

# Declarations under Article 28(8) EUTMR

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**Frequently asked questions**

**Updated 09/09/2016**

## Frequently Asked Questions

### 1. Who can make a declaration under Article 28(8) EUTMR?

Proprietors of EU trade marks, or international registrations designating the EU, filed or designated before 22/06/2012 and registered before the entry into force of Regulation 2015/2424 of 16 December 2015 amending Council Regulation (EC) No 207/2009 of 26 February 2009 on the EU trade mark that contain the entire heading of a Nice Class.

### 2. Will trade mark owners be informed about the need to amend?

The EUIPO will not individually inform trade mark owners about the possibility of filing a declaration under Article 28(8) EUTMR, but the President of the Office has issued a [Communication](#) explaining in detail which marks are affected and what steps owners can take should they wish to amend their specifications.

### 3. Do all trade mark owners have to make a declaration for trade marks that were filed before 22/06/2012 and which contain an entire class heading?

Trade mark proprietors/holders are not required to confirm whether they wish to cover the items listed in their trade mark or amend their specification. Rather, they may wish to declare that their intention at the date of filing was to seek protection for goods or services beyond those covered by the literal meaning of the class heading, provided that they are included in the alphabetical list for that class in the edition of the Nice Classification in force at the date of filing, and then the Register will be amended accordingly.

In other words, if you have an EU trade mark (or an international registration designating the EU) that complies with the requirements of Article 28(8) EUTMR, but all you wish to protect can be understood to fall within the literal meaning of the class heading, you do not need to take any action. If you would like to make a declaration for goods or services that are included in the alphabetical list but are not covered by the literal meaning of the heading, you will need to take into account the limitations of the effects of the amendment, as laid down in Article 28(9) EUTMR.

### 4. I have a trade mark for an entire class heading that was filed after 22/06/2012. Can I make a declaration under Article 28(8) EUTMR?

No. Pursuant to the wording of Article 28(8) EUTMR, trade marks filed on or after 22/06/2012 are not eligible.

### 5. My trade mark was filed before 22/06/2012 for an entire class heading but it is not yet registered. Can I make a declaration under Article 28(8) EUTMR?

No. Pursuant to the wording of Article 28(8) EUTMR, declarations can only be made for **registered** trade marks.

Applicants for EU marks that are not yet registered can amend their specification of goods and services under Article 43 EUTMR. However, this must be done before the entry into force of the amending Regulation. After the entry into force of the amending Regulation, Article 28(5) EUTMR will apply to all pending applications.

## **6. Do I need to appoint a representative?**

Proprietors/holders that have their domicile or place of business in the EEA (European Economic Area) need not appoint a representative.

For all other proprietors/holders, the general rules on representation apply (see the Guidelines, Part A, General Rules, Section 5, [Professional Representation](#)).

## **7. When can the declaration be made?**

Article 28(8) EUTMR declarations must be made between 23 March 2016 and 24 September 2016 inclusive.

## **8. Can the six-month period be extended?**

The six-month period for making the declaration cannot be extended. However, as the closing date falls on 24/09/2016 (i.e. a Saturday) and, pursuant to Rule 72 EUTMR, the deadline is automatically extended for the receipt of documents until the first working day of the Office.

## **9. Does the provision cover national and international trade marks as well as EU trade marks?**

Article 28(8) EUTMR applies to EU trade marks (CTMs) and international registrations designating the EU.

Article 28(8) EUTMR does not apply to national offices, but Article 39(5) of Directive (EU) 2015/2436 of the European Parliament and of the Council does apply. The latter will oblige all EU Member States to interpret class headings literally. In those Member States where the previous policy was to interpret them as covering the entire alphabetical list this may lead to establishing a transitional mechanism, such as Article 28(8) EUTMR. In any event, this is for the Member States concerned to decide within the period they have for transposing the Directive (until 15 January 2019).

## **10. Which form should I use?**

The Office has created a new online Recordal application form, under 'EUTM Recordal' subtype 'Declaration under Art. 28(8)'. The form will be available from 23 March 2016, and can be accessed [here](#). Users need to log in to make the online request.

Proprietors/holders wishing to file on paper should use the normal [Recordal Application form](#).

Only one form may be filed per EU trade mark.

**11. In which language can I file my declaration?**

Any language version of this form may be used, provided that it is completed in one of the five official languages of the Office, namely, English, French, German, Italian or Spanish in the case of EU trade marks, or in the case of IRs designating or subsequently designating the EU in the language of the international applications (English, French or Spanish).

