

IP Translator – brand owner perspectives

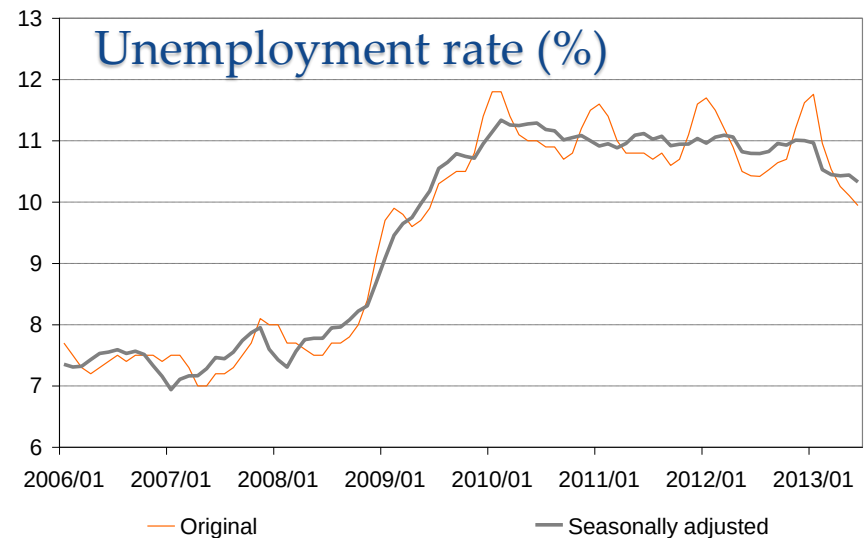
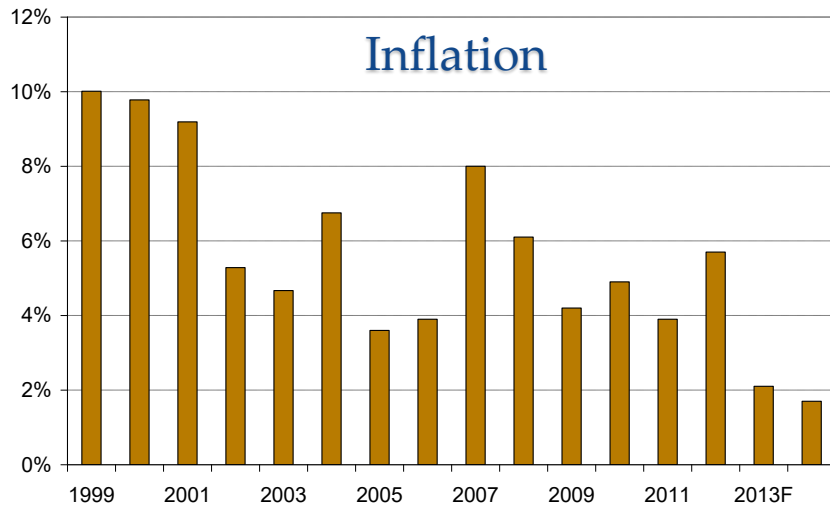
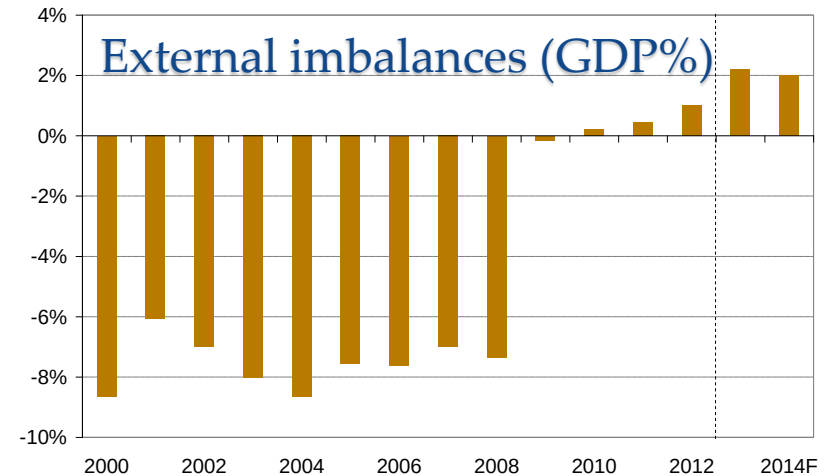
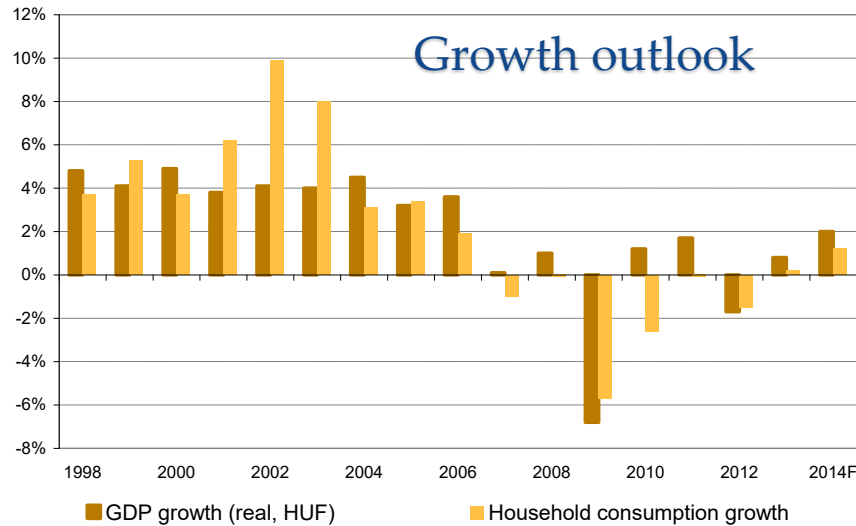
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**ECTA ROUND TABLE SESSION
BRAND OWNERS LIFE BEFORE AND AFTER IP TRANSLATOR
6 NOVEMBER 2013, BUDAPEST, HUNGARY**

