

Classification Practice at OHIM

Following the publication of the *IP Translator* judgment in June 2012, the Community trade marks office (OHIM) and the Intellectual Property offices of the European Union member states have been discussing how to interpret the Nice Classification class headings.

As noted in our previous news item relating to *IP Translator*, from 21 June 2012 OHIM considers that applications listing class headings only cover those goods or services explicitly mentioned, rather than all goods or services in the class. In contrast, for trade marks dated before 21 June 2012 OHIM considers that specifications that include class headings cover all goods or services in that class.

Further to this change in procedure, in May 2013 a decision was reached whereby 11 of the 197 general indications were deemed insufficiently clear and precise in order to be accepted for classification purposes. The terms that are not acceptable are listed below in bold:

- Class 6 - **Goods of common metal not included in other classes**
- Class 7 - **Machines** and machine tools
- Class 14 - Precious metals and their alloys and **goods in precious metals or coated therewith**, not included in other classes
- Class 16 - Paper, cardboard and **goods made from these materials [paper and cardboard]**, not included in other classes
- Class 17 - Rubber, gutta-percha, gum, asbestos, mica and **goods made from these materials [rubber, gutta-percha, gum, asbestos and mica]** and not included in other classes
- Class 18 - Leather and imitations of leather, and **goods made of these materials [leather and imitations of leather]** and not included in other classes
- Class 20 - **Goods (not included in other classes) 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**
- Class 37 – **Repair**
- Class 37 - **Installation services**
- Class 40 - **Treatment of materials**
- Class 45 - **Personal and social services rendered by others to meet the needs of individuals**

As a result, any application filed at the OHIM, which lists the class headings for any of the classes mentioned above, or the terms in bold above, will receive an objection from the classification examiner.

Additionally the OHIM will not accord a filing date against any application which simply states "all goods in class x" since it does not comply with the requirement to list the goods/services in respect of which registration is sought.

Similarly, any specification which terminates with the term "and all other goods/services in this class" will receive an objection from the classification examiner (although a filing date will be received).

This new practice is noted in the OHIM's amended *Manual on Trade Mark Practice* and entered into force on 2 December 2013 when the new website and new e-filing tool were launched.

Should you require any assistance with drafting the classification of goods and services for your trade marks please contact your usual trade mark attorney who will be happy to advise you further.