

Nice Classification and Examination of Goods & Services

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Hiroshi MORIYAMA
Director
International Trademark Classification Office
Trademark Division
Japan Patent Office (JPO)

Program of “Nice Classification”

1. Nice Classification and Examination of Goods & Services
2. Search Tools for G&Ss
3. Case study

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- How to overcome the Grounds for Refusal of G&Ss?
- How to examine the similarity of G&Ss in your Office?

1. International Classification of G&Ss

Nice Agreement

(Nice Agreement Concerning International Classification of Goods and Services for the Purposes of the Registration of Marks)

- The special agreement of Article 19 of Paris Convention in 1957
- Number of contracting parties: 84
- Nice Classification is used by more than 150 countries and intergovernmental organizations
- Japan joined the Nice Agreement in 1990

Nice Agreement

- Adoption of a common classification of goods and services for the purposes of the registration of marks
- Indication of the numbers of the classes in official documents and publications
- Committee of Experts of the Nice Union (26 sessions since 1961)
- Adoption of amendments and other changes to the Classification

Outline of the Nice Classification

- Authentic texts: English and French
- Editions:

First	1963
Second	1971
Third	1981
Fourth	1983
Fifth	1987
Sixth	1992
Seventh	1997
Eighth	2002
Ninth	2007
Tenth	2012
Eleventh	2017 (current edition)

Outline of the Nice Classification

Goods: Class 1 – Class 33 (33 classes)

Services: Class 34 – Class 45 (12 classes)

Nice Classification consists of;

- Alphabetical List

- List of Classes
 - Class Headings
 - Explanatory Notes

- General Remarks

Outline of the Nice Classification

General Remarks

- The indications of goods or services appearing in the class headings are general indications relating to the fields to which, in principle, the goods or services belong.
- The Alphabetical List should therefore be consulted in order to ascertain the exact classification of each individual product or service.

Outline of the Nice Classification

General Remarks

■ Goods

- If a product cannot be classified with the aid of the List of Classes, the Explanatory Notes and the Alphabetical List, the following remarks set forth the criteria to be applied:

Outline of the Nice Classification

General Remarks

■ Goods

- (a) finished product is classified according to its function or purpose
- (b) multipurpose composite object
- (c) raw, unworked or semi-worked materials
- (d) goods intended to form part of another product
- (e) material composition of a product
- (f) cases adapted to the product

Outline of the Nice Classification

General Remarks

■ Goods

(a) A finished product is in principle classified according to its function or purpose.

<e.g.> “leather jackets” (Cl.25) not Cl.18

If not mentioned in any class heading, classified by analogy with other comparable finished products.

If none is found, other subsidiary criteria (the material or its mode of operation) are applied.

<e.g.> “figurines of precious metal” (Cl.14)

“figurines of stone” (Cl.18)

“figurines of wood or plastic” (Cl.20)

Outline of the Nice Classification

General Remarks

■ Goods

(b) A multipurpose composite object may be classified in all classes that correspond to any of its functions or intended purposes.

<e.g.> “radio alarm clocks” (both Cl.9 and 14)

Outline of the Nice Classification

General Remarks

■ Goods

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

<e.g.> “cobalt, raw” (Cl.6)

“leather, unworked or semi-worked” (Cl.18)

“wood, semi-worked” (Cl.19)

“raw cotton” (Cl.22)

Outline of the Nice Classification

General Remarks

■ Goods

(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.

<e.g.>

“brushes for vacuum cleaners” (Cl.7) not Cl.21

“ashtrays for automobiles” (Cl.12) not Cl.34

Outline of the Nice Classification

General Remarks

■ Goods

(e) When a product 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.

<e.g.>

“coffee beverages with milk” (Cl.30) not Cl.29

“nut-based spreads” (Cl.29)

“chocolate spreads containing nuts” (Cl.30)

not Cl.29

Outline of the Nice Classification

General Remarks

■ Goods

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

<e.g.> “lipstick cases” (Cl.3)

“cases for smartphones” (Cl.9)

“cases for musical instruments” (Cl.15)

“cigarette cases” (Cl.34)

Outline of the Nice Classification

General Remarks

■ Services

- If a service cannot be classified with the aid of the List of Classes, the Explanatory Notes and the Alphabetical List, the following remarks set forth the criteria to be applied:

Outline of the Nice Classification

General Remarks

■ Services

- (a) services classified according to the branches of activities
- (b) rental services
- (c) advice, information or consultation services
- (d) services relating to franchising

Outline of the Nice Classification

General Remarks

■ Services

(a) Services are in principle classified according to the branches of activities specified in the headings and in their Explanatory Notes or, by analogy with other comparable services.

