



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

The President

**Communication No 1/2016 of the President of the Office
of 08/02/2016**

concerning the implementation of Article 28 EUTMR

THE PRESIDENT OF THE OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET (TRADE MARKS AND DESIGNS),

Having regard to Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (CTMR),

Having regard to Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the EU trade mark (CTMIR),

Having regard to Regulation (EU) No 2015/2424 of 16 December 2015 of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (the Amending Regulation),

Whereas:

- (1) Communication No 2/12 of the President of 20 June 2012 concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations established the practice of the Office as regards the scope of protection of class headings in applications and registrations filed before, and after, the entry into force of that Communication in the light of the Court's judgment of 19/06/2012 in case C-307/10, IP Translator, EU:C:2012:361.
- (2) Upon entry into force of the Amending Regulation, Article 28(1) to (7) of Council Regulation No 207/2009, as amended (EUTMR), will lay down the requirements for designating and classifying goods and services, including the conditions for, and the consequences of, the use of class headings.
- (3) Article 28(8) EUTMR allows for a transitional period during which proprietors of EU trade marks applied for before 22 June 2012 and registered for the entire heading of a Nice class may declare that their intention on the date of filing had been to seek protection for goods and services beyond those covered by the literal meaning of that heading.

- (4) Pursuant to Article 124(2)(a) CTMR, the President of the Office will take all necessary steps, including the adoption of internal administrative instructions and the publication of notices, to ensure the functioning of the Office.
- (5) In the absence of more detailed implementing rules and in view of the need to give effect to Article 28 EUTMR, it is necessary to specify the procedure for its implementation, explain how it will be applied and determine its impact on future and existing registrations,

HAS ADOPTED THE FOLLOWING COMMUNICATION:

1. Scope of Article 28 EUTMR

Article 28(1) to (7) EUTMR lays down the requirements for designating and classifying goods and services, including the conditions for, and the consequences of, the use of the class headings of the Nice Classification.

In accordance with Article 28(3) EUTMR, the Office will accept the use of general indications included in the class headings of the Nice Classification or other general terms, provided that they comply with the requisite standards of clarity and precision set out in Article 28 EUTMR. This provision applies directly to the designation of goods and services in all EU trade mark applications filed as from the entry into force of the EUTMR.

In accordance with Article 28(5) EUTMR, the use of class headings of the Nice classification and other general terms shall be interpreted as including all the goods or services clearly covered by the literal meaning of the general indication or term. Article 28(5) EUTMR applies as from the date of entry into force of the EUTMR and extends to all marks filed **after** 21 June 2012, as well as to applications that were filed **on or before** that date but are still not registered at the date of entry into force of the EUTMR.

Further guidance on the rules governing the designation and classification of goods and services are given in the Guidelines of the Office, Part B, Examination, [Section 3, Classification](#).

Article 28(8) EUTMR introduces a transitional period during which proprietors of EU trade marks applied for before 22 June 2012 and registered for the entire heading of a Nice class may declare that their intention on the date of filing was to seek protection for goods and 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.

Declarations made pursuant to Article 28(8) EUTMR (declarations) are subject to the conditions specified in this Communication.

2. Eligible Registrations

Declarations may only be made for EU trade marks that were filed before 22 June 2012, and continue to be registered for the entire heading of at least one Nice class.

In accordance with Articles 145 and 151 CTMR, the provisions of Article 28(8)

EUTMR also extend to protected international registrations that designated, or subsequently designated the EU before 22 June 2012, and that continue to be in force for the entire class heading of at least one Nice class.

The existence of additional goods and services in the specification, either in the same or in another class, does not preclude the application of Article 28(8) EUTMR to the class that includes the entire heading, provided that the language used does not limit or in any way disclaim the general indications of the Nice class heading.

3. Time limit

Declarations must be submitted to the Office within the period laid down in the Amending Regulation, that is, between 23 March 2016 and 24 September 2016 inclusive.

4. Form

In accordance with Rule 79 CTMIR, applications to record a declaration in the Register must be filed in writing.

In order to ensure that declarations concerning EU trade marks are handled efficiently, the Office has created a specific online form. It can be found in the User Area of the Office's website under 'Online forms – online Recordal application – Recordal – EUTM Recordal - Declaration under Art.28(8)' (the form).

The form contains a text box for indicating the goods and services claimed in accordance with Section 8 below.

The text box should be completed by indicating the class number followed by the names of the goods and services to be added. The individual goods and services should be separated by commas (to separate items within a similar category or expression) and/or semi-colons (to separate expressions), as the case may be. The different classes should be listed on a new line using a paragraph break.

