



THE CLASS HEADINGS ISSUE

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BASIC ELEMENTS OF A TRADE MARK REGISTRATION

SIGN →



GOODS/SERVICES →

Dancing queen services.

**THE MARK (SIGN) IS THE KEY ELEMENT
TO DIFFERENTIATE GOODS AND
SERVICES OF THE SAME NATURE**



Realmadrid
CLUB DE FUTBOL



**FOR NORMAL TMs, THE SAME SIGN IS ABLE TO
DISTINGUISH DIFFERENT GOODS/SERVICES FROM
DIFFERENT PRODUCERS**



**LOTUS -
Cars**



**IBM LOTUS
SYMPHONY
- Software**



**LOTUS -
Watches**

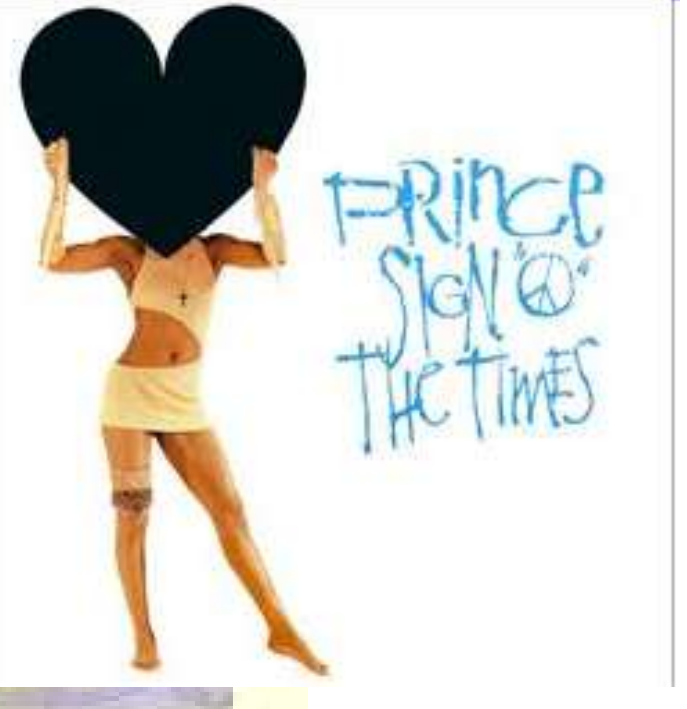
LEGAL BASIS IN THE CTMR (i)

Signs of which a CTM
may consist
Article 4

“Signs capable of distinguishing the goods or services of one undertaking from those of other undertakings”



gentlemen
WE CAN'T DANCE



LEGAL BASIS IN THE CTMR (i)

Signs of which a CTM
may consist
Article 4

“Signs capable of distinguishing the goods or services of one undertaking from those of other undertakings”

Filing request
Article 26.1c)

“A list of goods or services ...”





MICHAEL JACKSON

TRADE MARK SONGS



30TH
8-11 JUNE
-2011-
**ANNUAL
CONFERENCE
STOCKHOLM**
WELCOME TO SWEDEN

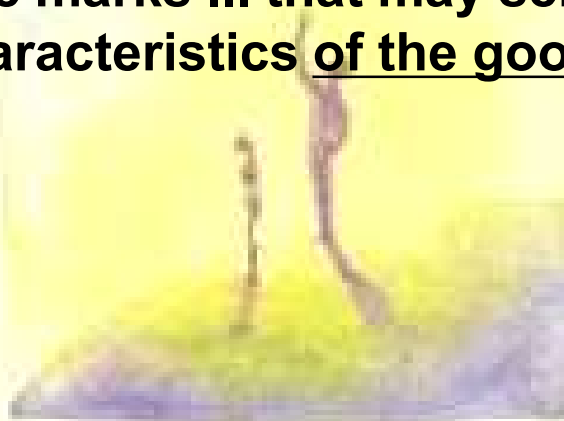
CTMR (i)

capable of distinguishing the goods or services of one undertaking from those of other undertakings”

of goods or services ...”