**12. Is there a fee for making an Article 28(8) EUTMR declaration?**

No. These entries in the register are free of charge.

**13. Is it possible to modify general indications that are considered to be unclear or imprecise (e.g. the 11 general indications)?**

Under Article 28(8) EUTMR, it will only be possible to specify the goods and services that go beyond the literal meaning of the class heading of that class, provided that those goods and services are included in the alphabetical list for the class of the edition of the Nice Classification in force at the date of filing.

Proprietors should not use Article 28(8) EUTMR to clarify general indications lacking in clarity and precision (see the Guidelines, Part B, Examination, Section 3, [Classification](#), paragraph 4.2). Article 28(3) EUTMR does not apply retroactively and such indications will be afforded their natural and usual meaning in proceedings before the Office.

Proprietors may, however, amend general indications lacking in clarity and precision by specifying the goods or services covered by the literal meaning, as usual, under Article 50 EUTMR using the recordal type 'Partial Surrender' (for more information see the Guidelines, Part E, Register Operations, Section 1, [Changes in a Registration](#), paragraph 1.3.5, Partial Surrender.)

**14. What criteria will be applied to determine whether an expression is clear and precise?**

Declarations can only be made for specific goods or services contained within the alphabetical list and not covered by the literal meaning of the class heading for the class of the edition of the Nice Classification in force at the date of filing. All goods and services contained within the alphabetical list are deemed to be sufficiently clear and precise.

## 15. Will the Office accept all declarations?

No. In particular, the Office will object to:

- generic expressions claiming, for instance, the entire alphabetical list;
- the use of unclear, imprecise or unspecific expressions (e.g. 'all goods in Class X' or 'all goods not clearly covered by the literal meaning');
- declarations for goods and services that are deemed to be clearly covered by the literal meaning of the class heading;
- declarations for goods or services not contained in the alphabetical list in question.

In such cases, the Office will issue a deficiency letter stating the reasons why the claim is unacceptable and set a deadline of two months for the proprietor to remedy the deficiency. In accordance with Rule 71 EUTMR, the deadline may be extended.

## 16. In the event that a mark has been limited as such, or as the result of an opposition, or cancellation action, will proprietors/holders be able to amend their list of goods and services under Article 28(8) EUTMR?

If the class heading is limited in any way, the Office cannot accept a declaration under Article 28(8) EUTMR. The trade mark must continue to contain the entire class heading in order for an Article 28(8) declaration to be acceptable.

Oppositions or cancellation actions resulting in a mark being partially rejected must have been worded in such a way that it is clear which goods/services are no longer covered by the mark.

## 17. Will there be a possibility of opposition or cancellation proceedings against the goods and services included in an Article 28(8) EUTMR declaration?

Under current practice, as defined in Communication No 2/12 of the President of the Office, marks filed on or before 21/06/2012 covering all the general indications of a particular class heading of the Nice Classification are interpreted as covering all the goods and services included in the alphabetical list of the particular class concerned in the edition in force at the time when the filing was made.

The transitional period, during which proprietors can declare that their intention at the time of filing was to cover specific goods and services of the alphabetical list not covered by the literal meaning, is an opportunity for proprietors to clarify the exact scope of their goods and services. It is not considered to be an extension of the scope of goods and services, but rather a clarification based on the assumption that these goods and services already formed part of the scope of the registration even though they were not stated explicitly.

The exact wording of Article 28(8) EUTMR makes it clear that the possibility of making such a declaration is without prejudice to use requirements. That provision, however, does not foresee the possibility of filing an opposition or cancellation against the declaration. Nor does this situation fall under Rule 14 CTMIR, which is only applicable to the publication of applications. It is clear, therefore, that the intention of the legislator was that no new opposition period should be opened.

Six months after the entry into force of the amending Regulation, and where no declaration under Article 28(8) EUTMR has been made, those marks will be deemed to cover only goods and services clearly covered by the literal meaning of the indications included in the class heading of the relevant class.

**18. I have a CTM on which an international application is based. Can I make a declaration?**

Yes, providing your CTM fulfils the requirements of Article 28(8) EUTMR (i.e. filed before 22/06/2012 and registered for an entire class heading of the Nice Classification). The Office will not forward the declaration to WIPO as it is not considered to be a 'ceasing of effect'. According to the Office's interpretation, the scope of protection is not reduced, only clarified. The declaration will not have any immediate effect in the designated territories, which will continue to interpret the heading in accordance with their respective national laws.

