

**THE MANUAL CONCERNING
EXAMINATION OF CLASSIFICATION OF
GOODS AND SERVICES**

PART B.3.

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**THE TEXT IN BLUE REFLECTS CHANGES IN
OFFICE’S PRACTICE THAT WILL ENTER INTO
FORCE ON 25 NOVEMBER 2013**

3. CLASSIFICATION

3.1. Introduction

Every CTM application must contain a list of goods and services as a condition of a filing date being accorded (Article 26(1) (c) CTMR). The list must be classified in accordance with the Nice Agreement (Article 28 CTMR and Rule 2(1) CTMIR). The list must be worded in such a way as to (a) indicate clearly the nature of the goods and services, and (b) allow each item to be classified in only one class of the Nice Classification (Rule 2(2) CTMIR).

The list shall be translated by the Office if it was filed in any language other than the five languages of the Office (Article 119 CTMR).

The purpose of this part of the Manual is to describe the Office practice concerning classification of goods and services.

The first part (points 1 to 4) sets out the principles applied by the Office. The second part (Point 5) summarizes the procedure of the examination of the list of goods and services.

In short, when examining the classification of a list of goods and services the Office's tasks are four:

- Check that each of the goods and services is **clear and precise enough**.
- Check that each term is proper to the Class in which it is applied for.
- Notify any deficiency.
- Refuse the application, in whole or in part, where the deficiency is not remedied (Rule 9(4) and (8) CTMIR).

3.2. The Nice Classification

The version of the Classification under the Nice Agreement in force at the filing date (the 10th edition as from 01/01/2012) will be applied to the classification of the goods or services in an application (available at: <http://tmclass.tmdn.org/ec2/>). Rule 2 requires the applicant to furnish a list of goods and services in the following manner:

- The list must be worded in such a way as to indicate clearly the nature of the goods or services and to allow each item to be classified in only one class of the Nice Classification.
- The goods or services must be grouped according to the Nice Classification, each group preceded by the number of the class to which the goods or services belong and presented in the order of the classification.

The Nice Classification consists, for each class, of:

- a) *Class headings*. The class headings are general indications relating to the field to which, in principle, the goods or services belong.

b) *Explanatory notes.* The explanatory notes explain which goods or services are meant or not meant to fall under the class headings and are to be considered an integral part of the Classification.

c) *The Alphabetical List.* The Alphabetical List shows how individual goods or services are appropriate to a class.

d) *General remarks.* If a term cannot be classified in accordance with the Class Headings or Alphabetical List the following criteria should be applied:

Goods

(a) A finished product is in principle classified according to its function or purpose. If the function or purpose of a finished product is not mentioned in any class heading, the finished product is classified by analogy with other comparable finished products, indicated in the Alphabetical List. If none is found, other subsidiary criteria, such as that of the material of which the product is made or its mode of operation, are applied.

(b) A finished product which is a multipurpose composite object (e.g. clocks incorporating radios) may be classified in all classes that correspond to any of its functions or intended purposes. If those functions or purposes are not mentioned in any class heading, other criteria, indicated under (a), above, are to be applied.

(c) Raw materials, unworked or semi-worked, are in principle classified according to the material of which they consist.

(d) Goods intended to form part of another product are in principle classified in the same class as that product only in cases where the same type of goods cannot normally be used for another purpose. In all other cases, the criterion indicated under (a), above, applies.

(e) When a product, whether finished or not, is classified according to the material of which it is made, and it is made of different materials, the product is in principle classified according to the material which predominates.

(f) Cases adapted to the product they are intended to contain are in principle classified in the same class as the product.

Services

(a) Services are in principle classified according to the branches of activities specified in the headings of the service classes and in their Explanatory Notes or, if not specified, by analogy with other comparable services indicated in the Alphabetical List.

(b) Rental services are in principle classified in the same classes as the services provided by means of the rented objects (e.g., Rental of telephones, covered by Class 38). Leasing services are analogous to rental services and therefore should be classified in the same way. However, hire- or lease-purchase financing is classified in Class 36 as a financial service.

(c) Services that provide advice, information or consultation are in principle classified in the same classes as the services that correspond to the subject matter of the advice, information or consultation, e.g., transportation consultancy (Cl. 39), business management consultancy (Cl. 35), financial consultancy (Cl. 36), beauty consultancy (Cl. 44). The rendering of the advice, information or consultancy by electronic means (e.g., telephone, computer) does not affect the classification of these services.

(d) Services rendered in the framework of franchising are in principle classified in the same class as the particular services provided by the franchisor (e.g., business advice relating to franchising (Class 35), financing services relating to franchising (Class 36), legal services relating to franchising (Class 45)).

3.3. Administrative tools for classification purposes

When filing an electronic application through e-filing users can select pre-approved terms to build their list of goods & services. All those selectable terms originate from a harmonised database and will automatically be accepted for classification purposes. Using these pre-approved terms will facilitate a smoother trade mark registration process. The harmonised database brings together terms which are accepted for classification purposes in a number of EU offices.

Should the applicant use a list of goods & services containing terms that are not found in the harmonised database, the Office will verify through an examination procedure whether they can be accepted.

Before filing an application the content of the harmonised database can be searched through the Office's tool TMclass (<http://tmclass.tmdn.org/ec2/>). This tool brings together classification databases of Participating Offices within and outside the EU and shows whether a term can be accepted in a particular jurisdiction. Within TMclass goods and services are grouped according to shared characteristics from a market perspective, starting from more general and ending at more specific terms. This way, the user is provided with a simplified search, and is given a better overview of the content of each class facilitating the selection of appropriate terms.

This grouping and ranking, also called Taxonomy, has no legal effect. In particular, the scope of protection of a Community trade mark is always defined by the natural and usual meaning of the chosen terms, not by the position of the terms in the Office's classification tools.

3.4. Wording of the list of goods and services

3.4.1. Use of class headings

The former practice of the Office, according to which the use of all the general indications listed in the class heading of a particular class constituted a claim to all goods or services falling under the class was abandoned in June 2012, following the judgment No. C 307/10 of the ECJ in the case "IP Translator" (see the President's Communication No 2/12 of 20/06/2012). All goods or services covered by a CTM application – including general indications of the class headings – will be interpreted by the Office on the basis of their natural and usual meaning.

3.4.2. Terms and expressions lacking clarity and precision

In collaboration with the Trade Mark Offices of the European Union, the Offices of Switzerland and Norway, the WIPO and various user associations, the Office has established a list of general indications of the class headings of the Nice Classification which are deemed not to be sufficiently clear and precise in accordance with the judgment of the Court of Justice of 19 June 2012 in Case C-307/10 *The Chartered Institute of Patent Attorney v Registrar of Trade Marks* ('IP TRANSLATOR').

The 197 general indications of the Nice class headings were examined with respect to the requisites of clarity and precision. Of these, 11 were considered to lack the clarity and precision to specify the scope of protection that they would give, and consequently cannot be accepted without further specification. These are set out below, highlighted in bold.