**Absolute grounds
Article 7.1c)**

“trade marks ... that may serve ... to designate ... characteristics of the goods or services”



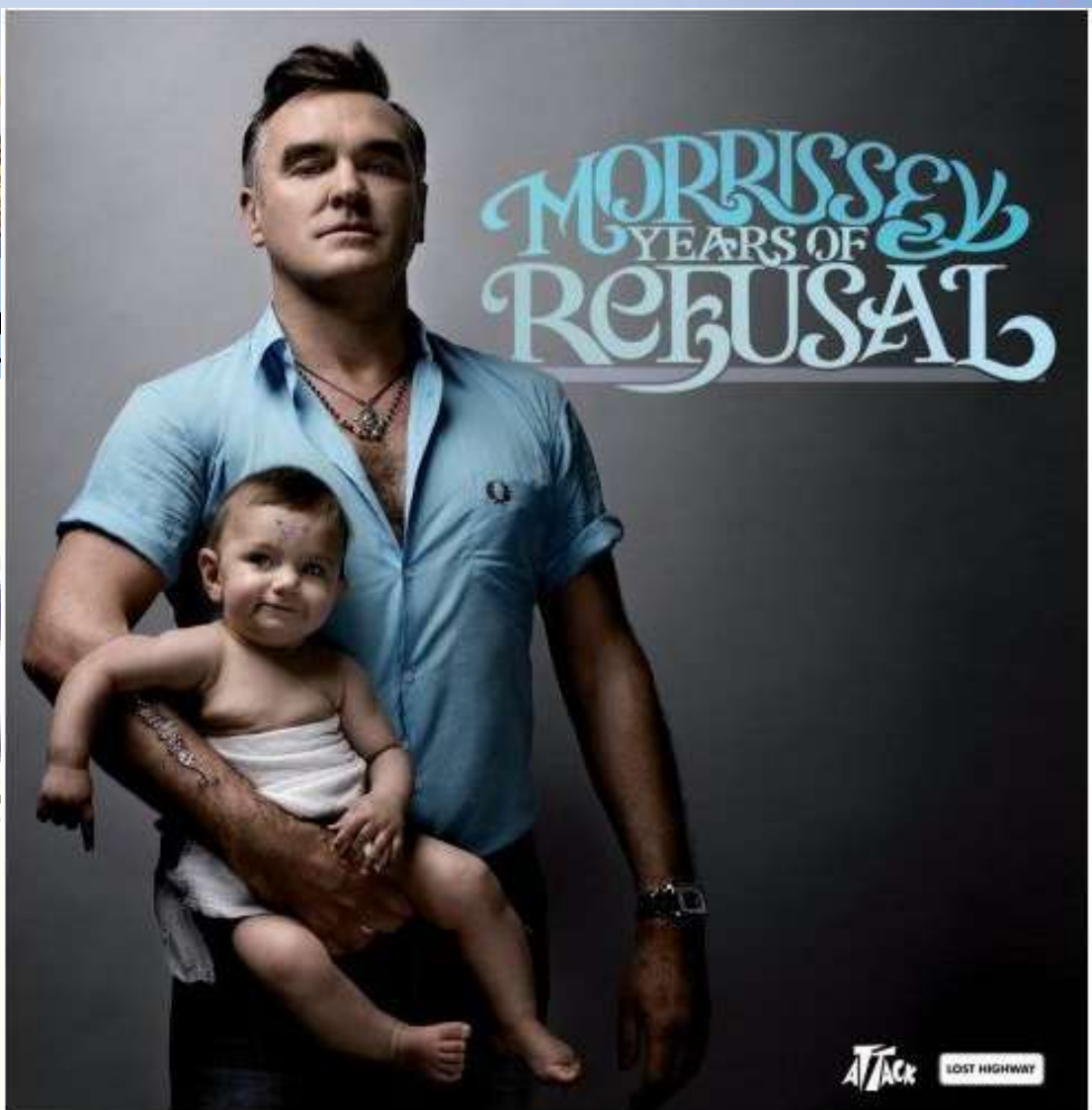
LEGAL BASIS IN

Signs of which a CTM
may consist
Article 4

Filing request
Article 26.1c)

Absolute grounds
Article 7.1c)

Relative grounds
Article 8a)
Article 8b)



