

Community Trade Mark Class Heading Registrations – Scope of Protection Article 28(8) Declaration

The EU trade mark reforms bring in a fundamental change to the scope of protection afforded to Community trade marks incorporating the NICE class headings.

Prior to 22 June 2012 Community trade marks covering class headings were deemed to cover the whole alphabetic list of goods and services contained within the particular NICE class. The European Court of Justice Decision in the IP TRANSLATOR case changed this approach. The Court found that in order to guarantee legal security and clarity trade mark registrations should be interpreted as covering the goods and/or services contained therein, i.e. if the trade mark is registered for the class heading, the protection should cover the literal meaning of the terms contained within the class heading.

The previous OHIM approach was inconsistent with many of the individual EU Member State Offices, in particular, the UKIPO. This left the system in limbo with the scope of protection unclear for many trade marks on the register pre the IP TRANSLATOR Decision.

The reforms address how to deal with such registrations with the introduction of the Article 28(8) Declaration. The solution proposed in Article 28(8) of the new EU Trade Mark reforms Regulation, No. 2015/2424 is to have a short window of six months during which owners of CTMs filed prior to 22 June 2012 which cover entire class headings will have an opportunity to amend the goods and services to include those which they really intended to cover, in addition to the class heading.

After the six months period expires, i.e. on **23 September 2016**, CTMs filed prior to 22 June 2012 will be interpreted strictly according to the literal meaning of the terms included.

What trade mark registrations are affected?

Community trade mark registrations and EU designations under an International Registration filed before 22 June 2012 containing the entire Nice Classification class heading in force at the time of filing. The deadline to file the Declaration will be 23 September 2016.

What if I decide not to file the Declaration?

If your Community trade mark was filed before 22 June 2012 and you decide not to file the Declaration, the registration in question will be deemed to extend only to goods or services clearly covered by the literal meaning of the class heading terms.

What if my Community trade mark was filed on or after 22 June 2012?

You cannot file the Declaration for your Community trade mark. Your Community trade mark will be considered to cover the literal meaning of the terms included in the goods and services specification (“what you see is what you get”). If you are concerned that this may not afford sufficient protection for your trade mark, please contact us and we can advise you on the best way to ensure your Community trade mark provides you with adequate protection.

What if my Community trade mark was filed on or before 22 June 2012 but has not yet been registered?

Under the draft Guidelines incorporating the changes, you cannot file the Declaration for pending trade marks. It may be possible to amend the class heading terms included in such applications by the partial withdrawal procedure to specifically set out the applicable terms from the alphabetical list of the NICE classification. If you would like assistance on this, please contact us and we can advise you further.

Can I amend my registration to cover anything in that class?

You can amend your registration to include any terms in the alphabetical list for that class of the edition of the Nice Classification in force at the date of filing which are not already clearly covered by the literal meaning of the class heading terms. For example:

- Clothing, footwear, headgear (entire class heading)
- Clothing, footwear, headgear; *shorts, caps* (entire class heading plus additional goods) - ACCEPTABLE
- Clothing, footwear, headgear *not including tennis clothing* (narrower than the class heading because of the limitation) – NOT ACCEPTABLE.

If you are unsure as to what was included in the alphabetical list of the NICE classification at the date of filing, contact us and we can provide you with a list. Alternatively, we can review your trade mark(s) and advise whether any are affected by this provision and if so advise regarding your options for amendment and related costs.

What if my Community trade mark includes other goods in the class along with the class heading?

Additional goods and services in the class do not prevent you from filing the Declaration, provided that the language used does not limit or disclaim the class heading.

What about national trade mark registrations?

National trade mark registrations are not affected. The national Trade Mark Offices’ of the EU

Member States have issued a Communication on the Implementation of the 'IP TRANSLATOR' decision and this sets out what they consider to be covered by their own national registrations containing class headings.

What if my Community trade mark does not contain the full class heading?

You cannot take advantage of this provision. If you are concerned that your Community trade mark registration does not provide adequate protection we can review your portfolio and provide you with our recommendations for an agreed fee.

How do I know if my Community trade mark contains the entire of a Nice Classification class heading?

We are happy to review any Community trade marks and file the Declaration and we can provide tailored cost estimates depending on the marks involved – we will consider discounts for large portfolios. In addition, where we are not the representatives on record we can also assume responsibility for your trade mark(s) at no additional charge and also provide a free trade mark watching service for any mark we take over as representative for the rest of the calendar year.

Can my Article 28(8) Declaration or the amended registration be opposed by a third party?

Third parties cannot object, however, the Examiner will examine the Declaration for compliance with the requirements and the amended registration is still subject to proof of use requirements.

What if someone infringes the goods or services added by the Article 28(8) Declaration?

The goods or services added by the Declaration will not give you the right to prevent the use by third parties of those goods or services, provided that such use commenced before the Declaration and did not infringe your rights on the basis of the literal meaning of the goods and services contained in your registration at that time. Similarly, you cannot oppose an application for that trade mark or seek invalidity of its registration. This third party defence does not apply to applications for partial surrender filed before the new Regulation comes into force on 23 March 2016, so if this is a concern for you, please contact us as soon as possible for an audit of your trade mark portfolio and we can advise you accordingly.

Contact us by email at info@nucleus-ip.com for further information or if you have any questions, or alternatively call or email your usual Nucleus IP contact for further information