The HU economical environment

(data provided by  CONCORDE)



TM filing statistics

(source: Annual Report of HIPO 2012)

Existing rights in 2012:

HU national TMs: 56130

CTMs: 888373

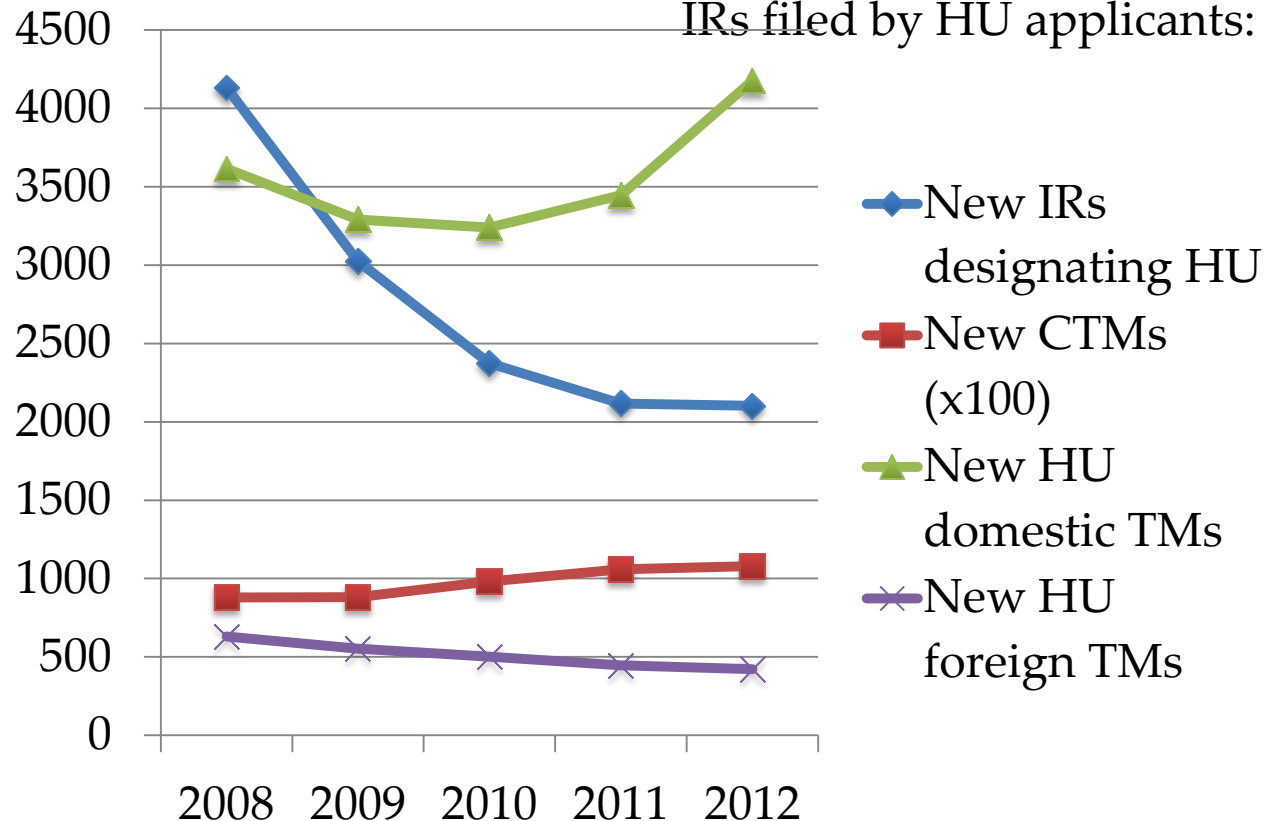
New filings in 2012:

HU national TMs: 4599 (4177 HU applicants)

CTMs : 107924 (370 HU applicants)

IRs designating HU: 2102

IRs filed by HU applicants: 292



Before the “IP TRANSLATOR” Decision

- HU followed the “class-heading-covers-all” (“CHCA”) approach (like e.g. OHIM, Lithuania, and Romania): class headings cover the literal meaning of the class heading plus the alphabetical list of the edition of the Nice Agreement at the time of filing.
- Additionally, in HU everything was deemed to be covered that could be classified into the certain class, i.e. not only the alphabetical list.
- Class 35: Praktiker decision No. C/418-02 of 7 July 2005. This judgment required to provide details with regard to the goods or types of goods to which retail services relate. “Retail services” or “retail services of a supermarket” were not accepted anymore.

Legal resources

HU TM Act, HIPO Guidelines, Case law

- HU TM Act:
 - the list of goods or services is the enumeration of goods and services with respect to which trade mark protection for the sign is sought (Art 52(2));
 - in the list of goods or services, the goods or services shall be grouped according to the classes of the Nice Agreement ... and, if possible, by using the terms included therein (Art 52(3));
 - instead of filing the sign and list of goods and services reference to a priority document is sufficient for according the filing date (Art. 51(2));
 - list of goods and services can be filed in any foreign language, provided that the HU translation is filed within four months (Art. 50(5)).
- HIPO Guidelines:
 - mentions C-307/10 (“IP TRANSLATOR”) Decision, according to which the goods and services of a trademark application shall be identified with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of protection (practically answer 1 of the Decision)
 - concludes from the Decision that if the applicant uses the class heading, shall declare whether it relates to all or to some of the goods and services in the alphabetical list of the Nice Agreement;
 - declares that certain terms in the headings can not be deemed to be precise enough in themselves;
 - there is a Notification on the HIPO web site referred to by the Guidelines about the consequences of the “IP TRANSLATOR” decision, which also contains a link to the list of non-acceptable terms.

The Notification of the HIPO - 1

- Refers to Articles 50-52 of the TM Act regulating the list of goods and services and to the “IP TRANSLATOR” decision, but does not refer to the Guidelines;
- The following is cited from the “IP TRANSLATOR” decision:
 - list of goods and services shall be clear and precise;
 - if the full class heading is used, a statement shall be filed whether all items of the given class or only some of them is sought for protection;
 - a certain general term in class headings shall be judged in a case-by-case basis, whether they are clear and precise.
- There is no reference in the Notification to CTMs.

The Notification of the HIPO – 2

Conclusions of the HIPO in the Notification

- the HIPO publishes those general terms that are surely not accepted as clear and precise;
- possibility of protection for all items in the alphabetical list is not excluded, however, a corresponding statement shall be filed, the consequences are the following:
 - after the “IP TRANSLATOR” decision a statement is necessary;
 - earlier all goods and services were covered in “class heading” applications irrespective whether they were listed in the edition of Nice Agreement at the time of filing, from now on only those goods and services are covered that are listed;
- it is possible to file the class heading, file the statement that all items of the alphabetical list is intended to be protected, and add further items that are not listed in the Nice Agreement (only at time of filing);
- if the statement was not filed together with the application, the HIPO will invite the applicant to file it;
- applications filed before 19 July 2012: for class heading applications the HIPO treats the application as all items of the alphabetical list are seeking protection (limitation until grant is possible).
- TM registrations filed after 1 May 2004 (accession of HU to EU) the HIPO treats the application as all items of the alphabetical list are seeking protection listed in the edition of Nice Agreement at the time of filing (limitation will be possible at renewal);
- The Registry will contain indication whether a certain application covers all items of the alphabetical list.