Two trade marks with:
Identical sign and identical goods/services
Identical/similar sign and identical/similar goods/services

or

ate

LEGAL BASIS IN THE CTMR (ii)

Rights conferred by a
CTM
Article 9.1

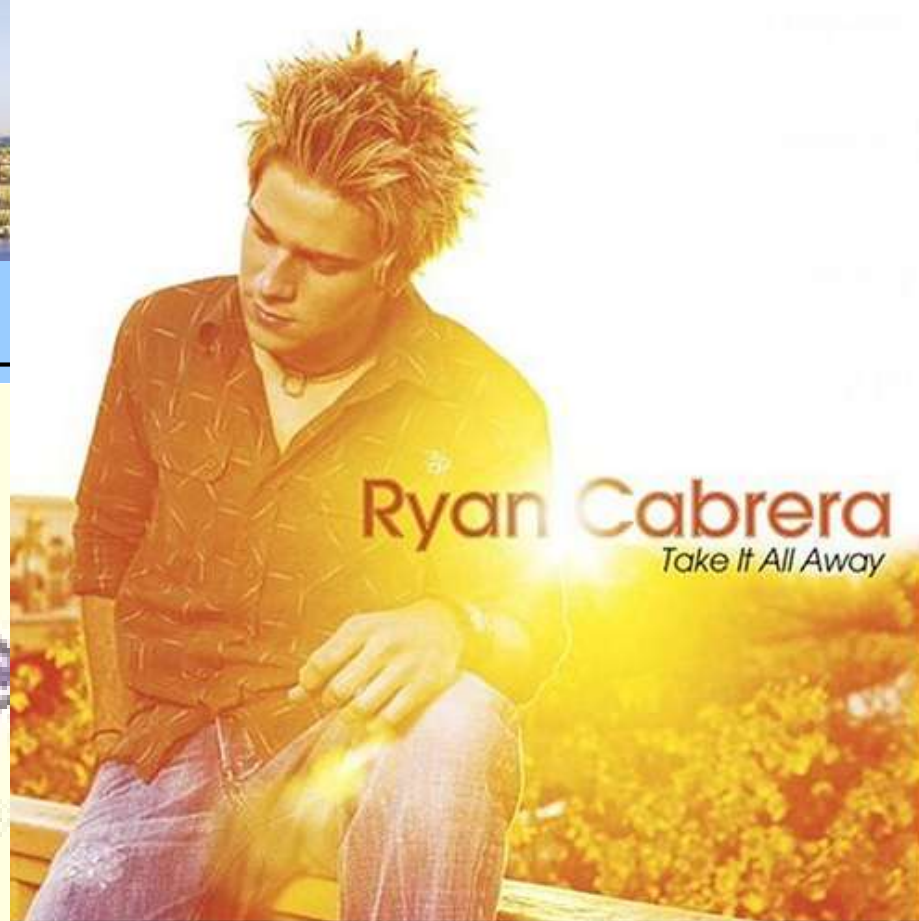
Exclusive rights against the use of:

- Identical sign for identical goods/services
- Identical/similar sign for identical/similar goods/services
- Identical/similar sign for dissimilar goods/services when reputation exists



LEGAL BASIS

Rights conferred by a
CTM
Article 9.1



of:
goods/services
identical/similar

similar
connection exists

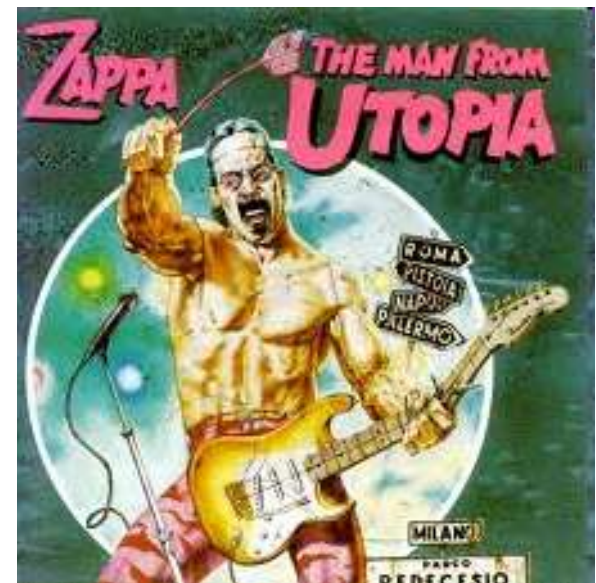
Grounds for revocation
Article 51.1a)

Article 51.2

Lack of use (for 5 consecutive years) of the sign “in connection with the goods or services in respect of which it is registered”
Where the grounds of revocation of rights exist in respect of only some goods or services ...
Revoked in respect of those goods or services.

