

IMPORTANT NOTICE

The ruling of the Court of Justice in the IP TRANSLATOR case and the Communication No. 2/12 of the President of the Office for Harmonisation in the Internal Market of 20/06/2012 concerning the use of class headings in the list of goods and services for Community trade mark applications and registrations.

On 19 June 2012 the Court of Justice of the European Union gave its ruling in Case C-307/10, better known as the IP TRANSLATOR case. (link here to Curia.europa.eu to read the ruling:

<http://curia.europa.eu/juris/document/document.jsf?text=&docid=124102&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=4020201>

The operative part of the CJ's ruling reads as follows:

Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that it requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark.

Directive 2008/95 must be interpreted as meaning that it does not preclude the use of the general indications of the class headings of the Classification referred to in Article 1 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, concluded at the Nice Diplomatic Conference on 15 June 1957, last revised in Geneva on 13 May 1977 and amended on 28 September 1979, to identify the goods and services for which the protection of the trade mark is sought, provided that such identification is sufficiently clear and precise.

An applicant for a national trade mark who uses all the general indications of a particular class heading of the Classification referred to in Article 1 of the Nice Agreement to identify the goods or services for which the protection of the trade mark is sought must specify whether its application for registration is intended to cover all the goods or services included in the alphabetical list of that class or only some of those goods or services. If the application concerns only some of those goods or services, the applicant is required to specify which of the goods or services in that class are intended to be covered.

As reported yesterday by **MARQUES** Class 46 (<http://www.marques.org/Class46/>), the Office for Harmonisation in the Internal Market (OHIM), which administers the Community Trademark system, has already issued its response and adopted the Communication No. 2/12 of the President of the Office which enters into force today and repeals the former Communication 4/03.

In its press release on 20 June 2012, the Community Trade Mark Office stated that:

OHIM, together with the EU National Offices, will work within the framework of the existing Convergence Programme towards adopting a common practice on the acceptability of each of the general indications of the Nice Agreement class headings.

In accordance with the Court's ruling, the Office is updating its filing systems to provide a user-friendly solution when using class headings to claim protection for all of the goods or services in the alphabetical list of the Nice Classification. This update is expected to be in place over the next few days. In the meantime, an interim solution has been implemented and is accessible via the Office's website.

Furthermore, Communication 4/03 (based on which the adoption of class headings of any classes in CTM applications meant to provide coverage for all goods or services of a class, without need of any further

specification) has now been repealed and replaced by Communication 2/12. This new Communication enters into force on 21 June 2012.

You can read the letter from the President of OHIM and the Communication No. 2-12 of the President of the Office by clicking on the links below.



[Letter from the President](#)



[Communication No2-12](#)

The Communication No. 2-12 of the President of the Office establishes, among others, the following:

- In view of the statements of the Courts, applicants are not precluded from using the general indications of the class headings to identify the goods and services for which protection is sought, provided that this identification is sufficiently clear and precise.
- Therefore, the Office will continue to accept the use of the general indications of the class headings but on a case-by-case basis. This will be specified in the guidelines of the Office, which will be periodically adapted to that effect. Until the guidelines are adapted, any such practice indication will be reflected in the Office's manual of trade mark practice.
- As to the question of whether or not the use of the entire class heading gives protection for the goods/services in any particular class, the Court has indicated that, in order to respect the requirements of clarity and precision mentioned above, an application for a trade mark who uses all the general indications of a particular class heading of the Nice Classification to identify the goods or services for which the protection of the trade mark is sought must specify whether its application for registration is intended to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services. If the application concerns only some of those goods or services, the applicant is required to specify which of the goods or services in that class are intended to be covered.

This principle shall be applied consistently in all proceedings before the Office.

- As regards Community Trade Marks registered before the entry into force of the present Communication which use all the general indications listed in the class heading of a particular class, the Office considers that the intention of the applicant, in view of the contents of the previous Communication 4/03, was to cover all the goods or services included in the alphabetical list of that class in the edition in force at the time when the filing was made. The above is without prejudice to the application of Article 50 CTMR
- regards Community trade mark applications filed before the entry into force of this Communication and which are still not registered in the case of applicants who use all the general indications of a particular class heading of the Nice Classification, the Office considers that their intention was to cover all the goods or services included in the alphabetical list of the particular class concerned, unless they specify that they had sought protection only in respect of some of those goods or services in that class. The above is without prejudice to the application of Article 43 CTMR
- As regards Community trade mark applications filed as from the entry into force of the present Communication, in the case of applicants who use all the general indications of a particular class heading of the Nice Classification, they must expressly indicate whether or not their intention is to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services in that class.