic searching of databases. The problem to be overcome was that the classification used by the trade mark search system at the time did not accommodate the ability to search by computer. Indeed, the manual search available at the time, and still presently available, is in the Trade-Marks Office and constitutes a public search room containing an index of every trade mark registration and indexed trade mark application. The trade marks are indexed by the statute of Parliament under which the mark was registered and the current Act for pending applications, these are then indexed alphabetically and also by their constituent elements and phonetic equivalents. Owing to the impossibility of putting these indices directly onto any useful software application the Trade-Marks Office decided to classify all the goods and services as set out in the Nice Classification, which is the means of classification used by most of the applicants for registration in Canada, i.e. the Canadian traders. The use of the Nice Classification by the Trade-Mark Office was likewise just as informal and it was solely employed in facilitating the creation of a trade marks database for the searching of registrations and applications.

The United Kingdom

The United Kingdom Trade Marks Registry allows for multi-class applications under Rule 8 of the Trade Mark Rules 2000. This means that one application can cover several different classes of goods. All the classes in an application must be stated in numerical order and with each class the relevant goods or services must be listed. Rule 8(3) of the Trade Mark Rules allows for amendment of classification upon a mistake being made by the applicant, and for such an amendment to be made form TM3A must be completed. The Registrar has the final decision, under s.34(2) TMA 1994, as to the relevant class for any particular goods or services¹⁰².

A multi-class application system is administratively very useful because it cuts down on the number of applications received by the Registry. It does have its problems however. These problems arise due to the extra care that is needed in the wording of an application so that the goods or services applied for actually receive the intended scope of protection upon registration. Under Practice Amendment Notice PAN 8/02, dated 19 June 2002, it states “the present practice is to raise bad faith objections to all specifications which include a claim to ‘All goods’ or ‘all Services’ in any class”¹⁰³. A bad faith objection is set out under s.3(6) TMA 1994:

A trade mark shall not be registered if or to the extent that the application is made in bad faith.

The Registry comes to the conclusion in PAN 8/02 that s.3(6) objections will continue to be raised in all classes where a claim is made to all the goods or services listed in the class as such a description is too vague and cannot constitute a proper list of goods or services¹⁰⁴.

¹⁰² Michaels A, “Chapter 3: Practice and Procedure in the Trade Marks Registry” in *A Practical Guide to Trade Mark Law*, 1996

¹⁰³ UK Patent Office at <http://www.patent.gov.uk/tm/reference/pan/pan0802.htm>

¹⁰⁴ op. cit.

The Registry also drew attention to the “Scope of the WIPO class headings” on 13 June 2003¹⁰⁵. It points out the common misconception that a class heading, when stated in an application, automatically covers all the goods and services in that class:

As part of the Nice Classification, class headings are only intended to convey general indications as to what the classes contain.¹⁰⁶

The notice continues:

A class heading loses its function as a heading when written as “a statement of goods or services” on a trade mark application. For example, the heading of Class 15 is “Musical Instruments” but on interpretation cannot include “music stands” or “musical instrument cases” which are also in the class. Furthermore, none of the class headings mention parts and fittings.

Problems have arisen where applicants have framed specifications in terms of class headings and then subsequently sought to restrict the goods and services only to be told that they had no cover on the applications as originally filed. Therefore care should be taken in the drafting of specifications to ensure that the goods or services of prime interest are specifically listed.¹⁰⁷

The case of *Altecnic Ltd.’s Trade Mark Application*¹⁰⁸ is relevant to all that has just been related and therefore lies at the heart of the United Kingdom’s interpretation of the Nice Classification and its legal effect. A good synopsis of the case facts is provided by Jonathan Radcliffe in his article “All Mixed Up? The Court Of Appeal in *Reliance Water Controls v Altecnic*”¹⁰⁹:

Altecnic manufactures valves for hot water systems whereas Reliance Water Controls Limited supplies plumbing equipment and apparatus and specialises in under basin thermostatic mixing valves. The dispute arose over the fact that both companies use the mark CAREMIX for blending valves.

