

## Convergence Programme – Class Heading

The interpretation of the scope of the protection of the Nice Class Headings is different between the European Trademark National Offices.

Until the IPT judgment there were two different approaches. 17 European Trademark National Offices followed the “means-what-it-says” approach under which a term was taken to cover only what fitted within its description. Whereas for the other offices, including OHIM, the Class Headings were interpreted as covering all goods or services within the class. Cyprus always followed the “means-what-it-says” approach.

The issue of Class Headings was sometimes presented as a problem. Also, it was a significant cause for confusion and unpredictability for applicants applying for a mark in multiple offices as the same list of goods and services might not be interpreted the same way in all jurisdictions. The situation led to legal unpredictability in cases of priority date claimed, seniority, opposition decisions where the conflicting trade marks were registered in offices with different practices, since it was not clear which interpretation would be followed.

Despite these problems the different practices caused, it was difficult to define a common practice.

### European Court Case which directly affects the practice that is followed regarding the interpretation of the scope of the Nice Class Headings – C-307: IP Translator Case

The following are the main points derived by the opinion of advocate general:

- “the registration of the trade mark must fulfil the basic function of the mark, which is to enable the consumer to distinguish, without any possibility of confusion, the goods or services of one undertaking from those of another undertaking. (20) Consequently, the products or services must be identifiable.”
- “**a trade mark must be registered in accordance with the speciality principle**. It requires the rights conferred by the trade mark to be defined with precision in order to limit the exclusive rights to the actual function of the trade mark. The description of the goods and services covered by the trade mark is needed to enable the competent authorities to assess whether the absolute grounds for refusal.”
- “It is obvious that that description must be clear and precise so that the goods or services may be identified accurately by the competent authorities and economic operators. That clarity and precision naturally require the expressions used to be intelligible and unambiguous.”
- “That interpretation is tantamount to affording the applicant almost unlimited exclusive rights over the goods and services in a class. However, under the speciality principle, a trade mark is never protected in the absolute.”
- “Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade

marks and Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark are to be interpreted as meaning that the identification of the goods or services for which the applicant seeks protection must satisfy requirements of clarity and precision which are sufficient to enable the competent authorities and the economic operators to determine accurately the scope of the protection conferred by the trade mark.”

- “This case now gives it the opportunity to define the rules governing the identification of the goods or services for which trade mark protection is sought and, indirectly, to assess the scope of the rules applied up to now by the Office for Harmonisation in the Internal Market (Trade marks and designs) (OHIM). This is particularly important when the national trade mark offices and OHIM develop different practices leading to varying requirements for registration contrary to the objectives pursued by the Union legislature.”
- “Directive 2008/95/EC (6) was adopted in order to abolish the disparities between the laws of the Member States which might impede the free movement of goods and freedom to provide services and might distort competition within the common market. The Directive limits approximation to those national provisions of law which most directly affect the functioning of the internal market. Among those provisions are those which define the conditions governing registration of a trade mark and those which determine the protection enjoyed by duly registered marks.”
- “...the attainment of the objectives pursued by the Directive calls for an approximation of the national laws in that respect.”

After the final decision of the European Court of Justice regarding the above mentioned case and in the context of the Convergence Project “Class Heading”, the Registrar of Trademarks decided that as from 01/01/2013, for the National Applications for Registration of a Trademark, the phrase “all goods / services in the class” will not be accepted.

It has been issued a common communication regarding the way that each office interprets the scope of protection of its national trademarks filed before and after the decision for the “IP Translator” case containing entire Nice Class Headings. The common communication document is available on the Department of Registrar of Companies and Official Receiver’s website.

As regards our office, the following apply:

- Class Headings terms are to be interpreted literally (means what it says) for Trademarks filed before or after IP Translator containing entire Nice Class Headings.
- The applicant’s intention with respect to the Nice Class Headings and / or the alphabetical list concerning Trademarks filed after IP Translator containing entire Nice Class Headings is reflected by listing all goods and services applied or registered individually.
- The scope of protection of CTM’s filed before or after IP Translator containing general indications for the Nice Class Headings, is interpreted literally (means what it says).

- For Trademarks filed after IP Translator containing the entire class heading, the applicant can obtain protection for the full alphabetical list by listing each of the terms individually.

