

COMMON COMMUNICATION
ON THE INTERPRETATION OF SCOPE OF
PROTECTION OF NICE CLASS HEADINGS
(FORMERLY *IMPLEMENTATION OF 'IP*
***TRANSLATOR'*)**

MARCH 2022

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1 Introduction

In December 2015, the European Parliament and the Council adopted the EU trade mark reform package. The reform contained Directive No 2015/2436 (hereafter 'TMD') and Regulation No 2017/1001 (hereafter 'EUTMR'), which were envisioned to further enhance the harmonisation of trade mark law in the European Union. Following the transposition of the TMD into national laws and the entry into force of the EUTMR, and in order to improve user friendliness and accessibility, this Common Communication provides guidance on the interpretation of the scope of protection of trade marks containing entire Nice class headings (formerly known as the *Common Communication on the Implementation of 'IP Translator'*).

2 Background

On 19 June 2012, the Court of Justice delivered its ruling in [Case C-307/10 'IP Translator'](#), which provided answers to questions related to the use of the general indications of the class headings of the Nice Classification. In particular, one of the three questions asked to the Court and the answer provided was:

In the context of [Directive 2008/95], is it necessary or permissible for such use of the general words of the Class Headings of [the Nice Classification] to be interpreted in accordance with Communication No 4/03 ...?

"An applicant for a national trade mark who uses all the general indications of a particular class heading of the Nice Classification to identify the goods or services for which the protection of the trade mark is sought must specify whether its application for registration 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."

Given the impact of the judgment on European classification practice at the time and on the interpretation of the scope of protection awarded by the use of the general indications of the Nice class headings, it was clear that a harmonised interpretation of the judgment by Member State Intellectual Property Offices, the Benelux Office for Intellectual Property and the European Union Intellectual Property Office (hereinafter collectively 'IPOs') would bring greater transparency, predictability, and legal certainty for both competent authorities and economic operators. The IPOs and User Associations (hereinafter 'UAs') expressed their willingness to collaborate on such an initiative and carried out a series of meetings and fruitful discussions covering the different areas of the judgment.

The extensive effort invested by IPOs and UAs resulted in the ***Common Communication on the Implementation of 'IP Translator' v1.2***, which provided an overview of how each IPO dealt with specific topics related to the implementation of the Court of Justice ruling, particularly as regards the question above.

Pursuant to Article 39(5) TMD and Article 33(5) EUTMR,

*"The use of general terms, including the general indications of the class headings of the Nice Classification, shall be interpreted as including all the goods or services **clearly covered by the literal meaning of the indication or term**. The use of such terms or indications shall not be interpreted as comprising a claim to goods or services which cannot be so understood."*

In light of the changes in the TMD and the EUTMR, the *Common Communication on the Implementation of 'IP Translator'* has been revised by IPOs and UAs. In particular, information regarding the scope of protection of entire Nice class headings has been updated, outdated tables have been archived, terminology has been

clarified and explanations regarding the practices of some IPOs have been provided. Finally, the Common Communication title has been changed to better reflect the content of the document.

The overview of the practices of each IPO addresses the following topics:

- How each IPO interprets the scope of protection of its own trade marks containing entire Nice class headings
- How each IPO interprets the scope of protection of EU trade marks (EUTMs) containing entire Nice class headings
- How the EUIPO interprets the scope of protection of national trade marks containing entire Nice class headings

3 Glossary

For the purpose of this document, the following terminology is used:

LITERAL: the scope of protection of trade marks containing the Nice class headings is interpreted as including the goods/services covered by the literal meaning of the general indications of those class headings.

e.g.: “Clothing, footwear and headgear” (the entire Nice class heading of Class 25) only encompasses the goods covered by the literal meaning of each indication, such as, respectively, trousers, sandals and hats.

LITERAL AND ALPHABETICAL LIST: the scope of protection of trade marks containing entire Nice class headings is interpreted as including the goods/services covered by the literal meaning of the general indications of those class headings and those included in the alphabetical list for those classes (even if those goods/services are not covered by the literal meaning of the general indications) in the edition of the Nice Classification in force at the date of filing.

e.g.: “Clothing, footwear and headgear” (the entire Nice class heading of Class 25), in addition to the goods covered by the literal meaning of each indication, would also cover the goods included in the alphabetical list for Class 25, even if they are not covered by the literal meaning of clothing, footwear and headgear, such as pockets for clothing, heels, hat frames [skeletons], if listed in the edition of the Nice Classification in force at the date of filing.

LITERAL, ALPHABETICAL LIST AND OTHER TERMS (Nice class heading covers all the goods/services in the class): the scope of protection of trade marks containing entire Nice class headings is interpreted as including the goods/services covered by the literal meaning of the general indications of those class headings, the ones included in the alphabetical list for those classes (even if they are not covered by the literal meaning of the general indications) in the edition of the Nice Classification in force at the date of filing and any other terms classified in the corresponding classes although not included in the respective alphabetical lists.

e.g.: “Clothing, footwear and headgear” (the entire Nice class heading of Class 25), in addition to the goods covered by the literal meaning of each indication and those included in the alphabetical list for Class 25 (in the edition of the Nice Classification in force at the date of filing), even if they are not covered by the literal meaning of clothing, footwear and headgear, would also cover any other term belonging to that class but not included in the alphabetical list, such as boot cuffs.