Expressions used in class headings that do not fulfill the requirements of clarity and precision

Class Number	Expression
6.	Goods of common metal <i>not included in other classes</i>
7.	Machines and machine tools
8.	Hand tools and implements (hand-operated)
14.	Precious metals and their alloys and goods in precious metals or coated therewith, <i>not included in other classes</i>
16.	Paper, cardboard and goods made from these materials, <i>not included in other classes</i>
16.	Plastic materials for packaging (<i>not included in other classes</i>)
17.	Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and <i>not included in other classes</i>
18.	Leather and imitations of leather, and goods made of these materials and <i>not included in other classes</i>
21.	Glassware, porcelain and earthenware <i>not included in other classes</i>
24.	Textiles and textile goods, <i>not included in other classes</i>
28.	Games and playthings; gymnastic and sporting articles <i>not included in other classes</i>
31.	Grains and agricultural, horticultural and forestry products <i>not included in other classes</i>
45.	Personal and social services rendered by others to meet the needs of individuals

- this is not a full list;
- the list can be amended from time to time;
- the HIPO can invite the applicant for a declaration in relation to non-listed items also.

Example

A Szellemi Tulajdon Nemzeti Hivatala (a továbbiakban: Hivatal) felhívja a bejelentőt, hogy

2013. november 10. napjáig

pótolja az alábbi hiányokat:

- jelölje meg, hogy a védjegyoltalmat a 38. 41. és a 42. osztály betűrend szerinti jegyzékében szereplő valamennyi szolgáltatásra vagy azok közül csupán egyes szolgáltatásokra kéri.

Amennyiben az oltalmat csak egyes szolgáltatásokra kéri, jelölje meg pontosan, hogy melyek ezek.

Amennyiben a bejelentő a felhívásnak a kitűzött határidőig nem tesz eleget, a védjegybejelentést visszavontnak kell tekinteni.

The Hungarian Intellectual Property Office (hereinafter: the Office)
invites the applicant to remedy

until 10 November 2013

the following deficiencies:

- specify whether the trademark protection is sought for all services in the alphabetical list of classes 38, 41, and 42, or only for some of them.

If the protection is sought only for some of the services, the applicant shall specify them exactly.

If the applicant does not comply with the invitation in due time, the trademark application shall be deemed to be withdrawn.

Possibilities in HU

- For HU applicants:
 - HU national application
 - CTM regional application
 - IR application
 - based on HU national application.
 - based on CTM regional application.
- For non-HU economic operators in HU
 - HU national application
 - CTM regional application (in HU: terms of the class headings are to be interpreted literally after the IP TRANSLATOR decision)
 - IR application
 - *based on a foreign national/regional application.*

Interpretation of OHIM and national offices

Table 2

TRADE MARKS FILED <u>AFTER</u> "IP TRANSLATOR" CONTAINING ENTIRE NICE CLASS HEADINGS INTERPRETATION BY THE OFFICE OF THE SCOPE OF PROTECTION OF ITS <u>OWN</u> TRADE MARKS			
National Office	Class Headings cover the entire class	Class Headings terms are to be interpreted literally (means what it says)	Class headings cover the literal meaning of the class headings plus the alphabetical list of the edition of Nice at the time of filing
AT		X	
BG		X	
BX		X	
CY		X	
CZ		X	
DE		X	
DK		X	
EE		X	
ES		X	
FI		X	
FR		X	
GR		X	
HU			X
IE		X	
IT			X
LV		X	
LT			X
MT		X	
NO		X	
OHIM		X	
PL		X	
PT		X	
RO			X
SE		X	
SI		X	
SK		X	
UK		X	