<e.g.> “online banking” (Cl.36)

“distribution of energy” (Cl.39)

“dentistry services” (Cl.44)

Outline of the Nice Classification

General Remarks

■ Services

(b) Rental services are in principle classified in the same classes as the services provided by means of the rented. Leasing services are analogous to rental services.

<e.g.> “rental of telephones” (Cl.38)

“computer rental” (Cl.42)

“rental of cooking apparatus” (Cl.43)

Outline of the Nice Classification

General Remarks

■ Services

(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.>

“business management consultancy” (Cl.35)

“entertainment information” (Cl.41)

“pharmacy advice” (Cl. 44)

Outline of the Nice Classification

General Remarks

■ 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” (Cl.35)

“financing services relating to franchising” (Cl.36)

“legal services relating to franchising” (Cl.45)

Changes of the Nice Classification

- The Committee of Experts of the Nice Union updates the Nice Classification

- Updating the Nice Classification
 - New Edition: Every 5 years
Transfer of the class/ Creation of any new classes
 - New Version: Every year
Any other changes (additions, deletions, changes of indications)

- **11th Edition** entered into force on January 1, 2017

Main changes in the 11th edition

- Amendments to class headings

- Amendments to list of goods and services
 - New indications
 - Indication to be deleted
 - Existing indications to be changed or transferred

■ Amendments to class headings

■ Class 3

- • • non-medicated soaps; • • • , non-medicated cosmetics, non-medicated hair lotions; non-medicated dentifrices.

Explanatory Note

Class 3 includes mainly cleaning preparations and non-medicated toiletry preparations.

This Class does not include, in particular:

• • •

– medicated shampoos, medicated soaps, medicated hair lotions and medicated dentifrices (Cl. 5); • • •

■ Amendments to class headings

■ Class 5

...

Explanatory Note

...

This Class includes, in particular:

...

– medicated shampoos, soaps, lotions and dentifrices; ...

This Class does not include, in particular:

– sanitary preparations being non-medicated toiletries (Cl.3);

...

■ Amendments to class headings

■ Class 21

...

Explanatory Note

...

This Class includes, in particular: . . .

- small hand-operated kitchen apparatus for mincing, grinding, or pressing or crushing, for example, garlic presses, nutcrackers, pestles and mortars;
- serving utensils, for example, sugar tongs, ice tongs, pie servers and serving ladles; . . .

This Class does not include, in particular: . . .

- table cutlery (Cl. 8); . . .

■ Amendments to list of goods and services

Examples of New Indications

- batteries for electronic cigarettes
- virtual reality headsets
- electronic interactive whiteboards
- humanoid robots with artificial intelligence
- toy robots
- apparatus for the regeneration of stem cells for medical purposes
- wine cellars, electric
- tefillin [phylacteries]

Examples of New Indications (cont.)

- judo uniforms
- karate uniforms
- kimonos
- galbi [grilled meat dish]
- guacamole [mashed avocado]
- edible insects, live
- sado instruction [tea ceremony instruction]
- unlocking of mobile phones
- washoku restaurant services
- reception services for temporary accommodation [management of arrivals and departures]
- human tissue bank services

Examples of Deletions

- Cl.5 headache pencils
- Cl.7 separators
- Cl.16 bookbindings
- Cl.21 strainers
- Cl.24 sanitary flannel

Examples of existing indications to be changed or transferred

- Cl.6: change “safes [strong boxes]” to “safes [metal or non-metal]”
- Cl.11: change “ice boxes” to “cool boxes, electric”
- Cl.28: change “lines for fishing” to “fishing lines”
- Cl.34: change “liquid nicotine solutions for use in electronic cigarettes” to “liquid solutions for use in electronic cigarettes”
- Cl.41: change “services of schools [education]” to “educational services provided by schools”
- Cl.45: change “security consultancy” to “physical security consultancy”

Examples of existing indications to be changed or transferred (cont.)

- Cl.3: transfer of “medicated soap” to Class 5
- Cl.5: transfer of “bracelets for medical purposes” to Class 10
- Cl.8: transfer of “needle-threaders” to Class 26
- Cl.8: transfer of “nutcrackers” to Class 21
- Cl.8: transfer of “sugar tongs” to Class 21
- Cl.9: transfer of “socks, electrically heated” to Class 11
- Cl.16: transfer of “rosaries” to Class 14
- Cl.28: transfer of “wax for skis” to Class 4

2. Examination of G&Ss in JPO

Examination Procedures for trademark applications in Japan

Examination of G&Ss

Article 6 of the Japanese Trademark Act



Examination of Absolute Grounds

(Distinctiveness of Trademarks)

Article 3 of the Japanese Trademark Act



Examination of Relative Grounds

(Public order/Similarity of Trademarks and G&Ss, etc.)

