

SPECIFICATIONS USING CLASS HEADINGS

Further to our [briefing document](#) in March, the changes to the European Union Trade Mark system have now come into force. Among the changes were new rules regarding the classification of goods and services. As a result, it is now possible to make amendments to EU TMs (European Union Trade Marks, formerly known as Community Trade Marks or “CTM”s) filed before 22 June 2012, and which covered the entire Class heading in a class of goods and/or services, in order to ensure that all relevant goods and services are covered by those Registrations.

What are the changes?

Whereas previously the Class headings could be used in an EU TM Application to claim protection for all goods or services in that Class, any EU TM registrations covering the Class headings will now be deemed to extend only to the goods or services clearly covered by the *literal meaning* of the terms listed in the Class headings.

Accordingly, there could be goods or services beyond the literal meaning of those terms, which fell into the respective Class at the time of filing the Application, but which, after the rule changes, will no longer be deemed to be covered by those existing European Union Trade Mark (“EU TM”) registrations which cover the entire Class heading.

Case Study

- + A ladies shoe designer, specialising in high heel footwear, registered in 2001 her house brand as an EU TM using the Class heading in Class 25 “clothing, footwear, headgear”. Part of her business includes providing spare “heelpieces”, sold separately from the shoes, to shoemakers and shoe repair shops.
- + Under the old practice, the Class headings in an EU TM Registration included protection for heelpieces even though that term is not covered by the literal meaning of the terms “clothing, footwear, headgear”.
- + Under the new practice, a declaration should be filed before 24 September 2016 so that her EU Registration will continue to cover “heelpieces” for high-heel shoes.
- + Had she not specified the entire Class heading in Class 25, this opportunity would not be available.

Action required

Trade mark owners have been given 6 months in which to file a declaration indicating that their intention was to seek protection for goods and services that were in the relevant Class at the time of filing but are beyond the literal meaning of the items listed in that Class in the Registration. If no such declaration is filed within that period, EUTMs covering the Class headings will be deemed to cover only the literal meaning of the goods or services actually listed.

We have until **24 September 2016** to file any declarations, but please do let us know as soon as possible whether this is something you wish us to handle. We recommend that clients review the specifications of their EU TM Registrations and let us know if there are any additional goods or services which might not be included within the literal meaning of the Class headings that should be covered. We would then be pleased to advise you whether those amendments would be permitted and assist in drafting and filing an appropriate declaration with the European Intellectual Property Office.

Your regular contact at Abel & Imray will be pleased to advise you further concerning whether action may be required in respect of any of your EU Trade Mark Registrations which currently cover the Class headings in one or more Classes.