The Interpretation of the Nice Class Headings in the European Union, or the Art of One Hand Clapping
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I. INTRODUCTION

The short story collection Nine Stories written by J.D. Salinger in 1953 began with this epigraph: “We know the sound of two hands clapping. But what is the sound of one hand clapping?” Salinger’s philosophical question was the paraphrase of a famous “koan,” a paradoxical statement used as a meditation discipline to test a student’s progress in Zen practice.1 At first sight, the task seems absurd and illogical: How can the clapping of one hand create a sound if you need two hands to clap? We imagine a novice monk meditating for weeks in his cell without solving the riddle.

When trying to interpret class headings included in trademark applications and registrations, examiners and practitioners in the European Union (“EU”) are sometimes confronted with similar problems as in the aforementioned koan. This may be illustrated by the following example: “We know the sound of musical instruments. But what is the sound of a conductor’s baton?” The natural answer would be that a conductor’s baton does not make any sound, as it is no musical instrument but just a stick used by the conductor to direct a musical performance. However, if a baton is not a musical instrument, why have nine trademark offices in the European Union taken the view that trademarks filed before June 2012 for the class heading “musical instruments” in Class 15 of the Nice Classification were deemed to protect “conductors’ batons” included in the alphabetical list of the same class?

This article has two purposes: First, it shows that trademark owners (and their competitors) should be in a position to know the precise subject matter of a trademark. Whereas class headings are generally unacceptable to identify goods or services in trademark

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applications filed in the United States, the trademark offices in the European Union generally allow the use of class headings. Moreover, some trademark offices in the European Union even took the position that a trademark comprising a class heading would protect all goods or services covered in that class. The problem is that the literal meaning of class headings covers most of the goods and services in a particular class but not all. In other words, there is a gap between the goods and services protected in a class when interpreting the class heading literally and the goods and services that are actually covered by that class according to the Nice Classification. For example, depending on the interpretation of class headings, a trademark application for the class heading “musical instruments” in Class 15 would protect only musical instruments or other goods covered in Class 15 such as “music stands,” “cases for musical instruments,” or the aforementioned “conductors’ batons.”

Second, this article discusses the imminent reform of the EU trademark law, which will have a direct effect on the interpretation of class headings contained in existing Community trademark (“CTM”) registrations. Owners of CTMs registered for any class heading should clarify whether their goods or services of interest are actually covered by the literal meaning of the registered terms. If the answer is “no,” the CTM owner should take action as soon as possible.

Part II of this article gives an overview of the Nice Classification and covers the relevance of the class headings. The different practices of the national trademark offices in the European Union through June 2012 are described in Part III. Part IV is dedicated to the IP Translator judgment. The harmonization of practices engendered by the judgment is outlined in Part V. Part VI deals with trademarks registered before IP Translator and explains the solution foreseen by Article 28(8) and (8a) of the

2. See Trademark Manual of Examining Procedure (“TMEP”) § 1402.01(b). Although a filing date is not denied, the United States Patent and Trademark Office (“USPTO”) requires amendment of any such identification. TMEP § 1402.02.

3. Class headings are not acceptable in the EU if they contain imprecise and vague terms. See infra note 81.

4. In the United States, use of the class heading in an application filed with the USPTO or in a request for extension of protection notified under the Madrid Protocol is not deemed to include all the goods or services in that class. See In re Fiat Grp. Mktxg. & Corporate Commc’ns S.p.A., 109 U.S.P.Q.2d 1593, 1598 (T.T.A.B. 2014); TMEP § 1402.07(a).

5. Once the new European Union Trade Mark Regulation becomes effective (see infra Part VI.B.), the name of “Community trade mark” will change to “European Union trade mark” (“EUTM”), see Article 1(1) Proposal-EUTMR. The name of the “Office for Harmonization in the Internal Market” (“OHIM”) will be replaced by the new name “European Union Intellectual Property Office” (“EU IPO”), see Article 2(1) Proposal-EUTMR.

6. For details, see infra Part VI.B.
proposal for a new European Union Trade Mark Regulation ("Proposal-EUTMR"). Part VII explores the scope and limits of the literal interpretation of terms and indications. The main conclusions are summarized in Part VIII.

II. THE NICE CLASSIFICATION AND THE CLASS HEADINGS

Class headings form part of the Nice Classification. Part II of this article explains the nature and function of the Nice Classification, the role of the class headings within that system, and the logic behind the Nice Classification.

A. The Nice Classification System

The Nice Classification is a common classification of goods and services for the purposes of the registration of trademarks. It was established by the Nice Agreement of 1957. Eighty-four countries are parties to the Nice Agreement, and among them are the United States of America, Japan, China, the Republic of Korea, the Russian Federation, and most European countries. Sixty-six other countries and four organizations—including the Office for Harmonization in the Internal Market (“OHIM”)—use the Nice Classification.

The Nice Classification has two organizational schemes—namely, the list of the forty-five classes (together with explanatory notes) and the alphabetical list. The alphabetical list consists of pre-validated terms for each of the forty-five classes: thirty-four classes for goods and eleven classes for services. The alphabetical list functions in two official languages, English and French, and contains approximately eight thousand terms. Some classes have short lists of goods or services; other classes contain very long lists. For example, Class 27 contains twenty-five items in its alphabetical list, whereas Class 9 includes around eight hundred fifty terms. The Nice Classification is administered by the World Intellectual Property Organization (“WIPO”). The tenth edition of


8. The EU member states Cyprus and Malta are not parties to the Nice Agreement but use the Nice Classification.


10. Article 1(2) of the Nice Agreement.

11. Article 1(4) of the Nice Agreement.
the Nice Classification was published in 2011. As of 2013, a new
version of each edition is published annually. The most current
version is the 2015 version of the tenth edition (NCL 10-2015). It
became effective on January 1, 2015. The Nice Classification is no
longer published in paper. The tenth edition, published in June
2011, was the last printed edition.12

The purpose of the Nice Classification is to harmonize member
countries’ practices by ensuring that all parties and users of the
system classify goods and services according to the forty-five
existing classes. In principle, its purpose is not to define the
precise subject matter of a trademark. This means that there may
exist terms in the alphabetical list that are not sufficiently clear
and precise to effectively identify the exact subject matter covered
by a trademark registration. Likewise, a trademark may enjoy
protection for a product or service that is not in the alphabetical
list. Accordingly, Article 2(1) of the Nice Agreement stipulates that
the Nice Classification shall not bind the countries of the Special
Union in respect of the evaluation of the extent of the protection
afforded to any given mark. Regarding CTMs, Rule 2(4) of the
Community Trade Mark Implementing Regulation (CTMIR)13
states that the classification of goods and services shall serve
exclusively administrative purposes. Therefore, goods and services
may not be regarded as being similar to each other on the ground
that they appear in the same class under the Nice Classification,
and goods and services may not be regarded as being dissimilar
from each other on the ground that they appear in different classes
under the Nice Classification.14 Nevertheless, although the Nice
Classification is an administrative tool, the class numbers do play
a certain role when defining the subject matter of a trademark.15

B. The Role of the Class Headings

The class headings indicate in a general manner the fields to
which the goods and services in each of the forty-five classes of the
Nice Classification belong.16 Each class heading consists of one or
more general indications. For example, the class heading in Class
38 consists of one general indication (“telecommunication”) whereas the class heading in Class 36 includes four general

12. The current version of the alphabetical list can be found on WIPO’s website:
13. See supra note 9.
14. See Kampol sp. z o.o. v. OHIM, Case T-382/12, para. 54 (GC, June 6, 2014)
(NOBEL) (EU:T:2014:563); Golam v. OHIM, Case T-486/12, para. 36 (GC, June 11, 2014)
(METABOL) (EU:T:2014:508); Case T-417/12, para. 77 (Oct. 23, 2013) (AQUA FLOW)
15. See infra Part VII.B.1.
16. Point 1 of the user guidance of the Nice Classification (10th ed. 2011).
indications ("insurance; financial affairs; monetary affairs; real estate affairs"). The alphabetical list should be consulted in order to ascertain the exact classification of each individual product or service.

The purpose of the class headings has never been to identify all goods or services covered by the relevant classes in a complete and exhaustive manner. Class 42 demonstrates that class headings are a nonexhaustive description of the contents of each class. Under the sixth edition of the Nice Classification, Class 42 included "services that cannot be placed in other classes." Under the fifth edition, the class heading in Class 42 was simply "Miscellaneous." Until the entry into force of the eighth edition of the Nice Classification in 2002, Class 42 was nothing more than a safe haven for all services which did not fall under any of the categories of Classes 35 to 41. Thus, the explanatory notes of Class 42 (seventh edition) clarified that this class covered all services which could not be classified in other classes.

C. The Logic Behind the Nice Classification

Following is an explanation of the criteria that determine the classification of goods and services in a particular class. This helps to show why goods or services with similar characteristics are sometimes placed in different classes.

The rules of the Nice Classification are set forth below. A finished product is, in principle, classified according to its function or purpose. For example, “thermometers for medical purposes” are classified in Class 10 (“medical apparatus and instruments”) whereas “thermometers” in general fall under Class 9 (“measuring apparatus and instruments”). If the function or purpose of the finished product is not mentioned in any class heading, the product is classified by analogy with other comparable finished products included in the alphabetical list. If there are no comparable products, other subsidiary criteria apply, such as the material of which the product is made or its mode of operation. For example, “sleeping bags for camping” fall under Class 20, as they can be compared with other items in the alphabetical list of that class (e.g., “beds” or “furniture”).

Raw materials, unworked or semi-worked, are in principle classified according to their composition. For example, “aluminium” is classified in Class 6 under “common metals and their alloys” whereas “gold” falls under “precious metals and their alloys” in Class 14.

