IP TRANSLATOR: OHIM's class heading approach is wrong

In *Chartered Institute of Patent Attorneys v Registrar of Trademarks* (Case C-307/10), Advocate General Bot has stated that Office for Harmonisation in the Internal Market (OHIM) Presidential Communication 4/03, which supports the 'class-heading-covers-all' approach to registration, does not offer sufficient clarity.

Communication 4/03 provides that it is acceptable for the goods or services in an application or registration to be identified by means of the class headings of the Nice Classification. It confirms that the use of the class heading constitutes a claim to all goods or services within that class.

In his opinion, the advocate general stated that Communication 4/03 "does not guarantee the clarity and precision required for the purposes of the registration of a trademark".

According to Hiroshi Sheraton, partner at McDermott Will & Emery, the opinion "clearly says that the OHIM guidance is wrong". He adds: "The communication essentially imposed a legal fiction on how wide the words used in class headings were interpreted."

Hastings Guise of Field Fisher Waterhouse, adds: "If the ECJ follows the opinion, OHIM will be obliged to adopt a more stringent examination of specifications and practitioners can expect to see a rise in specification objections. Furthermore, brand owners should review their existing portfolios and consider clarifying the scope of their rights where they have previously relied on broad class headings."

However, Sheraton believes that this opinion is unlikely to have a major impact on brand owners: "In any event, there is a requirement of use after five years for any brand and the courts have taken a fairly restrictive approach to how that is defined." Nevertheless, the opinion "does help, to a certain extent, to give clarity as to what is covered by existing registrations – which, from a practitioner's point of view, is helpful".