### **Description of the solution for convergence**

The solution involves the creation and use “a commonly acceptable set of comprehensive classification terms ideally covering all goods or services in a given class at a given time”. This set of terms is called “Class Scopes”. Class scopes are chosen in a bottom-up manner and they are sufficiently specific to describe all the goods and services which fall under them.

Class Scopes differ fundamentally from Class Headings in two respects: First, their origin is not the Nice Classification. Second, they are devised to include terms included in the Class, but which could not be inferred from the wording of the heading.

This project had the objective of achieving a common database of already accepted goods and services, translated to all EU languages. This common harmonised database consists of around 60 000 terms.

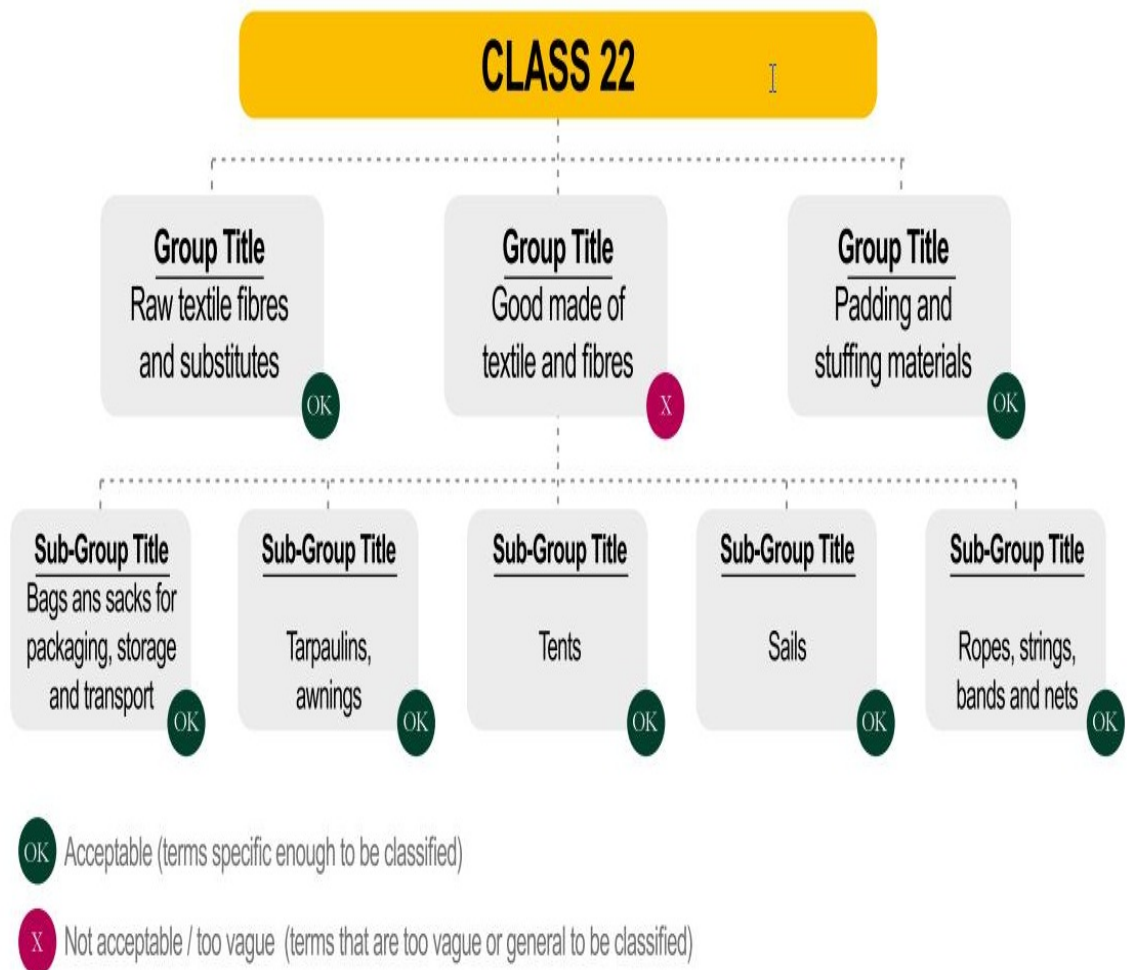
In order to facilitate data maintenance and improve users’ experience in finding the appropriate goods and services, a new hierarchical structure of the terms of the Nice classification, with broader terms on top and more specific terms below is created. This structure is known as the “Taxonomy” and its creation was a vital step in the process of reaching agreement on the new concept of “Class Scopes”.