THE RELEVANCE OF THE GOODS/SERVICES IN THE CTMR RELATE:

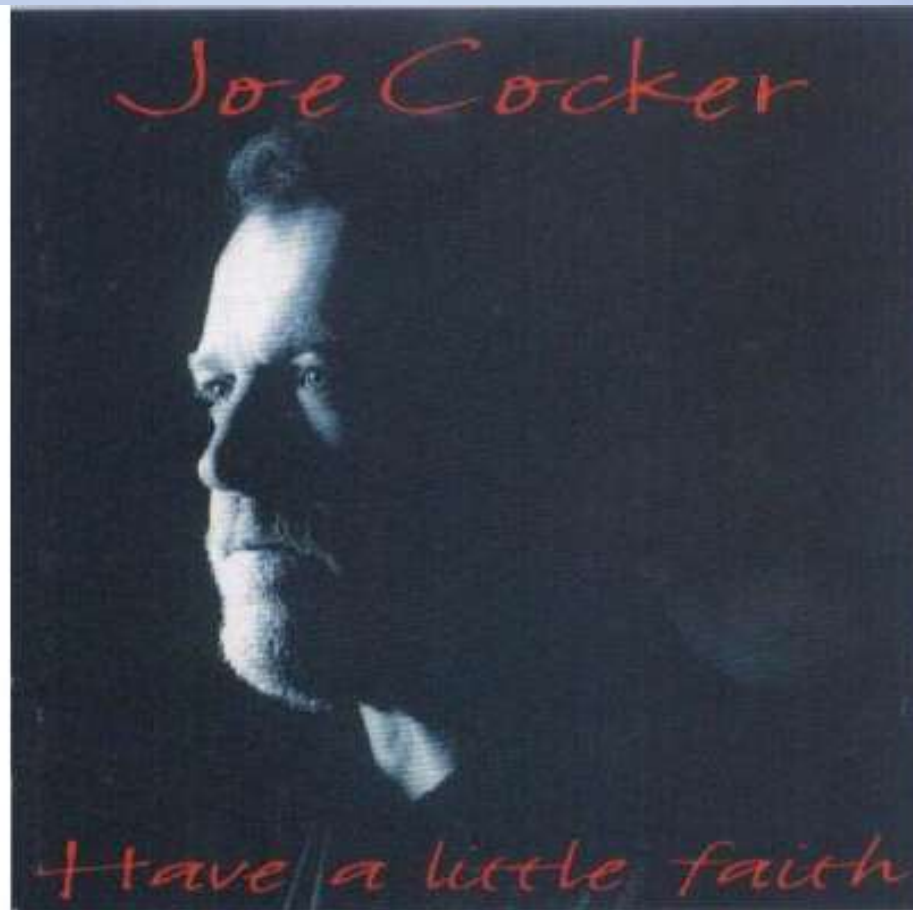
- TO THE DEFINITION OF THE RIGHT



THE RELEVANCE OF THE GOODS/SERVICES IN THE CTMR RELATE:

- TO THE DEFINITION OF THE RIGHT
- TO THE AVAILABILITY TO BE REGISTERED

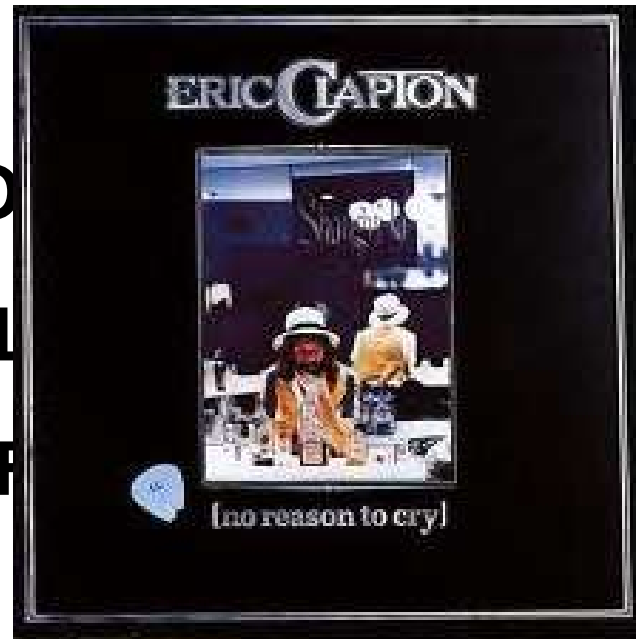




- -
 - **TO THE SCOPE OF PROTECTION OF THE REGISTRATION**
- RED**

THE RELEVANCE OF THE GOODS/SERVICES IN THE CTMR RELATE:

- TO THE DEFINITION
- TO THE AVAILABILITY
- TO THE SCOPE OF
- TO THE GROUNDS FOR REVOCATION



WHAT DO WE MEAN BY CLASS HEADINGS?

WHO ARE YOU

- AN INDICATION, IN A GENERAL MANNER, OF THE FIELDS TO WHICH THE GOODS/SERVICES IN PRINCIPLE BELONG
- APPEARS IN THE WIPO INTERNATIONAL CLASSIFICATION GUIDE BOOK
- CONSISTS IN 34 CLASS HEADINGS FOR GOODS AND 11 FOR SERVICES

WHAT DO WE MEAN BY CLASS HEADINGS?

• AN EXAMPLE:

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.



THE CURRENT OHIM PRATICE

- Same basic fee (900€) covers 3 classes. An extra fee (150€) for each additional class exceeding 3 (Rule 23).



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- OHIM accepts that class headings are indicated.



THE CURRENT OHIM

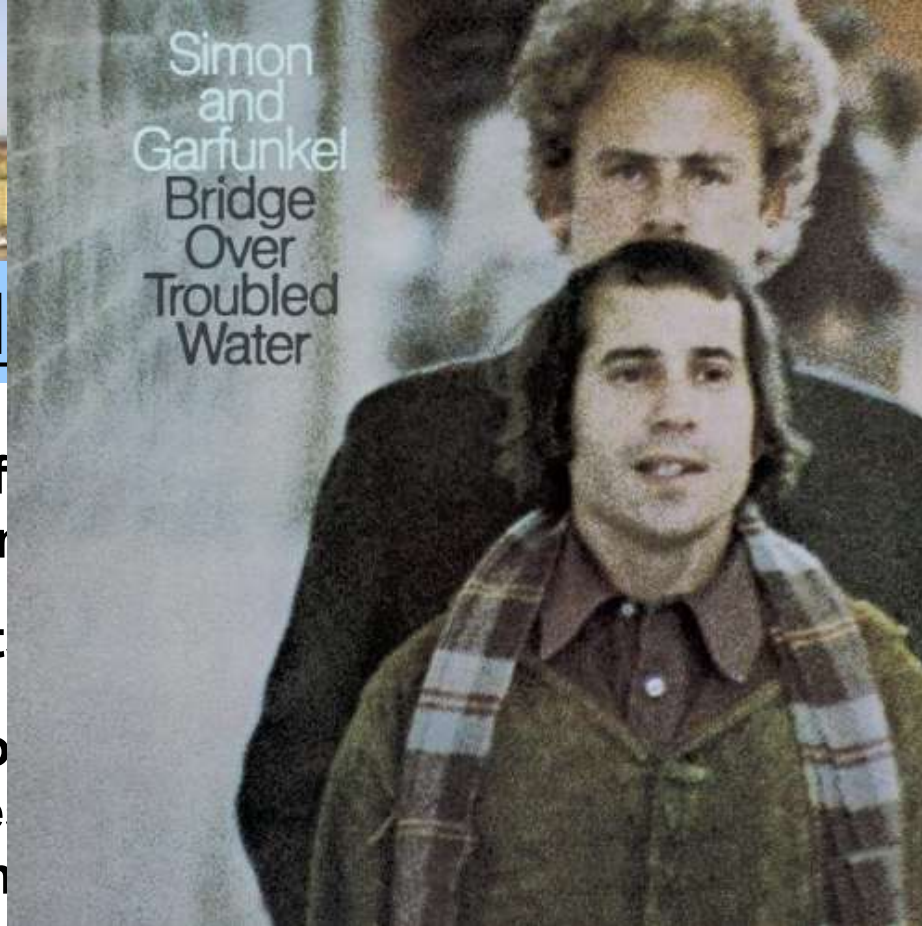
- Same basic fee (900€) covers 3 classes. An each additional class exceeding 3 (Rule 23)
- OHIM accepts that class headings are indicative
- According to Communication of the President N° 4/03 (June 16, 2003), the designation of class headings would be equivalent to designating “all goods/services” in that class.