Table 3

TRADE MARKS FILED <u>AFTER</u> "IP TRANSLATOR" CONTAINING ENTIRE NICE CLASS HEADINGS HOW DOES THE OFFICE REFLECT THE APPLICANT'S INTENTION WITH RESPECT TO THE CLASS HEADINGS AND/OR THE ALPHABETICAL LIST		
National Office	All goods and services applied for or registered will be listed individually	A general reference to the applicable edition of the alphabetical list will be available
AT	X	
BG	X	
BX	X (in the publications, certificates and register)	X (in the application)
CY	X	
CZ	X	
DE	X	
DK	X	
EE	X	
ES	X	
FI		X
FR	X	
GR		X
HU		X
IE	X	
IT		X
LV	X	
LT	X	
MT	X	
NO	X	
OHIM	X	
PL	X	
PT	X	
RO		X
SE	X	
SI	X	
SK	X	
UK	X	

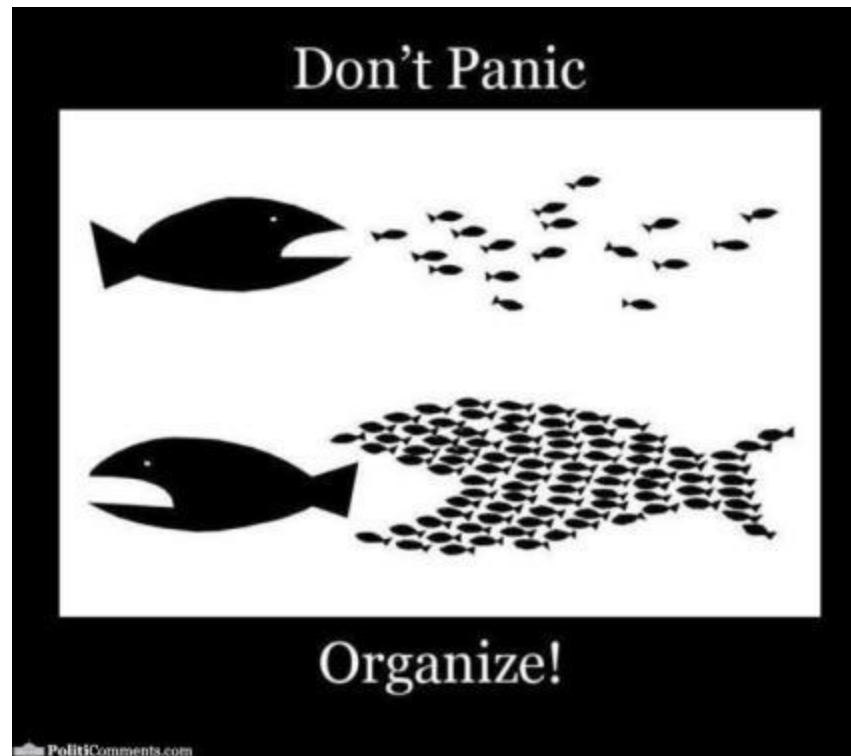
Source: Common Communication on the Implementation of the IP translator, 2 May 2013, OHIM web site

Conclusions – HIPO practice

- with a simple statement full class protection is possible;
- according to a non-representative search, simple full class protection via statement is possible for also for class 35;
- there are class heading terms that are acceptable as clear and precise, however, there are exceptions (published by the HIPO);
- the possibility of late-filed statement means inherently the HIPO still uses the CHCA approach, otherwise such statement were a type of broadening scope, in other words if a statement other than requesting protection the full alphabetical list is a simple limitation;
- as class heading of CTMs will be interpreted literally, and broadening the scope of class heading terms with statement for HU national applications is possible, it will be easier to get broader protection by filing HU national TMs;
- question on priority claims.

Conclusions – role of IRs

- IRs are not dealt with directly by the Notification (only for already registered TMs), however, all provisions shall be applied also to IRs based on the general principles of the TM Act.
- We do not know how the HIPO will deal with IR renewals, where the proprietor intends to file a limiting statement (question applicable for IRs filed after 1 May 2004, renewal is possible from 1 November 2013.) As this statement is a kind of limitation, we suggest to file a separate limitation (MM6) request.
- IRs based on most of the national EU TMs, on CTMs or on TMs with strict classification system may shift applicants to HU national TMs as this will generally provide broader protection (filing a simple statement is much easier and more cost effective than listing all items);
- IRs based on full class heading basic applications shall be accompanied for the HU part with the corresponding statement (additional cost).



Thank you for your attention!