¹⁰⁵ UK Patent Office at <http://www.patent.gov.uk/tm/reference/classcurrent.htm>

¹⁰⁶ *op. cit.*

¹⁰⁷ *op. cit.*

¹⁰⁸ [2001] EWCA Civ 1928; [2002] RPC 34; also known as *Altecnic Ltd v Reliance Water Controls Ltd*

¹⁰⁹ Radcliffe J, “All Mixed Up? The Court Of Appeal In *Reliance Water Controls v Altecnic*” (September 2002) *TW* 150(32)

Altecnic applied to register CAREMIX and ALTECNIC CAREMIX as trade marks on 15 March 1997. The application form stated the marks in relation to “valves; valves for use in water circulation; blending valves; and all other goods/services in this Class” and put the class down as being class 7 on the TM3 form. Class 7 has in its list machines and machine tools. Following this, on 27 March 1997 Altecnic asked for the words “and all other goods/services in this Class” to be removed, which was allowed. Then, on 16 April 1997, an amendment to restrict the mark to just CAREMIX on its own was allowed. A month later, on 16 May 1997, Altecnic desired to have its mark removed from class 7 and put into class 11 without any change to the wording of the application. Class 11 has in its list apparatus for water supply and sanitary purposes. This final request was allowed with the Registry, upon proof of use of the mark in relation to the goods involved, stating that class 11 was in fact the appropriate class. The application then proceeded to advertisement under class 11 as CAREMIX for “valves; valves for use in water circulation; blending valves”. It was this final amendment that was argued as being ultra vires by Reliance.

Reliance had applied to register CAREMIX in class 11 on 27 March 1997. Its specification was for “regulating and safety devices and apparatus, all for water apparatus and water pipes; thermostatic valves; thermostatic water mixing valves; water blending valves; tempering valves; fail-safe valves; parts and fittings for all the aforesaid goods”.

On 6 November 1997 the Registry hearing officer held that in amending the application form TM3 from class 7 to class 11 the registry had acted ultra vires. The argument was that the class number should be taken as being part of the description of goods applied for, and valves do fall prima facie within class 7. Therefore there was in fact no inconsistency between the class number and the goods applied for that could warrant an amendment.

Following this Altecnic appealed successfully before Mr Justice Laddie, who allowed the application to proceed to class 11. Laddie J held that a change in class was legal use of the Registrar’s powers under s.34 TMA 1994 and in so doing stated that classification was primarily a matter of administrative convenience, the classes

being “convenient, but loosely defined, pigeon holes into which applications can be put”¹¹⁰, and that the Registrar’s decision under s.34 TMA 1994 was a matter of discretion and could only be challenged if deemed irrational, thereby removing the chance of any opposition brought under a case for s.39 TMA 1994 amendment. Section 39(2) TMA 1994 states that an amendment can only be allowed where “the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application”.

Reliance obtained leave to appeal and take the case to the Court of Appeal, Lord Justice Aldous making the point that important issues had been raised concerning applications for trade marks and that the difference between the opinions of the trial judge and the registrar had to be settled.

In December 2001 the Court of Appeal overturned the judgement of Laddie J having heard the arguments of both sides and having access to the practices of the UK Registry and the Office for Harmonisation in the Internal Market.

Reliance put forward the argument that the classification of goods is not simply a matter of convenience but in fact:

Determines the scope of the rights conferred by the mark, which is crucial for infringement actions; and
Imposes an obligation on the proprietor of the mark in relation to those goods.¹¹¹

In response, Altecnic thought that a class number only takes on specific importance in that it is expressly, or impliedly, stated in the description of the specification of the goods. Added to this was the assumption that the class itself does not constitute a part of the application for a trade mark:

He [Mr. Purvis, acting for Altecnic] emphasised that the classes of goods varied greatly in terms of generalisation, were not by definition mutually exclusive and were neither precise nor logical.

¹¹⁰ *Altecnic Ltd.’s Trade Mark Application* [2002] RPC 34 at para. 21, as quoted in Radcliffe J, “All Mixed Up? The Court Of Appeal In *Reliance Water Controls v Altecnic*” (September 2002) *TW* 150(32)

¹¹¹ Radcliffe J, “All Mixed Up? The Court Of Appeal In *Reliance Water Controls v Altecnic*” (September 2002) *TW* 150(32)

They had always been treated as a matter of administrative convenience only.¹¹²

Despite this argument that such “an arbitrary administrative system should not be elevated to a position where it can control the scope of trademarks and has a substantive impact”¹¹³ the Court of Appeal found for Reliance. The case was largely decided around s.39 TMA 1994 and this is the only section of the Act that specifically deals with the amendment of applications.

