



**Common Communication
on the Common Practice on the
Acceptability of Classification Terms v1.0,
20 February 2014**

On 19/06/2012 the Court delivered its ruling in [Case C-307/10 "IP Translator"](#), giving the following answers to the referred questions:

1 – Directive 2008/95 must be interpreted as meaning that it requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark;

2 – Directive 2008/95 must be interpreted as meaning that it 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;

3 – 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.

This Judgment has an influence on the practice of all Trade Mark Offices of the European Union and in the interest of establishing certainty within the trademark system and for its users, calls for convergence on the interpretation of the general indications of the Nice class headings. Without prejudice to the fact that each Office is bound by its national legislation, national court decisions and, in some cases, previous communications, it is recognised by all that it is only through collaboration in implementing this Judgment in a harmonised manner will there be legal certainty both for the competent authorities and the economic operators.

As regards the first question, the Trade Mark Offices of the European Union have been working together to establish a common understanding of the requirements necessary to achieve clarity and precision in the identification of goods and services in an application for registration and to develop a common set of criteria. The Trade Mark Offices of the European Union, therefore, created a set of guidelines that will help to identify when a classification term is sufficiently clear and precise (annexed Guidelines on the acceptability of classification terms). The Guidelines can also help to reason the acceptance or rejection of any classification term that is applied for. The Guidelines will be constantly updated and fine-tuned when needed.

Tools such as [TMclass](#) are available to assist in searching for and identifying acceptable terms. A classification term that is applied for will be added to the harmonised database on condition that it meets the criteria set in the Guidelines. Subsequently remaining terms comprised in the harmonised database will

be made subject to revision in order to determine if they are in compliance with the Guidelines. The Guidelines can also be of assistance to reason the acceptance or rejection of these applied-for terms.

As concerns the second question, the ["Common Communication on the Common Practice on the General Indications of the Nice Class Headings"](#), published on 20/11/2013 explains the common practice regarding the acceptability of the general indications of the Nice Class headings. The Trade Mark Offices of the European Union established a list of 11 non-acceptable general indications of the Nice Class headings and presented reasons, based on the Guidelines, why each of the 11 non-acceptable general indications are not found sufficiently clear and precise and therefore not acceptable without further specification.

As regards the third question, the ["Common Communication on the Implementation of 'IP Translator'"](#), which updated version was published on 20/11/2013 provides an overview on how Trade Mark Offices of the European Union deal with specific topics relating to the implementation of the said Judgement.

The common practice on acceptability of classification terms will be implemented on the date of publication of this communication. *

The Trade Mark Offices of the European Union reiterate their commitment to continue to collaborate in the context of the Convergence Programme, further increasing transparency and predictability for the benefit of examiners and users alike.

EUROPEAN TRADE MARK AND DESIGN NETWORK

* Implementation dates for each office will be provided; however, some offices may have to delay implementation due to legal constraints.

List of implementing offices:

AT, BG, BX, CY, CZ, DE, DK, EE, ES, FI, FR, GR, HR, HU, IE, IT, LV, LT, MT, NO, OHIM, PL, PT, RO, SE, SI, SK, UK

GUIDELINES ON THE ACCEPTABILITY OF CLASSIFICATION TERMS

Introduction

During 26-28 June 2012 a working group meeting took place in the context of the Convergence of Class Headings project (CP2). In this meeting the Participating Offices had an exchange of ideas with regards to [Case C-307/10 "IP Translator"](#).

Two issues are clear from this judgment:

- The applicant should specify the goods and services of the trade mark with sufficient clarity and precision. This enables the competent authorities and economic operators to determine the extent of the protection conferred by the trade mark, on the basis of the list of goods and services alone.
- The general indications of the class headings of the Nice Classification (class heading terms) can be used 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. Following paragraph 54 of Case C-307/10 "IP Translator" this is not always the case for all general indications.

During the meeting all participants agreed to envisage a common interpretation of the acceptability for classification of the general indications of Nice Class headings. It was agreed to create guidelines which will help to identify which general indications are sufficiently clear and precise, and which are not. The working group decided at its meeting in February 28, 2013 to extend the guidelines to any classification term. The latest proposal is described in this document.