Simon
and
Garfunkel
Bridge
Over
Troubled
Water

TH

- Same basic f
each addition
- OHIM accept
- According to
2003), the de
to designatin



NTICE

fee (150€) for

4/03 (June 16,
e equivalent

- 1996 first filings “all goods/services in class X.” Article 36.1a) (Examination of conditions of filing). Article 27 (date of filing), Article 26.1c) requiring a “list of goods or services.”



PRATICE

n extra fee (150€) for
3).

cated.

dent N° 4/03 (June 16,
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t class.

ss X.” Article 36.1a)
le 27 (date of filing),
services.”

- It seems more a decision taken to solve a practical problem without considering the important consequences it has created.

THE BRITISH IP TRANSLATOR (C-307/10)

QUESTIONS RAISED BY THE APPOINTED PERSON TO THE ECJ:

1. Is it necessary for the various goods or services covered by a trade mark application to be identified with any (and if so, what particular) degree of clarity and precision?
2. Is it permissible to use the general words of the Class Headings of the International Classification of Goods and Services established under the Nice Agreement of June 15, 1957 for the purpose of identifying the various goods or services covered by the trade mark application?
3. Is it necessary or permissible for such use of the general words of the Class Headings of the said International Classification of Goods and Services to be interpreted in accordance with Communication No 4/03 of the President of the Office for Harmonisation in the Internal Market of June 16 2003 (OJ OHIM 2003 p. 1647)?