4 Scope of protection of trade marks containing entire Nice class headings

4.1 Interpretation by the Offices of the scope of protection of their own marks containing entire Nice class headings

IPO	Trade marks filed <u>before</u> 'IP Translator'	Trade marks filed <u>after</u> 'IP Translator' and <u>before</u> TMD transposition / EUTMR	Trade marks filed <u>after</u> TMD transposition / EUTMR
AT	Literal	Literal	Literal
BG	Literal, alphabetical list and other terms	Literal ¹	Literal
BOIP	Literal	Literal	Literal
CY	Literal	Literal	Literal
CZ	Literal	Literal	Literal
DE	Literal	Literal	Literal
DK	Literal	Literal	Literal
EE	Literal	Literal	Literal
ES	Literal	Literal	Literal
EUIPO	Literal ¹	Literal	Literal
FI	Literal ²	Literal	Literal
FR	Literal	Literal	Literal
GR	Literal, alphabetical list and other terms	Literal	Literal
HR	Literal	Literal	Literal
HU	Literal, alphabetical list and other terms	Literal and alphabetical list	Literal ³
IE	Literal	Literal	Literal
IT	Literal, alphabetical list and other terms	Literal ⁴	Literal
LT	Literal and alphabetical list	Literal	Literal
LV	Literal	Literal	Literal
MT	Literal	Literal	Literal
PL	Literal	Literal	Literal
PT	Literal	Literal	Literal
RO	Literal ¹	Literal ¹	Literal
SE	Literal	Literal	Literal
SI	Literal	Literal	Literal
SK	Literal	Literal	Literal

(1) See Annex 1 (BG, RO) and Annex 2 (EUIPO) for information on specific measures taken by IPOs.

(2) Following the transposition of the TMD, a transitional period was established during which the owners of trade marks containing entire Nice class headings and filed before 1 October 2012 can specify the scope of protection intended at the date of filing. This further specification must be made through a separate request and **no later than on the date on which the application for the renewal of the mark is filed for the first time** after the transposition of the TMD (i.e. as of 1 May 2019 and, in principle, effectively until 31 October 2029 – including the period of late submission of the request for renewal). After any such renewal, the goods/services covered by the mark are to be interpreted only on the basis of their literal meaning.

(3) TMD transposition took place on 1 January 2019.

(4) From 20 May 2014.

4.2 National offices' interpretation of the scope of protection of EUTMs containing entire Nice class headings

EUTMs irrespective of the filing date
Terms of the class headings are to be interpreted literally.

4.3 EUIPO interpretation of the scope of protection of national trade marks containing entire Nice class headings

For trade marks filed <u>before</u> 'IP Translator'	For trade marks filed <u>after</u> 'IP Translator'
<p>National trade marks are to be given the scope of protection awarded by the national IP Office unless the National Office interprets the Nice class headings to cover all goods/services in the class.</p> <p>In this case, the national trade marks are to be interpreted as covering the class heading on a 'literal' basis and including the alphabetical list of the Nice edition in force at the date of filing.</p>	<p>Terms of the class headings are to be interpreted literally.</p>

Annex 1 Information on measures taken by the BG and RO IPOs to clarify the scope of protection of trade marks filed before the TMD transposition containing entire Nice class headings

- **BG:**

The IPO gives the opportunity to trade mark owners to **specify**, via a **declaration**, the scope of protection intended at the date of filing (for trade marks filed after ‘IP Translator’ and before the transposition of the TMD). Therefore, goods/services included in the alphabetical list, and other terms classifiable in the particular class, may be requested to be added by trade mark owners.

In the absence of such a declaration, the goods/services covered by the mark filed after ‘IP Translator’ and before the transposition of the TMD are to be interpreted only on the basis of their literal meaning.

- **RO:**

During a two-month-and-a-half transitional period (from 13 July 2020 to 30 September 2020), owners of trade marks registered in respect of the entire Nice class headings, could **specify**, via a **declaration**, that their intention at the date of filing was to seek protection for goods/services other than those covered by the literal meaning of the general indications making up the entire Nice class headings, provided that the goods/services so specified were included in the alphabetical list of that class in the edition of the Nice Classification in force at the date of filing.

Furthermore, in relation to trade marks filed after ‘IP Translator’ (after 22 June 2012) and before the TMD transposition (before the entry into force of *Law No 112/2020* on 13 July 2020, amending *Law No 84/1998*), trade mark owners had the possibility to **specify, within the application itself**, that the scope of protection should also include the alphabetical list.

Trade marks for which no declaration was filed within the period referred to above (in the first paragraph), or for which no specification as referred to above (in the second paragraph) was included, are deemed to extend only to goods/services covered by the literal meaning of the indications included in the heading of the relevant class.

Annex 2 Information on measures taken by the EUIPO to clarify the scope of protection of trade marks filed before ‘IP translator’ containing entire Nice class headings

- **EUIPO:**

During a six-month transitional period (from 23 March 2016 to 24 September 2016), trade mark owners could **specify**, via a **declaration**, the scope of protection of the trade mark intended at the date of filing (for trade marks filed before 22 June 2012). The owners of the trade marks registered in respect of the entire class heading of a Nice class could declare that their intention at the date of filing had been to seek protection in respect of goods/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 in the edition of the Nice Classification in force at the date of filing.

EUTMs for which no declaration was filed within the period referred to above are 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.