



Neutral Citation Number: [2020] EWHC 990 (Ch)

Case No: HC-2016-001587

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS
INTELLECTUAL PROPERTY LIST (CHANCERY DIVISION)

Rolls Building
Fetter Lane, London, EC4A 1NL

Date: 29 April 2020

Before :

LORD JUSTICE ARNOLD

Between :

(1) SKY PLC
(2) SKY INTERNATIONAL AG
(3) SKY UK LIMITED

Claimants

- and -

(1) SKYKICK UK LIMITED
(2) SKYKICK INC

Defendants

Geoffrey Hobbs QC and Philip Roberts QC (instructed by **Mishcon de Reya LLP**) for the
Claimants

Simon Malynicz QC, Tom Hickman QC and Stuart Baran (instructed by **Fieldfisher LLP**)
for the **Defendants**

Approved Judgment

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic.

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LORD JUSTICE ARNOLD

Lord Justice Arnold :

Introduction

1. On 6 February 2018 I handed down my judgment following the trial of these proceedings ([2018] EWHC 155 (Ch), [2018] RPC 5, “the Main Judgment”). For the reasons given in that judgment, I concluded that it was necessary to refer five questions to the Court of Justice of the European Union in order to resolve some of the issues between the parties, although I was able to determine a number of other issues. On 27 April 2018 I handed down a second judgment dealing with certain matters arising out of the Main Judgment, in particular an application by Sky for reconsideration and/or amplification of aspects of the Main Judgment ([2018] EWHC 943 (Ch), [2018] RPC 12, “the Second Judgment”), and I made the order for the reference. An application for permission to appeal against that order was dismissed by the Court of Appeal on 30 July 2018 for reasons given on 6 September 2018 ([2018] EWCA Civ 2004, [2019] RPC 3).
2. In order to shorten this judgment, I will assume that the reader is familiar with the Main Judgment and the Second Judgment and I will continue to use the same defined terms as in those judgments. It may nevertheless be of assistance if I recapitulate the following points.
3. First, as noted in the Main Judgment at [6], for the purposes of their infringement claim under Article 9(2)(b) of the Regulation/Article 10(2)(b) of the Directive, Sky relied at trial upon the registrations of the Trade Marks in respect of the following goods and services (“the Selected Goods and Services”):
 - i) computer software (Class 9);
 - ii) computer software supplied from the internet (Class 9);
 - iii) computer software and telecoms apparatus to enable connection to databases and the internet (Class 9);
 - iv) data storage (Class 9);
 - v) telecommunications services (Class 38);
 - vi) electronic mail services (Class 38);
 - vii) internet portal services (Class 38); and
 - viii) computer services for accessing and retrieving information/data via a computer or computer network (Class 38).
4. Secondly, SkyKick contended that the Trade Marks were wholly or partly invalidly registered on the grounds that (i) the specifications of goods and services lacked clarity and precision and (ii) the applications were made in bad faith. I was not able to reach a final conclusion in relation to these contentions due to the legal issues which formed the subject of the reference, but I did make relevant findings of fact.

5. Thirdly, I concluded that, if the Trade Marks were validly registered in relation to the Selected Goods and Services, then SkyKick had infringed them pursuant to Article 9(2)(b) of the Regulation/Article 10(2)(b) of the Directive unless SkyKick could rely upon the own name defence, but I went on to conclude that SkyKick could not rely upon that defence.
6. Fourthly, I concluded that, absent a likelihood of confusion, Sky's case under Article 9(2)(c) of the Regulation/Article 10(2)(c) of the Directive was not made out. In other words, the paragraph (c) case added nothing to the paragraph (b) case.
7. Fifthly, I dismissed Sky's claim for passing off.
8. On 29 January 2020 the CJEU handed down its judgment on the reference in Case C-371/18 ([EU:C:2020:45], [2020] ETMR 24). Although a hearing had been arranged for further argument on the outstanding issues in the light of the CJEU's judgment on 2 April 2020, in the light of the Covid-19 pandemic the parties sensibly agreed to dispense with oral argument and to confine themselves to written submissions.
9. Although I have read and considered all of the written submissions filed by the parties with care, I do not intend to address all of them in this judgment. Even leaving aside submissions concerning two applications by SkyKick which were withdrawn, some of the submissions concern points which are no longer live following the CJEU's ruling and some amount to attempts to re-argue points which were decided in the Main Judgment.