Article 4 of the Japanese Trademark Act

Domestic Legislations for Examination of G&Ss

Article 6 of the Trademark Act

Designation shall be made according to the classification prescribed by the Cabinet Order. (Article 6 (2))

Trademark Law Enforcement Order by Cabinet Order

Classes shall be as shown in the Attached Table.

The Ministerial Ordinance stipulates the Goods/Services that fall under each class **in accordance with the Nice Classification**. (Article 1)

Trademark Law Enforcement Regulations by Ministerial Ordinance

Goods/Services that fall under each class shall be as shown in the Attached Table. (Article 6)

Examination of G&Ss in JPO

- Article 6 (1): Indication of G&Ss
Indications of G&Ss are clear enough?
- Article 6 (2): Classification of G&Ss
G&Ss are classified correctly?

- If not, Grounds for refusal of G&Ss are issued.

(Ref.) Japanese Trademark Act

• Article 6 (1) of the Trademark Act

An application for trademark registration shall be filed for each trademark and designate one or more goods or services in connection with which the trademark is to be used.

• Article 6 (2)

The designation of goods or services shall be made in accordance with the class of goods and services provided by Cabinet Order.

To overcome the Grounds for refusal of G&Ss

- How to overcome the Grounds for refusal?
 - Clarify/specify the scope of designated G&Ss by submitting a written amendment within certain period.
 - Explain the content and scope of designated G&Ss in a written opinion within certain period.

Examination of designated goods and services

- Cases in which requirements of Article 6(1) are not met:
Case 1 – Indications of G&Ss are “Too broad/vague”

[Cl.30]

tea, and other goods that belong to this class

[Cl.40]

treatment of materials

[Cl.7]

blade [parts of machines]

Examination of designated goods and services

- Cases in which requirements of Article 6(1) are not met:
Case 1 – Indications of G&Ss are “Too broad/vague”

[Cl.35]

provision of benefits to customers in the business of retail and wholesale nursing care equipment

[Cl.35]

retail services

Examination of designated goods and services

- Cases in which requirements of Article 6(1) are not met:
Case 2 – indications of G&Ss are “inappropriate”

[CI.5]

band-aid → adhesive plasters

[CI.12]

jet ski → stand-up personal watercraft

[CI.28]

PlayStation → home video game machines

[CI.32]

coke → cola

Examination of designated goods and services

- Cases in which requirements of Article 6(2) are not met:
Cases 3 – “Class is incorrect”

[Cl.3]

chemicals, pharmaceutical preparations

[Cl.9]

vending machines

[Cl.16]

magazines, representation of advertising by magazines

Examination of designated goods and services

- Cases in which requirements of Article 6(1) and (2) are not met:

[Cl.35]

provision of franchise

[Cl.36]

Investment Holding

[Cl.37]

lease of machinery and appliances

[Cl.42]

provision of information

3. Similarity of G&Ss

Examination Procedures for trademark applications in Japan

Examination of G&Ss

Article 6 of the Japanese Trademark Act



Examination of Absolute Grounds (Distinctiveness of Trademarks)

Article 3 of the Japanese Trademark Act

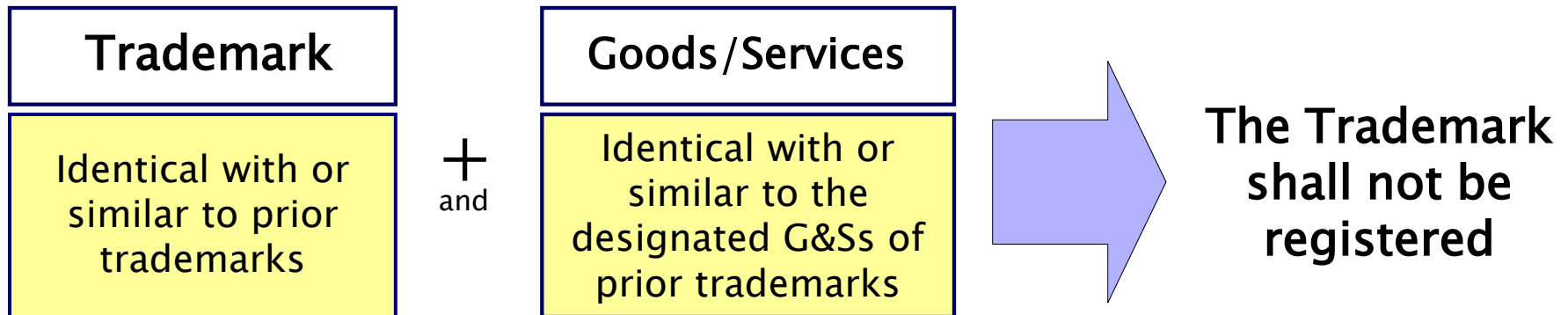


Examination of Relative Grounds (Public order/Similarity of Trademarks and G&Ss, etc.)