### **How does taxonomy help the creation of the Class Scopes**

The starting point is the Nice classification which consists of 45 classes. This is a one-level structure as shown in the example of Class 22 illustrated below, in which a specification – the Nice Heading - is given in the most general terms to the fields to which the goods and services are related to.



Fig. 2<sup>2</sup>



Taxonomy is a logical structure where goods and services are categorised in a hierarchical tree, with general groups at the top and more specific ones at the bottom. The taxonomy was created based on the classification database terms which are also commonly used in the specifications of real trade marks applications and is therefore a strong representation of the real market. Also, the applicants don't need to use large lists of goods and services while filing trademark applications.

### **How is this hierarchical tree built**

The Nice Classification is always used as the basis for taxonomy. The top level of each class is the Nice class number. Each class will contain at least one further level which brings together terms sharing the same characteristics into one or more groups, each of them having a group title. Terms are allocated based on them fitting within the meaning of the group title. Top level group titles have been defined independently of the Nice Class Headings but might coincide. Taxonomy has general groups at the top and more specific ones at the bottom (sub-groups). All terms in the harmonized database have been taken into account when creating the structure. This follows a bottom-up approach, which implies that all the goods and services classified in the lower levels of the hierarchy are effectively included in the higher levels.

In the example from Class 22 shown above there are several levels with “Group titles” and “Sub-Group titles”. Where the title or sub-title is deemed to be specific enough to indicate the goods and services this will be indicated. Where a group title is not specific enough e.g. “Goods made of textile and fibres”, it is necessary to “drill down” until a Sub-Group title is found that is “acceptable”. Nice terms then fit into the structure under a Group title or a Sub-Group title (sometimes with further iterations of Sub-Group titles), which is accepted for classification purposes as being specific enough to cover all the goods and services lower in the hierarchy. In classes where some terms remain after the rest have been grouped under a Sub-Group title, these terms must be added individually to the Class Scope.

Using the Nice classification as a basis, the Taxonomy can be used in order to:

1. Fit existing terms into hierarchical grouped structures.
2. Introduce a modern and flexible database approach, this will allow users to drill down for their goods and services instead of having to look in alphabetical lists.
3. Make it easier to control and update the database in a consistent way.

### **How will the taxonomy evolve through the time**

The taxonomy is a dynamic and flexible structure which easily incorporates changes and which is able to respond to that constant evolution, and allows easy and accurate access to information. The ease with which the taxonomy was adapted to incorporate the changes from the 9th to the 10th Edition of the Nice Classification shows how flexible and dynamic it is. This is because it makes it easy to identify and group terms with the same characteristics and move them to the new correct position. The taxonomy also provided an invaluable and effective tool for updating the harmonised classification list, saving many hours of time and duplication of effort.

### **Which are the principles of the new common practice**

The new practice rests on the following assumptions:

- Nice Class Headings will continue to exist and can be used in trade mark filings, if the applicant so wishes, but these will not be given a special interpretation. Nice Class heading terms will be treated the same way as any other term in a list of goods and services.
- Class scopes will be introduced and interpreted following “means-what-it-says” principle, since taxonomy itself is based on that principle. As the class scope is based on the taxonomy, it practically encompasses all goods and services of a given class at a given moment in time.

- The class scope will only contain group titles that are acceptable for classification. This permits a reasonable and workable level of abstraction without fear of the specification becoming too vague.
- The new common practice is agreed and applied by the national offices, OHIM and WIPO (as regards taxonomy); this means there will be a consistent means-what-it-says interpretation/acceptance of the class scopes throughout the EU.
- The group titles which compose the class scopes will be translated and validated by the National Offices, on the basis of the original English title.
- There will be a common strategy on the continuity of the practice.

