

# EU IP Offices Seek to Harmonise the Scope of Protection

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In June 2012, the Court of Justice of the European Union (CJEU) gave its decision in the IP TRANSLATOR case (C-307/10).

 The IP TRANSLATOR case had been referred to the CJEU on the basis that if national examination was in accordance with the Office for Harmonization in the Internal Market's (OHIM) practice, the use of the Nice class heading would mean that the specification on the application covers "translation services" as included in the Class 41 alphabetical list – but not mentioned in the Class 41 heading. OHIM was generally construing Nice class headings as having the same scope as "All goods in class X" (Communication of 4/03).

The CJEU stated that the applicants who use the general indications of a particular class heading "must specify whether its application is intended to cover all of the goods or services included in the alphabetical list for that class or only some of them". Hence, using a class heading would not automatically cover all of the goods or services under the particular class (also referred to as the "literal meaning" approach). Before the case, the literal meaning approach to trade mark applications was followed only by part of the national intellectual property offices. As a result, the CJEU's approach was a notable take on the class heading issue.

The ruling of the CJEU was applied to the original case in May 2013. In this decision, appeal was allowed, setting aside the original decision and remitting it for further examination. The applicant was requested to confirm whether the words of identification, for which it sought registration, were intended to cover any goods or services that do not fall within the natural and ordinary meaning of the words used in the application. The applicant was also told to consider whether any part of the verbal formula describing those services fails to identify the desired services with the requisite degree of clarity and precision.

## OHIM and PRH specified their practices

Although the CJEU's decision formally concerned national trade marks governed by the EU Directive (2008/95/EC) to approximate the trade mark laws of member states rather than Community Trade Marks, as a consequence, OHIM altered its official practice on the use of the Nice Classification.

On 20 June 2012, OHIM repealed Communication No. 4/03 and replaced it with Communication No. 2/12. According to the revised practice, the applicant needs to include an explicit declaration that the application is intended to cover all the goods and services in the alphabetical list, or otherwise the applicant is assumed to protect only the items included in the class heading. In either case, the OHIM follows the literal approach, which seeks to give the terms used their natural and usual meaning.

In Finland, the Finnish Patent and Registration Office also specified its interpretation practice as it adopted the same approach in regard to filings after 1 October 2012.

## Proposed reform of the trade mark system in the EU

On 27 March 2013, the European Commission published a number of initiatives aimed to reform the trade mark registration systems in the EU.

The proposed reforms contain recast of the 1989 Directive to approximating the laws of the Member States relating to trade marks (2008/95/EC) and revision of the 1994 Regulation on the Community trade mark (207/2009/EC), which need to be adopted by the European Parliament and the Council under the co-decision procedure. The revision

of the Trade Mark Fees Regulation (2869/95/EC), introducing a principle of "one-class-per-fee", will be adopted as an implementing act.

The new regulation proposals would introduce revision on the matter of designation of goods and services and class headings. According to Article 40(5) of the proposed Directive, "the use of general terms, including the general indications of the class headings of the Nice Classification, shall be interpreted as including all the goods or services clearly covered by the literal meaning of the indication or term. The use of such terms or indications shall not be interpreted as comprising a claim to goods or services which cannot be so understood", thus presenting a literal meaning approach and harmonising the scope of Community trade mark protection in line with the CJEU's interpretation in the IP TRANSLATOR case.

## Declaration of intention for the trade marks applied for prior

Notably, it is suggested that proprietors of Community Trade Marks applied for prior to 22 June 2012 and registered solely in respect of the entire heading of a Nice class, may declare their intention on the date of filing to extend the protection beyond the goods or services covered by the literal meaning of the particular class heading. The goods or services in question need to be included in the alphabetical list of that class in the edition of the Nice classification in force at the date of filing.

Any such declaration must be filed within four months of the date of the entry into force of the new regulations. Otherwise, the protection will only cover the literal meaning of the relevant class heading.

The proposed provision is understandable

but also problematic. On the one hand, it will provide recourse for those trade mark owners who relied on the practices before the changed interpretation, but, on the other, it gives trade mark owners the possibility to declare their scope of trade mark protection far broader than originally intended. Furthermore, it does not specify how the possible non-clear general indications will be interpreted.

Hence, a company that has considered properly (according to the CJEU), the list of goods of an earlier trade mark to mean what it says, may later be found infringing an earlier trade mark whose owner has, after the use of the junior mark commences, informed the IP Office that it, in fact, meant its mark to cover all goods or services in such class. This even opens up the possibility of speculative "broadenings", if the Commission's proposal enters into force as currently drafted.

## Eleven non-acceptable general indications are published

In order to "minimise differences by creating a comprehensive European Trade Mark and Design Network", the EU IP offices, led by OHIM, recently published a communication on a common new practice on the general indications of the Nice class headings.

The Communication, published on 20 November 2013, was the outcome of the EU IP offices having reviewed all general indications of the Nice class headings in order to determine which indications are sufficiently clear and precise. The review determined a list of 11 non-acceptable general indications that cannot be accepted without further specification. The list includes, for example, machines in class 7, repair in class 37 and personal and social services rendered by other's to meet the needs of individuals in class 45. The remaining

general indications are considered acceptable.

For a trade mark applicant, the list means that special attention must be paid on these specific 11 terms and closer specification needs to be added on the application in case the type of goods and services are desired to be covered by the registration. The list also means that the other class heading indications can be predicted to be precise – in their natural and usual meaning. Nevertheless, this does not mean that these indications would cover all of the goods or services in the same class that cannot be understood to fall within their ordinary meaning.

At the OHIM, the new practice has been effective as of 25 November and, in Finland, as of the 1 January 2014. The offices agreed that the change will not have a retrospective effect on prior registrations.

## Keeping up-to-date on changes

According to IP professionals around the EU, the new regulations are timely and in place. In general, the proposals are thought to be well prepared but some of the provisions are

## Tiesitkö että...

... kehitteillä on kansainvälinen innovaatiopankki?

Sen ideana on saada suuryrityksiltä ylijäänyt teknologia ja osaaminen pk-yritysten käyttöön kohtuullisilla kustannuksilla.

Suuryritykset tallentavat innovaatiopankkiin patentteja ja osaamistaan, ja pk-yritykset voivat lisensoida niitä erillistä vuosittaismaksua vastaan. Pankkia voi käyttää pk-yritys, jonka vuosittainen liikevaihto jää alle 75 miljoonan euron eikä se saa olla suuryrityksen omistuksessa.

Pankin toimintaa ei ole sidottu tiettyihin toimialoihin, vaan siellä on edustettuna laajasti eri alojen patentteja. Ensimmäiset asiakkaat valitaan maista, joissa on kehittynyt ja innovaatiomyönteinen yhteiskunta. Suomen lisäksi tähän joukkoon ovat valikoituneet muun muassa Itävalta ja Tanska. Suomen osalta innovaatiopankin pilottivaiheessa on ollut mukana Tekes. ■

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