Special rules apply to finished products with multiple purposes, goods intended to form part of another product, goods

18. Id. at 140-41.
made of different materials, and cases adapted to a product.\textsuperscript{19} Thus, cases fitted for musical instruments fall under Class 15, eyeglass cases belong in Class 9, and cigarette cases belong in Class 34.

Services are in principle classified according to the branches of activities specified in the class headings and in their explanatory notes or, if not specified, by analogy with other comparable services of the alphabetical list. Thus, “production of energy” falls under Class 40 (comparable to “treatment of materials”)\textsuperscript{20} and “publication of books” is in Class 41 (similar to “education; providing of training” or “cultural activities”). Specific rules apply to rental services, information and consultation services, and services rendered in the framework of franchising.\textsuperscript{21}

The aforementioned classification rules illustrate that classes are distinguished on the basis of the purpose or function of the finished product, the makeup of raw materials, or the branch of activities of a service. Many goods and services in the Nice Classification do not fall under the literal meaning of any class heading. These are classified through making an analogy to comparable goods or services. For example, in Class 12, a large number of terms of the alphabetical list are neither vehicles nor apparatus for locomotion. Overall, hundreds of terms in all forty-five classes have been identified that are not covered by the literal meaning of a class heading. Furthermore, some goods or services could fall under the literal meaning of two or more class headings, depending on the purpose of the finished product, the composition of raw materials, or existing comparable goods or services.

\section*{III. THE PRACTICES IN THE EUROPEAN UNION BEFORE JUNE 2012}

Having outlined the function of the Nice Classification and the role of the class headings in that system, this section will now address the question of how class headings were interpreted in the European Union before June 19, 2012—the date of publication of the \textit{IP Translator} judgment of the Court of Justice of the European Union (“CJEU”) (formerly known as the European Court of Justice (“ECJ”)).

Until June 2012, the interpretation of class headings was governed by two different approaches. Under the first approach, a trademark registered for the full class heading meant that the applicant presumed that all goods or services of that class would be protected by that trademark (“class-heading-covers-all”). For example, a trademark registration covering the class heading

\begin{itemize}
\item \textsuperscript{19} Nice Classification, General remarks (10th ed. 2011).
\item \textsuperscript{20} Roberts, \textit{supra} note 17, at 250.
\item \textsuperscript{21} Nice Classification, \textit{supra} note 19, General remarks.
\end{itemize}
“vehicles; apparatus for locomotion by land, air or water” in Class 12 would also protect parts and fittings for vehicles like tires, horns, luggage carriers, safety seats for children, and windshield wipers. Before the IP Translator judgment was rendered, nine trademark offices in the European Union (including OHIM) followed this approach.22

Under the second approach, which was followed by the remaining seventeen national trademark offices of the European Union, class headings were interpreted literally (“means-what-it-says”).23 According to the practice in those offices, a trademark registered for the class heading was not protected for any products that were not covered by the literal meaning of the enumerated general indications.

There is a historical reason why OHIM opted for the “class-heading-covers-all” approach: When the first CTMs were filed in April 1996, OHIM had accepted a simple reference to the class number such as “all goods/services protected in class X.” On May 1, 1996, the Trademark Law Treaty (Geneva Treaty 1994) came into effect. Under this treaty, reference to a class number alone was not sufficient to identify the goods or services covered by a mark in a clear and precise manner.24 The question arose how to treat those CTM applications that had included the phrase “all goods/services in class X.” OHIM decided to replace this phrase ex officio by the respective class heading. On June 16, 2003, the President of OHIM adopted Communication No. 4/03, which clarified and confirmed the previous practice.25 According to Section IV of Communication No. 4/03, the use of all the general indications listed in the class heading of a particular class constituted a claim to all the goods or services falling within this particular class. OHIM did not object to the use of any of the general indications and class headings as being too vague.26 A restriction to any properly classified product in a particular class was accepted if the mark originally contained the complete class heading of the same class.27 Furthermore, in opposition or cancellation proceedings, the goods were considered identical if the senior mark included the whole class heading of a particular class and the junior mark covered any product properly

22. Bulgaria, Finland, Greece, Hungary, Italy, Lithuania, Malta, Romania, and OHIM.
23. The countries are as follows: Austria, Benelux, Cyprus, Czech Republic, Denmark, Estonia, Germany, France, Ireland, Latvia, Poland, Portugal, Spain, Sweden, Slovakia, Slovenia, and the United Kingdom.
24. Article 9(1) of the Trade Mark Law Treaty clearly stipulates that the registration and publication of a trademark “shall indicate the goods and/or services by their names.” Nineteen member states of the EU have ratified or accessed to the treaty so far.
26. Communication No. 4/03, Section III.
27. Id., Section V.1.
classified in that same class. Likewise, the use of any product properly classified in a particular class was considered “use as registered” if the mark covered all the general indications of that same class.28

The different interpretations of the class headings by the trademark offices of different European countries created considerable doubt regarding the subject matter of trademark registrations, in particular CTMs and international registrations with designations in various member states of the European Union. The definition and scope of the subject matter of a registered trademark depended on the interpretation of class headings by each trademark office. This legal uncertainty led to numerous problems relating to priority and seniority claims, restrictions, the genuine use of trademarks, infringements, and the conversion of CTMs into national marks.29

IV. THE IP TRANSLATOR JUDGMENT

As outlined above, the trademark world in the European Union was divided into two groups: According to the supporters of the literal “means-what-it-says” philosophy, the class headings should be interpreted narrowly. On the other hand, the followers of the “class-heading-covers-all” approach took the view that the use of the entire class heading constituted a claim to all the goods or services falling within a particular class. It was therefore hardly surprising that many keen observers of trademark jurisprudence eagerly awaited a judgment of the CJEU on this controversial issue.

The IP Translator judgment,30 rendered on June 19, 2012, helped settle the issue. In that case, the CJEU was asked to clarify whether the “class-heading-covers-all” approach was in line with the EU Trade Marks Directive.31 The judgment had important consequences for the trademark practice of all European trademark offices and has also been referenced by trademark authorities outside the European Union.32

28. Id., Section V.2.
29. See Ashmead, International Classification class headings: illustrative or exemplary? The scope of European Union registrations, 2 JIPLP 76 (2007).
Following is an outline of the facts and proceedings of the IP Translator case, an explanation of the questions asked by the referring court (and the answers given by the CJEU), an analysis of the Court’s judgment, and a summary of the implementation of the judgment by OHIM.

A. Facts and Proceedings

On October 16, 2009, The Chartered Institute of Patent Attorneys (“CIPA”) filed the U.K. trademark application for the IP TRANSLATOR trademark for the class heading in Class 41, i.e., “Education; providing of training; entertainment; sporting and cultural activities.” On February 12, 2010, the Registrar of Trade Marks of the U.K. Intellectual Property Office (“UK IPO”) refused to register the application, arguing that the application covered translation services and that the IP TRANSLATOR trademark was descriptive and devoid of distinctiveness for those services. In other words, the Registrar took the view that the trademark application for the class heading would cover all services in Class 41 including translation services and not just the literal meaning of the listed terms.

The applicant appealed the UK IPO’s refusal to register the application to the Appointed Person, alleging that translation services were not covered by the application. According to the applicant, the IP TRANSLATOR mark covered only the literal meaning of the general indications, but not translation services. The trademark could therefore not be descriptive for translation services.

The Appointed Person stayed the proceeding and referred the case to the CJEU for a preliminary ruling.

B. The Referred Questions and the Answers Given by the CJEU

The Appointed Person submitted the following three questions to the CJEU:

1) Is it necessary for the various goods or services covered by a trademark application to be identified with any, and if so what particular, degree of clarity and precision?

2) Is it permissible to use the general words of the class headings of the Nice Classification for the purpose of...

33. Decision O-059-10 of the Registrar in the matter of Application No. 2528977.

34. An “Appointed Person” is an experienced Intellectual Property Law practitioner appointed by the Lord Chancellor to hear and decide appeals under the U.K. Trade Marks Act 1994 (“TMA-UK”—see Section 77 of the TMA-UK). An appeal from any decision of the Registrar may be brought to an Appointed Person (Section 76 of the TMA-UK). There is no right of appeal to a decision of an Appointed Person.
identifying the various goods or services covered by a trade mark application?

3) Is it necessary or permissible for such use of the general words of the Class Headings of the Nice Classification to be interpreted in accordance with Communication No. 4/03?

In addressing the submitted questions, the CJEU first pointed out that all three questions had to be considered together and that the referring court essentially asked whether the Trade Marks Directive required that the goods or services covered by a trademark application should be identified with a certain degree of clarity and precision. The CJEU confirmed that this was the case.

Apart from asking whether goods or services had to be identified with any precision, the first question also sought guidance about the necessary degree of clarity and precision. The CJEU emphasized that the goods and services in a trademark application must be sufficiently clear and precise in order “to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection sought.”

By the second question, the referring court asked the CJEU whether the general indications of the class heading are capable of identifying the goods or services of a trademark application in a sufficiently clear and precise way. As outlined above, each class heading consists of one or more general indications. Thus, the class heading in Class 41 has four general indications: “education,” “providing of training,” “entertainment,” and “sporting and cultural activities.” According to the CJEU, the general indications of some class headings are sufficiently precise, while others are not. It is up to the competent authorities to assess, on a case-by-case basis, whether the general indications of a class heading meet the requirements of clarity and precision. So long as the general indications are sufficiently clear and precise they can be used to identify the goods and services of the mark.

