

Madrid Protocol Concerning the International Registration of Marks

Change in examination of international registrations designating the European Union

1. The International Bureau of the World Intellectual Property Organization (WIPO) would like to bring to the attention of applicants, holders, Offices of the Contracting Parties and users of the Madrid System at large, that, as from October 1, 2014, the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) examines the indication of goods and services as listed in international registrations where the European Union has been designated (either in an international application or subsequent designation), for vague terms.
2. This change brings the OHIM practice in line with that of the European Union national and regional Intellectual Property Offices, as previously outlined in the Common Communication on the implementation of "IP Translator" dated February 20, 2014 (available on the OHIM website, at the following address: https://oami.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_ohim/who_we_are/common_communication/common_communication1_en.pdf).
3. The change in practice affects all international registrations, where the European Union has been designated (either in an international application or subsequent designation), notified by the International Bureau of WIPO to OHIM on or after October 1, 2014.
4. As a result, if a term, used in a list of goods and services covered by an international registration where the European Union has been designated (either in an international application or subsequent designation), is considered by OHIM as being too broad or too vague, and lacking clarity and precision, OHIM may issue a notification of provisional refusal with respect to the said registration.
5. A list of 11 terms considered by OHIM as being too broad or too vague, and lacking clarity and precision, is reproduced in the Annex hereafter.

6. For further information on this change in practice, please contact directly OHIM (<http://www.wipo.int/madrid/en/members/profiles/em.html>) or consult the Guidelines for Examination in OHIM on Community Trade Marks, Part M, International Marks, which are available on the OHIM website, at the following address: https://oami.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/wp_2_2014/21_part_m_international_marks_fast_track_en.pdf.

November 6, 2014

THE 11 TERMS CONSIDERED BY OHIM AS BEING TOO BROAD OR TOO VAGUE, AND LACKING CLARITY AND PRECISION*

According to the information available on the OHIM website, at the following address:
https://oami.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_ohim/who_we_are/common_communication/common_communication3_en.pdf.

TERM TOO BROAD OR TOO VAGUE, AND LACKING CLARITY AND PRECISION	PROPOSALS / POSSIBLE SOLUTIONS: (EXAMPLES FROM HARMONIZED DATABASE)
Goods of common metal not included in other classes (class 6)	Construction elements of metal (class 6)
	Building materials of metal (class 6)
Machines (class 7)	Agricultural machines (class 7)
	Machines for processing plastics (class 7)
	Milking machines (class 7)
Goods in precious metals or coated therewith (class 14)	Works of art of precious metal (class 14)
Goods made from paper and cardboard (class 16)	Filtering materials of paper (class 16)
Goods made from rubber, gutta-percha, gum, asbestos and mica (class 17)	Rings of rubber (class 17)
Goods made of these materials [leather and imitations of leather] (class 18)	Briefcases [leather goods] (class 18)
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 (class 20)	Door fittings, made of plastics (class 20)
	Figurines of wood (class 20)

* This list is only an indicative, non-binding list for information purposes.

Repair (class 37)	Shoe repair (class 37)
	Repair of computer hardware (class 37)
Installation services (class 37)	Installation of doors and windows (class 37)
	Installation of burglar alarms (class 37)
Treatment of materials (class 40)	Treatment of toxic waste (class 40)
	Air purification (class 40)
Personal and social services rendered by others to meet the needs of individuals (class 45)	Personal background investigations (class 45)
	Personal shopping for others (class 45)
	Adoption agency services (class 45)

[End of Annex]