



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

The President

Communication No X/XX of the President of the Office

of XX/XX/XXXX

concerning the implementation of Article 28 EUTMR

The President of the Office for Harmonization in the Internal Market (Trade Marks and Designs),

Having regard to Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark ('CTMR'),

Having regard to Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark ('CTMIR'),

Having regard to Regulation (EU) No XX/XXXX of XX/XX/XXXX of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs)(the 'Amending Regulation'),

Whereas:

- (1) Communication No 2/12 of the President of 20/06/2012 concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations established the practice of the Office as regards the scope of protection of class headings in applications and registrations filed before and after the entry into force of that communication in the light of the judgment of the Court of Justice of the European Communities of 19 June 2012 in Case C-307/10, 'IP Translator'.
- (2) Upon entry into force of the Amending Regulation, Article 28(1) to (7) of Council Regulation No 207/2009 as amended ('EUTMR') will lay down the requirements for designating and classifying goods and services, including the conditions for, and the consequences of, the use of class headings.
- (3) Article 28(8) EUTMR allows for a transitional period during which proprietors of EU Trade Marks that are registered in respect of the entire heading of a Nice class may declare that their intention on the date of filing had been to seek protection in respect of goods and services beyond those covered by the literal

meaning of that heading.

- (4) Pursuant to Article 124(2)(a) CTMR, the President of the Office will take all necessary steps, including the adoption of internal administrative instructions and the publication of notices, to ensure the functioning of the Office.
- (5) In the absence of more detailed implementing rules and in view of the need to give effect to Article 28 EUTMR, it is necessary to lay down the procedure for its implementation, explain the modalities of its application and determine its impact on future and existing registrations,

HAS ADOPTED THE FOLLOWING COMMUNICATION:

1. Scope of Article 28 EUTMR

Article 28(1) to (7) EUTMR lays down the requirements for designating and classifying goods and services, including the conditions for, and the consequences of, the use of the class headings of the Nice Classification.

In accordance with Article 28(3) EUTMR, the Office will accept the use of general indications included in the class headings of the Nice Classification or other general terms, provided that they comply with the requisite standards of clarity and precision. This provision applies directly to the designation of goods and services in all EU trade mark applications filed as from the entry into force of the EUTMR.

In accordance with Article 28(5) EUTMR, the use of class headings and other general terms will be interpreted as including all the goods or services clearly covered by the literal meaning of the general indication or term. This provision applies as from the date of entry into force of the EUTMR and extends to all marks filed **after** 21/06/2012, as well as to applications that were filed **on or before** that date but are still not registered.

Further details on the rules governing the designation and classification of goods and services are given in the Guidelines for Examination, Part B, Examination, Section 3, Classification.

Article 28(8) EUTMR introduces a transitional period during which proprietors of EU trade marks applied for before 22/06/2012 and registered for the entire heading of a Nice class may declare that their intention on the date of filing had been to seek protection for goods and services beyond those covered by the literal meaning of the heading of that class, provided that the goods or services so designated are included in the alphabetical list for that class of the edition of the Nice Classification in force at the date of filing.

Declarations made pursuant to Article 28(8) EUTMR ('declarations') are subject to the conditions specified in the present Communication.

2. Eligible Registrations

Declarations may only be made for EU trade marks that were filed before 22/06/2012 and continue to be registered in respect of the entire heading of at least one Nice class.

The existence of additional goods and services in the specification either in the same or in another class does not preclude the application of Article 28(8) EUTMR to the class that includes the entire heading, provided that the language used does not limit or in any way disclaim the general indications of the heading.

3. Time limit

Declarations must be submitted to the Office within six months of the entry into force of the Amending Regulation, that is to say, between XX/XX/2016 and XX/XX/2016 inclusive.

4. Form

In accordance with Rule 79 CTMIR, applications to record a declaration must be filed in writing.

In order to ensure that they are dealt with efficiently and expeditiously, the Office has created a specific online Recordal application form, which can be found in the User Area of the Office's website under 'Online forms — Online Recordal application — Recordal — EUTM Recordal — Declaration under Art. 28(8)' ('the form').

The form contains a text box for indicating the goods and services claimed in accordance with paragraph 8 below.