Finally, the third question deals with the crux of the matter: is it proper to interpret the use of an entire class heading in accordance with the “class-heading-covers-all” philosophy as reflected in Communication No. 4/03? The CJEU pointed out that the existence of two different approaches in parallel would affect

36. Id., para. 49.
37. See supra Part II.B.
39. See supra Part III.
the smooth functioning of the EU trademark system.\footnote{Chartered Institute of Patent Attorneys v. Registrar of Trade Marks, Case C-307/10, para. 59 (CJEU, June 19, 2012) (IP TRANSLATOR) (ECLI:EU:C:2012:361).} According to the CJEU, a situation in which the extent of protection depended on the approach taken by the relevant authority and not on the actual intention of the applicant was contrary to the principle of legal certainty.\footnote{Id., para. 60.} The requirement of clarity and precision must be respected.\footnote{Id., para. 61.} An applicant who uses all general indications of a class heading must specify whether its intention is to cover all goods or services of the alphabetical list\footnote{The explicit reference to “the alphabetical list” of the Nice Classification is a new element introduced by the Court of Justice of the European Union (CJEU). \textit{See infra} Part IV.D.} in that class or only some of those goods or services. In the latter case, the applicant must specify which goods or services are covered. If it cannot be determined from the class heading whether the applicant’s intention was to cover all or only some of the goods or services in that class, then the application is not sufficiently clear and precise.\footnote{Chartered Institute of Patent Attorneys v. Registrar of Trade Marks, Case C-307/10, para. 62 (CJEU, June 19, 2012) (IP TRANSLATOR) (ECLI:EU:C:2012:361).} According to the CJEU, it was for the referring court to determine whether the applicant of the U.K. application for IP TRANSLATOR specified whether its intention was to cover all services in Class 41 including translation services.\footnote{Id., para. 63. On May 2, 2013, the Appointed Person decided that the general indications included in the U.K. trademark IP TRANSLATOR were not intended to cover anything that did not fall within the natural and ordinary meaning of those terms and that the assumption of the Registrar that “translation services” fell within the scope of the words recorded in the application had been erroneous. Accordingly, the appeal brought by CIPA was allowed and the decision of the Registrar was set aside (O-197-13).}

\section*{C. Admissibility of the Reference for a Preliminary Ruling}

The proceedings in the United Kingdom give rise to the suspicion that the IP Translator case was manufactured.

First, the whole conflict between the applicant and the Registrar in the U.K. proceedings was based on the assumption that “translation services” are not covered by the literal meaning of the listed services in Class 41. This is, however, open to debate. One may make the point that “translation services” are directly related to the general indication “cultural activities” in Class 41. Literature forms part of our cultural heritage. The most influential books in Europe were often translations.\footnote{E.g., the Bible translations by St. Jerome, Erasmus of Rotterdam, Martin Luther, or William Tyndale.}
literary awards for outstanding translations. Many translations have become high-ranking works of literature.\textsuperscript{47} It is therefore probably not too farfetched to argue that a translation service may be considered a cultural activity like the writing of texts.\textsuperscript{48} The U.K. Registrar had raised the issue whether translation was covered by the term “cultural activities” but concluded that it was not.\textsuperscript{49}

Second, assuming that “translation services” are not covered by the ordinary meaning of the listed general indications in Class 41, one may wonder why the class heading identified in the trademark application for IP TRANSLATOR was interpreted on the basis of the “class-heading-covers-all” approach, referring to Communication No. 4/03 of the President of OHIM, when the UK IPO had always followed the “means-what-it-says” practice.\textsuperscript{50} According to former U.K. practice, the IP TRANSLATOR mark would be acceptable because it is not descriptive for the services “Education; providing of training; entertainment; sporting and cultural activities” on the basis of the literal meaning of the terms in the class heading. Nevertheless, the Registrar, in his decision, followed the internal guidelines of the UK IPO, which had stated that U.K. trademarks including the full class heading, which were descriptive of a characteristic of a good or service in that class but not covered by the ordinary meaning of the terms in the class heading, would face an objection. The objection could be overcome by an appropriate amendment to the list of goods or services, provided that the scope of the list was not expanded.

Third, since the Registrar was of the opinion that the mark was descriptive for translation services and the applicant apparently did not have any interest in those services, why was the list of services not amended by simply excluding translation services?\textsuperscript{51} If that had occurred, the dispute would have been resolved without the need to refer the matter to the CJEU.

In the proceedings before the CJEU, OHIM argued that the reference for a preliminary ruling must be declared inadmissible on the ground that it was artificial.\textsuperscript{52} The CJEU recalled that the

\begin{itemize}
\item[47.] E.g., the English translation of The Rubáiyát of Omar Khayyám by Edward FitzGerald or the French translation of Edgar Allan Poe’s works by Charles Baudelaire.
\item[48.] The term “writing of texts, other than publicity texts” is included in the alphabetical list of Class 41 (Basic No. 410184).
\item[49.] Decision O-059-10 of the Registrar in the matter of Application No. 2528977, para. 21.
\item[50.] Section 3.9 of the former IPO Trade Marks Manual and Guidance note published on June 13, 2003, see Ashmead, supra note 29, Appendix 2, 88.
\item[51.] The Registrar proposed to amend the mark by excluding translation services. However, the applicant rejected the proposal. See Decision O-059-10 of the Registrar in the matter of Application No. 2528977, para. 28.
\end{itemize}
procedure governing preliminary rulings is an instrument of cooperation between the CJEU and the national courts. In the context of that cooperation, questions concerning EU law enjoy a presumption of relevance. The CJEU may refuse to rule on a question referred by a national court only where it is clear that the interpretation of EU law that is sought is unrelated to the actual facts of the main action or its purpose, where the problem is hypothetical, or where the CJEU does not have the factual or legal material necessary to give a useful answer to the questions submitted to it. According to the CJEU, that was not so in the IP Translator case, because the UK IPO properly sought the interpretation of EU law.\(^53\)

**D. The CJEU's Interpretation of the Nice Class Headings**

The IP Translator judgment is supposed to provide “clarity and precision” but the CJEU’s answer to the third question it considered is not “clear and precise.” The decision is rather enigmatic and resembles the “koan” mentioned in the introduction of this article: the “sound of one hand clapping,” applied to trademark law.

In fact, the CJEU did not answer the third question at all. Instead, the Court introduced a “third category” between “means-what-it-says” and “class-heading-covers-all”: the approach of “class-heading-covers-alphabetical-list.”\(^54\) The following example illustrates the difference among those three categories: A trademark filed for the class heading “advertising; business management; business administration; office functions” in Class 35 would cover:

- only services covered by the literal meaning of the chosen terms according to the “means-what-it-says” philosophy; or

- the literal meaning of the chosen terms plus some additional terms included in the alphabetical list of the Nice Classification like “auctioneering” or “the rental of vending machines” according to the “class-heading-covers-alphabetical-list” approach introduced by the CJEU; or

- all services in Class 35 including services which are not covered by the literal meaning of the chosen terms or by the

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\(^{53}\) Id., para. 31-33.

\(^{54}\) This is the reason why the Common Communication of the EU trade mark offices on the implementation of ‘IP Translator’ of February 20, 2014 (version 1.2) distinguishes between those countries that continue to follow the approach “class headings cover the entire class” and countries, which follow the interpretation “class headings cover the literal meaning of the class headings plus the alphabetical list of the edition of Nice at the time of filing,” see Tables 1 and 4 of the common communication. See also infra note 71.
terms in the alphabetical list like “retail services for shoes” according to the “class-heading-covers-all” approach.

Since the CJEU did not answer the third question and, at the same time, introduced this new category between “means-what-it-says” and “class-heading-covers-all,” the defenders of each approach could claim that the IP Translator judgment supported their view. The followers of “means-what-it-says” insisted that the answer to the third question had to be seen in the context of the CJEU’s replies to the first two questions. Goods and services have to be sufficiently precise in order to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection sought. According to them, the “class-heading-covers-all” philosophy cannot determine the scope of protection “on that basis alone.”

On the other hand, according to the supporters of the “class-heading-covers-all” doctrine, the CJEU pointed out that the applicant of a mark comprising a class heading “must specify whether its intention is to cover all goods or services of the alphabetical list.” This wording would leave room for an interpretation beyond the literal meaning of the chosen terms.

The author’s interpretation of the CJEU’s answer to the third question is that the Court was well aware of the two opposing approaches. In fact, three of the seven paragraphs in the judgment dealing with question three are about the considerable risks that two approaches in parallel constitute for applicants, their competitors, and the EU trademark system in general. The CJEU might have also been aware of the dilemma it was confronted with: If the “class-heading-covers-all” approach is wrong, how should all those registered trademarks comprising class headings be interpreted in those countries that followed the “class-heading-covers-all” practice? Could the literal approach be applied retrospectively to those registrations, bearing in mind that their owners had relied on the existing practice at the time in those countries? On the other hand, if the “class-heading-covers-all” approach is right, how can this be reconciled with the principle of clarity and precision? Instead of giving a clear reply, the CJEU pointed out that the trademark offices in the European Union have created a “mess” and that it was up to them to fix it. As long as this confusion exists, the CJEU considers any registered trademark in the European Union comprising class headings unclear and imprecise unless the applicant had specified its intention (or was given the chance by the trademark office to declare its intention). This applies to all registered marks,

independently of the approach taken by the competent trademark office in the relevant jurisdiction.\footnote{Id., para. 62, which states: "An application for registration which does not make it possible to establish whether, by using a particular class heading of the Nice Classification, the applicant intends to cover all or only some of the goods in that class cannot be considered sufficiently clear and precise." In a subsequent judgment (Netto Marken-Discount AG & Co. KG v Deutsches Patent- und Markenamt, Case C-420/13 (Netto Marken-Discount) (July 10, 2014) (ECLI:EU:C:2014:2069), the CJEU seems to confirm this conclusion: the judgment dealt with the question whether the German mark NETTO MARKEN-DISCOUNT (fig.) filed on September 10, 2011 for, inter alia, "retail services in relation to advertising; business management; business administration; office functions" was sufficiently precise. The Court took the view that this specification of the German trademark application was not sufficiently clear and precise (para. 52): "Subject to verification by the referring court, that application does not ostensibly specify whether, by citing the entire heading of Class 35 of the Nice Classification, the applicant in the main proceedings seeks protection by that trade mark for the bringing together of all the services included in the alphabetical list of that class or solely of some of those services. In the light of the existence of different approaches within the European Union regarding the way in which the use of a Nice Classification class heading must be understood, an application which does not make it possible to establish whether, by using a particular class heading, the applicant intends to cover all or only some of the goods or services thereof could not be considered sufficiently clear and precise (Chartered Institute of Patent Attorneys EU:C:2012:361, paragraphs 58, 59 and 62)." The result is surprising, bearing in mind that the German authorities have always followed the "means-what-it-says" approach (see supra note 23).} Although the CJEU has not given a clear reply to question three, the \textit{IP Translator} decision did end the "class-heading-covers-all" philosophy. The following sub-section explains what had made this approach so attractive and why it was correct, in the author's opinion, to abandon it.

