



Common Communication on the
Implementation of 'IP Translator' v1.2,
20 February 2014

On 19/06/2012 the Court delivered its ruling in Case C-307/10 “IP Translator”, giving the following answers to the referred questions:

1 – Directive 2008/95 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;

2 – 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 Nice Classification 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;

3 – an applicant for a national 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 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.

This Judgment has an influence on the practice of all Trade Mark Offices of the European Union and calls for convergence on the interpretation of the general indications of the Nice Class Headings. Without prejudice to the fact that each Office is bound by its national legislation, national court decisions and, in some cases, previous communications, there is a willingness and a need to collaborate with a view to implementing this Judgment in a harmonised manner in order to provide legal certainty both for the competent authorities and the economic operators.

As regards the first question, the Trade Mark Offices of the European Union are working together to establish a common understanding of the requirements of clarity and precision in the designation of goods and services and to develop a common set of principles to be applied to their respective classification practices.

As concerns the second question, the Trade Mark Offices of the European Union are working together to determine which of the general indications of the Nice Class Headings are acceptable for classification, pursuant to the above criteria of clarity and precision. This will result in a harmonised approach on the acceptance for classification of each of them. As soon as this agreement is finalized, it will be communicated accordingly.

As regards the third question, the Trade Mark Offices of the European Union have created an overview (see Annex) that provides full transparency on how each Office deals with specific topics relating to the implementation of the Court’s ruling. The overview addresses the following topics:

- It reflects how each Office interprets the scope of protection of its own trade marks containing entire Nice Class Headings filed before and after the “IP Translator” Judgment. (Table 1, Table 2)
- It contains information about how each Office reflects in its register, publications and certificates the intention of the applicant with respect to Nice Class Headings and the alphabetical list. (Table 3)
- Each National Office informs how it interprets the scope of protection of CTMs containing an entire Nice Class Heading, filed before and after the IPT judgment. (Table 4)
- OHIM informs how it interprets the scope of protection of national trade marks containing an entire Nice Class Heading, filed before and after the IPT judgment. (Table 5)
- Trade marks filed after “IP Translator” containing the entire class heading: How can the applicant obtain protection for the full alphabetical list? (Table 6)

The Trade Mark Offices of the European Union reiterate their commitment to continue to collaborate in the context of the Convergence Programme, with the purpose of further increasing transparency and predictability for the benefit of examiners and users alike.

A first concrete aim is a harmonised list of acceptable goods and services. It will be presented in a visual hierarchical structure, which will allow the user to easily locate descriptions of goods and services that match the desired level of protection. This will be implemented into classification tools such as TMClass.

Whilst the hierarchical structure serves administrative purposes only and does not have any legal consequences the result is a comprehensive and dynamic classification tool that, by containing commonly acceptable terminology, offers more certainty to the user when constructing specifications of goods and services. This will help applicants to comply with the requisites of clarity and precision set forth in the “IP Translator” Judgment.

EUROPEAN TRADE MARK AND DESIGN NETWORK

LIST OF OFFICES: AT, BG, BX, CY, CZ, DE, DK, EE, ES, FI, FR, GR, HR, HU, IE, IT, LV, LT, MT, NO*, OHIM, PL, PT, RO, SE, SI, SK, UK

*observer

Table 1

TRADE MARKS FILED <u>BEFORE</u> "IP TRANSLATOR" CONTAINING ENTIRE NICE CLASS HEADINGS INTERPRETATION BY THE OFFICE OF THE SCOPE OF PROTECTION OF THE CLASS HEADINGS OF ITS <u>OWN</u> TRADE MARKS			
National Office	Class Headings cover the entire class	Class Headings terms are to be interpreted literally (means what it says)	Class headings cover the literal meaning of the class headings plus the alphabetical list of the edition of Nice at the time of filing
AT		X	
BG	X		
BX		X	
CY		X	
CZ		X	
DE		X	
DK		X	
EE		X	
ES		X	
FI	X		
FR		X	
GR	X		
HR		X	
HU			X
IE		X	
IT	X		
LV		X	
LT			X
MT	X		
NO		X	
OHIM			X
PL		X	
PT		X	
RO			X
SE		X	
SI		X	
SK		X	
UK		X	

Table 2

 TRADE MARKS FILED AFTER "IP TRANSLATOR" CONTAINING ENTIRE NICE CLASS HEADINGS
 INTERPRETATION BY THE OFFICE OF THE SCOPE OF PROTECTION OF ITS OWN TRADE MARKS