The use of the online form is highly recommended as it may considerably decrease the likelihood of formality deficiencies. Applicants who opt for other means of communication must ensure that their application complies with the requirements of this Communication.

For international registrations designating, or subsequently designating the EU, declarations should be filed using the ordinary [Recordal application form](#).

5. Language

In accordance with Rule 95(b) CTMIR, declarations for EU trade marks filed directly must be filed in one of the five languages of the Office, namely English, French, German, Italian or Spanish.

Any language version of the form identified in Section 4 above may be used, provided that it is completed in one of the languages of the Office, in particular as concerns the list of goods and services.

Declarations for international registrations designating or subsequently designating the EU must be filed in the language of the international application.

6. Applicants and Representatives

Declarations must be submitted to the Office by the proprietor(s) of the EU trade mark, or the holder of the international registration designating the EU, or their duly appointed representative before the Office.

The standard rules on mandatory representation apply (see Article 92(2) CTMR).

When the proprietor appoints a representative, they must indicate the representative's name and Office ID number. If the representative has not yet been assigned an ID number, the business address must be indicated. The Office may request authorisation in accordance with Articles 92(3) and 93(1) CTMR, in particular if the declaration is submitted by a representative different from the representative on file.

7. Mandatory indications

By analogy to Rule 36(1) CTMIR, declarations must contain the following information:

- a) the registration number of the EU trade mark, or international registration designating the EU;
- b) the proprietor's name and/or the proprietor's Office ID number;
- c) an indication of each of the goods and services the proprietor wishes to add, in accordance with Sections 4 and 8.

Pursuant to Rule 79 CTMIR, the claim must be signed by the EU trade mark proprietor or their duly appointed representative.

In accordance with Rules 80 and 82 CTMIR, if the declaration is submitted by telecopier (fax) or by electronic means, the indication of the sender's name is deemed to be equivalent to a signature.

8. Content of the declaration

In accordance with Article 28(8) EUTMR, the goods and services designated must be indicated in the proprietor's declaration in a clear, precise and specific manner.

The declaration must only include goods and/or services that:

- (i) are contained in the alphabetical list for the class in question of the edition of the Nice Classification in force at the date of filing, and
- (ii) are not clearly covered by the literal meaning of the general indications of the corresponding class heading.

In particular, the Office will object to:

- claims for the entire alphabetical list;
- the use of unclear, imprecise or unspecific expressions;
- declarations for goods and services that are clearly covered by the literal meaning of the class heading;
- declarations for goods or services not contained in the alphabetical list in question.

In order to assist proprietors in identifying goods and services that go beyond the literal meaning of the general indications of the class headings, the Office has compiled a non-exhaustive list of examples of such goods and services in Annex I of this Communication. This list is purely a guide that identifies the goods and services that the Office considers are clearly not covered by the literal meaning of the headings. Declarations relating to any of the goods or services included in this list for the corresponding class and edition will not be objected to by the Office on the ground of being covered by the literal meaning of the general indications.

9. Fees

Declarations are not subject to a fee.

10. Examination by the Office

The Office will examine whether the declaration complies with the requirements of Article 28(8) EUTMR and with Sections 2 to 8 of this Communication. If the declaration does not comply with these requirements, the Office will issue a deficiency letter stating the reasons why the claim is unacceptable and set a deadline of two months for the proprietor to remedy the deficiency. Rule 71 CTMIR sets down the applicable rules on time limits.

In the absence of a response, or if the deficiency is not overcome, the declaration will be rejected, wholly or in part.

In accordance with Articles 58 to 60 and 135 CTMR the proprietor may file an appeal against this decision.

11. Registration and Publication

If the declaration complies with the requirements of Article 28(8) EUTMR and Sections 2 to 8 above, the Office will amend the Register and inform the proprietor accordingly.

The declaration will be published in the EUTM Bulletin, in Part C.3.2.

The publication will contain the following data:

- the EU trade mark registration number;
- the list of goods and services after the Article 28(8) EUTMR declaration;
- the date and number of the entry of the Article 28(8) EUTMR declaration (i.e. the date when the Register was amended);
- the date the entry is published in the EUTM Bulletin;
- the indication 'Art. 28(8)' under INID code 580.

In the case of international registrations designating or subsequently designating the EU, the Office will send the International Bureau statements under Rule 18*ter*(4) of the Common Regulations.