Article 4 of the Japanese Trademark Act

Article 4(1)(xi) of the Trademark Act

*A trademark cannot be registered when the applied **mark** is identical with or similar to a registered trademark of another party used in **goods or services** identical with or similar to **goods or services designated by the prior registration**.*



Similarity of G&Ss in JPO

Examination Guidelines for Similar G&Ss

Goods/Services

Producers/Providers, Market Places,
Function, Purposes, Main Materials, Consumers,
Finished products/parts,
Business categories, etc.

- Organizing and Grouping related G&Ss
- Provide 5-digit Codes to each Groups (Similar Group Code)

The G&Ss with the same Similar Group Code are assumed
to be Similar in Examinations in JPO

Example of Similar Group Codes in the same Class

Class 18

Suitcases

21C01

Wallets

21C01

Folding umbrellas

22B01

Rucksacks

21C01

Walking sticks

22C01

Parasols

22B01

Example of Similar Group Codes Among Several Classes

Class 18

Handbags

21C01

Umbrellas

22B01

Pet Clothing

19B33

Class 21

Cookware

19A05

Pet feeding
dishes

19B33

Cleaning instruments,
hand-operated

19A06

Class 28

Pet Toys

19B33

Toys

24A01

Reels for fishing

24D01

Advantages of Similar Group Codes

The G&Ss with the same Similar Group Code are assumed to be Similar in Examinations

(For JPO)

- Ensure uniformity in examination of similarity of G&Ss
- Fast & Efficient searches of conflicting prior trademarks
- Not effected by any revision of the Nice Classification

(For Applicants/Representatives)

- Efficient Prior trademark searches with the Similar Group Code before filing an application
- Improve predictability of the results of Examination
- Easy amendments to G&Ss to avoid conflict with prior trademarks

4. International Initiatives for G&Ss

International Initiatives of Japan for harmonization of G&Ss

- The differences of acceptable indications and classifications of G&Ss among countries impose the burden both on applicants and IP Offices.
- Japan has promoted international initiatives in the frameworks of WIPO, TM5 and bilateral cooperation.
- For the purpose of reducing the procedural burden for Japanese applicants and the examination burden for overseas IP Offices.

International Initiatives of Japan for harmonization of G&Ss

➤ Nice International Classification

Participation in the Committee of Expert.

Propose new G&Ss based on requests from Japanese industry.

➤ Madrid G&S Manager (MGS)

Providing Japanese translation, acceptability and Similar Group Codes of G&Ss in Japan.

➤ ID List Project (TM5: Japan, USA, EUIPO, Korea, China)

This project started in 2002.

Each offices cooperate for making a list of G&Ss which are acceptable each other.

International Initiatives of Japan for harmonization of G&Ss

➤ TM Class (TM5 Project)

Providing Japanese translation and acceptability of G&Ss.

➤ Information on How TM5 Members Describe Goods and Services (TM5 Project)

Providing information on JPOs' practices of describing of G&Ss.

<http://tmfive.org/providing-information-on-how-tm5-members-describe-goods-and-services/>

➤ Bilateral Cooperation

Exchange corresponding table of G&Ss with Similar Group Codes between JPO and KIPO.

http://www.jpo.go.jp/sesaku_e/j-k_codes2017.htm

5. Search Tools for G&Ss

Search Tools for G&Ss

➤ Nice Classification (about 10,000 terms)

<http://web2.wipo.int/classifications/nice/nicepub/en/fr/edition-20170101/taxonomy/>

➤ MGS (about 40,000 terms)

<http://www.wipo.int/mgs/?lang=en>

➤ TM5 ID List (about 16,000 terms)

<http://euipo.europa.eu/ec2/tm5/;jsessionid=94DEF4AA939E520D4DFE4EBD991FB536.ec2t1?lang=en>

➤ TM Class

<http://euipo.europa.eu/ec2>

➤ J-PlatPat (about 50,000 terms)

https://www2.j-platpat.inpit.go.jp/SH1/sh1e_search.cgi?TYPE=000&sTime=1486967182676

Thank you for your attention.

