

Madrid Agreement and Protocol Concerning the International Registration of Marks

Indications that the Use of Class Headings of the Nice Classification in International Applications Is Intended to Cover all the Goods and Services Included in the Alphabetical Lists of the Classes Concerned

1. The International Bureau of the World Intellectual Property Organization (WIPO) would like to bring to the attention of applicants, holders, Offices of the Contracting Parties and users at large, that Rule 9 of the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement does not allow for international applications to include indications that the use of class headings of the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) is intended to cover all goods and services in the alphabetical lists of the classes concerned. Accordingly, and with respect to international applications including such indications, the International Bureau of WIPO will disregard any such indications.

2. Reference is made to Communication No. 2/12 of the President of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), which entered into force on June 21, 2012. In the aforesaid communication, the President indicates that:

“As regards Community trade mark applications filed as from the entry into force of the present Communication, in the case of applicants who use all the general indications of a particular class heading of the Nice Classification, they must expressly indicate whether or not their intention is to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services in that class.”

3. It is also recalled that, barring any irregularity concerning the indications themselves or their classification, the International Bureau of WIPO would accept the terms contained in the class headings of the Nice Classification as the indications of the goods and services for which the international registration of a mark is sought. Nevertheless, it is the Offices of the Contracting Parties designated in the aforesaid international registration which would ultimately determine the scope of protection of the mark in their corresponding territories.

4. In the course of the past few months, the International Bureau of WIPO has received some international applications that, while indicating the terms contained in the class headings of the Nice Classification as the goods and services for which the international registration is sought, contain a statement, either appended to the aforesaid terms or in the form of a separate document, to the effect that the applicant seeks protection for all the goods and services included in the alphabetical lists of the classes concerned. In most cases, the statement specifically refers to a designation of the European Union and invokes the aforementioned communication of the President of OHIM. In a few cases, the statement refers to designations of Contracting Parties other than the European Union or to the international registration itself.

5. Applicants wishing to cover all goods and services in the alphabetical list of a particular class may consider indicating in the international application all the terms contained in the alphabetical list of a particular class or classes (subject to the certification of the international application by the Office of origin).

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