

Austrian Patent Office

Common Position

Common position of the Austrian Patent Office and the German Patent and Trademark Office regarding the decision "IP Translator" by the European Court of Justice (created in coordination with the Swiss Federal Institute of Intellectual Property)

The Austrian Patent Office and the German Patent and Trademark Office welcome the decision by the European Court of Justice dated June 19, 2012 (C-307/10 "IP Translator") which emphasizes the fundamental requirement of a clear and precise list of goods and services as the sole basis for determining the relevant extent of the protection of trademark application by the competent authorities and economic operators.

The European Court of Justice so far confirmed the practice of these three authorities in its preliminary decision regarding questions 1 and 2. The European Court of Justice formulated the above requirements so that the competent authorities know with clarity and precision in how far goods and services are covered by a trade mark (paragraph 47) and economic operators have clear and precise information which applications and trademarks their current and future competitors initiated or received and may thus receive information with regard to third parties (paragraph 48).

Some of the general indications in the class headings of the Nice Classification are, in themselves, sufficiently clear and precise to allow the competent authorities to determine the scope of the protection conferred by the trade mark, while others are not such as to meet that requirement where they are too general and cover goods or services which are too variable to be compatible with the trade mark's function as an indication of origin (paragraph 54).

It is up to the national authorities, according to the ECJ, to determine which class headings are sufficiently precise and should be part of community wide harmonization efforts.

Regarding the central and repeatedly emphasized premise of clarity and precision of goods and services we consider it as doubtful whether in case an applicant uses all the general indications of a class heading in any case with an additional declaration it can be achieved that such an application shall apply to all goods and services included in the alphabetical list of the particular class heading (paragraph 61).

If single general indications fulfil the requirement of clarity and precision, indeed several general indications if used together in one class heading may also be clear and precise, since precision and clarity may not be eliminated by combining these indications. However, this does not necessarily mean that the total of all admissible general indications as class heading of a class provided for in the Nice Classification reflect and cover with the required clarity and distinctiveness all goods or services covered in the class's corresponding alphabetical list. The approach to solve the problem with a general reference to a changing list which is not shown in the register, does not allow an interested public to determine reliably the extent of a mark.

If a number of clear and precise class headings are used, with no need of interpretation, in pending procedures, compelling clarification, that all indications included in the alphabetical list of the particular class should be covered, could lead to an (invalid) expansion of the protective scope and cover further goods and services, which are not included in the specifically used list. This would be incompatible with the requirements of legal security.

Therefore, in the interest of ensuring the priority and central premise of clarity and precision of the goods or services, we currently see no reason to clarify the trademark registration whose applicant uses all indications of a particular class heading, whether the trademark registration covers all goods or services included in the alphabetical list of this class.

Therefore, we intend to continue our existing established practice, which may become subject to further detailed clarifying by the European Court of Justice, and in our responsibility as competent national authorities we will assess **on the basis of the wording** in each individual case, whether the chosen specifications, individually or in total or in case of choice of all indications of a class heading, meet the requirements of clarity and precision.

Applicants who intend to cover goods or services of a particular class that are not covered by the specifications of this class heading according to above mentioned criteria, should name the goods or services clearly and precisely.

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