1. The End of the "Class-Heading-Covers-All" Approach

One important advantage of the "class-heading-covers-all" philosophy was that it was very practical for trademark offices in the European Union that followed that approach. Examiners in those offices dealt with short lists of goods and services which made the examination of classification deficiencies and absolute and relative grounds for refusal less burdensome. In particular, if the earlier mark was protected for the class heading, the trademark office could assume that all contested goods in the same class were identical since the earlier mark was deemed to cover all goods in that class. If the contested mark was filed for the entire class heading, the trademark office compared the earlier goods with the general indications of the class headings. Moreover, the translation costs necessary for the specifications of CTM applications were very limited as standard translations could be used for the class headings. Finally, the "class-heading-covers-all" approach avoided arduous interpretations and delimitations of
different general indications that need to be addressed when interpreting them literally.\textsuperscript{57}

Nevertheless, the “class-heading-covers-all” approach could not continue, as it was not compatible with the Trade Marks Directive and as it conflicted with the principle of clarity and precision.\textsuperscript{58} With respect to CTMs, the requirement of clarity and precision is explicitly reflected in Rule 2(2) CTMIR. This rule states that the list of goods and services has to be worded in such a way as to clearly indicate the nature of the goods and services in a trademark application. If the list of goods is not clear and precise, trademark authorities are not in a position to properly examine an application for absolute or relative grounds of refusal and third parties will not be able to determine the trademark’s exact scope of protection. The “class-heading-covers-all” philosophy does not enable stakeholders to identify the goods and services protected by the mark in a sufficiently clear manner. There are hundreds of “invisible” goods and services which are not covered by the ordinary meaning of the respective general indications of the class headings. Furthermore, the Nice Classification is an evolving instrument and items have moved classes in the last several decades. For example, according to the logic of the “class-heading-covers-all” philosophy, a CTM filed in 2005 for “education; providing of training; entertainment; sporting and cultural activities” in Class 41 would protect “translation services.” However, if the same CTM had been filed in 2001 with the same class heading it would not cover “translation service” because this service was listed in Class 42 under the seventh edition of the Nice Classification.

The “means-what-it-says” approach complies not only with the requirement of clarity and precision but also with the specialty principle, according to which a trademark is never protected in the absolute but only for specific goods and services. It must be possible to determine the substantive scope of protection of a registered trademark. A trademark that purportedly protects an indeterminable number of partly “invisible” goods or services is not in line with this principle.

Before looking at the implementation of the \textit{IP Translato}r judgment by OHIM and the subsequent harmonization of practices in the European Union (as outlined in Part V), this article will

\textsuperscript{57} For example, are “sandwiches” (Basic No. 300106 of the alphabetical list in Class 30) covered by the general indications “preparations made from cereals,” “bread” or “pastry” in Class 30? If not, the term must be stated separately in order to be protected when interpreting the class headings literally.

address the role of the applicant’s intention when defining the scope of a trademark.

2. The Role of the Applicant’s Intent

According to the CJEU, the scope of the identification of goods and services of a trademark registration should not depend on the approach to interpretation adopted by the competent authority but should be based upon the applicant’s intent.59

In the author’s opinion, the CJEU’s statement that the scope of the identification of goods and services of a trademark application depends on the intention of the applicant might give rise to confusion. The literal meaning of the listed terms should define the subject matter of a trademark application, not the applicant’s intent. The list of goods and services cannot be expanded after a trademark application is filed.60 Suppose that the applicant in the U.K. proceedings for the IP TRANSLATOR trademark had stated, after the filing date and upon request of the UK IPO, that its intention had been to protect translation services. Such an amendment would violate Section 39 of the U.K. Trade Marks Act 1994 (TMA-UK),61 as it would impermissibly broaden the scope of the list of services. The U.K. trademark applicant could not have relied on a broader scope of services because the UK IPO has always interpreted the class headings literally.62

The CJEU’s judgment in the IP Translator case must be viewed in context. In June 2012, there were two different approaches for interpreting trademarks covering class headings, as the CJEU correctly emphasized in its judgment. However, one year after the IP Translator decision, in May 2013, all EU trademark offices agreed to abandon the “class-heading-covers-all” approach regarding trademarks filed after the IP Translator judgment.63 Going forward, the literal meaning of the chosen terms identifies the subject matter of the mark, not the applicant’s intention. Consequently, the applicant’s intent plays only a limited role when defining the precise subject matter of a trademark.64

60. See, e.g., Article 43(2) of the CTMR, Article 39 (1) of the German Trade Mark Act (Markengesetz), Section 39 of the TMA-UK.
61. See supra note 34.
62. See supra note 23.
63. See Common Communication of the EU trade mark offices on the implementation of ‘IP Translator’ of February 20, 2014 (version 1.2), Tables 2 and 4.
64. See infra Part VI.A and Part VII.B.2.
E. The Implementation of IP Translator by OHIM

Communication No. 2/12 of the President of OHIM, published on June 20, 2012, implemented the IP Translator judgment to CTMs.65 The communication emphasized that CTM applications and registrations will be interpreted on the basis of the natural and usual meaning of the listed terms in the identification of goods and services for all proceedings before the Office.66 The former Communication No. 4/03 was repealed.67

As mentioned above, the CJEU, in response to the second question that was presented in the IP Translator case, held that it was for the competent authorities to determine which general indications of the class headings met the requirements of clarity and precision. Accordingly, Section III of Communication No. 2/12 states that OHIM and the national trademark offices in the European Union will work within the framework of the OHIM’s Convergence Programme in order to identify those general indications that are not sufficiently clear and precise.68

The new interpretation of class headings by OHIM is summarized in Sections V to VII of Communication No. 2/12. With regard to registered CTMs for class headings, Section V provides that OHIM considers that the applicant’s intent was to cover all the goods or services included in the alphabetical list of that class in the edition of the Nice Classification in force at the time when the filing was made. Similarly, with respect to CTM applications for class headings filed before June 21, 2012,69 OHIM considers that the applicant’s intention was to cover all the goods or services included in the alphabetical list of the relevant class, except where applicants had specified that they had sought protection only for some of the goods or services in that class.70 Finally, Section VII clarifies that those who filed CTM applications for class headings after June 20, 2012, must expressly indicate whether or not their intention is to cover all the goods or services included in the alphabetical list of each concerned or only some of those goods or services in that class.

According to Communication No. 2/12, it is possible to partially withdraw or surrender CTMs filed or registered before June 21, 2012, by amending a term of the alphabetical list that is

65. Communication No. 2/12 of the President of the Office of June 20, 2012, concerning the use of class headings in lists of goods and services for CTM applications and registrations.
66. Id., Section VIII.
67. Id., Section IX.
68. See infra Part V.
69. The date when Communication No. 2/12 entered into force; see supra note 65, Section IX.
70. See Communication No. 2/12, supra note 65, Section VI.
deemed to be covered by the mark in accordance with Sections V and VI. Such a partial withdrawal or surrender is excluded only if the amended list contains a term that is not deemed to be covered by the mark. Once the partial surrender has been submitted, the scope of protection is limited to the literal meaning of the remaining terms.

On November 26, 2013, the President of OHIM issued Communication No. 1/13, stating that applicants should expressly indicate their intention to protect all goods or services of the alphabetical list “by designating all these goods or services explicitly and individually.” The President further declared that a general statement, by which the applicant declares its intention to cover all the goods or services of the alphabetical list, will not be accepted. The vast majority of the national trademark offices have followed a similar approach by asking applicants to list the intended goods or services individually. For example, the UK IPO amended its trademark application form in August 2013 to require

71. Id., Section VIII.3. For example, a CTM registered since November 15, 2009, for the class heading “advertising; business management; business administration; office functions” in Class 35 cannot be partially surrendered by adding the term “retail services in relation to cars.” The reason is that retail services are not covered by the literal meaning of the class heading terms and were not included in the alphabetical list of Class 35 when the mark was filed. In a recent judgment, the GC considered that certain retail services were protected by CTMs comprising the class heading in Class 35 (see Cactus S.A. v. OHIM, Case T-24/13 (GC, July 15, 2015) (CACTUS OF PEACE CACTUS DE LA PAZ / CACTUS) (ECLI:EU:T:2015:494)). The GC overlooked, however, that those retail services did not form part of the alphabetical list in Class 35. The GC judgment is therefore contrary to the IP Translator judgment (see supra Part IV.D).

72. Id., Section VIII.3.

73. Communication No. 1/13 of the President of the Office of November 26, 2013, concerning a new administrative tool for classification purposes (taxonomy) and the use of class headings of the Nice Classification, Section II.ii.