### **Classification of the services “sales” and “trade fairs” after the implementation of the common practice regarding the Convergence Project.**

In the context of the Class Heading project, it is decided that as from 1<sup>st</sup> of July (as soon as the common practice will go live), the office’s practice concerning the classification of the above mentioned services will be changed.

Due to the fact the class scope of Class 35, covers the services “sales” and “trade fairs”, the unchanged office’s practice will lead to the acceptance of those services in two classes, namely class 35 and class 36, while filing trademark applications.

As a result, the valid class will then be the Class 35.

### **Availability to the public of the taxonomy tool in the Cooperation Fund Project TMClass**

As from 1<sup>st</sup> of July, the taxonomy tool is available in the Cooperation Fund Project TMClass and it is translated in all EU languages.

If you want to know the class scope of any class, you can perform a blank search (a search with no term). In the following screenshot, the taxonomy tree is displayed on the left side.

Search for Goods and Services - TMclass - Mozilla Firefox

Search for Goods and Services - TMclass

testqa.oami.europa.eu/ec2/advancedsearch/find;jsessionid=4B29223D32185ACCE83EEFF56725ED2A.ec2t37?language=el&text=&niceClass=1-45&size=25&page=18

TMclass Help English (en)

Terminology Translation Nice Class headings

You have made no selection

Language: English (en) Search term: Search term (E.g. Milk) Nice Class: 1-45

Harmonized offices:  CD IPRD  IE IPO  OHIM  UKIPO  USPTO

Search

Advanced criteria

Tree structure (Disclaimer)

Tree structure Results settings Link to this page

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| Class | Term   | Path | OHIM |                          |
|-------|--|------|------|--------------------------|
| 1     | Abrasives (Auxiliary fluids for use with -)          | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Absorbent graphites                                  | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Absorbents derived from silica                       | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Absorbents for cleaning solvents                     | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Absorbing carbons                                    | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Absorbing oil (Synthetic materials for -)            | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Absorption agents                                    | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Accelerators for organic chemical reactions          | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Accelerators for speeding up chemical reactions      | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Accelerators for speeding up the setting of concrete | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Accelerators (Vulcanisation -)                       | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Accumulators (Acidulated water for recharging -)     | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Acetal   | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Acetaldehyde (ethanal)                               | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Acetanilide  | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Acetate [Aluminium -] *                              | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Acetate [Aluminium -]                                | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Acetate esters                                       | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Acetate of cellulose, unprocessed                    | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Acetates   | 1.0  | ✓    | <input type="checkbox"/> |
| 1     | Acetates [chemicals] *                               | 1.0  | ✓    | <input type="checkbox"/> |

Classification

| Classification | Count  |
|----------------|--------|
| Goods          | 64.729 |
| Class 1        | 49.014 |
| Class 2        | 4.580  |
| Class 3        | 1.111  |
| Class 4        | 1.298  |
| Class 5        | 646    |
| Class 6        | 1.346  |
| Class 7        | 2.698  |
| Class 8        | 4.558  |
| Class 9        | 918    |
| Class 10       | 4.962  |
| Class 11       | 2.287  |
| Class 12       | 2.770  |
| Class 13       | 2.118  |
| Class 14       | 461    |
| Class 15       | 658    |
| Class 16       | 287    |
| Class 17       | 1.720  |
| Class 18       | 1.478  |
| Class 19       | 569    |
| Class 20       | 1.703  |
| Class 21       | 2.270  |
| Class 22       | 1.618  |
| Class 23       | 551    |
| Class 24       | 176    |
| Class 25       | 1.005  |
| Class 26       | 1.015  |
| Class 27       | 445    |
| Class 28       | 147    |
| Class 29       | 1.537  |

Start Class Heading - Microsof... Ptolemy -- Windows Int... Πρόγραμμα Σύγκλισης g... link - Message (HTML) Search for Goods and ... 10:06

When you hover over with your mouse on any class, the class scope of the selected class will be appeared.



