



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

The President

**Communication No 2/12 of the President of the Office
of 20/06/2012**

**concerning the use of class headings in lists of goods and services for Community
trade mark applications and registrations**

I.

A Community trade mark application must contain a list of goods and services in respect of which registration is sought. This is a filing date requirement pursuant to Articles 27 and 26(1)(d) of the Community Trade Mark Regulation (CTMR). Pursuant to Article 28 CTMR and Rule 2 of the Implementing Regulation (IR), goods and services in respect of which Community trade marks are applied for shall be classified in conformity with the common 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, as revised and amended (the 'Nice Classification').

Pursuant to Rule 2(2) IR, the list of goods and services must be worded in such a way as to indicate clearly the nature of the goods and services and to allow each item to be classified in only one class of the Nice Classification.

II.

In its Judgment of 19/06/2012 in Case C-307/10 *The Chartered Institute of Patent Attorneys v Registrar of Trade Marks* ('IP TRANSLATOR'), the Court of Justice has ruled on the standards of clarity and precision to be applied to the classification of goods and services and on the principles applicable to the use of the general indications appearing in the class headings in the following terms:

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.

III.

In view of the above statements by the Court, 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.

In order to determine which indications meet the requisite standard of clarity and precision, the Office, together with the EU National Offices, will work within the framework of the Convergence Programme towards a common practice with regard to the acceptability of each of the general indications of the Nice Classification class headings.

IV.

As to the question whether or not the use of the entire class heading gives protection for all 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 applicant 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.

V.

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.

VI.

As 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.

VII.

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.

VIII.

In the case of Community trade mark applications or registrations which, according to the above, are deemed to cover all the goods or services included in the alphabetical list of a certain class or which cover only some of those goods or services, a literal approach, which seeks to give the terms used in those indications their natural and usual meaning, will be consistently used in all proceedings before the Office and, in particular:

1. In the absolute grounds examination of Community trade mark applications, signs which are objectionable under Article 7(1) and (2) CTMR for goods and/or services that are not deemed to be covered, will not be refused.
2. In examining the existence of an identity or similarity when comparing goods/services in opposition or cancellation proceedings, only the goods or services deemed to be covered will be considered.
3. In withdrawals, restrictions and partial surrenders, it will not constitute a proper restriction for the purposes of Article 43 and 50 CTMR when the amended list of goods and services of a Community trade mark application or registration contains a term not deemed to be covered.

It remains possible to submit a restriction or partial surrender by adding a limitation to a general indication.

Once a restriction has been submitted to the Office, it is no longer possible to revert to a broader specification.

4. As regards the requirement of use for the purposes of Articles 15, 42 and 57 CTMR, it will constitute proper use of a mark registered as above when the mark is actually used for the goods or services deemed to be covered. Whether or not such use is sufficient for all goods deemed to be covered or only for a sub-category thereof will depend on the facts of each specific case.

This is without prejudice to the scope of protection of the mark for which use has been demonstrated, which is generally based on the goods or services for which the mark has been used rather than on the goods or services for which it is registered.

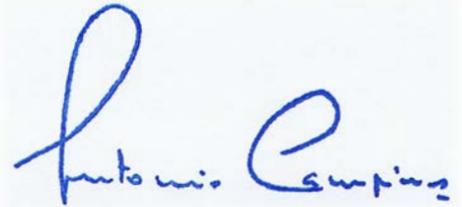
It is also possible to seek protection for all of the general indications of a class heading without including all the goods and/or services in the alphabetical list. In such a case, each of the general indications will have to respect the requirements of clarity and precision following the principles described above under paragraph III. Furthermore, in this particular case, such general indications will be interpreted following a literal approach.

To ensure legal certainty in the case of Community trade marks filed for the entire class heading, the Register of Community trade marks will reflect whether or not all goods and/or services in the alphabetical list are covered.

IX.

This Communication enters into force on 21 June 2012. It shall be published in the Official Journal of the Office.

Communication No. 4/03 of the President of 16 June 2003, concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations, is hereby repealed.

A handwritten signature in blue ink, reading "António Campinos". The signature is written in a cursive style with a large initial 'A' and 'C'.

António Campinos
President