**19. Will the Office provide an exhaustive list of terms clearly not covered by the literal meaning of the class headings?**

As an [Annex](#) to the [Communication](#) of the President on the implementation of Article 28 EUTMR, the Office has provided users with a non-exhaustive list of examples of goods and services clearly not covered by the literal meaning of the general indications of the Nice class headings. This list is purely for guidance. Declarations relating to any of the goods or services included in this list for the corresponding class and edition will not be objected to by the Office on the ground of being covered by the literal meaning of the general indications.

**20. Can I make a declaration for goods or services not included in the list of examples?**

Yes. The list is purely for guidance purposes. It is a non-exhaustive list containing examples of terms clearly not covered by the literal meaning, but there may be others for which there is reasonable doubt as to whether or not they are covered by the literal meaning of the class heading. Pursuant to Article 28(8) EUTMR, the Office will not object to the inclusion of terms not clearly covered by the headings in the specification. An example would be *computer software, recorded* or *computer programs [downloadable software]*. Computer software was not included as such in the class heading of Class 9 in the editions of the Nice Classification that were in force before 01/01/2012. While it could be interpreted as being covered by the literal meaning of one of the indications of the heading, namely *data processing equipment and computers*, the Office will not object to its inclusion in a declaration under Article 28(8) EUTMR, since there is reasonable doubt (i.e. it is not clearly covered by the class heading).

Further examples of terms that would be accepted as, even if they were considered to be covered, there is room for reasonable doubt are *diagnostic preparations for medical purposes* in Class 5 or *personnel recruitment* in Class 35.

**21. If my mark fulfils all the requirements for making an Article 28(8) EUTMR declaration and I choose to make one, what are the consequences?**

The Office will examine the declaration to ensure that it fulfils all the requirements. If the declaration is accepted and the register is amended, Article 28(9) EUTMR will apply.

Pursuant to Article 28(8) EUTMR, amending the list of goods and services of the earlier EU trade mark (or international registration designating the EU) will not give the proprietor the right to prevent third parties from using any of the added goods or services, on the understanding that the use commenced before the register was amended and did not infringe the proprietor's rights on the basis of the literal meaning of the goods and services in the register at that time.

Furthermore, the proprietor will not have the right to oppose or apply for a declaration of invalidity of a later trade mark if that later trade mark was in use or had been applied for prior to the register being amended, and that the use in relation to those goods or services did not infringe, or would not have infringed, the proprietor's rights based on the literal meaning of the goods or services recorded in the register at that time.

**22. If my mark fulfils all the requirements for making an Article 28(8) EUTMR declaration but I choose not to make one, what are the consequences?**

Under Article 28(8) EUTMR, if no declaration has been made within six months of the entry into force of the amending Regulation, those marks will be deemed to cover only goods and services clearly covered by the literal meaning of the indications included in the class heading of the relevant class.

**23. How can I see if a declaration under Article 28(8) EUTMR has been recorded in the register?**

Under Article 28(8) EUTMR, acceptable declarations will be recorded in the register and published in the EUTM Bulletin in Part C.3.2. These changes will also be reflected in eSearch plus. Acceptable declarations can be found as follows:

- through the Office's online database (eSearch plus) under the 'Publications' section for the mark concerned, and identified by the description 'Partial Surrender/Article 28(8) declaration'. Upon clicking, the relevant publication will open in the EUTM Bulletin under Part C.3.2 'Partial Surrender/Article 28(8) declaration', with the indication 'Art. 28(8)' under INID code 580 (date that the register is amended).
- through the Office's online database (eSearch plus) under the 'Records' section for the mark concerned, identified as being recordal type 'Declaration under Art. 28(8) EUTMR'.

The Office is looking at ways of reflecting such entries clearly in the list of goods and services on its website. This requires IT developments and may take some time.

**24. How will the Office deal with oppositions when the ground for opposition is a national trade mark registration whose list of goods contains the class heading of the class?**

Table 5 of the [Common Communication on the Implementation of 'IP Translator'](#) explains how the Office interprets the scope of protection of national trade marks containing general indications of the Nice class headings.