- Cl. 6 – **Goods of common metal not included in other classes**
- Cl. 7 – **Machines** and machine tools
- Cl. 14 – Precious metals and their alloys and **goods in precious metals or coated therewith**, not included in other classes
- Cl. 16 – Paper, cardboard and **goods made from these materials [paper and cardboard]**, not included in other classes
- Cl. 17 – Rubber, gutta-percha, gum, asbestos, mica and **goods made from these materials [rubber, gutta-percha, gum, asbestos and mica]** and not included in other classes
- Cl. 18 – Leather and imitations of leather, and **goods made of these materials [leather and imitations of leather]** and not included in other classes
- Cl. 20 – **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**
- Cl. 37 – **Repair**
- Cl. 37 – **Installation services**
- Cl. 40 – **Treatment of materials**
- Cl. 45 – **Personal and social services rendered by others to meet the needs of individuals**

In some cases, a part of a general indication may be considered to be sufficiently clear and precise if used on its own, for example, in the general

indication “Machines and machine tools”, the description ‘machine tools’ on its own would be acceptable because it describes a specific type of goods. Where this applies, the part of the general indication is shown in grey. However this does not apply to the phrase “, not included in other classes”.

The reasons why each of the 11 general indications of the Nice class headings are not clear and precise are expressed below.

- Cl. 6 – **Goods of common metal not included in other classes** - In light of the need for clarity and precision, this term does not provide a clear indication of what goods are covered as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and / or purposes, that may require very different levels of technical capabilities and know-how to be produced and / or used, could be targeting different consumers, be sold through different sales channels, and therefore relate to different market sectors.
- Cl. 7 – **Machines** and machine tools - In light of the need for clarity and precision, the term “machines” does not provide a clear indication of what machines are covered. Machines can have different characteristics or different purposes, they may require very different levels of technical capabilities and know-how to be produced and / or used, could be targeting different consumers, be sold through different sales channels, and therefore relate to different market sectors.
- Cl. 14 – Precious metals and their alloys and **goods in precious metals or coated therewith, not included in other classes** - In light of the need for clarity and precision, the term “goods in precious metals or coated therewith, not included in other classes” does not provide a clear indication of what goods are covered, as it simply states what the goods are made of or coated with, and not what the goods are. It covers a wide range of goods that may have very different characteristics, that may require very different levels of technical capabilities and know-how to be produced, could be targeting different consumers, be sold through different sales channels, and therefore relate to different market sectors.
- Cl. 16 – Paper, cardboard and **goods made from these materials, not included in other classes** - In light of the need for clarity and precision, the term “goods made from these materials [paper and cardboard], not included in other classes” does not provide a clear indication of what goods are covered, as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and / or purposes, that may require very different levels of technical capabilities and know-

how to be produced and / or used, could be targeting different consumers, be sold through different sales channels, and therefore relate to different market sectors.

- Cl. 17 – Rubber, gutta-percha, gum, asbestos, mica and **goods made from these materials and not included in other classes** - In light of the need for clarity and precision, the term “goods made from these materials [rubber, gutta-percha, gum, asbestos and mica] and not included in other classes” does not provide a clear indication of what goods are covered as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and / or purposes, that may require very different levels of technical capabilities and know-how to be produced and / or used, could be targeting different consumers, be sold through different sales channels, and therefore relate to different market sectors.
- Cl. 18 – Leather and imitations of leather, and **goods made of these materials and not included in other classes** - In light of the need for clarity and precision, the term “goods made of these materials [leather and imitations of leather] and not included in other classes” does not provide a clear indication of what goods are covered, as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and / or purposes, that may require very different levels of technical capabilities and know-how to be produced and / or used, could be targeting different consumers, be sold through different sales channels, and therefore relate to different market sectors.
- Cl. 20 – **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** - In light of the need for clarity and precision, this term does not provide a clear indication of what goods are covered as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and / or purposes, that may require very different levels of technical capabilities and know-how to be produced and / or used, could be targeting different consumers, be sold through different sales channels, and therefore relate to different market sectors.
- Cl. 37 - **Repair** - In light of the need for clarity and precision, this term does not provide a clear indication of the services being provided, as it simply states that these are repair services, and not what is to be repaired. As the goods to be repaired may have different

characteristics, the repair services will be carried out by service providers with different levels of technical capabilities and know-how, and may relate to different market sectors.

- Cl. 37 – **Installation services** - In light of the need for clarity and precision, this term does not provide a clear indication of the services being provided, as it simply states that these are installation services, and not what is to be installed. As the goods to be installed may have different characteristics, the installation services will be carried out by service providers with different levels of technical capabilities and know-how, and may relate to different market sectors.
- Cl. 40 – **Treatment of materials** - In light of the need for clarity and precision, this term does not give a clear indication of the services being provided. The nature of the treatment is unclear, as are the materials to be treated. These services cover a wide range of activities performed by different service providers on materials of different characteristics requiring very different levels of technical capabilities and know-how, and may relate to different market sectors.
- Cl. 45 – **Personal and social services rendered by others to meet the needs of individuals** - In light of the need for clarity and precision, this term does not give a clear indication of the services being provided. These services cover a wide range of activities performed by different service providers requiring very different levels of skill and know-how, and may relate to different market sectors.

CTM applications including one of the above-mentioned eleven general indications will be objected as being too vague. The applicant will be asked to specify the objected term (see Section 3.5.4.).

3.4.3. Vague terms

Any list of goods and services must be sufficiently clear and precise. Terms which are incomprehensible, even taking into account the scope of the class in which they are classified, should be objected to.

Examples of expressions which are considered to be vague, even when defined by the class in which they are applied for, are:

- *“Electric/electronic apparatus/instruments”*
- *“Association services”*
- *“Facilities management services”*

They all must be specified.

3.4.4. Punctuation

The use of correct punctuation is very important in a list of goods and services, almost as important as the words.

The use of commas serves to separate items within a similar category or expression. For example, “*Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes*” of Class 17 must be read as that the goods can be or are made from any of those materials.

The use of a semi-colon means a separation between expressions. For example, Class 30: “*flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder*” must be interpreted that the terms “*honey and treacle*” are independent from the other terms and do not form part of “*preparations made from...*”.

The separation of terms by incorrect punctuation can lead to changes in meaning and possible incorrect classification.

For example, in “*Computer software for use with agricultural machines; agricultural machines*” in Class 9: in this list of goods and services the inclusion of a semi-colon, means that the term “*agricultural machines*” must be considered as an independent category of goods. However, these are proper to Class 7, regardless of whether the intention was to protect computer software to be used in the field of agricultural machines.

A further example would be Class 35: “*Retail services in relation to clothing; footwear; headgear*”. The use of a semi-colon renders the terms “*footwear*” and “*headgear*” as goods, which are separate and not included in the retail services. In such cases, the examiner should separate the terms by commas, inform the applicant and give it the opportunity to comment on the examiner’s proposal.

3.4.5. Use of words to determine the scope of the list of goods/services

The use of the words “*namely*” or “*being*” is acceptable, but must be understood to be a restriction to the specific goods and services which are listed thereafter. For example, “*pharmaceutical preparations, namely analgesics*” in Class 5 means that the application only covers analgesics and not any other type of pharmaceuticals.

The expression “*in particular*” can also be accepted as it serves to indicate an example of the goods and services which are applied for. For example, “*pharmaceutical preparations, in particular analgesics*” means that the application covers any kind of pharmaceuticals, with “*analgesics*” being an example.

The same interpretation applies to the use of the terms “*including*”, “*including (but not limited to)*”, “*especially*” or “*mainly*” as in the example “*pharmaceutical preparations, including analgesics*”.