74. Id., Section II.ii. In the first four months after IP Translator, OHIM allowed the filing of a declaration as annex to the CTM application, by which the applicant declared its intention to protect all goods or services of the alphabetical list in the relevant class. Nevertheless, the majority of the national trademark offices in the EU did not accept a simple declaration reflecting an intention to cover the full alphabetical list as complying with the requirement of clarity and precision as required in the IP Translator judgment. According to the view expressed by those national trademark offices, a simple declaration would not enable the competent authorities and economic operators to identify the protected goods and services and to determine the extent of the protection conferred to the mark “on that basis alone,” as required by the CJEU. The aforementioned concerns of the majority of the EU trademark offices were shared by the European trademark association MARQUES in a position paper published on July 4, 2012 (see http://www.marques.org/PositionPapers). On October 15, 2012, OHIM introduced a new feature in its e-filing system (“tick-box”), which allowed applicants to tick a box indicating their wish to cover all the goods or services in the alphabetical list. The tool automatically inserted the full alphabetical list for the corresponding class and the mark was published with the full alphabetical list. Likewise, all CTM applications filed together with a declaration (as annex) between June 21 and October 14, 2012, were published with the entire alphabetical list added to the class headings. The first CTM applications with full alphabetical lists were published on November 30, 2012. The aforementioned “tick-box” solution introduced in October 2012 was abandoned in 2013.
applicants to confirm that the terms used in their list of goods or services should be given their ordinary and natural meaning.75

V. HARMONIZATION OF PRACTICES FOLLOWING IP TRANSLATOR

Part V deals with the harmonization of practices of the trademark offices in the European Union after the IP Translator judgment and the fundamental role of OHIM’s Convergence Programme in that respect.

Launched in 2011, before IP Translator, the OHIM Convergence Programme aims at reaching common ground in areas where the intellectual property offices in the European Union have different practices. OHIM, WIPO, national trademark offices, and user organizations76 are collaborating together in an effort to harmonize practices.77

The trademark offices of the European Union understood early on that the IP Translator judgment would affect their practices. The offices agreed that the decision should be implemented in a harmonized manner. On July 1, 2011, almost a year before the IP Translator judgment was rendered, representatives of all European trademark offices and user organizations met in Alicante, Spain, for the first time with the objective of finding a common interpretation of class headings. After several meetings, the EU trademark offices published three “common communications.” Each communication dealt with one of the three questions referred to the CJEU in the IP Translator judgment.

On May 2, 2013, the first common communication concerning the interpretation of class headings was published.78 In this common communication, all trademark offices in the European Union agreed to abandon the “class-heading-covers-all” approach for trademarks filed after the IP Translator judgment.79

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75. See UK IPO Practice Amendment Notice (PAN No. 03/13), point 9, and UK IPO Trade Marks Manual, the examination guide (section: specification—class headings), at 241. The new practice in the United Kingdom took into account the decision of the Appointed Person following IP Translator (O-197-13, May 2, 2013), see supra note 45.

76. The user organizations (e.g., INTA, ECTA, MARQUES, etc.) are invited to participate in the meetings and to represent the position and views of the users about the practices of the trademark offices (see https://oami.europa.eu/ohimportal/en/our-partners).

77. National offices outside the EU, user organizations, and WIPO participate in the Convergence Programme as observers. For more details, see http://www.tmdn.org.


79. Id., Table 2. Four offices (Hungary, Italy, Lithuania, and Romania) accepted that the class heading of future marks would also protect the alphabetical list of Nice at the time of filing provided that the terms of the alphabetical list were explicitly listed or that a reference to the alphabetical list was made (Table 3). See supra note 54.
CTMs, all trademark offices interpret class headings contained in CTM applications filed after *IP Translator* literally.\(^{80}\)

In November 2013, the EU trademark offices agreed in a second common communication on a list of eleven general indications that they consider too imprecise.\(^{81}\) This agreement is a direct consequence of the *IP Translator* judgment, which stressed that it was the task of the trademark offices to determine which general indications do not comply with the requirement of clarity and precision.

Finally, on February 20, 2014, the trademark offices of the European Union published a third common communication with guidelines designed to help identify terms that meet the requirement of clarity and precision.\(^{82}\)

With the collaboration of Europe’s national trademark offices and WIPO, OHIM developed a hierarchical structure of goods and services (“taxonomy structure”) within each of the forty-five classes of the Nice Classification. The goods and services are grouped according to shared characteristics from a market perspective. The primary purpose of the hierarchical structure is to provide users with a better overview of the contents of each class and to simplify the process of searching and selecting adequate terms for goods and services.\(^{83}\)

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80. *Id.*, Table 4.

81. *See* Common Communication on the Common Practice on the General Indications of the Nice Class Headings of February 20, 2014 (version 1.1). The eleven imprecise general indications are the following: Goods of metal in Class 6; machines in Class 7; goods in precious metals or coated therewith in Class 14; goods made of paper and cardboard in Class 16; goods made from rubber, gutta-percha, gum, asbestos, and mica in Class 17; goods made of leather and imitations of leather in Class 18; goods 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 in Class 20; repair and installation services in Class 37; treatment of materials in Class 40, and personal and social services rendered by others to meet the needs of individuals in Class 45. All trademark offices have implemented the new practice by now; see the overview on page 8 of the Common Communication. The High Court of Justice referred to the Convergence Programme and confirmed that the general indication “telecommunications” in Class 38 was sufficiently clear and precise in accordance with the judgment in *IP Translator*; *see* Total Limited v. YouView TV Limited [2014] EWHC 1963 (June 16, 2014) (Ch), para. 63.

82. Common Communication on the Common Practice on the Acceptability of Classification Terms of February 20, 2014 (version 1.1).

83. *See* Communication No. 1/13 of the President of the Office of November 26, 2013, *supra* note 73, Section I. The hierarchical structure is embedded in the common classification database “TMclass” (http://www.oami.europa.eu/ec2/). A lean version of the taxonomy structure (limited to the terms of the Nice Classification) is also available as an additional tool of the online publication “NicePub” administered by WIPO (http://www.wipo.int).
VI. TRADEMARKS FILED OR REGISTERED BEFORE 
IP TRANSLATOR—A DIFFICULT HERITAGE

As explained above, the EU trademark offices have reached a number of important agreements as a consequence of the IP Translator judgment. However, one issue has not yet been harmonized: How should the class headings of marks filed or registered before the IP Translator judgment be interpreted?

Part VI discusses whether the legitimate expectations of trademark owners resulting from OHIM’s previous practice can justify an interpretation of the class headings based on the “supposed intention” of the trademark owner when it filed its trademark application. The article will then discuss Article 28 Proposal-EUTMR, which offers a solution for existing CTMs covering the full class heading.

A. Are Legitimate Expectations Created by 
Communication No. 4/03?

In the author’s view, the basis for interpreting the subject matter of a trademark should generally be the literal meaning of the chosen goods or services, not the intention of the trademark owner. Under normal circumstances, it is very difficult to find out whether “the supposed intention” of the applicant had been to protect all goods or services in a particular class or only those covered by the ordinary meaning of the listed terms.

On the other hand, the interpretation of the scope of protection of existing CTMs as foreseen in Communication No. 2/12 is a concession to trademark owners in light of the previous practice as reflected in Communication No. 4/03 of the President of OHIM.

1. Nature and Function of 
Presidential Instructions and Notices

Pursuant to Article 124(2)(a) of the Community Trade Mark Regulation (CTMR), the President of OHIM shall take all necessary steps, including the adoption of internal administrative instructions and the publication of notices, to ensure the functioning of the office. All notices are published in the Official Journal of the Office (Article 89(b) CTMR). According to the internal terminology used by OHIM, a President’s notice is called “Decision of the President” if its publication is explicitly foreseen by the CTMR or the CTMIR. Other published notices of the President are referred to as “Communications of the President.” This does not mean, however, that “Decisions” are more binding

84. See supra Part IV.D.2.
85. See, e.g., Rules 3(6), 6(4), 8(4), 28(4), 55(2), 59(4), 65(2), 66(2), 72(1), (2), and (4), 82(1), 84(4), 85(1), 86(2), 87(2), 89(1), 91(1), and (2), 98(1), 108(3) of the CTMIR.
than “Communications.” Both types of presidential publications are internal administrative instructions for OHIM staff and do not constitute direct rights or obligations for trademark owners. The notices have only an indirect effect for the users insofar as the administration has to follow its internal instructions. The administration would infringe the principle of equality if it were to deviate arbitrarily from its internal instructions. On the other hand, the principle of equal treatment has to be balanced with respect for the law. If the former practice was unlawful, the office cannot continue it in the future.86

A main purpose of internal administrative instructions is to ensure the proper functioning of the administration and, in particular, to create legal certainty in areas where explicit legal provisions are missing or too vague.

2. Communication No. 4/03

Communication No. 4/03 was meant to create legal certainty for users of the CTM system by establishing, in a clear and predictable way, rules about how OHIM would interpret class headings.87 The principle of legal certainty is a fundamental principle of EU law that requires that rules be clear and precise so that the addressee may ascertain unequivocally what his rights and obligations are and take steps accordingly.88 Whether Communication No. 4/03 actually achieved this goal is open to debate. It is true that Communication No. 4/03 clarified a prior-existing practice that had never been specified in a written document.89 One may argue that Communication No. 4/03 did not provide legal certainty because the “class-heading-covers-all” approach reflected in this communication did not enable the stakeholders to determine the precise subject scope of the relevant trademarks.90

Nevertheless, trademark owners who filed a CTM application before the IP Translator judgment relied on OHIM’s “class-heading-covers-all” practice as stipulated in Communication No. 4/03. The principle of legitimate expectations is closely linked to the principle of legal certainty. Both principles are a corollary of

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86. Agencja Wydawnicza Technopol sp. z o.o. v OHIM, Case C-51/10 P (1000), para. 74-76 (CJEU, Mar. 10, 2011) (ECLI:EU:C:2011:139).
90. See supra Part IV.D.1.
the principle of legality. To maintain the principle of the protection of legitimate expectations, the legislature and other governmental bodies should exercise their powers in such a way that lawfully created situations and relationships are not affected in a manner that could not have been foreseen by a diligent person. The addressee may rely on that principle if the administration has promoted reasonable expectations and thus created a situation which can give rise to such expectations.

