



**WIPO | MADRID**

The International  
Trademark System



# Classification Guidelines

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# Classification of goods and services

- Important part of the trademark registration process
- To specify the goods and services to which a trademark will apply and define the scope of protection the trademark will enjoy

# Classification is a balancing act

- Terminology that describe the goods & services precisely enough – not too narrow and not too broad
- Avoid irregularities from the IB and refusals in designated Contracting Parties



# Classification role of the IB

- “The indication of classes given by the applicant shall be subject to control by the International Bureau” ( Article 3.2. of the Protocol)



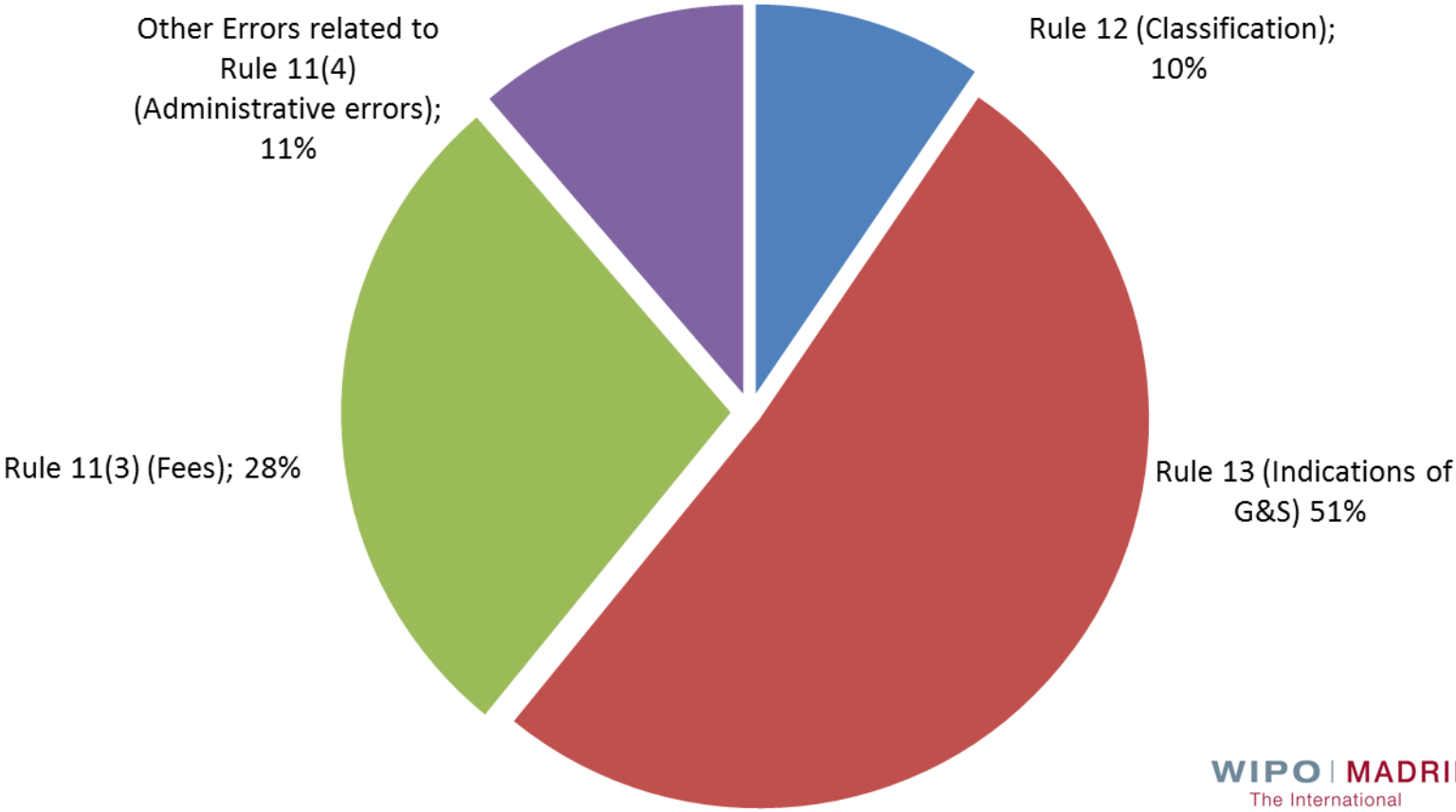
# Role of the IB

- Check if goods and services in international applications are :
  - grouped in the appropriate classes of the Nice Classification
  - the goods and services are indicated in precise terms
- Rule 12 and Rule 13 of the Common Regulations

# International Applications: irregularities



# Breakdown of irregularity letters



# Nice Classification

- Nice Agreement of 1957
- 149 States & WIPO follow the classification
- 10 editions and new versions every year
- 11 edition in 2017
  - Changes to 12 class headings



# “Source” for classification

- Class headings
- Alphabetical list of the Nice Classification
- Explanatory notes to the Nice Classification
- The “General remarks” for G&S in the Nice Classification
- Guidelines
- Madrid Goods & Services Manager (MGS)

# Guidelines

- Requested by Member States in the Roundtable in November 2015
- Introduced as a draft to the Members of the Madrid System in the Roundtable 17<sup>th</sup> of June 2016
- For discussion and comments until 1<sup>st</sup> of October 2016

# Guidelines

The purpose:

- Inform the Madrid System users of the practices followed by the IB
- Support users when listing goods and services
- Increase the predictability of examination in the IB
- Set an example for the practices in the Member States

# Guidelines

- Include only the **principles** applied by the IB
- Provide general guidance to the users of the Madrid System

# Guidelines

## Three main Sections

- General information about the Nice Classification and the Madrid System
- Classification principles applied by WIPO
- Practical information on the acceptable format to list indications of goods and services

# Guidelines - Classification principles

- Class headings

- The IB accepts the Class headings and the general indications in the Class headings

# Guidelines - Classification principles II

- Indications that can be classified in more than one class
  - The IB takes into account the class number indicated in the international application which provides the context within which the product is to be considered.

# Guidelines - Classification principles III

- Specification needed for indications that can be classified in **more than one class** according to **more than one** of the following criteria *purpose, material, function, mode of operation or nature*.



# Guidelines - Classification principles IV

- Use of certain expressions (namely, all other services..)
- Classification of specific goods and services (kits, electronic games...)
- Use of trademarks, geographical indications or appellations of origin in the list of goods and services

# Guidelines – Formatting the list

- Punctuation
- Use of capital letters
- Duplicate indications
- Names of goods and services in singular or plural form
- Use of abbreviations or acronyms
- Use of brackets

# Classification Guidelines

- Draft Examination Guidelines Concerning the Classification of Goods and Services in International Applications