In response to Reliance’s objection that moving Altecnic’s mark into class 11 would extend the goods covered by the application, thereby contravening s.39(2) TMA 1994, Altecnic argued that:

Reliance was misconceived in its submissions on section 39 as restricting the power of the registrar to amend an application by changing the class of goods. The change of class of goods in this case had no effect on the scope of the mark applied for, as the class was not referred to in the specification of goods. The request therefore was not an application under section 39 to amend the application to register and was not subject to the restrictions on the amending power in that section. It was a request to the registrar to exercise his own power under section 34 in a particular way.¹¹⁴

Having considered these arguments the Court of Appeal ruled:

The fact that the system of classes of goods is for the purposes of administrative convenience or that the identification of a Class number serves such purposes does not prevent the statement of the Class number from being part of the application, which can only be amended in accordance with the provisions of the 1994 Act and the Rules.¹¹⁵

Following on from this, Altecnic’s letter of request to change the mark from class 7 to class 11 was in fact asking for an amendment, which under s.39 TMA 1994 does not appear as an allowable change to the application. Obvious mistakes are allowed

¹¹² *Altecnic Ltd.’s Trade Mark Application* [2001] EWCA Civ 1928, Mummery LJ at para. 37

¹¹³ Radcliffe J, “All Mixed Up? The Court Of Appeal In *Reliance Water Controls v Altecnic*” (September 2002) *TW* 150(32)

¹¹⁴ *Altecnic Ltd.’s Trade Mark Application* [2001] EWCA Civ 1928, Mummery LJ at para. 38

¹¹⁵ *op. cit.*, Mummery LJ at para. 41

to be amended under s.39(2) TMA 1994, however the Court of appeal went even further and refused to see the application for class 7 as an obvious mistake because valves do prima facie fit in this class. Therefore the mistake could not be apparent just from the application form and so it was held to be a genuine but not an obvious mistake, resulting in any amendment to the application being effectively ultra vires.

The case is clearly of importance to applicants so they know the scope of their applications and the extent to which amendments can be made. It is of importance to third parties so they can establish their position with some degree of accuracy by making searches against prior marks...Finally, as the Registry itself acknowledges, it is important for the procedure at the Registry to be clarified.¹¹⁶

This means that the classification of trade marks is much more than an administrative convenience, within the confines of this case at least, it is in fact a substantive tool that limits and delineates the effective use and protection provided, by substantive law, to trade marks at as early a stage in the registration process as initial application.

The conclusions drawn from *Altecnic Ltd.'s Trade Mark Application*¹¹⁷ are supported by precedent in the case of *British Sugar PLC v James Robertson and Sons*¹¹⁸. British Sugar had trade marked the word “treat” under Class 30 for use on its product, a dessert sauce and syrup for ice-cream:

“Treat” is registered under No. 1516087. The specification of goods is: “Dessert sauces and syrups; all included in Class 30.”¹¹⁹

The point of contention arose when Robertson began using the same word in relation to its new product which was marketed as a spread.

Upon the introduction of Robertson’s spread it was to be found in supermarkets with other jams and preserves, whereas the British Sugar product was located near to the ice-cream section and with other ice-cream toppings available. Despite this British

¹¹⁶ Radcliffe J, “All Mixed Up? The Court Of Appeal In *Reliance Water Controls v Altecnic*” (September 2002) *TW* 150(32)

¹¹⁷ [2001] EWCA Civ 1928; [2002] RPC 34

¹¹⁸ [1996] RPC 281

¹¹⁹ *op. cit.* at p. 3

Sugar argued that the Robertson product was in direct competition with them as a dessert sauce or syrup based on the small print on the back of the Robertson jar:

Toffee Treat is delicious at breakfast, with desserts or as a snack anytime. Spread Toffee Treat on bread, toast or biscuits, spoon it over yoghurt or ice-cream or use as a filling for cakes.¹²⁰

The reasoning followed the line that because Robertson actually suggested, and therefore positively encouraged, its product to be used on desserts then, in this context, it was a sauce.

