



Common Communication on the
Common Practice on the General Indications of the
Nice Class Headings v1.0,
20 November 2013

On 19/06/2012 the Court delivered its ruling in [Case C-307/10 "IP Translator"](#), giving the following answers to the referred questions:

1 – Directive 2008/95 must be interpreted as meaning that it requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark;

2 – Directive 2008/95 must be interpreted as meaning that it does not preclude the use of the general indications of the class headings of the Nice Classification to identify the goods and services for which the protection of the trade mark is sought, provided that such identification is sufficiently clear and precise;

3 – an applicant for a national trade mark who uses all the general indications of a particular class heading of the Nice Classification to identify the goods or services for which the protection of the trade mark is sought must specify whether its application for registration is intended to cover all the goods or services included in the alphabetical list of that class or only some of those goods or services. If the application concerns only some of those goods or services, the applicant is required to specify which of the goods or services in that class are intended to be covered.

This Judgment has an influence on the practice of all Trade Mark Offices of the European Union and in the interest of establishing certainty within the trademark system and for its users, calls for convergence on the interpretation of the general indications of the Nice class headings. Without prejudice to the fact that each Office is bound by its national legislation, national court decisions and, in some cases, previous communications, it is recognised by all that it is only through collaboration in implementing this Judgment in a harmonised manner will there be legal certainty both for the competent authorities and the economic operators.

As regards the first question, the Trade Mark Offices of the European Union are working together to establish a common understanding of the requirements necessary to achieve clarity and precision in the identification of goods and services in an application for registration and to develop a common set of criteria which will be subject of a subsequent common communication.

As concerns the second question, the Trade Mark Offices of the European Union have already reviewed all general indications of the Nice class headings in order to determine which indications are sufficiently clear and precise. This review has determined that the 11 general indications detailed below are not clear and precise, and consequently cannot be accepted without further specification. The remaining general indications are considered acceptable. Further, the reasons why each of the 11 non-acceptable general indications of the Nice class headings are not found clear and precise have been agreed.

Implementation* will take place within 3 months of the date of publication of this Common communication. In exceptional cases this period can be extended for another 3 months.

The Offices have agreed that the judgment should not have a retrospective effect requiring that the register be changed ex officio with respect to registrations that contain one or more of these non-acceptable 11 general indications prior to the implementation of this communication.

Tools such as [TMclass](#) are available to assist in searching for and identifying acceptable terms.

As regards the third question, the ["Common Communication on the Implementation of 'IP Translator'"](#) provides an overview on how Trade Mark Offices of the European Union deal with specific topics relating to the implementation of the said Judgement.

The Trade Mark Offices of the European Union reiterate their commitment to continue to collaborate in the context of the Convergence Programme, further increasing transparency and predictability for the benefit of examiners and users alike.

EUROPEAN TRADE MARK AND DESIGN NETWORK

* Implementation dates for each office will be provided; however, some offices may have to delay implementation due to legal constraints.

List of implementing offices:

AT, BG, BX, CY, CZ, DE, DK, EE, ES, FI, FR, GR, HR, HU, IE, IT, LV, LT, MT, NO, OHIM, PL, PT, RO, SE, SI, SK, UK

ACCEPTABLE AND NON-ACCEPTABLE GENERAL INDICATIONS OF THE NICE CLASS HEADINGS

The general indications are the expressions that appear in the class headings between semicolons; for example, Class 13 is made up of 4 general indications: "Firearms;", "ammunition and projectiles;", "explosives;" and "fireworks".

The 197 general indications of the Nice class headings were examined with respect to the requisites of clarity and precision. Of these, 11 were considered to lack the clarity and precision to specify the scope of protection that they would give, and consequently cannot be accepted without further specification. These are set out below, highlighted in bold.

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

In some cases, a part of a general indication may be considered to be sufficiently clear and precise if used on its own, for example, in the general indication “Machines and machine tools”, the description ‘machine tools’ on its own would be acceptable because it describes a specific type of goods. Where this applies, the part of the general indication is shown in grey. However this does not apply to the phrase “, not included in other classes”.

