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New rules published by OHIM for CTM specifications

Jonathan Clegg (Cleveland Scott York) · Wednesday, February 24th, 2016

OHIM recently published procedural rules surrounding the important issue of the scope of CTM specifications of goods and services. These follow on from the new provisions of Article 28 EUTMR and trace back to the IP Translator decision. The new rules come in to effect on 23 March 2016 as part of a raft of other changes to the EUTMR.



These rules were published in a Communication from the President of OHIM (see Communication No. 1/2016 of 8 February 2016). The new Article 28 was published in final form two months ago in the so-called Amending Regulation (see Regulation (EU) 2015/2424 of 16 December 2015), whilst the CJ's judgment in IP Translator (see Case C-307/10 of 19 June 2012) and OHIM's implementation of this since then are well-known. What's new is some additional detail around the implementation of Article 28.

The basic effect of Article 28 is to move to a system, for all CTMs, where Nice class headings will have no broader effect than covering the goods or services indicated by the *literal meaning* of the terms within that class heading. In other words, class headings will be treated like any other terms and will not extend to all goods or services in a given class. Importantly, transitional provisions will allow proprietors of CTM registrations predating IP Translator and which include class headings, a period of six months (up to 24 September 2016) to make a declaration that they intended their CTM, on filing, to cover more than the goods/services represented by the literal meaning of a given class heading, and to identify these goods/services. The only caveat is that any further goods/services are listed in the relevant edition of the Nice Classification (see Article 28(8) EUTMR).

After 24 September 2016, any CTM for which no such declaration has been filed, will cover only the goods/services indicated by the literal meaning of the words in the specification, and this puts them on all fours with all CTM applications filed since IP Translator.

The opportunity to file these declarations is significant for businesses and is likely to be widely taken up. The flexibility allowed by the procedure, however, means that proprietors may avail themselves of this to ensure that just a handful of key terms for their particular businesses are stated in the amended specification, where they were

previously “concealed” within the class heading. In other words, there are various reasons why the option of maintaining coverage for a very large range of goods or services in a class may not be taken up by CTM proprietors, even though this will be technically possible. In most cases, CTMs predating the IP Translator decision will have been registered for more than 5 years and will therefore be vulnerable to non-use cancellation. So the best course of action may well not be to introduce a large number of new terms on which use has not been made.

For CTMs where declarations are to be filed, these are some of the key points in the new rules:

- If a specification includes terms which are additional to a class heading, that does not prevent a declaration being made as long as the actual class heading is still present and is not limited by any additional terms.
- An official form is being created for the purposes of making these declarations. Its use is “highly recommended” rather than mandatory.
- The goods/services listed must all be in the alphabetical list of the edition of the Nice Classification in force at the time the relevant CTM was filed.
- OHIM will object to declarations, for a given class, which extend to the full alphabetical list or which include unclear or imprecise terms.
- Objections will similarly be raised against terms which are “*clearly covered by the literal meaning of the class heading.*”
- A list of goods and services which are, in OHIM’s opinion, clearly not covered by the literal meaning of the class headings in the relevant Nice editions has been compiled (see Annex I to Communication No. 1/2016 of 8 February 2016). No objections will be raised against declarations which include any of these terms.

The penultimate bullet point above is potentially a difficult area because a review of OHIM’s new list against the class headings reveals some inconsistencies of scope in both directions. For example, the list includes “*snack foods made from rice*” in class 30, even though the class heading includes “*preparations made from cereals*”, and rice is a cereal – this should point to rice snacks being covered and there being no need for the term to be in OHIM’s list. On the other hand, “*vegetables*” are regarded by OHIM to include potatoes, and consequently potato chips are not listed, as they are considered to be covered within the class 29 class heading under the general term “*preserved, frozen, dried, and cooked ...vegetables*”. So there is an inconsistency in “*vegetables*” being interpreted broadly but “*cereals*” narrowly.

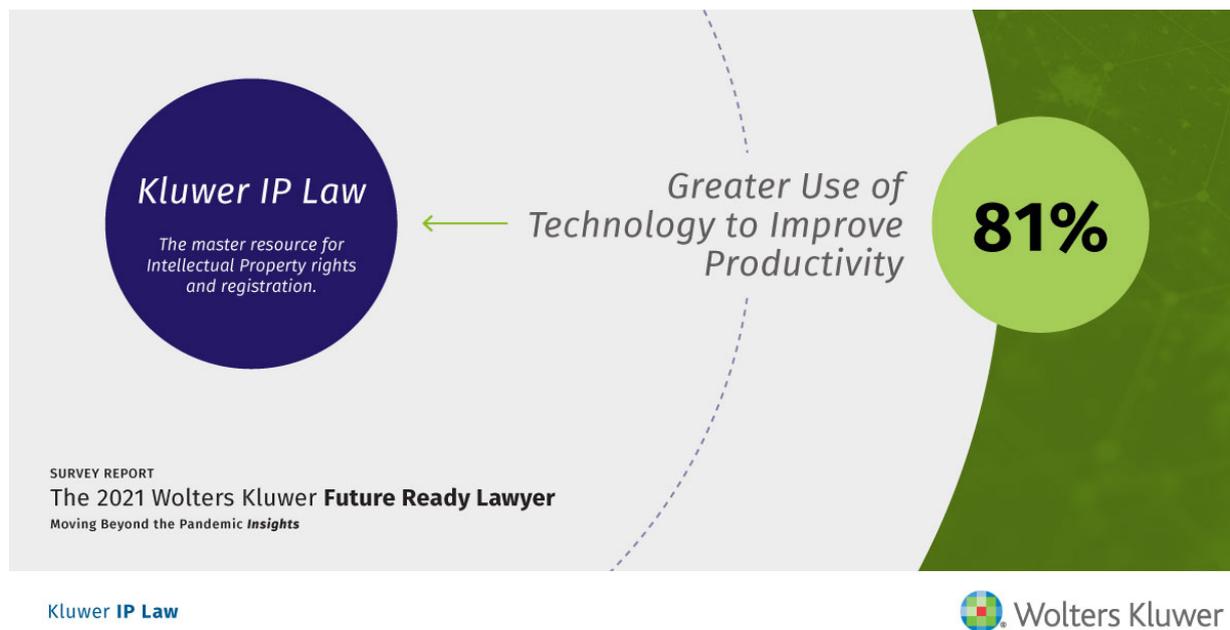
This just underlines that there will still be plenty of judgments to be made in the practicalities surrounding the making of these declarations.

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