The questions referred to the CJEU

10. The questions which I referred to the CJEU were as follows:

- “(1) Can an EU trade mark or a national trade mark registered in a Member State be declared wholly or partially invalid on the ground that some or all of the terms in the specification of goods and services are lacking in sufficient clarity and precision to enable the competent authorities and third parties to determine on the basis of those terms alone the extent of the protection conferred by the trade mark?
- (2) If the answer to question (1) is yes, is a term such as ‘computer software’ too general and covers goods which are too variable to be compatible with the trade mark's function as an indication of origin for that term to be sufficiently clear and precise to enable the competent authorities and third parties to determine on the basis of that term alone the extent of the protection conferred by the trade mark?
- (3) Can it constitute bad faith simply to apply to register a trade mark without any intention to use it in relation to the specified goods or services?
- (4) If the answer to question (3) is yes, is it possible to conclude that the applicant made the application partly in good faith and partly in bad faith if and to the extent that the applicant had an intention to use the trade mark in relation to some of the specified goods or services, but no

intention to use the trade mark in relation to other specified goods or services?

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

The CJEU's rulings

11. The CJEU's rulings were as follows:

- “1. Articles 7 and 51 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, as amended by Council Regulation (EC) No 1891/2006 of 18 December 2006, and Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that a Community trade mark or a national trade mark cannot be declared wholly or partially invalid on the ground that terms used to designate the goods and services in respect of which that trade mark was registered lack clarity and precision.
2. Article 51(1)(b) of Regulation No 40/94, as amended by Regulation No 1891/2006, and Article 3(2)(d) of First Directive 89/104 must be interpreted as meaning that a trade mark application made without any intention to use the trade mark in relation to the goods and services covered by the registration constitutes bad faith, within the meaning of those provisions, if the applicant for registration of that mark had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark. When the absence of the intention to use the trade mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that application constitutes bad faith only in so far as it relates to those goods or services.
3. First Directive 89/104 must be interpreted as not precluding a provision of national law under which an applicant for registration of a trade mark must state that the trade mark is being used in relation to the goods and services in relation to which it is sought to register the trade mark, or that he or she has a bona fide intention that it should be so used, in so far as the infringement of such an obligation does not constitute, in itself, a ground for invalidity of a trade mark already registered.”

Validity of the Trade Marks: clarity and precision

12. It is clear from the CJEU's first ruling that the Trade Marks cannot be declared wholly or partly invalid on the ground that their specifications are lacking in clarity or precision. It follows that that part of SkyKick's counterclaim must be dismissed.