What would normally be considered a vague term can be made acceptable by making them specific by using “*namely*” and a list of acceptable terms? An example would be, Class 9: “*electrical apparatus, namely computers*”).

However, it should be noted that vague terms would not be made specific, or acceptable, by the addition of such terms as “*including*” or “*in particular*”. The example “*electrical apparatus, including computers*” would not be acceptable as it remains vague.

3.4.6. Reference to other classes within the list

References to other class numbers within a class are not acceptable for classification purposes. For example, the descriptions (in Class 39) “*transport services of all goods in classes 32 and 33*” or (in Class 9) “*computer software in the field of services in Classes 41 and 45*” are not acceptable as in both cases the terms are too vague and lack legal certainty as to what goods and services are covered. The only way to overcome the objection to these lists of goods and services will be for the respective goods of Classes 32 and 33, and the services of Classes 41 and 45 to be specified.

The term “*...goods not included in other classes...*” is not acceptable in service classes because this expression only has a sense in its original goods class.

For example, the heading of Class 24 reads “*Textiles and textile goods, not included in other classes; bed and table covers*”. In that context the reference to “*...not included in other classes*” is meaningful. However, if that same term is used in a service class list of goods and services it cannot make sense. For example: Class 39: “*transport services of textiles and textile goods, not included in other classes; bed and table covers*”. The mention of “*...not included in other classes*” must be deleted.

3.4.7. Trade Marks in a list of goods/services

Trade Marks can not appear within a list of goods and services as if they were a generic term or a category of goods. In such cases, the examiner will object to the inclusion of the term, and request its replacement by a generic term for the goods or services.

Example:

- Class 9: “*electronic devices for transmission of sound and images; video players; CD players; iPods*”

Since iPod™ is a trade mark, the applicant shall be requested to replace it by a synonym such as (“a small portable digital audio player for storing data in a variety of formats including MP3”).

Other examples are Caterpillar™ (the correct classification would be “crawler type vehicle”), Discman™ (“portable compact disc player”), Band-Aid™ (“sticking plasters”), Blu Ray discs™ (“optical storage discs”) or Teflon™ (“nonstick coating based on polytetrafluoroethylene”). This list is not exhaustive and in cases of doubt examiners should refer cases to a relevant expert within the office.

3.5. Procedure of examination

3.5.1. Use of the TMclass classification tool

TMclass is the Office's classification database; it is made up of all of the terms from the Nice Classification, from terms from the Trilateral database (terms suggested and checked by the OHIM, the U.S. Patent Office, and the Japanese Patent Office), a Bilateral database (OHIM and the USPTO), and terms from the U.K. and Swiss classification databases. All of these terms have been thoroughly checked, and every term in the database must be accepted for classification purposes.

Each new application has its list of goods and services electronically checked against the TMclass database. If terms are not found in the TMclass database, examiners will verify whether the goods or service can be accepted in the class proposed by the applicant.

Taxonomy (see Section 3.3.) has been implemented in TMclass. This offers users a simplified search and a better overview of the content of each class facilitating the selection of appropriate terms. The Taxonomy structure is based on Nice Classification terms, starting from more general and ending at more specific terms.

3.5.3. Assessment of the list of goods and services

Any part of the list of goods and services which does not match the data in TMclass will be examined following the criteria specified under section 3.2 above. Examiners will initially look for analogous terms on TMclass. They may also refer to other sources of information such as specialized dictionaries, or the Internet.

If a term in an application is correct to the class in which it is applied for then it must be accepted. It does not matter that it may also appear in other classes.

For example, if the applicant includes “gloves” in Class 28, it is assumed that protection is sought for sports gloves, which belong to that class. It does not matter that other types of gloves may also be found under Classes 9, 10, 21, 24 or 25.

This principle is not incompatible with the obligation to exclude terms which are unclear or vague. The term “*gloves*” in Class 28 is unambiguous and can be understood to refer to a specific product (sport gloves).

3.5.4. Objections

Where examiners consider that there is a need to amend the list of goods and services they should, if possible, discuss the issue with the applicant. Whenever reasonably possible the examiner should offer a proposal for a correct classification. If the applicant submits a long list of goods/services which is not grouped under Class numbers or classified at all (such as happened under old German practice), then the examiner should simply object under Rule 2, and ask the applicant to furnish the list in a form that complies.

The response from the applicant must, under no circumstances, alter or extend the scope or range of goods or services.

Where the applicant has failed to identify any classes, or has incorrectly identified the class(es) for the goods or services, then any further explanation of the scope of the application may extend the number of classes required to accommodate the list of goods. It does not automatically follow that the list itself has been extended.

Example: An application covering “*beer, wine and tea*” in Class 33 should be corrected to:

- Class 30, “*Tea*”;
- Class 32, “*Beer*”;
- Class 33, “*Wine*”.

Although there are now three classes covering the goods, the list of goods has not been extended.

When the applicant has correctly attributed a class number to a particular term, this limits the goods to those falling under that Class. For example: an application for: Class 30, “*tea*” may not be amended to ‘Class 5: “*medicinal tea*” as that would extend the goods beyond those applied for.

Where there is a need to amend the classification the examiner will send a reasoned communication with the aim of pointing out the error(s) which have been detected in relation to the list of goods and services. The applicant will be requested to amend and/or to specify the list and the examiner may propose the way in which the items should be classified.

The original period of time allowed to submit observations to the classification deficiency letter can only be extended once. No further extensions will be granted unless exceptional circumstances apply.

Only where necessary, for example, following a long and detailed exchange of correspondence, should the examiner send a letter to informing the applicant of the definitive agreed list of accepted terms.

3.5.5. Amendments

See also: Manual, [Part E: Register Operations, Section 1: Changes in a registration](#).

Article 43(2) of the CTMR allows for the amendment of an application. This includes the amendment of the list of goods and services provided that “such a correction does not substantially change the trade mark or extend the list of goods and services”.

The amendment can be listed in either positive or negative terms, the following examples are both acceptable:

- “*Alcoholic beverages all being whisky and gin*”.
- “*Alcoholic beverages none being whisky or gin*”.

For classification purposes, two basic requirements must be met in order to make an amendment acceptable:

- (i) the new wording must not in fact constitute an extension of the list of goods and services;
- (ii) the restriction must constitute a valid description of goods and services and the restriction must apply only to goods or services that appear in the original application.

Otherwise, the Office has to refuse the proposed restriction and the list of goods and services will remain unchanged.

Because of point (i) above such amendments must be in the nature of a restriction or deletion of some of the terms originally contained in the application. Once such amendments (deletions) have been received (and later accepted) by the Office, the deleted terms cannot be re-introduced or the remaining list of goods extended.

A restriction may result in a longer list of goods and services than that filed. For example, the original list of goods and services may have been filed as “*Alcoholic beverages*”, but it could be restricted to “*Alcoholic beverages being wines and spirits, but not including whisky or gin and not including liqueurs, cocktails or combinations of beverages containing elements of whisky or gin*”.

In light of all of the above, here are some examples of unacceptable amendments:

- A request to amend the list of goods and services from “*Vehicles; apparatus for locomotion by land, air or water*” in Class 12 to “*batteries for vehicles*”, because these products are proper to Class 9 and were therefore not included in the original list.
- From “*Musical instruments*” to “*Steinway & Sons Pianos*”. Because the amended list of goods and services contains a Trade Mark.

