

Article 28 – European Union trade mark owners must review the scope of protection of their registrations

- ▶ Owners of European Union trade mark registrations filed before 22 June 2012 need to review the scope of protection of those trade marks that have been filed for the individual Class Headings of the Nice Classification, to ensure that they still accurately reflect the scope of protection required
- ▶ Where the normal meaning of the wording of the Class Headings does not accurately describe the scope of protection being claimed, a request should be filed under Article 28 EUTMR 2015/2424 to declare exactly what goods and services are to be covered by the registration
- ▶ This process is not compulsory, but any request must be filed before 24 September 2016

What's it about?

Following the introduction of the new European Union Trade Mark Regulation 2015/2424 on 23 March 2016, the European Union Intellectual Property Office has invited owners of all European Union trade mark registrations filed before 22 June 2012, for specifications of goods/services consisting of the Class Heading of the Nice Classification, to clarify the scope of protection of their trade marks.

This follows the decision in the *IP Translator* case, which held that specifications of goods/services were to be given their ordinary meaning. It had previously been the case that a trade mark filed for the Class Heading had been considered to cover ALL goods/services in the particular class. The *IP Translator* case held that this was incorrect, and any goods/services that were not specifically covered by the normal meaning of the terms used, would not be included in the scope of protection granted by the European Union trade mark registration.

Accordingly, owners of European Union trade mark registrations filed before 22 June 2012 need to review their trade mark registrations. If the specifications of the applications do not cover the required goods and services, a declaration should be filed under Article 28 to either confirm that the European Union trade mark registration should be considered to cover ALL goods in the particular class, or to suggest a suitable amended specification that will cover the scope of protection required.

If no declaration is filed before 24 September 2016, then the European Union trade mark registration will be considered to cover the goods/services covered by the specifications, according to their literal meaning.

Why does it matter?

Where previously a European Union trade mark that was registered for the Class Heading was considered to be registered for ALL of the goods/services in that class, this is no longer the case. In certain cases where the specifications are interpreted in the light of their literal meaning, this may mean that certain specific goods/services for which protection was previously thought in place, will no longer be valid. It is vital that European Union trade mark owners carry out this review process, to ensure that they do not end up with narrower protection than originally thought.

Now what?

You should contact your trade mark attorney to discuss this further, and to decide whether any action is required to file a suitable declaration under Article 28.

For further information on this or any other IP related matter please contact tim.carter@addleshawgoodard.com on 0161 934 6197.