Search for Goods and Services - TMclass - Mozilla Firefox

testqa.oami.europa.eu/ec2/advancedsearch/find.jsessionid=4b29223d32185ACC83EEFF56725ED2A.ec2t3?language=el&text=&niceClass=1-45&size=25&page=18

Tree structure (Disclaimer)

Classification 64,729

- Goods 49,014
  - Class 1 4,580
    - Filtering media of chemical and non-chemical substances included in the class
    - Chemical preparations and materials for film, photography and printing
    - Unprocessed plastics
    - Adhesives for use in industry
    - Chemicals for use in agriculture, horticulture and forestry
    - Detergents for use in manufacture and industry
    - Chemical substances, chemical materials and chemical preparations, and natural elements
      - Compositions for fire extinguishing and prevention
      - Photographic film
      - Chemical compositions and materials for use in science
      - Chemical compositions and materials for use in cosmetics
      - Chemical compositions for use in construction
      - Compositions and materials for treatment of leather and textile
    - Salts for industrial purposes
    - Unprocessed and synthetic resins
    - Starches for use in manufacturing and industry
    - Putties, and fillers and pastes for use in industry
      - Fillers for vehicle body and tyre repair
    - Compositions for use in food and beverages
    - Others
  - Class 2 1,111
  - Class 3 1,298
  - Class 4 646
  - Class 5 1,346

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| Class | Term   | Path | OHIM |  |
|-------|--|------|------|--|
| 1     | Abrasives (Auxiliary fluids for use with -)          |      | ✓    |  |
| 1     | Absorbent graphites                                  |      | ✓    |  |
| 1     | Absorbents derived from silica                       |      | ✓    |  |
| 1     | Absorbents for cleaning solvents                     |      | ✓    |  |
| 1     | Absorbing carbons                                    |      | ✓    |  |
| 1     | Absorbing oil (Synthetic materials for -)            |      | ✓    |  |
| 1     | Absorption agents                                    |      | ✓    |  |
| 1     | Accelerators for organic chemical reactions          |      | ✓    |  |
| 1     | Accelerators for speeding up chemical reactions      |      | ✓    |  |
| 1     | Accelerators for speeding up the setting of concrete |      | ✓    |  |
| 1     | Accelerators (Vulcanisation -)                       |      | ✓    |  |
| 1     | Accumulators (Acidulated water for recharging -)     |      | ✓    |  |
| 1     | Acetal   |      | ✓    |  |
| 1     | Acetaldehyde (ethanal)                               |      | ✓    |  |
| 1     | Acetanilide  |      | ✓    |  |
| 1     | Acetate [Aluminium -]*                               |      | ✓    |  |
| 1     | Acetate [Aluminium -]                                |      | ✓    |  |
| 1     | Acetate esters                                       |      | ✓    |  |
| 1     | Acetate of cellulose, unprocessed                    |      | ✓    |  |
| 1     | Acetates   |      | ✓    |  |
| 1     | Acetates [chemicals]*                                |      | ✓    |  |
| 1     | Acetates [Chemicals -]                               |      | ✓    |  |
| 1     | Acetates [chemicals]*                                |      | ✓    |  |
| 1     | Acetic acid  |      | ✓    |  |
| 1     | Acetic acid ester                                    |      | ✓    |  |

Displaying 1 - 25 of 64,729 results Page 1 of 2590

✓ Term accepted in the relevant office. (Disclaimer)

Start Class Heading - Microsof... Ptolemy - - Windows Int... Πρόγραμμα Σύγκλισης γ... link - Message (HTML) Search for Goods and ... EN 10:30 πμ

However, if you are interested in searching a specific term (in the following example the term is: milk) and perform the search, TMClass will retrieve all the group titles in the taxonomy structure that cover the term in question (the term is not necessary to be

a part of it). When you click on any group title, more specific terms covered by subgroups and containing the term in question will be displayed on the right side.