- A request made to restrict the goods from “*Washing machines*” to “*Washing machines for sale in France*”. Because the amendment goes against the concept of the unitary nature of a Community Trade Mark.

In certain circumstances restrictions are acceptable as long as the original term remains in the list of goods and services. Examples of acceptable restrictions:

- “*Catering services for airlines*”, because preparing food for flights is different in nature from preparing food for other occasions.
- “*Clothing for use in the catering industry*”, to the extent that this means specific professional clothing.
- “*Restaurant services, only in holiday resorts*”, the services can be recognized as being “*restaurant services*”.
- “*newspapers, only sold at railway stations*” because the goods can be recognized as being “*newspapers*”.
- “*Cars, but not including cars in the colour blue*” because the goods can be recognized as being “*cars*”.

3.5.6. Addition of Classes

Under the provisions of Article 43(2) (listed above), it is possible to add a class or classes to an application, but only where the goods or services detailed in the original application were clearly included in the wrong class.

For example, if the original list of goods reads:

Class 33: “*Alcoholic beverages including beer, wines and spirits*”

Since “*beer*” is proper to class 32, the applicant will be requested to transfer the term to Class 32, even if class 32 was not listed in the original application. If the applicant agrees then the application will cover goods in classes 32 and 33.

When classes are added additional fees may be payable and the applicant must be informed accordingly.

3.6. Practice on specific items

3.6.1. Inclusion of abbreviations and acronyms in lists of goods and services

Abbreviations within lists of goods and services should be accepted with caution. Trade marks could have an indefinite life, and the interpretation of an abbreviation could vary over time. However, provided that an abbreviation has only one meaning in relation to the class of goods or services applied for, it can be allowed. The very well known examples “*CD-ROMs*” and “*DVDs*” are acceptable in Class 9. If the abbreviation is well known in the field of activity it will be acceptable, but a more practical solution would be for examiners to

initially carry out Internet searches for the abbreviation to determine whether it needs to be expanded into words or the abbreviation or acronym followed by the abbreviation in square brackets (following WIPO's example).

Example: Application in class 45.

- "*Services offering advice on the application and registration of CTMs*".

Could be expanded to:

- "*Services offering advice on the application and registration of Community Trade Marks*";
- or
- "*Services offering advice on the application and registration of CTMs [Community Trade marks]*";

Acronyms can be accepted in a list of goods or services as long as they are comprehensible and appropriate to the Class applied for.

3.6.2. Inclusion of the term "*parts and fittings*"; "*components*" and "*accessories*" in lists of goods and services

The terms "*parts and fittings*"; "*components*" and "*accessories*" are, as single terms or in combination with each other, too vague for acceptance in any Class. Each of the terms requires further qualification to become acceptable.

Parts and fittings.

The qualified term "*Parts and fittings, for motor vehicles*" is acceptable in Class 12. Like the example given in respect of "*accessories*", the term can only cover those goods that are proper to Class 12. There are certain parts and fittings for vehicles that would be proper to other Classes, for example:

- "*Light bulbs*" are proper to Class 11,
- "*Carburettors and catalytic converters*" are proper to Class 7; and
- "*Audio products for use in vehicles; automatic indicators of low pressure in vehicle tires*"; are proper to Class 9.

Components.

Like the terms above and below care should be taken to ensure that the goods can stand up to scrutiny as goods in their own right. Components are usually a smaller, self-contained part of a larger entity. The term often refers to manufactured objects that are designed to be either part of a larger object or to provide a function within another setting. Examples of acceptable use of the term would be:

- "*Electrical circuit components*" (Class 9)
- "*Braking components for machines*" (Class 07)

- “*Building components made of wood*” (Class 19)
- “*Components of metal for assembly into buildings*” (class 6).

Accessories

The term can be accepted in Class 25 for the term “*clothing accessories*”. This term covers a fairly small range of goods, such as “*scarves and belts*”, which are proper to this class. Other items that may be included under the general description of “*clothing accessories*” may be proper to other classes, examples are; “*shoe laces*”, “*buckles*”, “*shoulder pads*”, “*hair slides*” or “*hair bands*”, are all proper to Class 26, and “*handbags and umbrellas*”, which are proper to Class 18.

Punctuation is important so that the parts and fittings, components and accessories, relate to the goods intended by the applicant. The following are examples of acceptable use:

- Class 9: “*Computers and parts and fittings therefore*”.
- Class 9: “*Computers and components for the aforesaid goods*”.
- Class 9: “*Computers; televisions; audio equipment; accessories for all the aforesaid goods*”.

3.6.3. The claim for “All goods/services in this Class” or “all goods/services of the alphabetical list in this Class”

Applications are sometimes submitted for “*All goods in Class X*”, “*All services in class X*” This specification does not comply with Art. 26(1)(c) CTMR which requires a list of the goods or services in respect of which the registration is requested. Consequently, no filing date is awarded.

On other occasions the applicant has correctly listed some goods and/or services to be covered and added, at the end of the listing in each class, the expression “*and all other goods/services in this class*” or “*and all goods/services of the alphabetical list in this class*” (or the like). In those cases, the application may proceed only for the part of the goods and/or services that is correctly listed.

If the applicant intends to protect all goods or services included in the alphabetical list of a particular class, it has to expressly indicate this intention by listing these goods or services explicitly and individually. In order to assist applicants, the use of the hierarchical structure (see Section 3.3.) is encouraged.

A general statement, by which the applicant declares its intention to cover all the goods or services included in the alphabetical list of a given class, will not be accepted. The Office will inform the applicant that those statements are too vague for classification purposes. This is because there is no accurate listing of the goods or services for which registration is requested (Article 26(1)(c) CTMR)

3.6.4. Use of the term “and/or”

The use of oblique strokes is acceptable in lists of goods and services; the most common use is in the phrase “and/or”. It is acceptable for the following examples:

- "Chemical/biochemical products"
- "Chemical and/or biochemical products".
- "Chemicals for use in industry/science"
- "Chemicals for use in industry and/or science"
- "Import/export agency services"

3.6.5. Use of the terms “and the like”; “ancillary”; “associated goods”; “etc”; “and related goods”

The use of qualifiers such as “and the like”, “ancillary”, “and related” and “etc” in a listing of goods or services is, in principle, unacceptable, as the goods or services have not been fully listed.

The use of such terms is not always unacceptable. The terms may be accepted as part of a secondary qualifier, and/or when the goods or services are specific, for example:

- Class 25: “Shirts, tee shirts and polo shirts, for use in games and the like leisure activities”. The goods are recognizable only as “shirts, tee shirts and polo shirts”.
- Class 41: “Training services for the operation of chain saws and related tree-felling apparatus and equipment”. The training services have been limited to those relating to a range of goods determined by their use.
- Class 25: “Sports footwear, including football boots, running shoes, golf shoes, tennis shoes, etc.” The goods are limited to being “sports footwear”.

3.6.6. Use of the terms “including”, “for example”, “namely”, “as well as”, “in particular”, “specifically”

Especial care must be taken to ensure that the use of such adverbs or qualifiers will make it clear and give legal certainty as to what goods and/or services are to be covered. We will not, as a matter of course, remove, delete or otherwise alter these sorts of terms because; to do so could widen the specification beyond that applied for.