**25. How do I know if I have all the general indications of a class heading?**

WIPO's website on the [Nice Classification](#) contains all the editions and versions of the Nice Classification since it was established, as well as an indication of the class headings for each edition/version.

The existence of additional goods and services in the specification, either in the same or in another class, does not preclude the application of Article 28(8) EUTMR to the class that includes the entire heading, provided that the language used does not limit or in any way disclaim the general indications of the heading. For example, a limitation in the class heading of Class 25, *Clothing; footwear; headgear to except shirts* would preclude the application of Article 28(8) EUTMR, because the general indication *clothing* has been limited.

**26. Which Nice Classification should I use for my declaration?**

The wording of Article 28(8) requires that the declaration be made for goods and services that appear in the alphabetical list of the Nice Classification. The Nice Classification has to be the one which was in force at the time the trade mark was filed. It can be anything from the 6th edition to the 10th edition which was in force at the time of filing the trade mark.

**27. Can I make a declaration for goods or services that are not contained in the alphabetical list in force at the time of filing?**

No. The goods and services have to be contained in the alphabetical list that was in force at the time of filing.

**28. Will the Office make all language versions of the Nice Classification available for all the editions concerned?**

The Office will not be making the Nice Classification available in all language versions because this is already available at the WIPO website, at least in English and French. The Office cannot provide translations of the Nice Classification into the other languages of the Office because OHIM is not competent for providing those translations. It is recommended to visit the WIPO website, and if the translations to the desired languages are not available, it is advised to contact the national office which is competent for translating the Nice Classifications into those languages.

**29. Can I file multiple declarations under Article 28(8) EUTMR for the same mark?**

In principle, a single declaration should be filed for each mark. However, the proprietor may submit a new declaration providing the six-month period is still in progress.

**30. I have an International Registration designating the European Union. Can I file a declaration?**

Yes. Declarations for international registrations that designated or subsequently designated the EU before 22 June 2012 and that contain the entire class heading and continue to be protected for the entire class heading may file a declaration under Article 28(8). Nonetheless, they cannot do that using the e-filing form mentioned earlier, and must use instead the PDF form for recordal applications available on the Office's website and file it in the language of the international registration.

**31. For IRs designating the EU, what date is to be taken into account for determining the registration date of the mark?**

The date to take into account is the date of second republication of the mark. Declarations under Article 28(8) would only be admissible in respect of IRs designating the EU before 22/06/2012 which have been the object of a **second republication** by the Office by 23/03/2016.

**32. How will the declaration be communicated to the World Intellectual Property Office?**

The Office will use the mechanism of further decision under rule 18ter(4) of the Common Regulation under the Madrid Agreement Concerning the International Registration of Marks and the Protocols Related to that Agreement. The Office will be communicating the further decision to the International Bureau which in return will take the necessary steps to record that decision in its register and to publish the statement in its gazette.

**33. I have the entire class heading as well as additional goods. Can I file a declaration?**

Yes. The Office has interpreted the wording of Article 28(8) to mean that the trade mark *covers* the entire class heading. Therefore, it can contain the entire class heading and additional goods or services provided that they do not limit the class heading.

**34. I do not have the entire class heading, but I have some general indications. Can I file a declaration?**

No. The wording of Article 28(8) refers to the entire class heading. The Office will allow declarations for trade marks that have the entire class heading and that

continue to be registered for the entire class heading. In the case of having only some general indications, the Office will not accept a declaration for that trade mark.

**35. I have the entire class heading but it is has a limitation. Can I file a declaration?**

No because there is a limitation which affects the entire list of goods and services and the entire specification is affected by a limitation - and therefore the class heading is also limited. If the class heading is limited the Office cannot accept a declaration under Article 28(8). The trade mark must continue to contain the entire class heading in order for an Article 28(8) declaration to be acceptable.

**36. I have the entire class heading of class 35. Can I file a declaration under Article 28(8) for “retail services in connection with...”?**

No. Retail services as such did not appear on the alphabetical list until the 2013 version of the 10<sup>th</sup> edition. Nor are they considered to be covered by the literal meaning.

**37. Where can I find more information?**

Information on the change in practice can be found in [Communication No 1/2016](#) of the President of the Office.

Please also visit our website for more information on the [Legal Reform](#).

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1.0	12/02/2016	KB	Final document following proofreading
1.1	25/02/2016	KB	Additional questions added.
1.2	09/09/2016	KB	FAQ 11 clarified in terms of language for IRs