

## **Communication regarding classification: insufficiently clear and precise terms in class headings**

**Date: 20 November 2013**

### **Introduction**

In a previous Communication dated 22 Augustus 2012, some practical implications of the IP Translator judgment (C-307/10) have already been touched upon. In this judgement, the European Court of Justice (ECJ) has – inter alia – ruled (second point of the operative part):

“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 Classification referred to in Article 1 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, concluded at the Nice Diplomatic Conference on 15 June 1957, last revised in Geneva on 13 May 1977 and amended on 28 September 1979, 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.”

The previous Communication states in this regard:

“5. The general indications of the class headings may be used, but only if they are sufficiently clear and precise to identify the goods and services for which trademark protection is sought. If this is not the case, a specification must be provided.

6. It should be emphasised that responsibility for an accurate description of goods and services always rests with the trademark proprietor.

7. The BOIP aims to cooperate with the Office for Harmonization in the Internal Market (OHIM), national offices and user organisations in Europe within the framework of the so-called ‘convergence programme’: a programme initiated by the OHIM to harmonise practices as much as possible within the European Union. As part of this programme, work is currently underway on a structured list of goods and services for classification purposes.”

The cooperation in the convergence programme has resulted in a Common Communication that is published today by OHIM and all participating offices and can be found [here](#). The Common Communication identifies eleven terms of the class headings that are considered insufficiently clear and precise by the participating offices.

### **Consequences for existing registrations and for new applications**

As emphasised in the previous Communication, the responsibility for an accurate description of goods and services always rests with the trademark proprietor. It is up to him to determine the extent of the protection he wishes to claim and to do so in terms that are sufficiently clear and precise for others to understand them.

Existing registrations can be restricted at the request of the holder. If a registration contains a term that is insufficiently clear and precise, BOIP will allow a restriction to goods or services that are sorted in the same class and can be considered to fall under the natural and usual meaning of that term.

For new Benelux applications, the classification tool in the e-filing system (BOIP online filing) will be modified to draw the applicant’s attention to the fact that the eleven terms concerned need to be specified. Another classification tool is the TMclass database, which contains a taxonomy structure that has been developed within the framework of the convergence programme: <http://tmclass.tmdn.org>. The use of these tools is highly recommended. When BOIP nevertheless notes that an applicant uses insufficiently clear and precise terms, it will point this out and invite him to provide a clarification.

### **Consequences for inter partes procedures (oppositions)**

In oppositions BOIP will apply the general rule that the consequences of the lack of clarity and precision of a term are borne by the party that uses it. So in case of an opposition in which one party invokes vague terms and the other party terms that are sufficiently clear and precise, BOIP will rule in favour of the latter.

This situation should, in principle, occur less and less in practice, since BOIP will not accept vague terms in new applications.

The principle that parties bear responsibility for their own acts or omissions also applies of course in inter partes proceedings. It is up to the parties to take the initiative to restrict the list of goods or services of their registration or application if they deem that to be appropriate. BOIP will not actively invite them to do so, since this would be at odds with the role BOIP should fulfil as deciding authority in inter partes proceedings and with the principle that it is up to the parties to determine the extent of the dispute and their pleas.