12. Traceability

In the interest of legal certainty, and in order to enable the competent authorities and economic operators to keep track of additions made by virtue of Article 28(8) EUTMR, in particular for the purposes of applying Article 28(9) EUTMR, acceptable declarations will be entered in the Register and can be found as follows:

- through the Office's online database (eSearch Plus) under the 'Publications' section for the mark concerned, identified by the description 'Partial Surrender/Article 28(8) declaration': upon clicking, the relevant publication will open in the CTM Bulletin under Part C.3.2, 'Partial Surrender/Article 28(8) declaration', with the indication 'Art. 28(8)' under INID code 580 (date on which the Register is amended);
- through the Office's online database (eSearch Plus) under the 'Records' section for the mark concerned, identified as being Recordal type 'Declaration under Art. 28(8) EUTMR';

For international registrations designating the EU:

- the International Bureau will record and publish the pertinent information in the International Register and inform the holders of the concerned international registrations;

13. Effect

As from the end of the period referred to in Section 3, all the marks referred to in Section 2 for which no acceptable declaration has been filed will be deemed to protect only the goods or services clearly covered by the literal meaning of the indications included in the heading of the relevant class.

During the transitional period referred to in Section 3 above, Communication No 2/12 of 20 June 2012 of the President of the Office will continue to apply.

Declarations filed within the period referred to in Section 3 above will take effect from the date of their entry in the Register. Until registration is effected, the previous paragraph applies.

14. Limitations of rights

Where the declaration is accepted and the Register is amended, Article 28(9) EUTMR will apply.

Consequently, the amendment of the list of goods and services of the earlier EU trade mark or international registration designating the EU, pursuant to Article 28(8) EUTMR, shall not give the proprietor the right to prevent the use by third parties of any of the goods or services so added, provided that use commenced before the Register was amended and did not infringe on the proprietor's rights on the basis of the literal meaning of the goods and services in the Register at that time.

Nor will the proprietor have the right to oppose or to apply for a declaration of invalidity of a later trade mark if that later trade mark was in use or had been applied for prior to the Register being amended and the use in relation to those goods or services did not infringe, or would not have infringed, the proprietor's rights based on the literal meaning of the goods or services recorded in the Register at that time.

Further details on how Article 28(9) EUTMR is applied are given in the Guidelines of the Office, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, [Chapter 2, Comparison of Goods and Services](#).

15. Relationship with other provisions

Article 28(8) EUTMR is an exceptional, transitional arrangement that allows proprietors to amend the wording of their specifications in the interest of legal certainty, by expressly identifying goods and services that they originally intended to include in their specifications, but which were not clearly reflected in the Register as they fell outside the natural and usual meaning of the class heading concerned.

Proprietors are advised to carefully consider the declaration they wish to make under Article 28(8) EUTMR bearing in mind, in particular, that any such addition of goods and services (i) is made without prejudice to Article 15, Article 42(2) and Article 51(1)(a) CTMR, with regard to the obligation to put said goods and services to genuine use and (ii) will be subject to the sanctions of Article 28(9) EUTMR.

Therefore, declarations made pursuant to Article 28(8) EUTMR should not be confused with, or be considered as an alternative to, partial surrenders within the meaning of Article 50 CTMR, which are, and will remain, available to proprietors after the end of the transitional period.

In particular, declarations under Article 28(8) EUTMR should not be used to restrict lists containing class headings to specific goods or services covered by their literal meaning, or to replace a general indication with more precise terms. In such cases proprietors should make use of partial surrenders under Article 50 CTMR using the 'Online forms – online Recordal application – Recordal – EUTM Recordal – [Partial Surrender](#)'.

16. Entry into force

This Communication enters into force on the date of entry into force of the Amending Regulation, that is, 23 March 2016. It will be published in the Official Journal of the Office.

Communication No 2/12 of the President of 20 June 2012, concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations, is repealed:

- as of 23 March 2016, as far as it concerns EU trade marks filed after 21 June 2012, and EU trade marks filed before 22 June 2012 but not yet registered at the time of entry into force of the EUTMR (paragraphs I to V and IV to XI of that Communication);
- as of 25 September 2016, for marks filed before 22 June 2012 and registered for the entire heading of a Nice class at the time of entry into force of the EUTMR, for which no declaration is filed;
- as of the date of entry in the Register for the declaration of those marks for which an acceptable declaration is filed within the period referred to in Section 3 above.

A handwritten signature in black ink, appearing to read 'António Campinos', with a stylized flourish at the end.

António Campinos
President