OHIM created reasonable expectations on part of the trademark owners and applicants. Communication No. 4/03 was published in the Official Journal and on OHIM’s web site. The contents of the communication also formed part of the OHIM Guidelines, which were adopted by the President after consulting the Administrative Board (Article 126(4) CTMR). Moreover, Communication No. 4/03 was consistently applied by OHIM’s examiners as well as by OHIM’s Opposition and Cancellation Divisions. The Boards of Appeal also followed the “class-heading-covers-all” approach although they were not bound by Communication No. 4/03. Finally, the practice was confirmed by the General Court (“GC”).

92. Id., para. 25.
95. Thus, Part B (Examination), Section 3.5 of the Guidelines of April 2008 stated: “A class heading covers all the goods or services that fall under that class, and restricting a class heading to a particular good falling under that class does not constitute an extension. Example: ‘Musical instruments’ (which is the class heading for Class 15) may be restricted to ‘cases for violins’ which fall under the Alphabetical List of Class 15, although one cannot play music on a case. To refer to: Communication No 4/03, OJ OHIM 2003/10.” The 2008 version of the Guidelines is accessible at http://www.oami.europa.eu).
A measure that retrospectively interprets class headings of existing CTM registrations literally would disregard the owners’ reasonable expectations in the previous “class-heading-covers-all” practice and possibly interfere with the protection of their property rights.

3. Communication No. 2/12

Instead of applying the literal-meaning approach retrospectively for existing CTMs, OHIM’s practice was to assume that the registrant’s intention had been to include all goods or services of the alphabetical list in that class.98 Communication No. 2/12 explicitly stipulates that the supposed intention of the trademark owner to cover more than the literal meaning of the class headings had to be taken into account “in view of the contents of the previous Communication 4/03.”99

The new OHIM practice as outlined in Communication No. 2/12100 was approved by the General Court. In the Babilou judgment,101 the question at bar was whether a CTM registered since 2007 for the class heading in Class 35 (“business management; business administration; office functions”) covered “auctioneering,” which was included in the alphabetical list of the same class. In the proceedings before the GC, the owner of the senior CTM registration confirmed that it had intended to include “auctioneering services” when filing its CTM. The GC shared the view taken by the Board of Appeal that “auctioneering services” were indeed protected by the earlier registration and that, consequently, the services of the earlier CTM were identical to the “provision of auctioneering services on the Internet” covered by the applied-for mark.

Moreover, in the recent Lambretta case, the GC held that a CTM filed on February 7, 2000, and registered on August 6, 2002, for “vehicles; apparatus for locomotion by land, air or water” in Class 12 covered all goods in the alphabetical list in that class including parts and fittings for scooters although the latter goods are not covered by the literal meaning of the class heading terms.102 The applicant represented that it intended to cover those

the GC held that the contested solutions for use in contact lenses were included in the alphabetical list in Class 5 and therefore “necessarily” covered by the earlier mark which protected the entire class heading in the same class.

98. See supra Part IV.E.
99. See Communication No. 2/12 of the President of the Office of June 20, 2012, supra note 65, Section V.
100. See supra Part IV.E.
goods when it filed its CTM application. The GC pointed out that “a legitimate expectation had been created by OHIM itself, since it had given assurances as regards the treatment of trade mark applications using the complete heading of a particular class.” According to the GC, this interpretation of the class heading applies even though the CTM application had been filed and registered before Communication No. 4/03 was published. First, Communication No. 2/12 does not distinguish between marks filed or registered before or after the publication of Communication No. 4/03. Second, the GC stated that Communication No. 4/03 was not intended to introduce a new practice but to explain and clarify OHIM’s previous practice. Third, the wide interpretation of class headings was applied by the GC in previous judgments in relation to CTMs filed and registered before the publication of Communication No. 4/03.

4. Comment

In the author’s opinion, taking into account the legitimate expectations of the trademark owner in OHIM’s previous “class-heading-covers-all” practice is justified, at least if there are specific reasons to believe that the trademark owner actually had the intention to protect more goods or services than covered by the literal meaning of the class heading when filing the mark. In particular, concrete indications confirming the applicant’s intention to have broad protection may exist in at least two situations.

First, concrete indications may exist if the applicant had requested the priority or seniority of a national mark that included goods or services in the relevant class not covered by the literal meaning of the class heading terms of the filed CTM application. By way of illustration, a CTM application filed for the class heading “Education; providing of training; entertainment; sporting and cultural activities” in Class 41 claims the seniority of an earlier national mark for “publication of books.” This is a

103. Id., para. 27.
104. Id., para. 30.
105. Id., para. 31. See also supra note 25.
106. Id., para. 32. In the quoted judgment (BMI Bertollo Srl v. OHIM, Case T-186/02 (GC, June 30, 2004) (DIESELIT/DIESEL) (ECLI:EU:T:2004:197), supra note 97), the General Court confirmed that the intervener’s CTM registration No. 743 401 (filed on February 9, 1998 and registered on April 27, 1999 for the class headings in Classes 11, 19, 20, and 21) “covered all goods capable of being comprised within the classes applied for at the Community level” (para. 42).
107. In the Lambretta case (see supra note 102), the CTM owner had claimed seniority of the earlier U.K. mark No. 874 581 for parts and fittings of motor cars, motor vans, and cycles.
108. Basic No. 410024 of the alphabetical list in Class 41 of the Nice Classification.
concrete indication that the applicant also intended to protect the CTM for the services listed in the earlier national mark.

Second, concrete indications confirming the applicant's intention to have broad protection may exist where the trademark owner used the CTM for goods or services not covered by the literal meaning of the class heading in the same class. By way of example, a CTM is registered for the class heading “Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers” in Class 26, but the registrant had made genuine use of the mark for “wigs; toupees; false hair.” The use of the mark in connection with those goods indicates that the applicant had intended to protect those goods when filing the CTM application.

**B. The New EU Legislation**

The *IP Translator* judgment will be implemented in Article 40 Proposal-Directive and Article 28 Proposal-EUTMR, which set forth common rules for the designation and classification of goods and services. Following a provisional agreement reached between the European Commission, the Council of the European Union, and the European Parliament on April 21, 2015, the Council published a finalized text on June 8, 2015. The new EUTMR is likely to become effective by the beginning of 2016. As soon as Article 28 Proposal-EUTMR enters into force, Communication No. 2/12 of the President of OHIM will be repealed.

Article 40(5) Proposal-Directive and Article 28(5) Proposal-EUTMR stipulate that “the use of general terms, including the general indications of the class headings of the Nice Classification, shall be interpreted as including all the goods or services clearly covered by the literal meaning of the indication or term. The use of such terms or indications shall not be interpreted as comprising a claim to goods or services which cannot be so understood.”

However, pursuant to Article 28(8) Proposal-EUTMR, owners of registered CTMs will be given an opportunity to declare whether they intended to cover further goods and services of the alphabetical list beyond the literal meaning of the class heading. The provision foresees that CTM owners of marks filed before

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109. Basic Nos. 260079, 260089, and 260043 of the alphabetical list in Class 26 of the Nice Classification.


112. See supra Part IV.E and VI.A.3.
June 22, 2012, that consist of entire class headings “may declare that their intention on the date of filing had been to seek protection in respect of goods or services beyond those covered by the literal meaning of the heading of that class, provided that the goods or services so designated are included in the alphabetical list for that class of the edition of the Nice classification in force at the date of filing.”

The time limit for submitting such a declaration is within six months of the effective date of the new EUTMR. In the declaration, the CTM owner must identify the goods and services that it intended to protect when filing the mark that are not clearly covered by the literal meaning of the class heading terms. Once the declaration is accepted, the CTM register will then be amended accordingly. If the trademark owner does not file any declaration before the end of the designated period, the scope of protection of the CTM will be limited to the literal meaning of the general indications included in the relevant class heading.

According to Article 28(8a) Proposal-EUTMR, the amendment of the list of goods will not give the CTM owner the right to prevent any third party from continuing to use a trademark in relation to goods or services where and to the extent that the third party started to use its trademark before the amendment and the use of the third party trademark did not infringe the CTM owner’s rights based on the literal meaning of the record of the goods and services in the register at that time. Furthermore, the amendment will not give the CTM owner the right to oppose or to apply for a declaration of invalidity of a later trademark where and to the extent that the later trademark was either filed or in use for goods or services before the register was amended, and the use of the third party trademark did not infringe, or would not have infringed, the owner’s rights based on the literal meaning of the record of the goods and services in the register at that time.

By way of illustration, imagine that a hypothetical company named Alibay Corp., an online auction company, registered a CTM for the class heading “advertising; business management; business administration; office functions” in Class 35 on October 15, 2008. In July 2015, the company learns that its core service “auctioneering” is actually not covered by the literal meaning of the class heading. Suppose that Article 28(8) Proposal-EUTMR becomes effective on December 1, 2015, the company has to declare by June 1, 2016 that its intention, on the filing date of its CTM, had been to cover “auctioneering” in Class 35. If the company does not file any declaration by the deadline the protection of its CTM will cover only the literal meaning of the registered services. Moreover, Article 28(8a) Proposal-EUTMR will prevent Alibay

113. Basic No. 350030 of the alphabetical list in Class 35 of the Nice Classification.
Corp. from claiming infringement or cancelling a registered third party mark on the basis of the added term “auctioneering” if a third party filed and registered or used its mark for “auctioneering” in the European Union after October 15, 2008 (the filing date of the CTM).

Owners of CTMs comprising class headings should check whether their goods of interest are actually covered by the literal meaning of the registered general indications. If this is not the case and if the products of interest are included in the alphabetical list of the same class, the CTM owner should declare a partial surrender pursuant to Article 50 CTMR and request OHIM to amend the existing list of terms as soon as possible, ideally before the EUTMR becomes effective. The possibility of a partial surrender is explicitly foreseen by Communication No. 2/12. By partially surrendering the mark, the trademark owner makes sure that its goods or services of interest or use are effectively protected by the registration. Likewise, a partial surrender may be necessary before the CTM can be converted into a national mark of a member state that interprets the list of goods or services of CTMs literally.