The text box should be completed by indicating the class number followed by the names of the goods and services to be added. The class number should be indicated at the start and the individual goods and services should be separated by commas (to separate items within a similar category or expression) and/or semicolons (to separate expressions), as necessary. Each different class should be listed on a new line following a paragraph break.

The use of the online form is highly recommended as it may considerably decrease the likelihood of formal deficiencies. Applicants who opt for other means of communication must ensure that their application complies with the requirements established in this Communication.

5. Language

In accordance with Rule 95(b) CTMIR, declarations must be filed in one of the five languages of the Office, namely English, French, German, Italian or Spanish.

Any language version of the form identified in paragraph 4 above may be used, provided that it is completed in one of the languages of the Office, in particular the list of goods and services.

6. Applicants and Representatives

Declarations must be submitted to the Office by the proprietor(s) of the EU trade mark or their duly appointed representative.

The standard rules on mandatory representation apply (see Article 92(2) EUTMR).

When the proprietor appoints a representative, he or she must indicate the representative's name and ID number. If the representative has not yet been assigned an ID number, the business address must be indicated. The Office may request an authorisation in accordance with Articles 92(3) and 93(1) EUTMR, in particular if the declaration is submitted by an employee representative or by a representative that is not the representative on file.

7. Mandatory Indications

By analogy with Rule 36(1) CTMIR declarations must contain the following information:

- a) the registration number of the EU trade mark concerned;
- b) the proprietor's name and the ID number attributed to the proprietor by the Office;
- c) an indication of each of the goods and services the proprietor wishes to add, in accordance with paragraphs 4 and 8.

Pursuant to Rule 79 CTMIR, the claim must be signed by the EU trade mark proprietor or its duly appointed representative.

In accordance with Rules 80 and 82 CTMIR, if the declaration is submitted by fax or by electronic means, the indication of the sender's name is deemed to be equivalent to a signature.

8. Content of the Declaration

The goods and services designated in accordance with Article 28(8) EUTMR must be indicated in the proprietor's declaration in a clear, precise and specific manner.

The declaration must only include goods and/or services that:

- (a) are contained in the alphabetical list for the class in question of the edition of the Nice Classification in force at the date of filing, and
- (b) go beyond the literal meaning of those covered by the general indications of the corresponding class heading.

The Office will object to the use of unclear, imprecise or unspecific terms, to claims for the entire alphabetical list, to declarations for goods and services that are deemed to be clearly covered by the literal meaning of the class heading or to declarations for goods or services not contained in the alphabetical list in question.

In order to assist proprietors in identifying goods and services that go beyond the literal meaning of the general indications of the class headings, the Office has compiled a list of examples of such goods and services as Annex I to this Communication. Declarations relating to any of the goods or services included in this list for the corresponding class and edition will not be objected to by the Office on the ground of being covered by the literal meaning of the general indications.

9. Fees

Declarations are not subject to a fee.

10. Examination by the Office

The Office will examine whether the declaration complies with the requirements of Article 28(8) EUTMR and with paragraphs 2 to 8 of the present Communication.

If the declaration does not comply with the above requirements, the Office will issue a deficiency letter stating why the claim is unacceptable and setting a deadline of two months for the proprietor to remedy the deficiency.

In the absence of a response, or if the deficiency is not remedied, the declaration will be rejected.

In accordance with Articles 58 to 60 and 135 EUTMR, the proprietor may file an appeal against this decision.

11. Registration and Publication

If the declaration complies with the requirements of Article 28(8) EUTMR and paragraphs 2 to 8 above, the Office will record it in the Register and inform the proprietor accordingly.

The declaration will be published in the EUTM Bulletin in part C.3.2.

The publication will contain the following data:

- the EU trade mark registration number
- the list of goods and services after the Article 28(8) EUTMR declaration
- the date and number of the entry in the Register of the Article 28(8) EUTMR declaration
- the date of publication of the entry in the EUTM Bulletin
- the indication 'Art. 28(8)' under INID code 580.

12. Traceability

In the interests of legal certainty, and in order to enable the competent authorities and economic operators to keep track of additions made by virtue of Article 28(8) EUTMR, in particular for the purposes of applying Article 28(9) EUTMR, declarations that are accepted will be entered in the Register and can be searched for/accessed in two ways.