Validity of the Trade Marks: bad faith

13. SkyKick accept that, in the light of the CJEU’s second ruling, the Trade Marks can only be declared invalid in relation to those goods and/or services in respect of which the Court finds that the applications were made in bad faith, and not totally invalid. Apart from that, there is a substantial dispute between the parties as to the consequences which flow from applying the CJEU’s statement of the law to the facts found in the Main Judgment.
14. In considering this dispute, it is necessary for me to start by acknowledging an important point which I appear partly to have overlooked in the Main Judgment at [251] and [257]. This is that SkyKick did not allege that the Trade Marks had been applied for in bad faith in relation to two of the Selected Goods and Services, namely “telecommunications services” and “electronic mail services”. (SkyKick nevertheless contended that the Trade Marks were wholly invalid, but that was on the basis of their argument that bad faith in relation to some goods and services tainted the whole registration.)
15. Faced with this difficulty, SkyKick sought permission in their submissions in reply to amend their case to allege bad faith in relation to “telecommunications services” and “electronic mail services”. Unsurprisingly, this application was opposed by Sky. In my judgment it is far too late for SkyKick to seek to raise this allegation now. As Sky point out, bad faith is a serious allegation which must be distinctly pleaded and proved. Sky cannot be deprived of the opportunity of adducing evidence to answer such an allegation, which is the effect of what SkyKick are proposing. The only alternative would be to have a second trial on these issues, but SkyKick do not suggest taking that course and in any event to do so would in my view amount to an abuse of process. I would add that, in the case of “electronic mail services”, the allegation is a hopeless one anyway. Moreover, in the case of “telecommunications services”, it would not, for reasons that will appear, assist SkyKick even if they were successful in cutting down the scope of this term.
16. Given the consequences that this point has for the infringement case, as explained below, I propose to deal with the remaining issues under this head relatively briefly.
17. The next question to address is whether SkyKick have established that the Trade Marks were applied for in bad faith to any extent at all. Sky contend that, in the light of the CJEU’s ruling, the answer to this question is no. SkyKick contend that the answer is yes.
18. In considering these contentions, it is necessary to set out more fully what the CJEU said in the relevant part of its judgment:
 - “74. The Court has held that in addition to the fact that, in accordance with its usual meaning in everyday language, the concept of ‘bad faith’ presupposes the presence of a dishonest state of mind or intention, regard must be had, for the purposes of interpreting that concept, to the specific context of trade mark law, which is that of the course of trade. In that regard, the EU rules on trade marks are aimed, in particular, at contributing to the system of undistorted competition in the European Union, in which each undertaking must, in order to attract and retain

customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin (judgment of 12 September 2019, *Koton Mağazacılık Tekstil Sanayi ve Ticaret v EUIPO*, C-104/18 P, EU:C:2019:724, paragraph 45 and the case-law cited).

75. Consequently, the absolute ground for invalidity referred to in Article 51(1)(b) of Regulation No 40/94 and Article 3(2)(d) of First Directive 89/104 applies where it is apparent from relevant and consistent indicia that the proprietor of a trade mark has filed the application for registration of that mark not with the aim of engaging fairly in competition but with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties, or with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, in particular the essential function of indicating origin recalled in the previous paragraph of the present judgment (judgment of 12 September 2019, *Koton Mağazacılık Tekstil Sanayi ve Ticaret v EUIPO*, C-104/18 P, EU:C:2019:724, paragraph 46).
 76. Admittedly, the applicant for a trade mark is not required to indicate or even to know precisely, on the date on which his or her application for registration of a mark is filed or of the examination of that application, the use he or she will make of the mark applied for and he or she has a period of 5 years for beginning actual use consistent with the essential function of that trade mark (see, to that effect, judgment of 12 September 2019, *Deutsches Patent- und Markenamt (#darferdas?)*, C-541/18, EU:C:2019:725, paragraph 22).
 77. However, as the Advocate General observed in point 109 of his Opinion, the registration of a trade mark by an applicant without any intention to use it in relation to the goods and services covered by that registration may constitute bad faith, where there is no rationale for the application for registration in the light of the aims referred to in Regulation No 40/94 and First Directive 89/104. Such bad faith may, however, be established only if there is objective, relevant and consistent indicia tending to show that, when the application for a trade mark was filed, the trade mark applicant had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark.
 78. The bad faith of the trade mark applicant cannot, therefore, be presumed on the basis of the mere finding that, at the time of filing his or her application, that applicant had no economic activity corresponding to the goods and services referred to in that application.”
19. The key findings of fact in the Main Judgment were as follows:

- “250. The conclusion I draw from Mr Tansey’s evidence is that, at the dates of applying for the Trade Marks, Sky did not intend to use the Trade Marks in relation to all of the goods and services covered by the specifications. Sky were already using the Trade Marks in relation to some of the goods and services; Sky had concrete plans for using the Trade Marks in relation to some other goods and services; and Sky had a reasonable basis for supposing that they might wish to use the Trade Marks in the future in relation to some further goods. But the specifications include goods and services in respect of which Sky had no reasonable commercial rationale for seeking registration. I am forced to conclude that the reason for including such goods and services was that Sky had a strategy of seeking very broad protection of the Trade Marks regardless of whether it was commercially justified.
251. It is important to note that the specifications included goods and services in relation to which I find that Sky had no intention to use the Trade Marks in three different ways. First, the specifications included specific goods in relation to which I find that Sky no intention to use the Trade Marks at all. Examples of this are ‘bleaching preparations’ (Class 3, EU992 and UK604), ‘insulation materials’ (Class 17, EU992 and UK604) and ‘whips’ (Class 18, EU352, EU619, EU992 and UK604). Secondly, the specification included categories of goods and services that were so broad that Sky could not, and did not, intend to use the Trade Marks across the breadth of the category. The paradigm example of this is ‘computer software’ in EU112, EU992 and UK604, but there are others Thirdly, the specifications were intended to cover all of the goods and services in relevant classes. For example, the Class 9 specifications, including the Class 9 specifications in EU352 and EU619, were intended to cover not just any computer software, but a great deal more besides. ...”
20. In addition, in the case of UK604, I found that Sky plc’s section 32(3) declaration was partly false: see the Main Judgment at [254].
21. In my judgment Sky applied for the Trade Marks partly in bad faith in each of the three ways referred to in the Main Judgment at [251]. Not merely did they not intend to use the Trade Marks in relation to some goods and services covered by the specifications at the application dates, but there was no foreseeable prospect that they would ever intend to use the Trade Marks in relation to such goods and services. Moreover, Sky made the applications pursuant to a deliberate strategy of seeking very broad protection of the Trade Marks regardless of whether it was commercially justified. Sky thus applied for the Trade Marks with the intention of obtaining an exclusive right for purposes other than those falling within the functions of a trade mark, namely purely as a legal weapon against third parties, whether in threats of infringement claims or actual infringement claims or oppositions to third party applications for registration (as to which, see also the Main Judgment at [69]-[72]).
22. In the case of UK604, there is the additional factor that Sky made a partly false section 32(3) declaration in order to obtain such protection. That is plainly inconsistent with honest practices in industrial and commercial matters, and thus strengthens the conclusion that, to that extent, Sky made that application in bad faith.

23. The next question is what should be done about the Selected Goods and Services other than “telecommunications services” and “electronic mail services” in the light of the foregoing conclusions.
24. It is convenient once again to start with “computer software” in Class 9. SkyKick’s primary contention is that, given that I have concluded that Sky acted in bad faith in the second way identified in the Main Judgment at [251], it follows that the Trade Marks should be declared invalid in so far as they are registered for “computer software”. In my judgment, this does not follow. The fact that Sky did not intend to use the Trade Marks across the breadth of this category of goods does not mean that they did not intend to use the Trade Marks in relation to any computer software. On the contrary, I made findings in the Main Judgment that Sky had actually used the Trade Marks in relation to some kinds of software.
25. In the alternative, SkyKick contend that the Court should adopt a similar approach to that adopted in the context of revocation for non-use (as to which, see *Merck KGaA v Merck Sharp Dohme Corp* [2017] EWCA Civ 1834, [2018] ETMR 10 at [242]-[249]). In my judgment, however, there is a significant difference between the Court’s tasks in the two contexts. In the non-use context the Court’s task is to devise a fair specification having regard to the use of the trade mark during the relevant period which has been established by the proprietor (on whom the burden of proving use rests). In this context the Court’s task is to determine the extent to which it is necessary to cut down the specification having regard to the bad faith of the trade mark proprietor which has been established by the opposing party (on whom the burden of proving bad faith rests). To the extent that bad faith is not proved, then the specification must be left alone. Subject to that, I accept that there is a similarity between the two tasks, in that the Court must consider in both cases the extent to which a broad category of goods or services embraces subcategories which are, as Kitchin LJ put it in *Merck*, “capable of being viewed independently”, and thus fall to be separately considered.
26. On their alternative argument, SkyKick propose that “computer software” should be cut down to the following goods:

“application software enabling access to audio-visual content live or on demand on a mobile or desktop computer device; software for uploading and securely storing, organising, printing, viewing and sharing photographs, music, video and document files between devices; software for presenting audio-visual content programming; software for set top boxes; software for the purposes of sending and receiving emails; software for the purposes of instant messaging; software for the purposes of downloading or streaming music; electronic calendar software; software for monitoring or securing broadband connections”.
27. Sky resist “computer software” being cut down at all, and they criticise the wording proposed by SkyKick, but they have not proposed any more limited specification of their own even by way of a fall-back position despite having had the opportunity to do so. It follows that I am compelled to reach a conclusion without the assistance which could have been provided if Sky had proposed a more limited specification.
28. I consider that bad faith has been proved in so far as Sky applied to register the Trade Marks for “computer software” as part of their strategy without any commercial

justification. The main problem with SkyKick's proposed wording, however, is that it is explicitly (although Sky say inaccurately) based upon my findings as to the use which Sky have actually made of the Trade Marks, and no doubt for that reason it is quite specific. But it does not follow that Sky had no commercial justification for seeking protection wider than their actual use. On the contrary, it is well established that trade mark proprietors have a legitimate interest in seeking protection in respect of goods or services in relation to which they may wish to use the trade mark in question in future. Furthermore, as the non-use cases show, even in that context proprietors also have a legitimate interest in seeking a modest penumbra of protection extending beyond the specific goods and services in relation to which use had been proved (but not to distinct categories or subcategories of goods and services).

29. In the absence of any alternative proposal from Sky, I must do the best I can to devise a specification which reflects the extent of the bad faith proved, but no more. The conclusion I have reached is that the Trade Marks should be declared invalid in relation to "computer software" except for the following:

"computer software supplied as part of or in connection with any television, video recording or home entertainment apparatus or service; computer software supplied as part of or in connection with any telecommunications apparatus or service; electronic calendar software; application software for accessing audio, visual and/or audio-visual content via mobile telephones and/or tablet computers; games software".

30. I am conscious of the fact that the first two parts of this wording could be said to be somewhat imprecise, but I have not been able to devise more precise wording which gives Sky fair protection. I should explain that I consider that telephony, broadband, wifi, email and instant messaging are all embraced by "telecommunications". Although it might be argued that "electronic calendar software" and "application software for accessing audio, visual and/or audio-visual content via mobile telephones and/or tablet computers" would be covered by "computer software supplied ... in connection with ... any telecommunications ... service", I have included them separately in order to make sure that they are covered. Although it does not appear to me that Sky have supplied, or intended to supply, games software as a good, rather than as a service, I consider that they cannot be accused of bad faith in seeking protection for it as a good as well.
31. Turning to "computer software supplied from the internet" in Class 9, this should be limited in the same way as "computer software". As for "computer software and telecoms apparatus to enable connection to databases and the internet" in Class 9, this should be limited to "computer software and telecoms apparatus to enable connection to databases of audio, visual and/or audiovisual content and documents; computer software and telecoms apparatus to enable connection to the internet". This involves some duplication of my revised specification for "computer software", but that is justifiable to ensure proper protection for Sky. Similarly, "data storage" in Class 9 should be limited to "storage of audio, visual and/or audio-visual content and documents".
32. In the case of "internet portal services" in Class 38, I do not consider that any limitation is required.

33. As for “computer services for accessing and retrieving information/data via a computer or computer network” in Class 38, this should be limited to:
- “computer services for accessing and retrieving audio, visual and/or audio-visual content and documents via a computer or computer network”.
34. The final question under this heading is what to do about the specifications of the Trade Marks in so far as they extend beyond the Selected Goods and Services. SkyKick point out that it was only shortly before the trial that Sky focused their paragraph (b) infringement claim on the Selected Goods and Services and that even now Sky have not formally abandoned or withdrawn their claim for infringement of other parts of the Trade Marks. In those circumstances there is clearly an argument for determining the validity of the other parts of the Trade Marks. On the other hand, there does not appear to be any practical need to do so from SkyKick’s perspective in circumstances where Sky are not actively pursuing their infringement claim based on the other parts of the Trade Marks. That would be consistent with the view that national trade mark courts only have jurisdiction to entertain counterclaims to claims for infringement of EU trade marks where the counterclaims are defensive in nature (as to which, see *Adobe Systems Inc v Netcom Distributors* [2012] EWHC 1087 (Ch), [2013] FSR 5).
35. In those circumstances I shall give Sky seven days from the date on which this judgment is handed down in which formally to withdraw their infringement claim save in so far as it is based on the Selected Goods and Services. If Sky withdraw their infringement claim based on the other parts of the Trade Marks within that period, then I will make no order on the counterclaim in so far as it seeks a declaration of invalidity in respect of those parts of the Trade Marks on the ground of bad faith. If Sky fail to withdraw their infringement claim based on the other parts of the Trade Marks within that period, then I will proceed to determine the validity of those parts of the Trade Marks and to make appropriate declarations.