The use of the words, “namely” or “being” (or their equivalent in any acceptable Community language), is acceptable and is considered to be a restriction to the goods and/or services which follow. Examples of **acceptable use** would be:

Class 29: <i>“Dairy products namely cheese and butter”</i>	This would restrict the goods to only cheese and butter and exclude all other dairy products
Class 43: <i>“Provision of sports facilities, all being outdoors.”</i>	This would restrict the services to cover only outdoor facilities and exclude any indoor facilities.
Class 25: <i>“Clothing, all being underwear”</i>	This would restrict the goods covered to only that which is considered underwear and will exclude all other types of clothing.

Other words or phrases may only point out that certain goods are important, and the inclusion of the term does not restrict the further listing in any way. Examples would be:

Class 29: <i>“Dairy products, in particular cheese and butter”</i>	The coverage would include <u>all</u> dairy products; cheese and butter are probably the TM owner’s most successful goods.
Class 43: <i>“Provision of sports facilities, for example outdoor running tracks.”</i>	The coverage now extends to both indoor and outdoor facilities without restriction.
Class 25: <i>“Clothing, including underwear”</i>	The coverage extends to all clothing and not just underwear.

3.7. Addendum to Classification Manual

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INTRODUCTION

When classifying the general principles of the Nice classification must be applied.

The purpose of this Addendum is to clarify the classification of certain problematic terms. It also provides notes on classification practice (including words or phrases that should not be used)

The Office's classification database TMclass is available at <http://tmclass.tmdn.org/ec2/>

ADVERTISING SERVICES

In principle, advertising services belong to Class 35. The main entries on advertising services in the list of services in the Nice Classification are

“Advertising”
“Radio advertising”
“Radio commercials”
“Television advertising”
“Television commercials”
“Layout services for advertising purposes”
“Publication of publicity texts”
“Production of advertising films”

These entries cover the design of advertising material and production of commercials, as they are services which will be provided by advertising agencies.

AIR FRESHENING AND PERFUMING PREPARATIONS

See “Perfuming and air freshening preparations”

AMUSEMENT APPARATUS AND ELECTRONIC GAMES

Following changes to the International Classification on 1st January 2012, all “games” (whether electronic or not) are classified in Class 28.

These are shown in the alphabetical list as follows:

“Games (Apparatus for-)”
“Video game machines”
“Arcade video game machines”

Most of these Class 28 devices come loaded with the games. However, if these games are not loaded on the devices, they will be recorded on data carriers or they will be downloadable. In these cases, the games are considered to be game programmes which are especially adapted for use with gaming devices and thus be classified in class 9.

ASSOCIATION SERVICES OR SERVICES PROVIDED BY AN ASSOCIATION TO ITS MEMBERS

These, and similar terms are too vague for acceptance. The type, or scope, of the service being provided needs to be mentioned. Examples of **acceptable** specifications are:

Class 35

“Association services in the nature of business administration services.”

Class 45

“Services provided by an association to its members in the form of legal services.”

See also “Charitable services”

BEAUTY APPARATUS

Class 7

“Sprayers (machines) for applying artificial sun tanning preparations”

Class 8

“Hand-operated instruments/tools for beauty purposes”

“Tattooing needles/apparatus”

“Depilatory apparatus (electric and non-electric)”

Class 10

“Massage apparatus”

“Microdermabrasion apparatus”

“Apparatus for the treatment of cellulite”

“Lasers for cosmetic beauty treatments”

“Laser hair removal apparatus”

“Photoepilation apparatus”

PhotoEpilation is a procedure carried out by pulsed light devices. These devices use the same principle as lasers (i.e. heating up the hair follicle), yet they are not lasers.

Class 11

“Ultra-violet ray lamps for cosmetic purposes”

“Sun beds”

“Steam apparatus for cleaning the skin”

Class 21

“Cosmetic brushes and applicators”

BRINGING TOGETHER OF SERVICES

See “Ordering of services” and “Retail and wholesale services”

BROADCASTING AND/OR TRANSMISSION SERVICES

These services are proper to Class 38; both mean the same thing. The services provided in this area only cover the provision of the means of communication (e.g. the provision of a network of fibre optic cables; the provision of broadcasts or transmissions via geo-stationary satellite transmission facilities, the rental of communications apparatus and systems). Class 38 does **not** cover any programmes, advertising, information or advice which may be transmitted by the means of telecommunications or broadcasting technology. Those services would remain in the appropriate classes

BROKERAGE SERVICES

These are services provided by an individual or company whereby they buy and sell commodities for a fee or commission. The fee may be charged to the buyer or the seller of the commodity (or both). The broker may never see the goods or services in question.

There are three listed Classes for brokerage services. These are:

Class 35

“Brokerage of name and address based lists.”

Class 36

[A large number of listings for] *“brokerage of futures, carbon offsets, real estate, bonds, securities and other financial based items”*

Class 39

“Brokerage services relating to distribution, transport, and storage”

CASES (AND CARRYING BAGS)

Cases (and bags) adapted for the carrying or transportation of the product they are intended to contain are in principle, classified in the same class as the product they are adapted to carry.

All non-adapted carrying bags are in Class 18.

Some terms may belong to two classes, according to size or adaptation; for example *“laptop bags”* can be accepted in both Class 9 and Class 18.

CHARITABLE SERVICES

This term is too vague for acceptance in any class without further qualification.

Charitable services are defined by the service which is being offered. Therefore they can be classified in any of the service classes, given the correct definition. For example:

Class 35

“Charitable services, namely administration and general office work.”

Class 36

“The organisation of charitable collections; charitable fund raising.”

Class 38

“Charitable services, namely provision of broadband communications.”

Class 39

“Charitable services, namely ambulance transport.”

Class 40

“Charitable services, namely water treatment services.”

Class 41

“Charitable services, namely education and training”

Class 42

“Charitable services, namely environmental protection services.”

Class 43

“Charitable services, namely the provision of food and drink, catering services”

Class 43

“Charitable services, namely providing temporary accommodation”

Class 44

“Charitable services, namely providing medical services”

Class 45

“Charitable services, namely mentoring [personal or spiritual]”

COLLECTION AND STORAGE SERVICES

In the case of physical goods both the collection and storage services would be proper to Class 39. This class includes ‘*transport*’ and ‘*warehousing*’ in its listings. This includes the collection and physical storage of data; whether it is in written form or recorded on media and that media is then housed (Nice has “*physical storage of electronically stored data or documents*” in Class 39).

The “*office service*” of electronically collecting, collating, manipulating and electronically storing and/or retrieving data are all proper to Class 35.

“Collection, storage and provision of images, photos, multimedia content, sound, audio and video data” can also be proper to Class 41 in analogy with library services.

“Storage of digital data” is seen to be in analogy with hosting services, and so is proper to Class 42. *“Cloud computing data storage services”* are also proper to Class 42.

COMPUTER SERVICES

The term *“computer services”* is a term which is acceptable in Class 42 without any further qualification. It is not acceptable in any other class, unless it is limited in some way, to indicate the nature of the services offered.