- Using the Office's online database (eSearch plus) under the 'Publications' section for the mark concerned, identified by the description 'Partial Surrender / Declaration under Art.28(8) EUTMR'. Upon clicking, the relevant publication will open in the CTM Bulletin under part C.3.2 'Partial Surrender / Declaration under Art.28(8) EUTMR' with the indication 'Art. 28(8)' under INID code 580.
- Using the Office's online database (eSearch plus) under the 'Records' section

for the mark concerned, identified as recordal type 'Declaration under Art. 28(8) EUTMR'.

13. Effect

As from the end of the period referred to in paragraph 3, all the marks referred to in paragraph 2 for which no acceptable declaration has been filed will be deemed to extend only to goods or services clearly covered by the literal meaning of the indications included in the heading of the relevant class.

During the transitional period referred to in paragraph 3, above, Communication No 2/12 of 20/06/2012 of the President of the Office will continue to apply.

Declarations for EU trade marks filed within the period referred to in paragraph 3 above will take effect from the date of their entry in the Register. Until registration is effected, the previous paragraph will apply.

14. Limitations of Rights

Where the declaration is accepted and the Register is amended, Article 28(9) EUTMR will apply.

In consequence, the amendment of the list of goods and services of the earlier EU trade mark pursuant to Article 28(8) EUTMR will not give the proprietor the right to prevent the use by third parties of any of the goods or services so added, provided that use commenced before the Register was amended and did not infringe the proprietor's rights on the basis of the literal meaning of the goods and services in the Register at that time.

Nor will the proprietor have the right to oppose or to apply for a declaration of invalidity of a later trade mark if that later trade mark was in use or had been applied for prior to a declaration being entered in the Register and that the use in relation to those goods or services did not infringe, or would not have infringed, the proprietor's rights based on the literal meaning of the goods or services recorded in the Register at that time.

Further details on the modalities of application of Article 28(9) EUTMR are given in the Guidelines for Examination, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 2, Comparison of Goods and Services.

15. Relationship with Other Provisions

Article 28(8) EUTMR is an exceptional, transitional, arrangement, which allows proprietors to amend the wording of their specifications in the interests of legal certainty by expressly identifying goods and services that they originally intended to include in their specifications but were not clearly reflected in the Register as falling outside the natural and usual meaning of the class heading concerned.

Proprietors are advised to consider carefully the declaration they wish to make under Article 28(8) EUTMR, bearing in mind, in particular, that any such addition of goods and services (i) is made without prejudice to Article 15, Article 42(2) and Article 51(1)(a) EUTMR, with regard to the obligation to put said goods and services

to genuine use and (ii) will be subject to the sanctions of Article 28(9) EUTMR.

Declarations made pursuant to Article 28(8) EUTMR should not be confused with, or be considered as an alternative to, partial surrenders within the meaning of Article 50 EUTMR, which are, and will remain, available to proprietors after the end of the transitional period.

In particular, declarations under Article 28(8) EUTMR should not be used to restrict lists containing class headings to specific goods or services covered by their literal meaning or to replace a general indication with more precise terms.

In such cases, proprietors should make use of partial surrenders under Article 50 EUTMR using the 'Online forms — Online Recordal application — Recordal — EUTM Recordal — Partial Surrender'.

Article 154 EUTMR does not contemplate the application of Article 28(8) EUTMR to international registrations designating the EU. Consequently the provisions of this Communication do not apply to international registrations designating the EU.

16. Entry into Force

This Communication enters into force on the date of entry into force of the amending Regulation, that is to say on .../.../2016. It will be published in the Office's Official Journal.

Communication No 2/12 of the President of 20/06/2012, concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations, is repealed

- as of XX/XX/XXXX insofar as it concerns EU trade marks filed after 21/06/2012 and EU trade marks filed before 22/06/2012 but not yet registered at the time of entry into force of the EUTMR;
- as of XX/XX/XXXX for marks filed before 22/06/2012 and registered in respect of an entire Nice class heading at the time of entry into force of the EUTMR for which no declaration is filed;
- as of the date of entry in the Register of the declaration for those marks for which a declaration that is accepted is filed within the period referred to in paragraph 3 above.

António Campinos
President