National Office	Class Headings cover the entire class	Class Headings terms are to be interpreted literally (means what it says)	Class headings cover the literal meaning of the class headings plus the alphabetical list of the edition of Nice at the time of filing
AT		X	
BG		X	
BX		X	
CY		X	
CZ		X	
DE		X	
DK		X	
EE		X	
ES		X	
FI		X	
FR		X	
GR		X	
HR		X	
HU			X
IE		X	
IT			X
LV		X	
LT			X
MT		X	
NO		X	
OHIM		X	
PL		X	
PT		X	
RO			X
SE		X	
SI		X	
SK		X	
UK		X	

Table 3

**TRADE MARKS FILED AFTER 'IP TRANSLATOR' CONTAINING ENTIRE NICE CLASS HEADINGS
 HOW DOES THE OFFICE REFLECT THE APPLICANT'S INTENTION WITH RESPECT TO THE CLASS HEADINGS
 AND/OR THE ALPHABETICAL LIST**

National Office	All goods and services applied for or registered will be listed individually	A general reference to the applicable edition of the alphabetical list will be available
AT	X	
BG	X	
BX	X (in the publications, certificates and register)	X (in the application)
CY	X	
CZ	X	
DE	X	
DK	X	
EE	X	
ES	X	
FI	X (from 1. 1. 2014)	X (until 31. 12. 2013)
FR	X	
GR		X
HR	X	
HU		X
IE	X	
IT		X
LV	X	
LT	X	
MT	X	
NO	X	
OHIM	X	
PL	X	
PT	X	
RO		X
SE	X	
SI	X	
SK	X	
UK	X	

Table 4

HOW WILL THE SCOPE OF PROTECTION OF CTMs CONTAINING GENERAL INDICATIONS OF THE NICE CLASS HEADINGS BE INTERPRETED						
National Office	For CTMs filed before "IP TRANSLATOR"			For CTMs filed after "IP TRANSLATOR"		
	Terms of the class headings are to be interpreted literally	Class headings cover all goods or services in the class	Class headings cover the literal sense of the class headings terms plus the alphabetical list valid at the time of filing	Terms of the class headings are to be interpreted literally	Class headings cover all goods or services in the class	Class headings cover the literal sense of the class headings terms plus the alphabetical list valid at the time of filing
AT	X			X		
BG		X		X		
BX	X			X		
CY	X			X		
CZ	X			X		
DE	X			X		
DK	X			X		
EE	X			X		
ES	X			X		
FI			X	X		
FR	X			X		
GR		X		X		
HR	X			X		
HU			X	X		
IE	X			X		
IT		X		X		
LV	X			X		
LT			X	X		
MT		X		X		
OHIM			X	X		
PL	X			X		
PT	X			X		
RO			X	X		
SE	X			X		
SI	X			X		
SK	X			X		
UK	X			X		

Table 5

OHIM INTERPRETATION OF THE SCOPE OF PROTECTION OF NATIONAL TMs CONTAINING GENERAL INDICATIONS OF THE NICE CLASS HEADINGS

For trade marks filed <u>before</u> “IP TRANSLATOR”	For trade marks filed <u>after</u> “IP TRANSLATOR”
<p>OHIM will accept the filing practice of all EU Trade Mark Offices. National trade marks have the scope of protection awarded by the National Office <u>unless the National Office interprets the Class Headings to cover all goods and services in the Class</u>. In this case, the National trade mark containing Nice Class headings will be interpreted as covering the class heading on a ‘literal’ basis plus the alphabetical list of the Nice edition in force at the time of filing.</p>	<p style="text-align: center;">Terms are to be interpreted literally</p>

Table 6

“Trade marks filed after “IP Translator” containing the entire class heading: How can the applicant obtain protection for the full alphabetical list?”

National Office	By completing a declaration	By means of an electronic tickbox	By listing each of the terms individually
AT			X
BG	X		X
BX	X		
CY			X
CZ			X
DE			X
DK			X
EE			X
ES			X
FI	X (until 31. 12. 2013)		X (from 1. 1. 2014)
FR			X
GR	X		
HR			X
HU	X	X	
IE			X
IT	X		
LV			X
LT	X		X
MT			X
NO			X
OHIM			X
PL			X
PT			X
RO	X		
SE			X
SI			X
SK			X
UK			X