ECTA STUDY

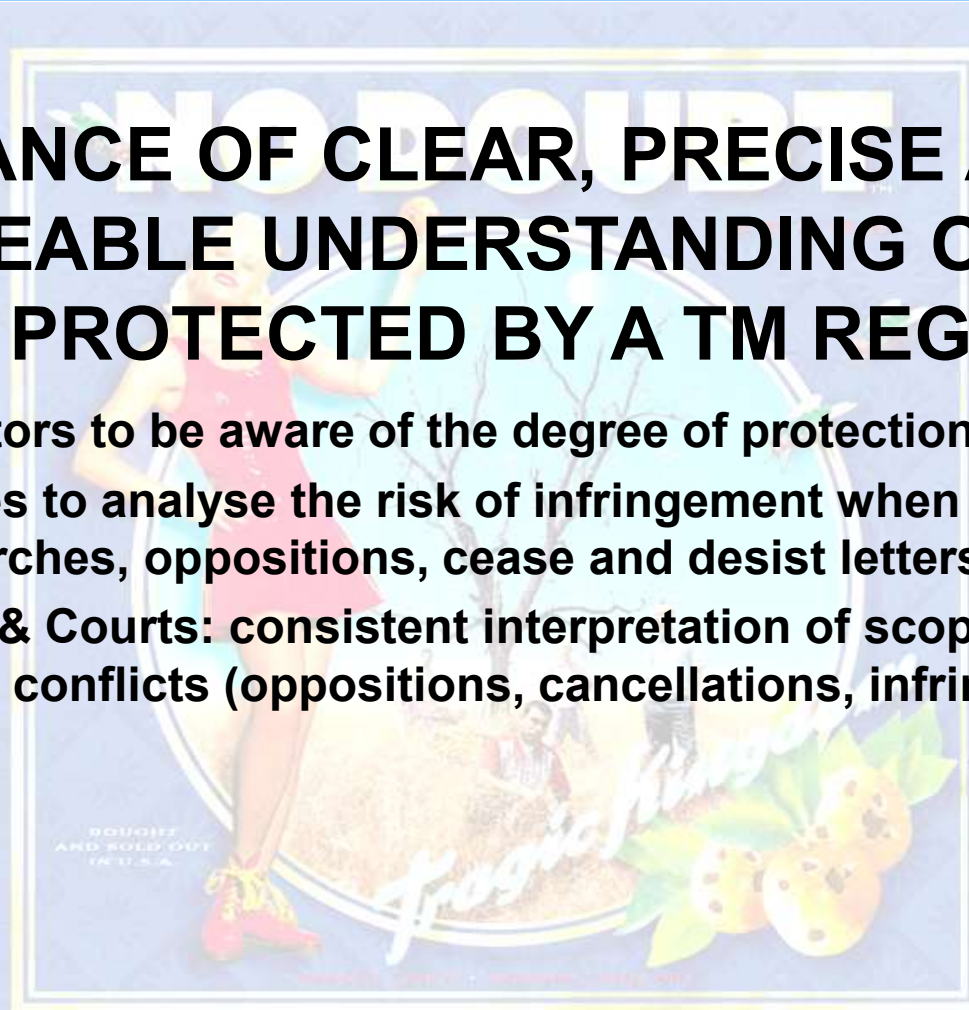
POGUES

- **NEED FOR A HARMONISED APPROACH**
- **IN FAVOUR OF “CLASS-HEADINGS-COVER-ALL”?**
- **IN FAVOUR OF “CLASS-HEADINGS-MEANS-WHAT-IT-SAYS”?**

ECTA REPLIES TO QUESTIONS PUT TO ECJ

1. IMPORTANCE OF CLEAR, PRECISE AND FORESEEABLE UNDERSTANDING OF WHAT IS PROTECTED BY A TM REG.

- TM proprietors to be aware of the degree of protection of reg.
- Third parties to analyse the risk of infringement when adopting new marks (searches, oppositions, cease and desist letters)
- TM Offices & Courts: consistent interpretation of scope of protection in inter partes conflicts (oppositions, cancellations, infringements)



ECTA REPLIES TO QUESTIONS PUT TO ECJ

2. USE OF CLASS HEADINGS TO DESIGNATE GOODS/SERVICES:

- Yes, provided that the nature of designated goods/services is clear
- It provides administrative convenience for applicants and TM Offices
- Permits expansion of future use. Tempered with possibility to revoke TM for lack of use.

3. INTERPRETATION OF CLASS HEADINGS

- Class headings should be interpreted to mean what they say, and not to cover all goods in the class because:
 - a) Otherwise, TMs would grant very wide protection, overloading TM Registers
 - b) Too broad specifications could create artificial barriers for third parties

TRANSITIONAL PERIOD

- Interpretation of “means-what-it-says”, applicable as from date entering into force change
- For earlier registrations, term to amend specifications to clarify the scope of rights

MPI STUDY PROPOSALS

- **CONSISTENCY** → **Same criteria in OHIM & National Offices**
- **CLASS FEES** → **A separate class fee from the beginning**
- **DEFINITENESS** → **- Accept terms when it is clear that the genus comprises a coherent group of products (clothing)**
→ **- Otherwise, require to specify**
- **DIFFERENTIATION OF ACCEPTABLE CLASS HEADINGS** { **Agreement between OHIM and Member States**
- **RECLASSIFICATION** → **At renewal when goods services move from one class to the other**
- **TRANSITIONAL RULES** → **to adapt their specifications accordingly**
- **HEARING 26-05-11** → **Majority of NGOs in favor of “what it says”.**
Conclusion: open question

The image features a classic hypnotic spiral background, consisting of concentric circles that create a 3D tunnel effect. The colors transition from a dark red at the center to a deep black at the outer edges. Overlaid on this background is the iconic phrase "That's all Folks!" written in a white, elegant cursive script. The text is positioned diagonally across the center of the spiral, with the word "Folks!" being significantly larger than "That's all".

That's all Folks!