

A background image showing a grid of white-capped vials and clear-bottomed vials on a wooden surface.

European Union – TM tips for description of goods/services

European trade mark protection

We know that the US trade mark system requires very specific and narrowly defined descriptions of goods and services - which are subject the strict use requirements to maintain the trade mark.

The EU system is different.

There is no strict use requirement to obtain registration at the EUIPO, nor any need of an intent to use basis. Once registered, there is a period of five years before there is any use/validity requirement.

Preparing the specification for filing at the EUIPO

Consider peripheral activities and foreseeable extension of interests, especially if this falls into the same class. It is more cost effective to file one application from the outset rather than several separate applications as and when new interests/activities arise.

However although there is the ability to file more broadly in the EU, it is very important to consider third party rights and an increased risk of conflict/opposition by filing overbroad specifications.

Recommended best practice:

To list specific interest and include slightly broader "umbrella" terms for best protection.

Examples:

1. Specific interest = "Education services in relation to primary age children"
 - Umbrella term = "Education services"
2. Specific interest = "Hair care products"
 - Umbrella term = "Toiletries"

Helpful on-line tool:

TMClass: <http://tmclass.tmdn.org/ec2/>

TMClass is an online tool which helps to correctly classify goods and services, and is the equivalent of the US ID Manual.

An extensive list of classification terms can be searched and pre-defined acceptable terms are identified. The pre-defined acceptable terms are collated through the Harmonised Database (HDB).

What is the Harmonised Database?

The HDB sets out a list of all of the terms which the EUIPO finds to be acceptable for specification purposes.

If you select terms from the HDB they this will automatically be accepted by the EUIPO when the application is examined, providing no additional terminology not found on the HDB is included.

Terms from the HDB have already been translated into all other EU languages (except Irish). This allows the application to be processed more quickly and efficiently by the EUIPO – this is a “Fast Track” application.

How we can help

Historically, approaches to descriptions of goods and services within Europe, especially Continental Europe, have varied widely. Some practices have also been affected by law changes.

Our own approach has always been to anticipate such changes and to provide advice that enables clients to obtain the best protection with minimal risk.

We have many years’ experience and are always happy to provide input and guidance on application and filing strategies. Please contact your usual attorney or paralegal for further assistance, or email us at paralegals@barkerbrettell.co.uk

Why use Barker Brettell LLP

At Barker Brettell LLP all our trade mark attorneys have many years’ experience in preparing and filing trade mark applications including dealing with trade mark offices around the world. We will use our experience to provide you with the broadest trade mark protection we can, in order to create a sphere of protection around your trade mark which would be difficult for a third party to successfully break.

We can advise you more on these issues, as well as on any of the other aspects of intellectual property as Barker Brettell LLP offers a full range of intellectual property services and we are always happy to take the time to tailor our services to your needs.