CONSTRUCTION SERVICES

Construction services are proper to Class 37 and can include the construction of structures such as houses, shops, factories and offices or civil engineering activities like the construction of roads, bridges, dams and so on. The construction of ships is also proper to this class. Construction services do not include the planning, design and architectural services connected therewith; these are proper to Class 42.

Custom construction of certain single, ‘one-off’ products for third parties, for example a sailing boat or a sports car by a specialist in that field would be proper to Class 40. Custom construction of made-to-measure kitchen units would be included in Class 40, but their installation would be proper to Class 37.

CURTAINS AND BLINDS

Blinds, in all their forms, can be used on windows both internally and externally. The classification of these goods depends upon the purpose of the product and its material composition.

Curtains are normally found in use indoors and they are similarly classified according to their material composition.

Examples of acceptable entries are:

Class 6

“Outdoor blinds of metal”

“External metal blinds as part of a building for security purposes”

Class 17

“Curtains of asbestos (safety-)” (The material and use have a strong influence)

Class 19

"Blinds [outdoor] not metal and not of textile." (These goods are probably made of wood or plastic.)

Class 20

"Blinds (slatted indoor)"

"Venetian and vertical window blinds."

"Indoor window blinds"

"Blinds (indoor window) [shades] [furniture]"

"Curtains (bamboo-)"

"Paper blinds"

"Curtains (bead-)[for decoration]"

Class 24

"Outdoor blinds of textile;"

The vast majority of curtains will fall under Class 24 since most domestic curtains (sometimes referred to as 'drapes') are of textiles or plastic.

Care should be taken of any references to curtain walling, or curtain walls. This refers to a type of construction technique relating to buildings and the associated goods are building materials and they are proper to Class 6 (for metal goods) or 19 (for non-metallic goods).

CUSTOM MANUFACTURE/MANUFACTURING FOR THIRD PARTIES

The term "*custom manufacture*" is acceptable in Class 40 and is usually interpreted as the manufacture of goods for third parties; this would include for example the manufacture of cars or boats according to customers' specifications. Note that this is always a particular service which is undertaken on orders from a third party.

The term can also refer to the assembly of complete or partially-completed articles or items on behalf of others. See note under "Construction services" above.

DATA SERVICES

The term cannot be accepted on its own. It must be qualified.

The provision of data can be proper to several classes depending on the way in which the data is provided or on the nature of the data being provided. In each case the exact nature of the service being offered will need to be stated "*the provision of data*" is not enough. The following are examples of acceptable terms and their relevant classification:

Class 44

"Collection of data (information) relating to the use of pharmaceuticals"

(This would refer to the systemised collection of data which could only be interpreted by someone with specialised medical training)

Class 45

“Collection and interpretation of data relating to animal tracking”

(This would refer to services in relation to the relocation of a lost or stolen animal. If the data was for other purposes then the classification would be proper to other classes e.g. Class 42 for measuring or scientific reasons)

DESIGN SERVICES

“Design services” are, as such, proper to Class 42.

“Design of advertising” and *“design of brand names”* are both proper to Class 35 as these are both part of advertising services.

Likewise *“landscape design”*, *“floral design”*, *“turf design”* and *“planning [design] of gardens”* are proper to Class 44 as these are horticultural services.

DOWNLOADABLE GOODS

All material which is downloadable is proper to Class 9; this includes publications, music, ring tones, pictures, photographs, films or film extracts, etc. The result of the download is that the material is captured onto the drives or memory of a computer, telephone or PDA where it operates independently of the source from whence it came. These can also be called *“virtual goods”*; all these downloadable goods can be retailed.

ELECTRICITY AND ENERGY

The following is a guide to some of the goods and services which surround electricity.

Class 4

“Electrical energy”

Class 7

“Electrical generators”

Class 9

“Apparatus and instruments for conducting, switching, transforming, accumulating, regulating, or controlling electricity”

“Solar cells for electricity generation”

“Photovoltaic cells and modules”

Class 36

“Brokerage of electricity” (see also note under “Brokerage services”)

Class 39

“Distribution of electricity”

“Storage of electricity”

Class 40

“Generation of electricity”

See also entry on “Solar power” below.

ELECTRONIC AND ELECTRIC APPARATUS

The term “*electronic and electric apparatus/devices/instruments*” is too vague for classification purposes; it is not acceptable in any goods class, and should be specified.

Please be aware that specifications of “*electronic and electric apparatus/devices/instruments*” such as listed below are considered too vague as well:

- for controlling the environment
- for household purposes
- for use in hairdresser saloons

ELECTRONIC GAMES

See guide at “Amusement apparatus and electronic games”

FRANCHISING

It may be useful to define what franchising services are. The verb “franchise” refers to the giving or selling of a franchise to another party. As a noun “franchise” means “the authorisation granted to an individual or group by a company to sell its products or services in a particular area” (Oxford English Dictionary).

Under General Remarks to the Nice Classification (10th Edition) it says:

(d) Services rendered in the framework of franchising are in principle classified in the same class as the particular services provided by the franchisor (e.g., business advice relating to franchising (Class 35), financing services relating to franchising (Class 36), legal services relating to franchising (Class 45)).

The Office will accept within Class 35 the term “*franchise service*” or “*franchising services*”. The term would cover a limited range of activities.

GPS SYSTEMS – LOCATION, TRACKING AND NAVIGATING

GPS and satellite navigation systems provide location, tracking and navigating services, to provide the user with information.

The easiest way classify these services is to divide them into those services which provide the telecommunications which run the services, (Class 38), and those services which provide information via the GPS device. The range of information provided goes beyond mere travel route information (Class 39), it

can include information regarding restaurants and accommodation (Class 43), information regarding shopping outlets (Class 35) or telephone numbers (Class 38).

The use of GPS devices in relation to the movement of vehicles and people can also lead to classifications over a range of classes. The route planning services (Class 39) have already been mentioned. This classification would also extend to logistic or freight moving companies keeping track of their vehicles using the same devices.

GPS systems can also be used in conjunction with other technology, to locate the source of a mobile telephone signal. If this is being done as part of a telecommunication service it will be proper to Class 38. If, however, it is being done as part of a criminal investigation service it would be proper to Class 45.

There are other services that can be associated with the services listed above. For example the creation of maps for GPS systems is proper to Class 42. The downloadable applications which run the service or provide alternative “voices” are proper to Class 9. The retail services for providing the downloadable applications are proper to Class 35.

The examples below demonstrate how these and other terms are classified.

Class 35

“Compilation and provision of commercial directory information regarding service providers for GPS navigation”

Class 38

“Satellite transmissions” (Nice 9th Edition)

“Providing public subscribers directory information for GPS navigation”

“Providing access to general information supplied via satellite transmission”

“Telecommunications services for location and tracking of persons and objects”

“Tracking of mobile telephone via satellite signals”

“Location of mobile telephones via satellite signals”

“Providing access to GPS navigation services via satellite transmission”

“Satellite transmission of navigation data”

Class 39

“Providing GPS navigation services”

“Providing traffic information services via satellite transmission”

“Providing road information services via satellite transmission”

“Location services for logistics purposes of vehicles and goods”

“Tracking services for logistics purposes of vehicles and goods”

Class 42

“Providing weather information via satellite transmission”

“Creation of GPS maps”

Class 45

“Providing public amenity and civic directory information for GPS navigation”

“Tracing and locating of missing persons via satellite transmission”

“Tracking of persons carrying electronic tagging devices”

“Security tracking services of vehicles”

“Security location services of vehicles”

HAIR STYLING

Class 8

Most of the “*electric and non-electric hair styling apparatus*” is classified in class 8.

