

Declarations under Article 28(8) EUTMR

Frequently asked questions

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1. Who can make a declaration under Article 28(8) EUTMR?

Proprietors of EU trade marks filed before 22/06/2012 and registered before the entry into force of Regulation XX/XXXX of XX/XX/XXXX amending Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark that contain the entire heading of a Nice class.

2. Do I need to appoint a representative?

The general rules on representation apply (see the Guidelines for Examination, Part A, General Rules, Section 5, Professional Representation).

3. When can the declaration be made?

Article 28(8) EUTMR declarations must be made within six months of the entry into force of the Regulation.

4. Can the six-month period be extended?

The six-month period for making the declaration cannot be extended. However, if the Office issues a deficiency letter, remedies may be submitted after expiry of the six-month period.

5. Will trade mark owners be informed about the need to amend?

Trade mark owners will not be informed individually by the Office about the possibility of filing a declaration under Article 28(8) EUTMR. A communication from the President of the Office will be issued explaining in detail which marks are affected and what steps owners should take if they wish to amend their specifications.

6. Does it cover only CTMs or also national trade marks?

Article 28(8) EUTMR applies only to EU trade marks (CTMs).

7. What form should I use?

The Office has created a new online recordal application form, under 'EUTM Recordal', type 'Declaration under Art.28(8) EUTMR'.

The form must be completed in one of the five languages of the Office.

8. Will there be a fee for making an Article 28(8) EUTMR declaration?

No. These recordals are free of charge.

9. Will it be possible to amend any general indication, or only those considered to be unclear or imprecise (i.e. the 11 general indications)?

Under Article 28(8) EUTMR, it will only be possible to specify the goods and services that go beyond the literal meaning of the class heading of that class, provided that the goods and services are included in the alphabetical list for the class of the edition of the Nice Classification in force at the date of filing.

It will not be possible to amend general indications considered to be too vague under Article 28(8) EUTMR.

Requests to amend the specification of goods or services to those covered by the literal meaning should be filed, as usual, under Article 50 EUTMR using the 'Partial Surrender' recordal type (for more information, see the Guidelines for Examination, Part E, Register Operations, Section 1, Changes in a Registration, paragraph 1.3.5).

10. What criteria will be applied to determine whether an expression is clear and precise?

Declarations can only be made for specific goods or services contained within the alphabetical list and not covered by the literal meaning of the class heading for the class of the edition of the Nice Classification in force at the date of filing. Such goods and services are deemed to be sufficiently clear and precise.

11. Will marks that have been limited as such, or as the result of opposition, or cancellation proceedings, be able to expand their protection under Article 28(8) EUTMR?

Oppositions resulting in a mark being partially rejected must have been worded in that manner. Examiners will, however, be instructed to ensure that this is not an issue.

12. Will there be a possibility of opposition or cancellation proceedings against the goods and services included in an Article 28(8) EUTMR declaration?

Under current practice, as defined in Communication No 2/12 of the President of the Office of 20/06/2012, marks filed on or before 21/06/2012 covering all the general indications of a particular class heading of the Nice Classification are interpreted as covering all the goods and services included in the alphabetical list of the particular class concerned in the edition in force at the time when the filing was made.

The transitional period during which holders can declare that their intention was to cover specific goods and services of the alphabetical list not covered by the literal meaning at the time of filing is an opportunity for holders to clarify the exact scope of their goods and services. It is not considered to be an extension of the scope of goods and services, but rather a clarification based on the assumption that these goods and services already formed part of the scope of the registration, despite the fact that this was not explicitly stated.

The exact wording of Article 28(8) EUTMR makes it clear that the possibility to make such a declaration is without prejudice to use requirements. That provision, however, does not foresee the possibility of filing an opposition or cancellation against the said declaration. Nor does this situation fall under Rule 14 CTMIR, which is only applicable to the publication of applications. It is clear, therefore, that the intention of the legislator was that no new opposition period should be opened.

Six months after the entry into force of the new regulation, and where no declaration under Article 28(8) EUTMR has been made, those marks will be deemed to cover only goods and services clearly covered by the literal meaning of the indications included in the relevant class heading.

13. Is the list of vague terms considered to be exhaustive?

Declarations can only be made for specific goods or services contained in the alphabetical list that are not covered by the literal meaning of the class heading for the class of the edition of the Nice Classification in force at the date of filing. Such goods and services are deemed to be sufficiently clear and precise.

14. If my mark fulfils all the requirements for making an Article 28(8) EUTMR declaration, but I do not make one, what are the consequences?

Six months after the entry into force of the new regulation, and where no declaration under Article 28(8) EUTMR has been made, those marks will be deemed to cover only goods and services clearly covered by the literal meaning of the indications included in the relevant class heading.

15. How will the adjustment to the 'IP Translator' judgment be carried out?

Declarations that are accepted under Article 28(8) EUTMR will be recorded in the Register and published in the Bulletin in part C.3.2. These changes will also be reflected in [eSearch plus](#).

16. How does the Office deal with oppositions based on a national trade mark registration, when the list of goods contains the class heading of the class?

Table 5 of the Common Communication on the Implementation of 'IP Translator' explains how the Office interprets the scope of protection of national trade marks containing general indications of the Nice class headings.

17. How do I know if I have all the general indications of the class heading?

WIPO's web page on the [Nice Classification](#) contains all the editions and versions of the Nice Classification since it was established, as well as an indication of the class headings for each edition/version.

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. For example, a limitation in the class heading of Class 25, *Clothing; footwear; headgear* to 'except shirts' would preclude the application of Article 28(8) EUTMR, because the general indication 'clothing' has been limited.

18. Can I file multiple declarations under Article 28(8) EUTMR for the same mark?

In principle, a single declaration should be filed for each mark. However, if a deficiency is raised that is not overcome during the period for response, the proprietor may submit a new declaration providing the six-month period is still running.

19. Where can I find more information?

Information on the change in practice can be found in Communication No XX/XXXX of the Executive Director of the Office.