

## What's in a trademark – More than it says?



The scope of protection of a trademark registration is determined by the specific sign and the specification of the goods and services for which the sign is to be used. The requirements for the identification of goods and services have not been harmonized so far. However, the class headings of the Nice Classification, which divides goods and services in 45 classes, had been a help and guidance.

In the past, the European trademark offices had two different approaches: The OHIM and some national trademark offices held that a specification merely listing all class headings of a certain class gives the trademark owner protection for all goods or services covered by the respective international class (*"class-heading-covers-all approach"*). Against this, many national trademark offices (e.g. in Germany) held that a trademark only enjoys protection for the explicitly specified goods or services (*"class-heading-covers-what-it-says approach"*).

## DECISION

In its decision of 19 June 2012 in the matter C-307/10 "IP TRANSLATOR", the European Court of Justice (ECJ) now refused the "*class-heading-covers-all*" approach of the OHIM.

The ECJ confirms that it is basically possible to use the general indications of the class headings of the Nice Classification in order to specify the goods and services, provided that they are sufficiently clear and precise. However, the ECJ observes that some of the general indications in the class headings are, in themselves, sufficiently clear and precise, while others are too general and cover goods or services which are too varied. Accordingly, it is for the competent authorities to assess on a case-by-case basis, according to the goods or services for which the applicant seeks the protection, in order to determine whether those indications meet the requirements of clarity and precision.

The ECJ also points out that if an applicant uses all the general indications of a particular class heading of the Nice Classification to identify the goods or services of a trademark registration, the applicant has to specify whether the application 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.

## CONSEQUENCES

Already on 20 June 2012, the OHIM published an official communication (No. 02/12) regarding the changes of its practice in order to implement the ECJ decision:

The Office will continue to accept the use of general indications of the class headings of the Nice Classification, provided that they meet the requirements set by the ECJ. More details will be found in OHIM's Manual of Trade Mark Practice.

Further, as regards Community trademarks (registered before 21 June 2012) using all the general indications listed in the class heading of a particular class, the OHIM considers that they 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 same shall apply to respective pending trademark applications, unless the applicant specifies that protection is only sought in respect of some of those goods or services in that class.

However, all respective new applications (as of 21 June 2012), using all the general indications listed in the class heading of a particular class, must expressly indicate whether or not their intention is to cover all the goods or services or only some of them. If all goods and services are claimed, the applicant must attach a declaration which is downloadable from OHIM's website.

Otherwise, the general indications will be interpreted following a literal approach, i.e. in their natural and usual meaning.

Summarizing, trademark owners should check the scope of protection of their Community trademarks and may – in case of vague general indications – consider the filing of new applications regarding such goods and/or services eventually not covered anymore by existing registrations. In addition, new applications have to meet the above mentioned new requirements.

If you have any questions or if you require more detailed information, please do not hesitate to contact us.

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