

Important- Update of the specifications of goods and services of European Union trade marks

The reform of the trade mark law in the European Union has a practical implication on the specification of goods and services (G&S) of European Union trade marks, and on their opposability. It puts an end to diverging practices which lasted for several years, and which had a troublesome impact: the same specification of G&S could be interpreted differently depending on the European trade mark Office concerned, or the date of application of the trade mark.

Indeed, until 22 June 2012, the specifications of G&S of community trade marks ("EUTM" as of 23rd March) were interpreted very widely and generously: the mere designation of a class heading was sufficient to consider that each and every product or services belonging to this class was designated.

Since then, and following a judgment of the Court of Justice, the specifications of G&S of community trade marks are interpreted objectively, attending their literal meaning: are covered those goods or services which are effectively designated, or which belong to a wider category which is effectively designated (for example, a "hydrating cream" belongs to the wider category of "cosmetics", in class 3).

As part of the reform which was just adopted, the legislator has implemented a transitional period of six months during which the owners of European union trade marks applied for prior to the 22 June 2012, and registered at the time when the modification is sought, will be allowed to adapt their specification of G&S in order to conform them to the practice of literal interpretation. During a period of 6 months, as of 23rd March 2016, any community trade mark owner covering at least a class heading will be entitled to precise which goods and services it actually wishes to cover.

For example: the title of class 10 is "Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials". In accordance with the former practice of OHIM, a community trade mark covering this specification was deemed to cover all the goods pertaining to this class, including for example "baby bottles". However, with the entry into force of the legal reform, this trade mark will solely cover the goods which are actually designated, and "baby bottles" are not included any longer. Therefore, if the CTM owner wishes to preserve its protection for "baby bottles", it will have to make the corresponding request with OHIM, as of 26 March 2016 and during a six months period.

In practice, we have the feeling that this transitory period will have a limited impact. This is true, at least, for those community trade marks filed by our firm, as we have always advocated for a literal interpretation of the specifications of goods and services, when elaborating them.

However, we remain at your disposal to audit your portfolio of community trade marks, and to suggest adaptations of the specifications of goods and services during this transitional period. This analysis will be billed on an hourly basis. No official fee will have to be paid to the EUIPO.

Do not hesitate to contact us if you have any question regarding the classification of your community trade marks and the impact of this reform on their scope of protection.