



Office for Harmonization in the Internal Market  
(Trade Marks and Designs)  
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**Observations on the Communication No 4/03 of the  
President of OHIM of 16 June 2003**

MARQUES, the Association of European Trade Mark Owners, is an association created to promote the professional development and education of brand owners in the selection, management, protection and exploitation of their trade marks and other IP within the global economy.

In this context, MARQUES welcomes all efforts to streamline and harmonize existing procedures in trade mark registration systems to the benefit of the brand owners, taking into account the interests of both the general public and the registration offices.

With this in mind, MARQUES is raising its concerns with the Communication No 4/03 of the President of OHIM of 16 June 2003 concerning the use of class headings in lists of goods and services for Community Trade Mark applications and registrations. Therein, OHIM takes the following views:

- 1. The use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within that particular class.*

2. *Where only one or more general indications is recited – rather than all general indications of that particular class –, such general indication also covers those goods/services which do not clearly fall within the meaning of any general indication of that particular class but which come closest to the specifically recited general indication.*

3. *As a consequence, OHIM considers it a proper restriction (and not an inadmissible extension) to limit a list of goods/services reciting a general indication to those goods/services which do not fall within the meaning of any general indication of that particular class but which come closest to the specifically recited general indication. This rule is applied in examination, opposition and cancellation proceedings and, furthermore, to the assessment of genuine use of a trade mark.*

From the discussions that MARQUES has had with representatives of OHIM on this topic it has emerged that, on the one hand, the former practice in some of the Member States of accepting the definition of goods/services in the form of “all goods/services in class X” was not considered sufficiently specific, but, on the other hand, OHIM considered it too complicated to list each and every good instead. Therefore, in the interest of both the users of the CTM registration system and OHIM as the registration office, the Presidential Communication 4/03 stipulates inter alia that the use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within that particular class.

As set out above, while MARQUES generally supports improvements to the benefit of the brand owners, it must be recognized that the Presidential Communication 4/03 introduces severe uncertainties to both brand owners and the general public.

Therefore, MARQUES would like to briefly summarize some of the major negative impacts as follows:

- MARQUES does not consider the practice established by the Presidential Communication 4/03 clearer than the use of the term “all goods/services in class X”. This is due to the fact that the class headings of the NICE classification system do not literally encompass, and are not intended to literally encompass, all goods/services falling within a specific class. The class headings are only a guide to facilitate proper classification in a unitary system.
- An ordinary user of the trade mark system cannot conclude from the registration details the full scope of protection without (a) being aware of the Presidential Communication 4/03 and (b) having sufficient knowledge about the NICE classification system to recognize whether the general indications of a

particular class heading are listed completely (so that all goods/services are covered) and what other goods/services not falling within the literal meaning of the general indications about the goods/services belong in the respective class. Such knowledge must not be expected from an ordinary user.

- The NICE classification is subject to change. For instance, class 42 was split into classes 42 to 45 recently. Considering that trade marks may enjoy protection *ad infinitum*, it would be most complex to estimate the scope of protection of a trade mark on the basis of a class heading regime that was pertinent decades ago. It is particularly the case that this cannot be expected from an ordinary user.

- The above concerns not only relate to the situation in which all class headings of a particular class are listed, thereby giving protection to the entire class, but also to the situation in which the list of goods/services specifies only one or some general indications, thereby giving protection also to those goods/services “coming closest” to the general indication. In these circumstances, an ordinary user would have to recognize that the listed goods/services in fact correspond to a general indication rather than to specific goods/services, he would have to know that a general indication can mean more than it says, and he would have to know what other goods/services in the particular class come closest to the general indication. At least the latter issue is an impossible undertaking even for an experienced practitioner.

- The problems outlined above will have to be dealt with during the entire life of a trade mark, including in the context of opposition and nullity proceedings, as well as when genuine use of the trade mark is to be examined. Illustrative examples of the practical impacts thereof have been described e.g. in the articles of Dr. Paul Ströbele, judge at the German Federal Patent Court (“Die rechtliche Bedeutung der Klasseneinteilung für die Verzeichnisse von Waren und Dienstleistungen angemeldeter Marken”, *Mitteilungen der Patentanwälte*, 2004, 249ff) and Richard Ashmead (“International Classification class headings: illustrative or exemplary? The scope of European Union registrations”, *Journal of Intellectual Property Law and Practice*, 2007, 76ff).

From the above it seems clear to MARQUES that OHIM’s approach does not provide more legal certainty to the interested public than the formulation “all goods/services in class X”. On the contrary, the use of a complete class heading or a general indication thereof rather misleads an ordinary user to believe that the terms specified in the list of goods/services might limit the scope of protection to what is specified.

Overall, it is the view of MARQUES that the Presidential Communication 4/03 introduces a great deal of legal uncertainty, and that this is not outweighed by the practical advantages that OHIM's approach might bring for the registration procedure.

As outlined above, MARQUES supports the harmonization of trade mark law where that is in the benefit of the trade mark owners. A survey conducted by MARQUES among practitioners in the EU member states (plus Iceland, Norway and Switzerland), which survey also includes many official replies obtained from the respective national offices, shows that the practices before almost half of the national offices seem to be in line with the Presidential Communication 4/03, whereas the practices of more than half of the national offices require that the scope of protection conferred by a trade mark registration is to be assessed on the basis only of the goods/services as specifically recited in the list of goods/services. The result of the survey is published on the MARQUES website under <http://www.marques.org/Teams/TeamPage.asp?PageID=95&TeamCode=TradTeam..>

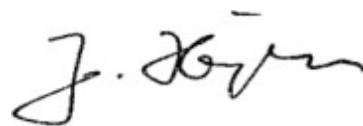
MARQUES therefore urges the OHIM (and all national offices which currently follow the Presidential Communication 4/03) to abolish this practice. MARQUES is open to contribute to further improving the trade mark registration system in terms of a proper and simple classification of goods and services. However, legal certainty and clarity for the general public, in particular for an ordinary, non-professional, user, is a major aspect that must be considered.

We would be happy to discuss these issues with you further. Please contact either of us should you wish to do so (Knud Wallberg - [kw@slw.dk](mailto:kw@slw.dk) - and Jochen Höhfeld - [hoehfeld@ksnh.com](mailto:hoehfeld@ksnh.com) -).

Yours sincerely,



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