Infringement under Article 9(2)(b) of the Regulation/Article 10(2)(b) of the Directive

36. I addressed this issue in the Main Judgment on the assumption that the Trade Marks were validly registered in respect of the Selected Goods and Services. The conclusion I reached at [303] was that, if the Trade Marks were validly registered in respect of those goods and services, then SkyKick had infringed them pursuant to Article 9(2)(b) of the Regulation/Article 10(2)(b) of the Directive (subject to the own name defence).
37. As Sky point out, the combined effect of (i) the CJEU’s ruling that trade marks cannot be declared invalid on the ground that the specification of goods and services lacks clarity and precision, (ii) the CJEU’s ruling that trade marks cannot be declared wholly invalid where bad faith only affects part of the specification and (iii) SkyKick not having attacked the validity of the Trade Marks in so far as they are registered in respect of “telecommunications services” and “electronic mail services” on bad faith grounds is that the Trade Marks are validly registered in relation to those services whatever the position may or may not be with regard to other goods and services.
38. The next point to note is that, as I recorded in the Main Judgment at [162], in relation to “telecommunications services” and “electronic mail services”, SkyKick advanced their case of lack of clarity and precision as a “squeeze” on interpretation of those terms.

SkyKick's primary case was that these terms should be narrowly construed; but SkyKick contended that, if those terms were interpreted so broadly as to include the services provided by SkyKick as being identical, then they lacked clarity and precision.

39. As Sky point out, I concluded in the Main Judgment at [297] that SkyKick's email migration service was identical to "electronic mail services". To that extent, therefore, I did not accept SkyKick's "squeeze" argument based on clarity and precision. Still further, I concluded at [302] that, where SkyKick's goods and services were identical to those covered by the Trade Marks, there was a likelihood of confusion. As Sky submit, it follows that SkyKick have infringed the Trade Marks at least in so far as SkyKick have used the signs complained of in relation to their email migration service and in so far as the Trade Marks are registered in relation to "electronic mail services".
40. SkyKick's only answer to this is to repeat their argument that "electronic mail services" should be narrowly construed and, on that basis, to invite me to reconsider the conclusion that SkyKick's email migration service is identical to "electronic mail services". I see no justification for reconsidering that conclusion, however.
41. I would add that, at least in this context, SkyKick's argument that their products are different to the goods and services which Sky actually supply and are targeted at different markets is misplaced. I found in the Main Judgment at [44] that Sky had supplied SKY-branded email services to broadband customers since July 2006. Moreover, for the reasons noted above, it is perfectly legitimate for Sky to seek and obtain, by way of a registration of "electronic mail services", protection which extends a little more broadly than their actual use. As explained in the Main Judgment at [356] and in the Second Judgment at [26], it is for that reason that there can be infringement of the Trade Marks under paragraph (b) of the legislation even though there is no passing off.
42. Given that the conclusion reached in paragraph 39 above is, for practical purposes, determinative of the dispute between the parties, I shall deal with the remaining aspects of the infringement claim relatively briefly.
43. So far as "telecommunications services" are concerned, I held in the Main Judgment at [297] as follows:

"Mr Schwartz also accepted that SkyKick's products were provided over telecommunications links, namely the internet. Whether this means that SkyKick provides 'telecommunications services' in Class 38 depends on how broadly that term is interpreted. Sky's case requires it to be very broadly interpreted, which engages SkyKick's case on clarity and precision. If it is narrowly interpreted, it is debatable whether SkyKick's products are even similar."
44. I did not reach a conclusion on this question of interpretation in the Main Judgment. Although it is not strictly necessary to do so in view of the conclusion reached in paragraph 39 above, I shall address it now.
45. Article 33(5) of the Regulation (formerly Article 28(5) of Regulation 207/2009 as amended by Regulation 2015/2424 with effect from 23 March 2016) provides:

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

46. Counsel for Sky submitted, and I agree, that there is no difference of any substance or significance between the approach laid down by Article 33(5) and the approach to interpretation adopted in the United Kingdom both prior to the *IP TRANSLATOR* case (as to which see generally *Omega Engineering Inc v Omega SA* [2012] EWHC 3440 (Ch), [2013] FSR 25 at [20] to [41]) and after that case (as to which see generally *Total Ltd v YouView TV Ltd* [2014] EWHC 1963 (Ch), [2015] FSR 7 at [57]-[63]).
47. So far as specifications of services are concerned, Jacob LJ stated in *Reed Executive Plc v Reed Business Information Ltd* [2004] EWCA Civ 159, [2004] RPC 40:
- “43. Before turning to these points it is as well to consider the general principles as to the construction of a specification of services. In *Avnet Inc v Isoact Ltd* [1998] F.S.R. 16, I said at p.19 that:
- ‘specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.’
44. Neither side dissented from this. The proposition follows from the inherent difficulty in specifying services with precision and from the fact that a service provider of one sort is apt to provide a range of particular services some of which will be common to those provided by a service provider of another sort....”
48. As recorded in the Second Judgment at [10], in the context of Sky’s application for reconsideration of aspects of the Main Judgment, counsel for Sky drew attention to a series of decisions of the General Court which he submitted stood as authority for the proposition that terms in specifications of goods and services which were not sufficiently clear and precise were to be disregarded in any claim for infringement or opposition on relative grounds, namely Case T-162/08 *Frag Commercio Internacional SL v Office for Harmonisation in the Internal Market* [2009] ECR II-212 at [31], Case T-571/11 *El Corte Inglés SA v Office for Harmonisation in the Internal Market* [EU:T:2013:145] at [23]-[24], [51]-[56], Case T-229/12 *Advance Magazine Publishers Inc v Office for Harmonisation in the Internal Market* [EU:T:2014:95] at [33]-[42], Case T-39/16 *Nanu-Nana Joachim Hoepf GmbH & Co KG v European Union Intellectual Property Office* [EU:T:2017:263] at [40]-[49] and Case T-102/17 *Cantina e Oleificio Sociale di San Marzano v European Union Intellectual Property Office* [EU:T:2018:50] at [28]-[40].
49. Sky re-iterated this submission in their written submissions to the CJEU on the reference and again in their submissions to this Court following the CJEU’s ruling. Moreover, SkyKick agreed with it.

50. As counsel for Sky also pointed out in their submissions to this Court, however, this line of case law has recently been reviewed by the General Court in Case T-279/18 *Alliance Pharmaceuticals Ltd v European Union Intellectual Property Office* [EU:T:2019:752].

51. In the *Alliance Pharmaceuticals* case the General Court held at [51] that:

“... if two possible literal interpretations of the specification of that mark exist, but one of them would lead to an absurd result as regards the extent of the protection of the mark, the Board of Appeal must resolve the difficulty by opting for the most plausible and predictable interpretation of that specification”.

52. The Court went on, having reviewed the earlier case law, to hold at [60] that:

“... it is only if both possible literal interpretations of the list of goods and services designated by an earlier EU trade mark are each equally plausible and predictable that, in determining the extent of the protection of that mark and assessing the evidence of genuine use that has been adduced, it is appropriate to apply the principle derived from paragraph 48 of the judgment of 6 April 2017, *NANA FINK* (T-39/16, EU:T:2017:263), that the proprietor of an EU trade mark should not gain from the infringement of its obligation to indicate the goods and services with clarity and precision.”

