

User Association/National Office	INTERNATIONAL TRADEMARK ASSOCIATION (INTA)
---	--

Contributor (name & position)	OHIM Subcommittee of Trademark Office Practices Committee (and in addition Madrid System Subcommittee of Trademark Office Practices Committee in relation to issue 6).
Linguistic version the comments refer to	EN <input checked="" type="checkbox"/> DE <input type="checkbox"/> ES <input type="checkbox"/> FR <input type="checkbox"/> IT <input type="checkbox"/>
Part/Section/Chapter of the Guidelines the comment(s) refer to	Communication of the President of the Office concerning the implementation of Article 28 EUTMR
Page of the document	4 et seq. of the Communication
Issue(s) you wish to comment on	<p>INTA wishes to comment on the following issues:</p> <ol style="list-style-type: none"> 1. No availability of Article 28(8) for CTM applications pending at the time of entry into force (throughout the document) 2. Interpretation of goods and services that are “clearly covered” by the literal meaning of the class heading (section 8 draft Communication and list of examples of terms not covered) 3. Examination by the Office and possible partial rejection of the declaration (section 10 draft Communication) 4. Clarification in section 11 as to amendment of list of goods and services in the trademark registration 5. Minor correction in section 14 (typo) 6. Applicability of Article 28(8) to IRs designating the EU (section 15) 7. Suggested amendment as to possibility to combine surrender and declaration under Article 28(8) <p>The below comments will follow this numbering and include the headings. There will not be separate suggestions for alternative text.</p>
1. No availability of Article 28(8) for CTM applications pending at the time of entry into force (throughout the document)	The Office considers that Article 28(8) does not apply to CTM applications pending at the time the new law enters into force. It is submitted that, while this has some basis in the letter of the law,

	<p>there is room for interpretation, and there is no good reason for differentiating between pending applications and registrations.</p> <p>Of course Article 28(8) speaks of “EU trade marks applied for before 22 June 2012 which are registered in respect of the entire heading of a Nice class”... However, from the perspective of the purpose of this provision, namely to protect the legitimate expectations of CTM <i>applicants</i> that they had at the time of filing their applications, there is no good reason to distinguish between marks that were registered quickly and marks that received oppositions and are for that reason not yet registered. The CTM applicants’ expectations were the same. Moreover, it has been held by the ECHR in <i>Anheuser Busch v. Portugal</i> that also trademark applications are covered property rights. The law should therefore be read as applying also to marks that would be registered in the absence of third party oppositions. “Are registered” can be interpreted as referring to what the applicant pretended to put on the register and what is, therefore, on record as defining the scope of the application for registration.</p>
<p>2. Interpretation of goods and services that are “clearly covered” by the literal meaning of the class heading (section 8 draft Communication and list of examples of terms not covered)</p>	<p>Article 28(8) was not meant to prompt needless expansions of specifications of goods and services and the Office helpfully clarifies in its Draft Communication that amendments under this provision are only allowed for goods and services that are (1) contained in the alphabetical list and (2) not “clearly covered” by the literal meaning of the class headings (see Art. 28(8), second sentence). The Office’s endeavour to put together a list of examples of terms that are considered to be not “clearly covered” is considered very helpful for users. However, it is suggested that Section 8 gives rise to some issues and that the list of examples should be significantly expanded.</p> <p>a) While Art. 28(8) second sentence requires declarants to indicate in a clear, precise and specific manner which terms (for goods and services) should be added, the provision also requires for any such terms to be taken from the alphabetical list. It is then questionable how any such additional term could be “unclear, imprecise or unspecific”. At the level below the general indications it seems that all stakeholders agree that the terms in the alphabetical list are sufficiently clear and precise. This statement gives rise to doubts on that point and should therefore be deleted or amended.</p>

b) When considering the list of examples compiled by the Office, one gets the impression that the Office did not include terms that are not “clearly covered” but only those that are “clearly not covered”.

For example, in the list for class 9 (versions prior to the present version of Nice), computer software is not listed. To the extent that this indicates that the Office considers computer software to be covered by “data processing equipment and computers”, INTA disagrees with the position. While it is certainly possible to take the stance that these general indications cover also computer software, this is certainly not “clear”, and so software is at least not “clearly covered” by the literal meaning of the general indications in class 9 of Nice editions nos. 6 – 9.

Another example is class 5. The Office appears to consider that Class 5 is just about all-encompassing, which means that it would consider diagnostic preparations as “clearly covered” by pharmaceutical preparations. While that is certainly a respectable position, in a more literal reading, pharmaceutical preparations are drugs, presented in their finished dosage form. This may well include the materials used in the preparation or formulation of the finished dosage form. However, drugs are remedies and diagnostics are not. So, again, it does not seem “clear” that diagnostics are covered by “pharmaceutical preparations”.

It is clear that the Office is not saying that it will object to terms that are not listed in the list of examples. However, it is suggested that the Office should amend the list with the aforementioned examples and perhaps others, and add an explanation in the Communication whereby, when there is any reasonable doubt as to whether the term to be amended is or is not covered by the literal meaning of the class heading, the Office will accept the declaration, because the term is at least not “clearly covered”.

The purpose of declarations under Article 28(8) is clarification of the register and there is no need to be restrictive in the application of the provision.