Jacob J rejected this argument as the use of the Robertson spread with dessert was not going to constitute a great percentage of its actual use given the variety of products it could be associated with. He highlights the fact in the case that the Robertson product is sold in a jam jar because it is like a jam¹²¹ whereas the British Sugar product is in a squeezable plastic bottle designed for pouring, as opposed to spreading¹²²:

When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade.¹²³

Jacob J followed up this observation with a discussion of the words used in British Sugar's registration: *included in Class 30*. He begins by stating that:

Under the Trade Marks Acts goods and services are divided into a series of classes. The main purpose of the classes is to enable trade mark searching to be carried out...

...Generally there is no difficulty in identifying which class is relevant for a particular article. But borderline cases are not infrequent. For these the Registrar often uses the practice of describing goods or services and adding the words *included in this Class* or *included in Class X*. He did that here. The effect of this is to confine the specification to goods which fall within the

¹²⁰ op. cit. at p. 5

¹²¹ op. cit. at p. 6

¹²² op. cit. at p. 2

¹²³ op. cit. at p. 6

description and which also were, at the time of registration, put in that class by the Registrar.¹²⁴

Jacob J concluded his brief introduction to classification with the fact that British Sugar had failed in providing evidence to show that the Robertson product could at any time be put in Class 30, given that jellies and jams are within Class 29:

Confirmation is provided by the fact that it is the Registrar's current view that the Robertson product falls within Class 29 and there is no evidence suggesting that there has been a change of practice since 1992 when the British Sugar was registered.¹²⁵

Section 10 TMA 1994 sets out exactly what constitutes infringement of a trade mark in the various circumstances under which it can arise:

10(1) A person infringes a registered trade mark if he uses in the course of trade a sign which is *identical* with the trade mark in relation to goods or services which are *identical* with those for which it is registered.

10(2) A person infringes a registered trade mark if he uses in the course of trade a sign where because—

(a) the sign is *identical* with the trade mark and is used in relation to goods or services *similar* to those for which the mark is registered, or

(b) the sign is *similar* to the trade mark and is used in relation to goods or services *identical with or similar to* those for which the trade mark is registered,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark. (Emphasis added)

Upon answering the question as to whether s.10(1) applies to the case Jacob J states:

On my finding about the specification of goods this question does not arise.¹²⁶

and

¹²⁴ op. cit. at pp. 6 & 7

¹²⁵ op. cit. at p. 7

¹²⁶ op. cit. at p. 11

I think, if I am wrong on classification, that the use is within s.10(1).¹²⁷

These statements are followed by:

Because “Treat” is the very mark registered and is clearly used by Robertson’s I think the case falls to be considered under s.10(2)(a), the identical mark/similar goods provision.¹²⁸

Having discussed infringement under s.10(2)(a) Jacob J went on to broach the issues of a defence for Robertson under s.11(2) TMA 1994 and the validity of British Sugar’s registration before concluding that it was invalid under s.47(1) TMA 1994 as it lacked distinctive character.

This case sees Jacob J beginning with the assertion that the primary role of classification is administrative and then going on to using the classification boundaries to determine the scope and use of s.10 TMA 1994. Had British Sugar not put the words “included in Class 30” in its specification then the scope of protection given to its trade mark might not have been so limited in its interpretation and the case might have been decided in British Sugar’s favour under s.10(1) without recourse to the questions of customer confusion and association that s.10(2) entails. Jacob J himself provided an example of the limiting effect of the extra words:

Thus in *GE TM* ([1969] RPC 418 at p. 458-459) Graham J held that a registration for “Electrical machinery included in this Class” did not cover electrical switchgear: even though it was admittedly electrical machinery it was not at the time of registration put in the class concerned.¹²⁹

¹²⁷ op. cit. at p. 11

¹²⁸ op. cit. at p. 12

¹²⁹ op. cit. at p. 7

Conclusion

The case of *Altecnic Ltd.'s Trade Mark Application* saw Laddie J's decision overturned before the Court of Appeal. However, the Court of Appeal did not definitively reject Laddie J's idea of classification function:

The fact that the internationally agreed Nice Classification System has been devised to "serve exclusively administrative purposes" (see, for example, rule 2(4) of the Commission Regulation 2868/95 E.C.) does not mean that the selection by the applicant of one or more Class numbers in his application for registration has to be totally ignored in deciding, as a matter of the construction of the application, what the application is for and whether it can be properly amended.¹³⁰

An appeal was allowed for Altecnic's case to be considered before the House of Lords but the parties settled before the case could be brought at the beginning of 2003. This means that there can be no definitive and final answer regarding the correctness of Laddie J's assertion. However, the context of the case of *Altecnic Ltd.'s Trade Mark Application*¹³¹ can be distinguished from the more general context of the Nice Agreement.

It is the conclusions of this essay that:

The history of classification explains how a classification system for trade marks came to be a viable and necessary entity and that this is very closely associated with the development of trade marks as a legal entity in their own right. This means that there must be more to placing trade marks into classes than at first meets the eye of the orderly mind.

In studying the Nice Classification as an international entity Laddie J can be seen to be correct in his assertion that such a classification is purely an administrative convenience, and is in fact designed to work as such for better or for worse.

¹³⁰ *Altecnic Ltd.'s Trade Mark Application* [2001] EWCA Civ 1928, Mummery LJ at para. 42. See also quote from para. 41 of the judgement as cited above at note 95.

¹³¹ [2001] EWCA Civ 1928

However, when this so called convenience is put into practice by a country, such as the UK, the classification boundaries invariably take on a whole new significance depending on how much authority is given to their interpretation upon application for registration. This is ironically also true in the case of Canada, which, in having chosen not to adopt the Nice Classification in any formal sense, has in fact underlined the potential substantive effects of such a procedural instrument.

In effect Laddie J created a confusing paradox by applying the correctly perceived rationale and legal effect of an international agreement at a national level. Although the actual Nice Classification can be literally transferred directly into national legislation ad verbatim, the Agreement behind the Classification, which sets out its rationale and legal effect, does not and cannot be literally translated into the laws of individual nations with any kind of meaningful result. The Nice Classification was designed to assist international trade mark applications and provide them with international recognition and not to dictate the understanding of national laws to its member states. So in conclusion Laddie J was correct in his assertion that the classification of trade marks is an administrative convenience, but wrong to apply it to the principles of national registration of trade marks in the context that he did.

This conclusion can be applied in a broader sense with regard to the three possible, mutually exclusive, positions on the classification of trade marks (the table on p. 4 has been reproduced here for ease of reference):

	Function	Legal Status
1	Classification is a procedural requirement only and should not determine substantive issues in the registration process.	The indexing and searching of applications and registrations is facilitated on a national and international level.
2	Classification boundaries determine the amount of similarity between trade marks, with regard to the goods and services to which they are applied, in cases of potential confusion (as in position 2 in the previous table).	Well-known trade marks are given protection from identical or similar marks in different classes as well as those in the same class.
3	Classification has the same rationale as substantive trade mark law: At a national level classification and the law developed together and at an international level the objective is one of harmonisation.	The choice of classes in an application for registration, and in the registration itself, <i>determines in all cases</i> the scope of protection afforded to the trade mark, and the class specification and boundaries are perceived as black letter law.

The history of classification demonstrates how it developed directly alongside substantive trade mark law, and therefore they could be said to share objectives and a rationale. This is clearly supportive of the third position as outlined above.

A study of Canadian trade mark registration, on the other hand, clearly shows that Canada falls under the first position on the table with regard to the function and legal status of classification.

A study of the Nice Agreement in respect of the three stances on classification is not as straightforward. This is because the rationale of the Nice Agreement has not been truly reflected in its product, the Nice Classification. Prima facie, the contents of the Nice Agreement puts it firmly under the first position, i.e. even a black-letter law approach would have to treat it as a purely procedural provision. However, the rationale of the Nice Agreement, that of harmonisation, asks for it to be considered under the third position. In reality the Nice Agreement exists under the first position at an international level and the Nice Classification sits nearer to the third position at a national level. This has to be the case because the concept of harmonisation is something that has to be physically enacted in the real world in order to mean anything. The idea of harmonisation in itself and on its own achieves nothing but an

unattainable utopia. The dichotomy that exists between the Nice Agreement and its classification system is therefore enhanced by the practical striving of nation states towards harmonisation under a classification system without substantive guidelines.