VII. THE SCOPE AND THE LIMITS OF THE “MEANS-WHAT-IT-SAYS” PHILOSOPHY

As explained above, Article 40(5) Proposal-Directive and Article 28(5) Proposal-EUTMR stipulate explicitly that class headings shall be interpreted literally. The “means-what-it-says” approach reflected in those provisions is in line with the principle of clarity and precision. Furthermore, according to Article 40(4) Proposal-Directive and Article 28(4) Proposal-EUTMR, the competent office should reject a trademark application for unclear or imprecise indications or terms if the applicant does not propose acceptable language within a period set by the office to that effect.

This section deals with two questions. First, what is the “literal meaning” of a registered indication or term? Second, what

114. See supra Part IV.E.
115. See example, supra note 71.
116. Communication No. 2/12 of the President, supra note 65, Sections V and VIII.3.
117. Common Communication on the Implementation of ‘IP Translator’ of February 20, 2014 (version 1.2), Table 4. Example: On November 12, 2013, the owner of a CTM mark protected since June 20, 2010, for the class heading in Class 12 (“vehicles; apparatus for locomotion by land, air or water”) would like to convert its CTM into national marks in Austria, France, Germany, and the United Kingdom, but only for the goods “anti-theft devices for vehicles.” Since all the aforementioned member states interpret the list of goods literally (“means-what-it-says”), the conversion request might be rejected in those countries. Thus, the owner would need to partially surrender its CTM to “anti-theft devices for vehicles” before submitting the conversion request.
are the limits of an interpretation based on the literal meaning of a term?

A. The Scope of “Means-What-it-Says”

What is covered by the literal meaning of an indication or term? The starting point should be the dictionary definition of the term. For example, a “vehicle” is a “means of conveyance provided with wheels or runners and used for the carriage of persons or goods; a carriage, cart, wagon, sledge, or similar contrivance.”

Thus, a trademark covering “vehicles” in Class 12 would protect cars and motorcycles and also trolleys or pushchairs because the latter fall under the definition of a vehicle. On the other hand, the same mark would not protect motors, tires, or brakes. Although those goods form an integral part of many vehicles they do not fall under the definition of a “vehicle.” Consequently, a trademark is only protected for component parts of the main product or goods and services directly related to the product if they are listed in the application.

The meaning of terms may change with time. A trademark may enjoy protection for goods which did not yet exist at the time of the registration provided that the new product is covered by the literal meaning of the registered term. For example, the meaning of the term “telecommunications” has broadened considerably over the last twenty years and now also covers, for example, streaming of data via broadband connections to computers, mobile phones or other devices. If a company filed a trademark for “telecommunications” in 1995, its use in 2015 for audio or video streaming services would be genuine use of the registered services.

If the product at issue has more than one function, it may be difficult to determine whether it is still protected under the literal

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119. A different question is whether the continued use of component parts and ancillary services is genuine use of the main product in a trademark registration if that product was sold in the past but is not available anymore. E.g., genuine use of a trademark for “vehicles” may exist if a car producer has used the mark for cars, stops production, but continues to offer spare parts and repair services ((Ansul BV v. Ajax Brandbeveiliging BV, Case C-40/01 (Mar. 11, 2003) (MINIMAX) (ECLI:EU:C:2003:145)). This does not mean, however, that the scope of protection of a mark extends to spare parts and repair services if those goods and services are not covered by the literal meaning of the list of goods in a registration.

120. For example, the 2015 version of the 10th edition of the Nice Classification introduced various new goods and services that did not exist a couple of years ago, such as “3D printers” in Class 7, “digital signs” in Class 9, “oral vaporizers for smokers,” “flavourings, other than essential oils, for use in electronic cigarettes” in Class 34, or “streaming of data” in Class 38. See the official publication of the Nice Classification (NicePub), http://www.wipo.int/classifications/nice/en/.

meaning of the registered indication or term. The decision depends on the “core meaning and function” of the registered terms and the used product. For example, the use of a trademark for an MP3 player with a radio function is probably covered by the literal meaning of the term “radio receiving apparatus.” A radio can be defined as “an apparatus for receiving radio signals, a radio receiving set.” One of the core functions of the aforementioned MP3 player is to receive and transmit radio signals. On the other hand, the used product is not covered by the literal meaning of the registered term if it forms a merely peripheral and rather insignificant part of the used product. Thus, a multifunctional shower system with an integrated radio would probably not be covered by the registered term “radio receiving apparatus.” The “core meaning and function” of both products—radio on the one hand and shower on the other hand—are different.

Finally, the scope of the literal meaning may also depend on the chosen language of the identification of goods and services. With respect to CTMs, Article 120(3) of the CTMR stipulates that, when in doubt, the text in the language of OHIM in which the CTM application was filed shall be binding. If the application was filed in an official EU language other than one of the five languages of OHIM, the text in the second language indicated by the applicant shall be binding. For example, a CTM application filed in English for “pastry and confectionery” in Class 30 would cover the term “chewing gums” because the latter falls under the broad definition of “confectionery.” However, if the same mark was filed for “feine Back- und Konditorwaren” (which is the “official” German translation of the general indication “pastry and confectionery”) it might not protect “chewing gums”: the literal translation of “feine Back- und Konditorwaren” is “fine bakery products, cakes and pastry.”

122. Compare the example of the UK IPO decision O-301-05 of November 11, 2005 concerning Registration No. 961 804, para. 35: use of a combined CD, radio, and cassette player is covered by a U.K. trademark registration for “radio receiving apparatus.”


124. See the example used in the judgment Total Limited v. YouView TV Limited, supra note 121, para. 60: the registered term “database” would not cover use of a trademark for cars that have the facility to store data about preferred seat positions for a variety of drivers. As Sales J pointed out, “the information programmed into a car seat would not readily be regarded as falling within the core meaning of the term ‘database’ where the trade is one of selling cars to ordinary consumers, since it would be a peripheral and (in context) insignificant part of the thing being sold.”

125. English, French, German, Italian, and Spanish, see Article 119(2) of the CTMR.

126. See § 19(2) and Annex 1 of the German delegated Regulation “Verordnung zur Ausführung des Markengesetzes” of May 11, 2004.
B. The Limits of “Means-What-it-Says”

This section outlines the limits of a literal interpretation of indications or terms. There are situations when the definition of a chosen term is not binding but may need to take into account other elements such as the Nice class number or, in exceptional circumstances, the intention of the applicant if the class number and meaning of the chosen indications do not match.

1. The Role of Class Numbers

As seen above, the main purpose of the Nice Classification’s class numbers is to classify goods and services. Nevertheless, class numbers may also play a role in defining the subject matter of a trademark. Thus, there are hundreds of terms in the Nice Classification that fall under the literal meaning of a general indication in one class but actually belong in a different class.

To give an example, a trademark registration covering the class heading “footwear; headgear; clothing” in Class 25 does not actually protect all goods that are covered by the literal meaning of those three general indications. Such a trademark registration would not cover “protective shoes and boots” (Class 9), “clothing for protection against accidents, irradiation and fire” (Class 9), “orthopaedic shoes and boots” (Class 10), “fire resistant clothing” (Class 9), “clothing especially for operating rooms” (Class 10), “dog shoes” (Class 18), “clothing for pets” (Class 18), “snow shoes” (Class 28), “clothing, shoes and headgear for dolls” (Class 28), “riding helmets” (Class 9), “paper party hats” (Class 28), “carnival caps” (Class 28), “head protection” (Class 9), “safety headgear” (Class 9), or “headwear for sporting activities for protection against injury” (Class 9). All these terms are covered by the alphabetical list of the Nice Classification and fall under the literal meaning of the general indications included in the class heading of Class 25 but are not protected in that class.

Is the list of goods “footwear; headgear; clothing” in Class 25 sufficiently clear and precise in order to identify, “on that basis alone,” the subject matter of a trademark registered in the European Union? One could take the view that all three terms are imprecise since there are many other products falling under the literal meaning of “footwear; headgear; clothing” in other classes. However, this would require a fundamental change of the examination practice for most European trademark offices.

127. See supra Part II.A.
128. Roberts, supra note 17, at 82, 131, 164, 175.
129. In the United States, applicants have to use very specific terms to identify the goods and services in an application. The general rule is that the identification must itself provide a clear indication of the nature of the goods or services, without reference to the class. The title of a class cannot be used to define the nature of the goods when the same
a specific term such as “gloves” in Class 25 would become unclear and vague because there are gloves for different purposes in at least seven classes of the Nice Classification. Moreover, it is difficult to define a term like “clothing” in a way that excludes clothing items for special uses without referring to the relevant class number.

In certain situations, class numbers play a role when identifying the subject matter of a trademark on the basis of the literal meaning of the listed terms. Thus, in the example above, when a trademark is filed for “footwear; headgear; clothing” in Class 25, the trademark authorities and competitors know (or are deemed to know) that the mark protects only clothing items, hats, and shoes in Class 25, and not related goods covered in other classes.

Consequently, if two terms are identified in different classes of the Nice Classification, they cannot be considered identical even if one term falls under the literal meaning of the other. Thus, “milk-based beverages” in Class 29 are not identical to “non-alcoholic beverages” in Class 32 although the former is covered by the literal meaning of the latter.131 Likewise, in the author’s opinion, “tobacco” in Class 34 should not be considered identical to “natural plants” in Class 31 and “rice” in Class 30 should not be regarded identical to “seeds; grains” in Class 31.132

Moreover, if a trademark has been used for a product not belonging to the registered class number, it will not be deemed to have been used at all even if the mark was used in connection with goods falling under the literal meaning of the registered term.133 For example, use of a trademark for a liquid herbal concentrate that serves as a nutritional supplement is not covered by the registered goods “non-alcoholic beverages” in Class 32, although item could be classified in more than one class depending on its function, material composition, or field of use. Accordingly, any term that includes items classified in more than one class is not acceptable (e.g., “artists’ materials,” “chronographs,” “blankets,” “boxes,” etc.). However, under exceptional circumstances, an amendment of the application is not needed if a term can be clearly identified when read in association with the title of the class in which it is placed See examples in TMEP, supra note 2, § 1402.03.

