

RETROSPECTIVE APPLICATION OF CLASSIFICATION OF TRADEMARKS TMR 28(5)

Retrospective application of the classification system would mean loss of rights to many trademark owners in Finland. Many trademarks applied and registered with class heading would be affected, i.e. the scope of protection would be made very much smaller and sometimes the applied protection would vanish totally.

The signatories of this common communication are of the opinion that retrospective application of the legislation is against the Nordic legal rules and praxis as well as the better regulation principle of the EU.

The proposal of the trademark regulation (TRM) is currently being worked on in Trilogy by the Commission, the Council and European Parliament. Concerns have been raised about proposed Article 28 (5) regarding retrospective application of classification of community trademarks.¹

The background of the harmonization of classification rules is the IP TRANSLATOR judgment (C307/10, 19 June 2012) in which ECJ for the first time gave guidelines for classification of trademarks. This article would apply to all community trademarks irrespective of when these trademarks were applied for or registered, i.e. retrospectively. Thus, the proposed provision of the regulation goes further than the IP TRANSLATOR judgment.

The retrospective application would limit the scope of protection of prior community trademarks only to the goods or services that are covered by the literal meaning of the class heading of the Nice class applied for, excluding several goods or services that at a time when application was made, were considered to be included. This would lead to loss of rights for trademark holders.

In Finland this retrospective application would have very big consequences since a vast majority of Finnish trademark applications have been done using class headings. The applications were made according to the classification rules and practices in force at a time when the application was done. We strongly believe that this applies also to community trademark holders of Italy, Bulgaria, Greece, Malta, Hungary, Latvia, and Romania.

The proposed provision would apply retrospectively to all prior community trademarks. Trademark holders have acted in good faith when applying their community trademarks. They have followed

¹ Proposed Article 28 (5) reads as follows (retrospective application is marked bolded):

*The use of general terms, including the general indications of the class headings of the Nice Classification, shall be interpreted as including all the goods or services clearly covered by the literal meaning of the indication or term. The use of such terms or indications shall not be interpreted as comprising a claim to goods or services which cannot be so understood, **irrespective of when the trademark was applied for or registered.***

the classification rules and practices in force at a time when a trademark application was made. The proposed article would now lead to loss of rights.

We are of the opinion that prior community trademarks should remain unaffected by the new regulation or, at least, the trademark holder should be given a possibility within a time frame to declare his or her original intention regarding the goods and/or services of a prior community trademark.

We believe that a solution to this problem may be found from the proposals of article 28 (8) of the Commission and European Parliament². The trademark owner should be given a time frame to give a correct specification of goods or services of particular trademark.

Confederation of Finnish Industries (EK)

Finland Chamber of Commerce

The Federation of Finnish Enterprises

[NDM, the Swedish Business Committee on Market Law][not confirmed]

² The European Parliament proposed last spring a following article 28 (8):

Proprietors of European Union trade marks applied for before 22 June 2012 which are registered in respect of the entire heading of a Nice class may declare that their intention on the date of filing had been to seek protection in respect of goods or services beyond those covered by the literal meaning of the heading of that class, provided that the goods or services so designated are included in the alphabetical list for that class of the edition of the Nice classification in force at the date of filing.

The declaration shall be filed at the Agency within six months from the entry into force of this Regulation, and shall indicate, in a clear, precise and specific manner, the goods and services, other than those clearly covered by the literal meaning of the indications of the class heading, originally covered by the proprietor's intention. The Agency shall take appropriate measures to amend the Register accordingly. This possibility is without prejudice to the application of Article 15, Article 42(2), point (a) of Article 51(1) and Article 57(2).