<p>3. Examination by the Office and possible partial rejection of the declaration (section 10 draft Communication)</p>	<p>Section 10, third paragraph of the Draft Communications creates the impression that a declaration can either be accepted or rejected as a whole. However, it is submitted that declarations can be partially rejected. The text should therefore be amended as follows to reflect that.</p>
<p>4. Clarification in section 11 as to amendment of list of goods and services in the trademark registration</p>	<p>INTA recommends amending section 11 to clarify that, in accordance with Article 28(8) third sentence, the Office will amend the Register in accordance with the admissible declaration. Section 11 only says that the declaration will be published, not that the Register will be amended. We suggest this for clarification purposes only.</p>
<p>5. Minor correction in section 14 (typo)</p>	<p>Section 14, third paragraph, third line: "that" must be deleted ("... if that later trade mark was in use ... and that the use in relation to those goods... did not infringe...).</p>
<p>6. Applicability of Article 28(8) to IRs designating the EU (section 15)</p>	<p>According to the last paragraph of Section 15, "Article 154 EUTMR does not contemplate the application of Article 28(8) EUTMR to international registrations designating the EU. Consequently the provisions of this Communication do not apply to international registrations designating the EU." The said paragraph seems to imply that (i) the Office considers that the procedure provided for in paragraph (8) of Article 28 would not apply to holders of international registrations designating the EU, where the date of the international registration or of the subsequent designation is earlier than 22 June 2012 and where protection has been granted in respect of the entire heading of a class of the Nice Classification; and that (ii) the legal basis for such interpretation is that Article 28(8) is not expressly referred to in Article 154 as being applicable to holders of such international registrations. INTA disagrees with this position.</p> <p>On substance, INTA supports the well-established principle that, as a rule, trademark owners having chosen the international route to seek protection for their mark in a member of the Madrid Union</p>

should be applied terms and conditions for such protection no less favourable than those applicable to trademark owners having chosen the direct (national or regional) route. In this particular case, the Association sees no reason why holders of international registrations designating the EU should be denied the possibility to file a declaration under Article 28(8).

From a legal standpoint, the reason given by the Office is unconvincing. The fact that Article 154 does not contemplate the application of article 28(8) to international registrations designating the EU has no bearing on its applicability to such international registrations. First, because Article 28(8) falls beyond the scope of Article 154. The latter deals with the examination as to clarity and precision of the identification of the goods and services for which protection is sought and with examination as to absolute grounds, i.e. while the territorial extension to the EU is still at the examination stage, whereas Article 28(8) provides for a procedure applicable to registered trademarks, i.e. trademarks which have been accepted for protection.

Second, and foremost, because the Office's interpretation of Article 154 would be inconsistent with Article 145 of the EUTMR, under which "Unless otherwise specified in [Title XIII], this Regulation and the acts adopted pursuant to this Regulation shall apply to [...] registrations of marks in the international register maintained by the International Bureau of the World Intellectual Property Organization [...] designating the European Union." Article 154 does not provide that Article 28(8) does not apply to international registrations; neither does it specify any procedure that could be considered as derogating from the procedure provided for in Article 28(8).

It should be recalled here that Article 145 EUTMR -- which was originally introduced in the CTMR (as Article 140) by Council Regulation (EC) No 1992/2003 of 27 October 2003 amending Regulation (EC) No 40/94 to give effect to the accession of the EU to the Madrid Protocol -- enshrines the general principle that, as stated in recital (13) of Council Regulation 1992/2003, "the rules and procedures relating to international registrations designating the European Community should, in principle, be the same as the rules

and procedures which apply to Community trade mark applications and the protection of Community trademarks."

Moreover, excluding the possibility for holders of international registrations designating the EU to file a declaration under article 28(8) would defeat the purpose of, and be inconsistent with, Article 4(1)(a) of the Madrid Protocol and Article 151(2) EUTMR under which, unless refused, "the international registration of a mark designating the European Union shall, from the date [of the international registration or the subsequent designation], have the same effect as the registration of a mark as a European Union trade mark."

Under Article 4 of the Madrid Protocol and Article 151 EUTMR, the protection granted to the mark, whether obtained by the direct route or through the international route, must be the same. Not allowing the holder of an international registration designating the EU to specify in an Article 28(8) declaration the goods or services in respect of which he intended to seek protection, beyond those covered by the literal meaning of a class heading, would amount to deprive him of the possibility to maintain the same scope of protection as would be available to the holder of a European Union trade mark registration obtained through the direct route.

Finally, it should be pointed out that, if the reasoning according to which Article 28(8) would not be applicable to international registrations designating the EU because Article 154 does not contemplate such application were to be followed, then other provisions of Article 28, in particular paragraph (5) thereof, would presumably not be applicable either to international registrations. What then would be the regime applicable to international registrations regarding the interpretation of class headings?

For the above reasons, INTA urges the Office to reconsider its position regarding the applicability of Article 28(8) EUTMR to holders of international registrations designating the EU. Implementation details may be worked out with the International Bureau of WIPO, in consultation with user organisations.

7. Suggested amendment as to possibility to combine surrender and declaration under Article 28(8) (Section 15)

Section 15 helpfully explains the differences in applicability and effect of partial surrenders and declarations under Article 28(8). However, it is suggested that the Office interpret any statements from trade mark owners in such a way as to allow them to be registered. If a trade mark owner erroneously files a “declaration under Article 28(8)” but the content of the application is that of a partial surrender (e.g. replacement of a vague general indication with more specific admissible terms), the Office should not reject this but reinterpret and accept it to the extent that it is admissible.

Where declarations partially rely on Article 28(8) and partially on Article 50, the Office should again allow them to the greatest extent possible, combining the legal bases for the desired amendment of the Register, whether or not the declarant correctly refers to either of these provisions. What matters is the declaration, not the legal basis referred to.

In other words, the Office is encouraged to be as little formalistic in its treatment of any amendments of the lists of goods and services of existing CTMs, in keeping with its usual user-friendly and pragmatic approach.