130. In the United Kingdom Treat judgment (British Sugar plc v. James Robertson & Sons Ltd, [1996] RPC 281 (289)), Jacob J emphasized: “The effect of this . . . [adding the words ‘included in this Class’ or ‘included in Class X’ to a specification by the Registrar] . . . is to confine the specification to goods which fall within the description and which also were, at the time of registration, put in that class by the Registrar.”

131. Compare the example of Decision O-292-08 of the UK IPO of October 24, 2008, at para. 41: “Cider” in Class 33 is not identical to “non-alcoholic beverages” in Class 32 although the meaning of “cider” also includes non-alcoholic cider.

132. For more examples, see OHIM Examination Guidelines, Part C Opposition, Section 2 Double Identity and Likelihood of Confusion, Chapter 2 Comparison of Goods and Services, Section 2.2.

133. See OHIM Examination Guidelines, Part C Opposition (Section 6) Proof of Use (Section 2.8.2).
the used product would fit under the ordinary meaning of the term "non-alcoholic beverages." The goods were only used in connection with herbal nutritional supplements in Class 5. The different purposes of the beverages covered in Classes 5 and 32 have to be taken into account when assessing the scope of protection of the registered goods.134

In that context, it is also important to consider the filing date of a trademark when determining whether a good or service belongs to a certain class number.135 Sometimes terms are moved to a different class of the Nice Classification. For example, the term "playing cards" was transferred from Class 16 to Class 28 under the eighth edition of the Nice Classification in 2002.136 A trademark registered in 2000 for "goods made of paper and cardboard" in Class 16 also protects playing cards, although this term is not in Class 16 anymore. In contrast, a trademark registered in 2000 for "games and playthings" in Class 28 does not protect playing cards since those goods were registered in Class 16 at the time of filing. In the author's view, the fact that playing cards fall under the literal meaning of "games and playthings" is irrelevant in this specific case. The trademark does not enjoy protection for "games and playthings" as such but for "games and playthings covered by Class 28 at the time when the mark was filed. Likewise, a trademark filed in 2015 for "gloves" in Class 25 will always protect only gloves covered by that class in 2015 but not any gloves protected in other classes even if those items may be transferred to Class 25 in the future.137

Article 9(1) of the Trademark Law Treaty states that goods and services have to be "preceded by the number of the class of that Classification to which that group of goods or services belongs." Likewise, Article 2(3) of the Nice Agreement obliges the trademark offices of signatory countries to "include in the official documents and publications relating to registrations of marks the numbers of the classes of the Classification to which the goods or services for which the mark is registered belong." The fact that class numbers have to be mentioned when filing a trademark indicates that their role is not merely limited to classifying goods and services. Regarding CTMs, Rule 2(3) of the CTMR states that "the goods and services shall, in principle, be grouped according to

135. See Reed Executive plc and Reed Solutions plc v. Reed Business Information Ltd and Reed Elsevier (UK) Ltd, totaljobs.com Ltd, [2004] 159 EWCA (Civ); [2004] RPC 40, para. 47.
136. The different editions of the Nice Classification are available at http://www.wipo.org.
137. See OHIM Examination Guidelines, supra note 132, Section 1.2.4.
the classes of the Nice classification, each group being preceded by the number of the class of that Classification to which that group of goods or services belongs and presented in the order of the classes under that Classification.” Non-compliance with Rule 2 of the CTMIR leads to a deficiency. 138 When a CTM application is published, the notice references the list of goods or services and relevant class numbers. 139 The same information must be included in the register of the CTMs. 140

The above explanations and examples illustrate that the literal meaning of a chosen indication or term alone is not always sufficient to define the subject matter of a trademark registration. Sometimes the class number must be taken into account when trying to identify the precise goods or services covered by a mark. 141

2. Contradictions Between Literal Meaning of the Listed Term and Class Number

In principle, contradictions between the list of goods and services and the class number should be resolved by giving preference to the literal meaning of the goods or services protected by the trademark. For example, if a trademark is registered for “cars” in Class 21, the protection refers to “cars” in Class 12 and the incorrect class number is disregarded.

In exceptional circumstances, the supposed intention of a trademark owner on the filing date may serve to define the subject matter of a registered mark. For example, the classification of a trademark registered for “cars” in Class 28 would be wrong and ambiguous. On the one hand, the class number suggests that protection is sought for toy or model cars. On the other hand, the literal meaning of “cars” indicates that the owner intended to protect vehicles in Class 12. The term “cars” as such is classified in Class 12 of the Nice Classification only. In such a case, the actual intention of the trademark owner at the filing date may be considered to determine the subject matter of the mark. 142 Nevertheless, the intention of the trademark owner should be ignored if it clearly contradicts the ordinary meaning of the protected good (e.g., the trademark covers “toy cars” in Class 28

138. Rule 9(3)(a) and (4) of the CTMIR.
139. Rule 12(d) of the CTMIR.
140. Rule 84(2)(g) of the CTMIR.
141. See OHIM Examination Guidelines, supra note 132, Section 1.5.3: the terms used in the list of goods or services have to be interpreted both in the light of the Nice Classification and from a commercial perspective. In cases of doubt or ambiguity, the meaning of the term under the Nice Classification prevails.
142. The criteria mentioned supra in Part VI.A.4 may be used to find out the intention of the owner on the date of filing.
and the owner alleges that its intention had been to protect the mark for “cars” in Class 12).

VIII. CONCLUSION

What is the sound of one hand clapping?

As seen above, the different interpretations of class headings in the European Union also meant a challenge to the laws of logic. All of a sudden, “invisible” goods such as “conductors’ batons” appeared like magic wands in a list of goods (“musical instruments”) that did not include those goods. Instead of solving the mysteries of the “class-heading-covers-all” approach in a “clear and precise” manner, the CJEU’s answer to the third question in IP Translator caused even more confusion. In the author’s opinion, the CJEU’s answer may be interpreted as a request to the “competent authorities” to “fix this mess.” Looking at the situation three years after the IP Translator judgment, it seems that the EU trademark offices and the legislature have indeed understood the message.

With respect to trademark applications filed after the IP Translator judgment, national trademark offices in the European Union have agreed to abandon the “class-heading-covers-all” approach.143

Regarding trademarks filed or registered before IP Translator, the situation is more complex. Nine EU trademark offices had followed the “class-heading-covers-all” approach before the IP Translator judgment was rendered. The legitimate expectations created by the former practice of those offices should be taken into account, bearing in mind that the practice of those nine offices was backed up by official administrative instructions, case law, and, at least in the case of Italy, even by an explicit legal provision.144

Article 40 Proposal-Directive and Article 28 Proposal-EUTMR implement the IP Translator judgment. The new EUTMR is likely to become effective by the beginning of 2016. Article 28(8) Proposal-EUTMR gives the owners of CTMs registered for an entire class heading the opportunity to declare that their intention on the date of filing had been to seek protection for goods or services of the class (see Article 11(2)(h) of Decree No. 33/2010 (“Regolamento di attuazione del Codice della proprietà industriale”), which states that an Italian trademark application has to include a list of goods or services, preceded by the class number or the class heading with the number of that class if in the latter case the applicant wants to claim all goods or services of the class (“elenco dei prodotti o dei servizi, preceduto dall’indicazione del numero della classe ovvero il titolo della classe con il numero della stessa qualora in questo secondo caso si voglia rivendicare tutti i prodotti o servizi della classe”). See http://www.wipo.int/wipolex/es/text.jsp?file_id=230646#LinkTarget_1087 for the full text of the Decree. The rules contained in Decree No. 33/2010 complement the Italian “Codice della Proprietà Industriale” (see Massimo Scuffi / Mario Franzosi, Diritto Industriale Italiano, at 123 (ed. 2014)).

143. See supra Part V.

144. See Article 11(2)(h) of Decree No. 33/2010 (“Regolamento di attuazione del Codice della proprietà industriale”), which states that an Italian trademark application has to include a list of goods or services, preceded by the class number or the class heading with the number of that class if in the latter case the applicant wants to claim all goods or services of the class (“elenco dei prodotti o dei servizi, preceduto dall’indicazione del numero della classe ovvero il titolo della classe con il numero della stessa qualora in questo secondo caso si voglia rivendicare tutti i prodotti o servizi della classe”). See http://www.wipo.int/wipolex/es/text.jsp?file_id=230646#LinkTarget_1087 for the full text of the Decree. The rules contained in Decree No. 33/2010 complement the Italian “Codice della Proprietà Industriale” (see Massimo Scuffi / Mario Franzosi, Diritto Industriale Italiano, at 123 (ed. 2014)).
services beyond the literal meaning of the class heading. The time limit for filing such a declaration is six months after the new EUTMR becomes effective. The declaration under Article 28(8) Proposal-EUTMR will only be possible if the additional goods or services are included in the alphabetical list for that class of the Nice Classification edition in force at the date of filing.\(^{145}\) Unfortunately, Article 40 Proposal-Directive does not foresee a similar provision like Article 28(8) Proposal-EUTMR.

Owners of CTMs registered before *IP Translator* comprising class headings should act now. In particular, they should carefully check their portfolios and clarify whether the goods or services of interest are actually covered by the literal meaning of the general indications of relevant class headings. If the product of interest is not covered by the literal meaning of the listed terms but included in the alphabetical list of the same class, the trademark owner may declare a partial surrender pursuant to Article 50 of the CTMR.\(^{146}\)

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145. *See example supra* note 71.
146. *See supra* Parts IV.E and VI.B.