This initiative is also encouraged in paragraph 41 of Case C-307/10 "IP Translator": *"recital 8 of the preamble to Directive 2008/95 emphasises that attainment of the objectives at which the approximation of the laws of the Member States is aiming requires that the conditions for obtaining and continuing to hold a registered trade mark be, in general, identical in all Member States"*.

Objective of this document

This document contains a set of guidelines that will help to identify when any classification term is sufficiently clear and precise.

These guidelines will be of assistance to the harmonised workflow, through which new classification terms are assessed in order to be added to the harmonised database. The guidelines can also be of help to reason the acceptance or rejection of any classification term that is applied for.

It is a live document that will be constantly updated when needed.

Explanatory notes

The Nice Classification is a system of classifying the goods and services that can be found in the global market place into “classes”. The Nice Classification is based on the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, which is administered by WIPO. It consists of a list of classes, explanatory notes and an alphabetical list of goods and services. The list of classes of Nice Classification, guidelines, explanatory notes, and general remarks on classification practice published by WIPO is the primary source of interpretation of the acceptability of any classification term.

There are 34 classes of goods and 11 classes of services. The class headings are general indications relating to the fields to which, in principle, the goods and services belong. The general indications of the Nice class headings are the expressions that appear in the class headings between semicolons, for example, Class 13 is made up of 4 general indications: “Firearms;”, “ammunition and projectiles;”, “explosives;” and “fireworks”. The class number may give further clarification but is not a decisive factor.

Tools such as [TMclass](#) are available to assist in searching for and identifying acceptable terms.

Summary of guidelines

A set of 3 guidelines that describes criteria to determine the clarity and precision (or lack of such) of a term has been established.

The set of guidelines is the following:

- I. Explanation when a description of goods and services is sufficiently clear and precise
- II. Examples of factors that can add sufficient clarity and precision
- III. Specification of terms in a number of classes

Guidelines

- I. A description of goods and services is sufficiently clear and precise when its scope of protection can be understood from its natural and usual meaning.**
- II. If this scope of protection cannot be understood, sufficient clarity and precision may be achieved by identifying factors such as characteristics, purpose and / or identifiable market**

sector*. Elements that could help to identify the market sector may be, but are not limited to, the following

- consumers and/or sales channels
- skills and know-how to be used/produced
- technical capabilities to be used/produced.

Examples:

<u>Not clear and precise term</u>	<u>Proposals / possible solutions: (examples from harmonised database)</u>
Goods of common metal not included in other classes (cl 6)	Construction elements of metal (cl 6)
	Building materials of metal (cl 6)
Machines (cl 7)	Agricultural machines (cl 7)
	Machines for processing plastics (cl 7)
	Milking machines (cl 7)
Goods in precious metals or coated therewith (cl 14)	Works of art of precious metal (cl 14)
Goods made from paper and cardboard (cl 16)	Filtering materials of paper (cl 16)
Goods made from rubber, gutta-percha, gum, asbestos and mica (cl 17)	Rings of rubber (cl 17)
Goods made of these materials [leather and imitations of leather] (cl 18)	Briefcases [leather goods] (cl 18)
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 (cl 20)	Door fittings, made of plastics (cl 20)
	Figurines of wood (cl 20)
Repair (cl 37)	Shoe repair (cl 37)

	Repair of computer hardware (cl 37)
Installation services (cl 37)	Installation of doors and windows (cl 37)
	Installation of burglar alarms (cl 37)
Treatment of materials (cl 40)	Treatment of toxic waste (cl 40)
	Air purification (cl 40)
Personal and social services rendered by others to meet the needs of individuals (cl 45)	Personal background investigations (cl 45)
	Personal shopping for others (cl 45)
	Adoption agency services (cl 45)

- III. **A term may be part of the description of goods and services in a number of classes; it may be clear and precise in a particular class without further specification.** For example [Furniture](#) (cl 20), [Clothing](#) (cl 25).

If protection is sought for a specialised category of goods and services or a specialised market sector belonging to a different class, further specification of the term may be necessary. For example [Furniture especially made for medical purposes](#) (cl 10), [Furniture especially made for laboratories](#) (cl 9), [Protective clothing](#) (cl 9), [Clothing especially for operating rooms](#) (cl 10), [Clothing for pets](#) (cl 18).

Tools such as [TMclass](#) are available to determine whether the particular category of goods and services needs this further specification or not.

*market sector describes a set of businesses that are buying and selling such similar goods and services that they are in direct competition with each other.