In the void created by this lack of substantive law, economic rationale and a common sense approach to justice were required to fill the gap at a national level. This approach recognised dilution theory in a system of law, the substantive authority of which was directly derived from its history. This explains why the second position on the table is so much closer to the third stance than the first. The countries that have embraced the Nice Classification, because of the lack of substantive law to guide them, have placed the classification system in line with their own substantive trade mark law and its rationale. However, because harmonisation still remained the objective they could not totally place themselves within the third position as, ironically, this would never achieve harmonisation without the guidance of substantive law to that particular end.

The result is that most countries, such as the UK, Mexico, Turkey and Japan could be described as adhering to the second position regarding trade mark classification as a part of their substantive trade mark law. The only other option available to countries is the one taken by Canada, which is not to get involved with a classification system for trade marks, but this in itself reflects the issues for those countries that have chosen to adopt the Nice Classification.

In conclusion, no country that utilises the Nice Classification as intended by the Nice Agreement can put itself in the third position without international guidance to that end, as this would defy the rationale of harmonisation set out in the Agreement and its parent Treaties. However, in striving towards harmonisation these countries have tried to get as close as they can to the third position whilst paying homage to the laws of justice and the market place. This is not such a surprising resort given the amount of influence available to large multinationals which are always looking to diversify and corner a new niche in the market. These companies stand to benefit the most from a wholesale acceptance of dilution theory and they are large enough to exert themselves on economic policy. In such an environment, Laddie J will not have been

the only person in legal history to confuse the international and national aspects of the paradox that is the Nice Classification.

Appendix A

Date	Title of Treaty and Location of Revisions			
20/3/1883	Paris Convention			
14/4/1891		Madrid Agreement		
14/12/1900	Brussels	Brussels		
2/6/1911	Washington	Washington		
6/11/1925	The Hague	The Hague		
2/6/1934	London	London		
15/6/1957		<i>Nice</i>	Nice Agreement	
31/10/1958	Lisbon			
14/7/1967	Stockholm	Stockholm	Stockholm	
1977			Geneva	
27/6/1989				Madrid Protocol

The location of the Treaty revisions and their dates clearly show the interdependency of the Treaties, the relationships between which are demonstrated by the arrows; the Treaties at the bottom of the table are dependant on those higher up. The exception to this being that between the Nice Agreement and the Madrid Protocol, as both derive directly from the Madrid Agreement. The Madrid Agreement makes abiding by the Nice Agreement compulsory, as does the Madrid Protocol, which was brought into

being for the sole purpose of making the Madrid Agreement more acceptable to more countries. However, the Nice Agreement was conceived by the Madrid Agreement before the Madrid Protocol and so there exists a direct interdependency between the Nice Agreement and the Madrid Protocol (hence the two-way arrow in the table), i.e. The Madrid Protocol had to make the implementation of the Nice Agreement compulsory because it was designed to reflect the Madrid Agreement in better terms, however, this means that to some extent the Madrid Protocol must also be designed to make the Nice Agreement more acceptable and widely used. For example, Canada will not sign up to the Madrid Protocol because it will mean that as a country it will have to adopt the Nice Agreement, and therefore the Nice Classification. Although this is a negative example it demonstrates quite clearly how the Madrid Protocol can not be considered without the Nice Agreement and vice versa.

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Abbreviations

BIRPI	United International Bureau for the Protection of Intellectual Property
CTM	Community Trade Mark
OAPI	African Intellectual Property Organisation
OHIM	Office for Harmonisation in the Internal Market (Trade Marks and Designs)
TMA	Trade Marks Act (1994)
TRIPS	Trade-related Aspects of Intellectual Property Rights (TRIPS Agreement 1994)
WIPO	World Intellectual Property Organisation
WTO	World Trade Organisation