53. In the *NANA FINK* case the opponent relied upon its earlier registration of a trade mark for “*Waren aus Leder und Lederimitationen sowie Waren daraus*”. The General Court explained at [46] that this German phrase could be understood in two different ways. It could be interpreted in the manner suggested by the opponent, namely that it meant “leather goods and imitations of leather and goods made of imitations of leather”. It could also be interpreted in the manner suggested by EUIPO, namely that it meant “leather goods and goods made of imitations of leather”. The Court went on to hold at [47] that the wording was ambiguous, and therefore did not meet the requirement for clarity and precision, and that the opponent had itself created the ambiguity by adding the words “*Waren aus*” (goods made of) at the beginning of the class heading to Class 18. As the Court stated:

“... if the [opponent]’s intention was to seek protection for ‘imitations of leather’, the responsibility rested on it to choose wording for the list of goods which made this intention clear.”

Accordingly, the Court held that the specification should not be interpreted as including “imitations of leather” as the opponent contended.

54. This decision appears to me to be an application of the principle which I identified in the Second Judgment at [11], namely that an unclear or imprecise term will be narrowly interpreted as extending only to such goods or services as it clearly covers.

55. On further reflection, however, I accept that some of the decisions cited by Sky go further than this. For example, in the *El Corte Inglés* case, the opponent relied upon an earlier registration of a trade mark for “an advertising sentence” in Class 35. The

General Court recorded at [51] that the Board of Appeal had held that this description “did not correspond to any of the goods or services listed by the Nice Classification, was neither a good nor service within the meaning of Article 8(1)(b) of Regulation No 207/2009, and could not be interpreted as covering ‘advertising services’ without constituting an inadmissible extension of the scope of the services covered by the earlier mark”. The Court held at [53] that the opponent’s arguments did not call this assessment into question. It went on to hold at [54] that “the description of the services designated by the earlier mark ... does not allow them to be compared with the goods designated by the mark applied for”. Accordingly, the Board of Appeal’s decision to reject the opposition was upheld. As counsel for Sky submitted, and counsel for SkyKick agreed, this amounts to a decision that a term which cannot be interpreted is to be disregarded.

56. In summary, therefore, the applicable principles of interpretation are as follows:
- (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.
 - (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.
 - (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.
 - (4) A term which cannot be interpreted is to be disregarded.
57. Applying these principles, I do not understand SkyKick to contend that the term “telecommunications services” cannot be interpreted. Although it is somewhat imprecise, I do not consider that this factor calls for a narrower interpretation than that which is any event called for by the second principle. Applying that principle, it should be interpreted as meaning services consisting of or relating to telecommunication *per se*.
58. Given that “telecommunications” includes email, it follows that “telecommunications services” include services consisting of or relating to email. This adds nothing to Sky’s infringement case based on “electronic mail services”, however.
59. If services consisting of or relating to email are disregarded, none of SkyKick’s products is identical to “telecommunications services” since none of them is a service consisting of or relating to telecommunication. The mere fact that they are supplied via the internet does not in my view mean that they are even similar, since many goods within Class 9 and services are provided via the internet.
60. Nevertheless, I consider that there is some similarity between SkyKick’s products and some “telecommunications services” other than email services. It is not necessary for me to consider this point in detail, however, because it is clear from my conclusion that SkyKick’s products are not identical to “telecommunications services” other than email services that Sky’s infringement case based on “telecommunications services” other than email services is weaker than their case based on “electronic mail services”. Furthermore, as SkyKick point out, Sky’s case at trial was focused on the alleged identity of SkyKick’s products to the Selected Goods and Services.

61. As for the remaining Selected Goods and Services, it suffices to say that I do not consider that SkyKick's products are identical to any of the goods or services in the revised specifications. Again, therefore, the infringement case based on those services is weaker than that based on "electronic mail services".

Conclusion

62. For the reasons given above, SkyKick have infringed the Trade Marks at least in so far as the Trade Marks are registered for "electronic mail services". The fact that the Trade Marks are partially invalid on the ground that they were applied for partly in bad faith does not affect this.