

**Feedback form for comments on the draft
Communication of the President concerning the implementation of Article 28 EUTMR**

User Association/National Office	MARQUES - THE EUROPEAN ASSOCIATION OF TRADE MARK OWNERS
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Contributor (name & position)	Robert Guthrie, Chair, MARQUES European Trademark Law and Practice Team
Linguistic version the comments refer to	EN <input checked="" type="checkbox"/> DE <input type="checkbox"/> ES <input type="checkbox"/> FR <input type="checkbox"/> IT <input type="checkbox"/>
Part/Section/Chapter of the Guidelines the comment(s) refer to	Numbered paragraph 8 – Content of the Declaration , of the draft Communication of the President concerning the implementation of Article 28 EUTMR
Page of the document	4
Issue(s) you wish to comment on	<p>Bullet point (b) of paragraph 8 states that the declaration must only include goods and/or services that go beyond the literal meaning of those covered by the general indications of the corresponding class heading. However, MARQUES notes that Article 28(8), 2nd para does not impose a restriction in this manner but instead states that the declaration shall indicate the goods and services originally covered by the proprietor's intention <i>"other than those clearly covered by the literal meaning of the indications of the class heading"</i>. MARQUES understands that the use of the word <i>"clearly"</i> is intended to ensure that proprietors of EU trade marks are given the opportunity to amend their trade marks by the inclusions of additional goods and/or services if there is any doubt as to whether or not the goods and/or services concerned are covered by the literal meaning of the indications of the class heading.</p> <p>MARQUES' view is that this benefit of the doubt should also be given in circumstances when the relevant general indication of the class heading could potentially be considered to be insufficiently clear and precise, even if it is currently considered by OHIM to be sufficiently clear and precise. An example of this would be the general indication "Entertainment" and the service "production of television and radio". OHIM considers the former to be sufficiently clear and precise and to cover the latter. MARQUES' view is that proprietors should be allowed to add the latter service in accordance with Article 28. Even if the Office takes the view that an alphabetical list indication falls within a class heading indication that the Office believes is sufficiently clear and precise, a court could take a different view at some point in the future. Accordingly, where there is any potential ambiguity as to whether a term from the alphabetical list falls within a class heading term, MARQUES' view is that the Office should err on the side of the proprietor, especially as the proprietor will have gained no advantage if the Office's view is adopted by any court in the future.</p>
Suggestion for text	<p>Replace sub-paragraph 2 of paragraph 8 with:</p> <p>The goods and/or services included in the declaration:</p> <ul style="list-style-type: none"> (a) must be contained in the alphabetical list for the class in question of the edition of the Nice Classification in force at the date of filing, and (b) must not be clearly covered by the literal meaning of the indications of the class heading.

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	<p>Insert the following sentence at the end of the third sub-paragraph of paragraph 8:</p> <p>Goods and/or services will not be objected to on the basis that the Office considers they are covered by the literal meaning of the class heading unless the Office considers that they are clearly covered, so that this view is not open to any serious doubt.</p>
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Part/Section/Chapter of the Guidelines the comment(s) refer to	Numbered sub-paragraph 3 of paragraph 1 – Scope of Article 28 EUTMR Numbered paragraph 13 – Effect Numbered paragraph 16 – Entry into Force
Page of the document	2, 6 and 7
Issue(s) you wish to comment on	<p>MARQUES does not agree that Article 28(5) does not <u>also</u> apply to marks filed and registered on or before 21/06/2012. It applies to all marks and we cannot see what justification there can be to the contrary statements in sub-paragraph 3 of paragraph 1. Article 28(5) may be subject to Article 28(8) but this does not mean it does not apply to all marks filed on or before 21/06/2012. Article 28(8) only applies to marks that are registered in respect of the entire heading of a Nice class, so the approach currently adopted would mean that many marks would not be covered by either Article 28(5) or (8).</p> <p>We also understand from paragraphs 13 – Effect and 16 – Entry into Force that the intention is to continue to apply Presidential Communication No. 2/12 until the end of the transitional period or a declaration filed in respect of a particular mark is registered. We believe that this would mean that EU trade marks registered before 22 June 2012 for the entire headings of a Nice class will continue to be treated as covered by the entire Nice alphabetical list of that class during the transitional period.</p> <p>This approach may be sensible if the marks concerned are subject to cancellation but it could be inappropriate if the marks concerned are being relied upon to cancel or oppose third party rights, particularly as any alphabetical terms that are added would be subject to the provisions of Article 28(9).</p> <p>MARQUES believes that as an alternative (and more legally consistent) measure, the Office should just stay any decision that will be dependent on whether or not a declaration is filed under Article 28(8).</p>

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Suggestion for text	<p>Amend sub-paragraph 3 of paragraph 1 as follows:</p> <p>In accordance with Article 28(5) EUTMR, the use of class headings and other general terms will be interpreted as including all the goods or services clearly covered by the literal meaning of the general indication or term. <i>This provision is subject to the provisions of Article 28(8).</i></p> <p>We suggest that paragraphs 13 and 16 are also amended to ensure that trade mark proprietors cannot rely on Presidential Communication No. 2/12 to their advantage when they are challenging third party marks.</p>
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