

## IP TRANSLATOR – AG Opinion

### Background

This is a test case brought by CIPA (the UK Chartered institute of Patent Attorneys) in the UK seeking a definitive view from the ECJ on whether OHIM's stated practice that class headings are deemed to cover all goods or services within that class is correct, or whether the words in the class headings should be given their more natural interpretation of covering only those goods and services specifically identified.

The Appointed Person (Geoffrey Hobbs QC) referred the following questions to the ECJ for guidance

"Is it

1. Necessary for goods and services covered by a trade mark application to be identified with any, and if so what, degree of clarity and precision?
2. Permissible to use class headings to identify goods and services to be covered by a trade mark application?
3. Necessary or permissible for class headings to be interpreted as covering all goods and services in that class, even if those goods and services are not specifically identified in the specification as filed?"

### The Advocate General's Opinion

In a decision issued on 29 November AG Kot considered the facts and answered the questions as follows –

- 1a. Goods and services covered by trade mark specifications must be identified with sufficient clarity and precision to enable the authorities and third parties to identify exactly what protection arises from the registration.
- 1b. this can be done by providing specific lists of all the goods and services for which protection is being sought. It can also be done by providing details of the "basic" goods or services, provided that these are precise enough to enable the authorities and third parties to identify the "essential characteristics and objective properties" of the goods and services covered
2. An applicant can use terms appearing in the class headings as part of its specification, provided that this satisfies the clarity and precision characteristics mentioned above.
3. The earlier OHIM communication indicating that specifications reciting class headings would be interpreted as covering all goods or services falling within the relevant class did not satisfy the clarity and precision tests.

### Comment

This is welcome clarification and adopts a sensible middle view. In reality decisions about "clarity and precision" will always be decided on a case by case basis. In some classes, such as 25 (class heading "clothing, footwear, headgear") it is hard to see that there will ever be items covered that

do not fall within these general terms, so there is probably sufficient precision. By contrast, with the class 41 heading, (the subject matter of this case), there is not sufficient precision for the class heading to cover all services within that class. However, assuming that the ECJ follows this opinion, specifications for class headings will generally no longer be seen as covering all goods or services in that class.



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