(e.g. “*Electric hair curling irons*”; “*Hair tongs*” [non-electric hand implements];

“*Crimping irons for the hair*” etc)

Except:

Class 9

“*Electric hair curlers/rollers*” (e.g. CARMEN™ CURLERS)

Class 26

“*Hair curlers/rollers, other than hand implements*”

Class 11

“*Hair dryers*”

Class 21

“*Combs and brushes*” (non-electric and electric)

HIRE SERVICES

See guide at “Rental services”

HUMANITARIAN AID SERVICES

Office practice on “*humanitarian aid services*” is the same as that on “*charitable services*”; the nature of the services must be specified (see section on “Charitable services”).

INTERNET SERVICES, ON-LINE SERVICES

The term “*Internet services*” is too vague for acceptance in any class. It must be further defined.

There are a range of services, offered by individuals and business to other individuals and businesses, which relate to the setting up, operation and servicing of Internet web-sites. There are appropriate listings for these services across a range of service Classes.

There is an even wider range of services offered to customers through the medium of telecommunications including via the Internet. You can shop over

the Internet, obtain advice about your bank account, learn a new language, or listen to a 'local' radio station which is situated on the other side of the world.

The application of the Nice classification system generally applies regardless of whether the service is provided face-to-face, in dedicated premises, over a telephone, on-line from a database or from an Internet web site. However, there can therefore be confusion as to where certain goods and services are to be correctly classified.

For example, since the explosion of the Internet in the last two decades, many publications which had been sold solely in the form of printed matter (for example newspapers) are now also available on the Internet. In most cases these electronic publications are designed for viewing on-line, and the provision of such publications is considered to be a service which is proper to Class 41.

KITS AND SETS

It is common in trade for certain goods to be sold in groups of more than one item. If the items are all the same, e.g. a pack of three toothbrushes, then the classification is simple. However, sometimes the collection of goods could be component parts of another item, or have a function which is not defined by the individual goods. These groups of goods sometime have collective names such as kit or set. These small words can have a big impact on (1) the acceptability as collection of goods and (2) the appropriate classification.

A kit can mean either (i) a set of parts ready to be made into something (for example: *"a kit for a model plane"*) or (ii) a set of tools or equipment that is to be used for a particular purpose (for example: *"a first-aid kit"*).

A set is a number of articles that are thought of as a group. This may have a defined number or not. (for example; *"a set of keys"*, *"a set of saucepans"*, *"a set of golf clubs"*; *"a cutlery set"*).

"Kits" appear in the International Classification, for example, as in the following example:

Class 3

"Cosmetic kits"

Class 5

"First aid kits" (seen as a collection of plasters and treatments)

It sometimes happens that the individual goods which make up the kit or set would normally be classified in more than one class. However the Office will not object to acceptance of such collective terms, provided that they make sense and/or are in common usage. The difficulty comes in determining the correct Class for them.

Class 3

“Shoe cleaning kits” (seen as a collection of cleaning products)

Class 21

“Shoe cleaning kits” (seen as a collection of brushes and cloths)

When determining the correct classification for a kit or set, it is necessary to understand either; what the kit is going to be used for, or alternatively, if it going to make or construct something from its components, what the finished article will be.

Further examples of acceptable terms would be:

Class 8

“Manicure and pedicure sets”

Class 9

“Hands free kits for phones”

Class 12

“Tyre repair kits (for repairing a vehicle part that is in Class 12)”

Class 27

“Rug making kit”

Class 28

“Scale model kits [toys]”

“Toy model kits”

Class 32

“Beer making kits”

Class 33

“Wine making kits”

LEASING

The General Remarks in the Nice Classification (10th Edition) say:

“Leasing services are analogous to rental services and therefore should be classified in the same way. However, hire- or lease-purchase financing is classified in Class 36 as a financial service.”

Also see guide at “Rental services”

MAIL ORDER

See also in this addendum “Retail and wholesale services “.

MANUALS (FOR COMPUTERS, ETC.)

Electronic items such as computers, printers, photocopiers and other electronic items are often delivered as new goods to the customer with a list of operating instructions. The instructions can be in paper (printed) format, or in an electronic format, such as a recording on a disc, or as a downloadable or non-downloadable document available at the manufacturer's web-site.

"Manuals" as such in Class 9 will be accepted as they are seen to be electronic and/or downloadable publications.

Other examples of this would be:

Class 9

"Computer software and hardware and associated manuals in electronic format sold as unit therewith"

Class 16

"Manuals sold as a unit with computer software and hardware"

MANUFACTURING

This is not a service as such, except when it is undertaken for third parties and must be specified as such. See entry on "Custom manufacture/manufacturing for third parties" above.

NEWS SERVICES

"News agency services" are proper to Class 38. They are essentially a hub or collection point through which journalists and others can file and obtain newsworthy materials (in the form of stories, script or photographs). They do not perform any other function such as editing or verification services.

"News gathering and dissemination services" are proper to Class 41. News has no boundaries, the subject could be anything.

Other examples are:

Class 38

"News broadcasting services"

Class 40

"Printing of newspapers"

Class 41

"Presentation of news (programmes)"

"Publication of news"

"Editing of news"

“Downloadable news pod casts”, “news clips”, “news items”, “news publications”, etc are all goods which are proper to Class 9.

ON-LINE SERVICES

See guide at “Internet services, on-line services”

ORDERING OF SERVICES

“The ordering of goods/services for others” can be accepted in Class 35 as a business service/office function. There are individuals and companies who offer services of providing solutions to a variety of problems on behalf of others, e.g. if you need a leaking tap to be fixed, the intermediary (service provider) will arrange the services of a plumber for you. This classification is in analogy with 9th Ed. Nice Classification Class 35 “*Procurement of services for others [purchasing goods and services for other business]*”.

PERFUMING AND AIR FRESHENING PREPARATIONS

There is logic to the classification of these goods. There are preparations which serve to merely mask unpleasant smells (perfume) and there are preparations which chemically “wrap-up” and remove unpleasant odours. The relevant listings in the WIPO guide include:

Class 3

“Air fragrancing preparations”

“Incense”

“Potpourris [fragrances]”

“Sachets for perfuming linen”

“Scented wood”

“Fumigation preparations [perfumes]”

“Room sprays”

Class 5

“Air deodorising preparations”

“Air purifying preparations”

Other goods which may release pleasant odours include “perfumed candles” which are proper to Class 4 (the release of perfume is a secondary characteristic) and “perfumed drawer liners” (proper to Class 16 as being analogous to “packaging material” and usually made of paper).

PERSONAL AND SOCIAL SERVICES RENDERED BY OTHERS TO MEET THE NEEDS OF INDIVIDUALS

The general indication “personal and social services rendered by others to meet the needs of individuals” is not clear and precise enough and will not be accepted by the Office (see Section 3.4.2.).

The wording needs to be specified by the applicant.