**Search for Goods and Services - TMclass - Mozilla Firefox**

testqa.oami.europa.eu/ec2/advancedsearch/find;jsessionid=4829223032185ACCE83EEFF56725ED2A.ec2t3?language=el&text=0&niceClass=1-45&size=25&page=18

Language: English (en) | Search term: milk | Nice Class: 1-45

Harmonized offices:  CD IPRD  IE IPO  OHIM  UKIPO  USPTO

**Tree structure (Disclaimer)**

- Classification: 143
  - Goods: 141
    - Class 1: 8**
      - Detergents for use in manufacture and industry
      - Chemical substances, chemical materials and chemical preparations, and natural elements
      - Compositions for use in food and beverages
    - Class 3: 16
      - Others
    - Class 5: 13
      - Medical and veterinary preparations and articles
        - Pharmaceuticals and natural remedies
      - Others
    - Class 6: 2
      - Containers, and transportation and packaging articles, of metal
    - Class 7: 10
      - Others
    - Class 9: 1
      - Others
    - Class 10: 1
      - Feeding aids and pacifiers
    - Class 11: 2

**Class 1 / Detergents for use in manufacture and industry / "milk"**

Displaying 1 - 2 of 2 results

| Class | Term                                      | Path | OHIM |                          |
|-------|---|------|------|--------------------------|
| 1     | Ferments (Milk -) for industrial purposes |      | ✓    | <input type="checkbox"/> |
| 1     | Milk ferments for industrial purposes     |      | ✓    | <input type="checkbox"/> |

Displaying 1 - 2 of 2 results

✓ Term accepted in the relevant office. (Disclaimer)

A great effort was made in order all the group titles to be enough clear and precise, so they will be accepted for classification purposes.

However, the following group titles are not considered by the majority of the national offices to be enough clear and precise.

Class 1

- Products for agriculture, horticulture and forestry

Class 14

- Other articles of precious metals and precious stones, and imitations thereof
- Statues and figurines
- Ornaments

Class 17

- Unprocessed and semi-processed materials included in the class, not specified for use
- Finished or semi-finished goods, of materials included in the class, specified for use
- Statues and works of art
- Coverings

Class 19

- Unprocessed and semi-processed materials included in the class, not specified for use

Class 20

- Unprocessed and semi-processed materials included in the class, not specified for use
- Non-metallic hardware

Class 21

- Articles for clothing and footwear
- Articles for animals

Class 29

- Prepared meals, snacks and desserts (incl. soups and snacks)

Class 37

- Installation, cleaning, repair and maintenance

Class 45

- Personal and social services

As a result, for all the EU national offices, the above mentioned group titles will not be acceptable for classification purposes while filing a Trademark application.

## **Acceptance / Rejection of the general indications of Nice Class Headings after the IP Translator judgment**

The IP Translator judgment, that was issued on 19/06/2012 is competitive and in line with the creation of the taxonomy structure and the class scopes. It also encourages a common interpretation and examination of the level of clarity and precision of the general indications of the Nice Class Headings.

The further convergence is clear at the following paragraphs of the IP Translator judgment.

- 54 “In that connection, it must be observed that some of the general indications in the class headings of the Nice Classification are, in themselves, sufficiently clear and precise to allow the competent authorities to determine the scope of the protection conferred by the trade mark, while others are not such as to meet that requirement where they are too general and cover goods or services which are too variable to be compatible with the trade mark’s function as an indication of origin.”
- 55 “It is therefore for the competent authorities to make an assessment on a case-by-case basis, according to the goods or services for which the applicant seeks the protection conferred by a trade mark, in order to determine whether those indications meet the requirements of clarity and precision.”
- 56 “Accordingly, Directive 2008/95 does not preclude the use of the general indications of the class headings of the Nice Classification to identify the goods and services for which the protection of the trade mark is sought, provided that such identification is sufficiently clear and precise to allow the competent authorities and economic operators to determine the scope of the protection sought.”

In cooperation with EU national offices and Ohim, the following general indications of the Nice Class Headings are not enough clear and precise.

1. Goods of common metal not included in other classes (class 6)
2. Machines and machine tools (class 7)
3. Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes (class 14)
4. Paper, cardboard and goods made from these materials, not included in other classes (class 16)
5. Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes (class 17)
6. Leather and imitations of leather, and goods made of these materials and not included in other classes (class 18)

7. Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics (class 20)
8. Repair (class 37)
9. Installation services (class 37)
10. Treatment of materials (class 40)
11. Personal and social services rendered by others to meet the needs of individual (class 45)

As a result, the above mentioned general indications will not be acceptable for classification purposes while filing a Trademark application.  
Please note that the Nice Class Headings will still be acceptable for classification purposes in case the problematic items are deleted.