

Managing Trade Marks

IP TRANSLATOR: WHAT NOW FOR TRADE MARK OWNERS?

29 November 2011

Emma Barraclough, London

The Court of Justice's senior legal adviser this morning told the Court it should harmonise the way that IP offices in Europe interpret class headings. So what will happen next for trade mark owners?

In his opinion, Advocate general Yves Bot said that OHIM's class-heading-covers-all approach to applications does not provide the clarity required for registering trade marks.

That approach was set out by OHIM in a [2003 presidential communication](#). In it, the Office said that applicants can use class headings from the Nice Classification and added that none of the class headings was "too vague or indefinite" to use on their own.

Today the AG criticised the communication, saying it "is not a legislative text and has no binding legal value" and recommended that the Court rule that applicants must identify the goods and services for which they seek protection with "sufficient clarity and precision" to allow trade mark officials and businesses to determine the scope of the protection that the trade mark owner enjoys.

The opinion has been welcomed by trade mark practitioners.

"We are pleased that the AG has said that we should have harmonised rules on this," Tove Graulund of MARQUES told Managing IP.

David Latham of Hogan Lovells said that the AG had attempted to be even handed.

The opinion was also welcomed by Iain Stewart, a partner at Kilburn & Strode whose application to register the trade mark IP Translator on behalf of CIPA led to the referral to the Court of Justice.

"The AG considers that the use of class headings is permissible provided that the terminology used is sufficiently clear and precise. The AG also notes that the OHIM practice ... does not guarantee the clarity and precision required for the purpose of trade mark registration in the EU. That makes sense," said Stewart.

Although the AG's opinion is not binding on the Court, if the 13 judges deciding the case choose to follow it then OHIM will need to change its approach.

Managing IP understands that the Alicante office will not overhaul its rules as a result of the AG's opinion, but could potentially change its position before the Court of Justice issues its final decision as a result of other developments.

The first is discussions already underway between OHIM and national IP offices within the EU as part of a [convergence programme](#). OHIM's representative at October's hearings at the Court of Justice in Luxembourg stressed that the Office is working with member states to iron out difficulties caused by the differences in approach. In June this year it launched a project to reach consensus on different interpretations of the scope of class headings in trade marks.

The second is that the European Commission is understood to want to include proposals for harmonising the rules on class headings when it presents its plans for reforming the EU's trade mark rules next year.

But IP owners say that if that happens, the Commission will need to provide transitional provisions to clarify what should happen to Community trade marks whose owners end up with a different scope of rights than they believed they had.

Bookmarks

[Del.icio.us](#) [Diqq.com](#) [Facebook](#) [LinkedIn](#) [Reddit.com](#) [Stumbleupon.com](#)
[Twitter](#)

[Back to top](#)