There are many personal and social services that are classifiable, but are proper to Classes other than Class 45. These include:

Class 36

"Personal insurance services" (such as life assurance)

Class 41

"Personal tuition"

Class 44

"Personal medical services"

Class 45

"Personal body guarding"

"Consultancy services relating to personal appearance"

"Personal tour guide services"

"Personal shopping services"

PRECIOUS METAL GOODS

The general indication "goods of precious metals or coated therewith, not included in other classes" in class 14 is not clear and precise enough and will not be accepted by the Office (see Section 3.4.2.). The applicant needs to specify the wording of the term.

Caution needs to be applied when classifying goods made from precious metals.

Historically, virtually all goods which were made from, or coated with, precious metals were grouped together in Class 14. It was considered that the material had an influence on why the goods were bought, and that in turn determined where the goods were classified.

Since 1st January 2007, the classification of many goods that would have been in Class 14 has been re-classified. The reclassification of the goods is based upon their function, rather than their material from which they are made.

The following goods are examples of goods which are classified according to their function or purpose:

Class 8

"Cutlery of precious metal"

Class 16

"Pen nibs of gold"

Class 21

"Teapots of precious metal"

“Candlesticks of precious metal”

“Containers of precious metal”

Class 34

“Cigarette and cigar boxes made of precious metals”

There are however some goods remaining in class 14 which can be made of precious metal, these are jewellery, clocks and watches.

PROTECTIVE CLOTHING

The heading of Class 9 includes the term “life saving apparatus and instruments”. Some of that category of goods could be designed to be worn on the person. If items that are worn (or sometimes carried) have their **primary** function as the prevention of serious and/or permanent injury, or death; if that protection is offered against, for example contact with or exposure to extremes of temperature, chemicals, radiation, fire, or environmental or atmospheric hazards, then those goods would be proper to Class 9.

Examples of such protective goods would include the hard-hats worn on building sites, and the helmets worn by security guards, horse riders, motorcyclists, and American football players. Bullet-proof vests, metal toe-capped shoes, fireproof jackets and metal butchers’ gloves are examples of these: they are not clothing as such. Aprons, smocks and overalls which merely protect against stains and dirt are not proper to Class 9 but to Class 25 as general clothing: protective sporting articles are proper to Class 28: none of these protect against loss of life or limb.

RENTAL SERVICES

Rental or hire services are classified, in principle, in the same class as the services provided. For example, the rental of cars falls in Class 39 (transport), rental of telephones in Class 38 (telecommunications), rental of vending machines in Class 35 (retail services). The same principle applies to “*leasing services*” which are found on TMclass in all of the service classes.

RETAIL AND WHOLESALE SERVICES

As regards “*retail services*” or other services in class 35 limited to activities around the sale of goods, the Office applies ECJ C-418/02, “Praktiker”: “*Retail services*” are acceptable, with or without specification of the nature of the retail activity (e.g., “supermarket”), as long as the type of goods sold at retail is indicated. For details, see Communication No 7/05 of the President of the Office.

There is an indication in the explanatory note to the listing of Class 35 in the 10th Edition of the Nice Classification Guide, that the term “*the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase*”

these goods” is acceptable in Class 35. However, the principles established in the ‘Praktiker’ case still apply, and the acceptance of this term will only be allowed if an indication of the nature of the goods is attached to the term.

Retail services is defined as “*The action or business of selling goods in relatively small quantities for use or consumption*” (Oxford English Dictionary), which to scope of the services which is covered by this term.

The same principles apply to similar services rendered in connection with other forms exclusively related to the sales of goods, such as wholesale services, mail order services and e-commerce services.

If the nature of the place in which the goods are sold in is sufficiently specific to allow the recognition of the category of the goods, this will also be accepted; acceptable wordings are:

“Retail services relating to clothes shops”.

“Retail services relating to garden centres”.

“Retail services relating to bakers”.

As shown in the Communication of the President, the term “*retail services of a supermarket*” and, by extension, “*retail services of a department store*” and similar terms are not acceptable as the goods to be sold are not defined.

Broad categories such as “*retail services relating to foodstuffs, white goods, electric and electronic goods*” are acceptable as the goods are ascertainable.

Examples of categories of goods which are seen as being too vague for classification purposes are as follows:

“Merchandising articles”

“Fair-trade goods”

“Lifestyle accessories”

“Gift articles”

“Souvenirs”

“Collectors’ articles”

Examples of categories of goods which are not acceptable in relation to retail as they are seen as a service proper to a different class:

“Financial products” - these are in fact financial services classified in class 36.

“Lottery tickets” - these are lottery services classified in class 41.

“Airplane tickets” – these are part of travel agency services classified in class 39.

Finally, retail services for non-acceptable general indications of the class headings (see Section 3.4.2.) are not acceptable. For example, the Office will not accept “*retail services for machines*”. However, “*retail services in relation to agricultural machines*” would be sufficiently precise and acceptable.

The specification of the goods by terms such as “including, in particular, for example, featuring, specifically, such as” is not precise enough since all these terms mean, in principle, “for example”. They do not restrict the goods which follow. Consequently, the above mentioned terms should be replaced by

“namely or being” as – as such - it will restrict the goods which follow those terms.

SATELLITE TRACKING

See “GPS Systems – Location, tracking and navigating” above

SETS

See guide at “Kits and sets”

SOCIAL NETWORKING SERVICES

“*Social networking services*” is an acceptable term in class 45. It would be seen as a personal service which includes the identification and introduction of like-minded people for social purposes.

There are other aspects of the “social networking” industry which could be proper to Classes other than class 45, for example:

Class 38

“The operation of chatroom services”

“the provision of on-line forums”

SOLAR POWER

Solar power is energy that is derived from the sun and converted into heat or electricity.

Goods relating to the generation and storage of electricity from solar energy are classified in Class 9.

Goods relating to the generation and storage of heat from solar energy are classified in class 11.

Services relating to the generation of electricity from solar energy are classified in class 40.

Class 9

“Photovoltaic cells”

“Solar panels, modules and cells”

Class 11

“Solar collectors for heating”

Class 40

“Production of energy”

STORAGE SERVICES

See “Collection and storage services” above.

SUPPLY OF ...

Care should be taken in the acceptance of this term when it is used to qualify services. It is acceptable in some circumstances, for example, “*supply of electricity*” in Class 39, where the term is often closely allied to “*distribution*”. It is also acceptable in the term “*Catering services for the supply of meals*” (in Class 43) because the material being supplied, and the nature of the service, have both been given.

In the term “*supply of computer software*” (in Class 42) it is not clear what services are being provided. Whilst this class does include the services of “*design, rental, updating and maintaining computer software*”, it is not clear if any of those services are included in the general term “*supply*”. The word is often used as an apparent synonym for retail services but Class 42 does not include such services, they would be proper to Class 35.

SYSTEMS

This is another term which is too vague for acceptance in any Class.

It can be accepted only when qualified in a way that has a clear and unambiguous meaning. For example, the following are acceptable:

Class 7

“*Exhaust systems*”

Class 9

“*Telecommunication systems*”

“*Computer systems*”

“*Alarm systems*”.

Class 16

“*Filing systems*”

TICKETS (FOR TRAVEL, ENTERTAINMENT ETC.)

A ticket is a “promise to supply” in relation to a service, or a reservation service, the right to a service. Examples are:

Class 39

“*Issuing of aeroplane tickets*”.

Class 41

“*Ticket agency services (box office)*”

Note that tickets are not seen as goods retailed in Class 35.