The reasons why each of the 11 general indications of the Nice class headings are not clear and precise are expressed below.

- Cl. 6 – Goods of common metal not included in other classes - In light of the need for clarity and precision, this term does not provide a clear indication of what goods are covered as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and / or purposes, that may require very different levels of technical capabilities and know-how to be produced and / or used, could be targeting different consumers, be sold through different sales channels, and therefore relate to different market sectors.
- Cl. 7 – Machines and machine tools - In light of the need for clarity and precision, the term “machines” does not provide a clear indication of what machines are covered. Machines can have different characteristics or different purposes, they may require very different levels of technical capabilities and know-how to be produced and / or used, could be targeting different consumers, be sold through different sales channels, and therefore relate to different market sectors.
- Cl. 14 – Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes - In light of the need for clarity and precision, the term “goods in precious metals or coated therewith, not included in other classes” does not provide a clear indication of what goods are covered, as it simply states what the goods are made of or coated with, and not what the goods are. It covers a wide range of goods that may have very different characteristics, that may require very different levels of technical capabilities and know-how to be produced, could be targeting different consumers, be sold through different sales channels, and therefore relate to different market sectors.
- Cl. 16 – Paper, cardboard and goods made from these materials, not included in other classes - In light of the need for clarity and precision, the term “goods made from these materials [paper and cardboard], not included in other classes” does not provide a clear indication of what goods are covered, as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and / or purposes, that may require very different levels of technical capabilities and know-how to be produced and / or used, could be

targeting different consumers, be sold through different sales channels, and therefore relate to different market sectors.

- Cl. 17 – Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes - In light of the need for clarity and precision, the term “goods made from these materials [rubber, gutta-percha, gum, asbestos and mica] and not included in other classes” does not provide a clear indication of what goods are covered as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and / or purposes, that may require very different levels of technical capabilities and know-how to be produced and / or used, could be targeting different consumers, be sold through different sales channels, and therefore relate to different market sectors.
- Cl. 18 – Leather and imitations of leather, and goods made of these materials and not included in other classes - In light of the need for clarity and precision, the term “goods made of these materials [leather and imitations of leather] and not included in other classes” does not provide a clear indication of what goods are covered, as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and / or purposes, that may require very different levels of technical capabilities and know-how to be produced and / or used, could be targeting different consumers, be sold through different sales channels, and therefore relate to different market sectors.
- Cl. 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 - In light of the need for clarity and precision, this term does not provide a clear indication of what goods are covered as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and / or purposes, that may require very different levels of technical capabilities and know-how to be produced and / or used, could be targeting different consumers, be sold through different sales channels, and therefore relate to different market sectors.
- Cl. 37 - Repair - In light of the need for clarity and precision, this term does not provide a clear indication of the services being provided, as it simply states that these are repair services, and not what is to be repaired. As the goods to be repaired may have different characteristics, the repair services will be carried out by service providers with different levels of technical capabilities and know-how, and may relate to different market sectors.

- Cl. 37 – **Installation services** - In light of the need for clarity and precision, this term does not provide a clear indication of the services being provided, as it simply states that these are installation services, and not what is to be installed. As the goods to be installed may have different characteristics, the installation services will be carried out by service providers with different levels of technical capabilities and know-how, and may relate to different market sectors.
- Cl. 40 – **Treatment of materials** - In light of the need for clarity and precision, this term does not give a clear indication of the services being provided. The nature of the treatment is unclear, as are the materials to be treated. These services cover a wide range of activities performed by different service providers on materials of different characteristics requiring very different levels of technical capabilities and know-how, and may relate to different market sectors.
- Cl. 45 – **Personal and social services rendered by others to meet the needs of individuals** - In light of the need for clarity and precision, this term does not give a clear indication of the services being provided. These services cover a wide range of activities performed by different service providers requiring very different levels of skill and know-how, and may relate to different market sectors.