



**DRAFT EXAMINATION GUIDELINES CONCERNING THE CLASSIFICATION
OF GOODS AND SERVICES IN INTERNATIONAL APPLICATIONS**

May 2016

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Introduction

This document contains guidelines for the examination undertaken by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) of the indications of goods and services listed in applications for the international registration of a mark (international applications) filed under the Madrid System.

The Madrid System gives trademark owners the possibility to seek protection for their marks in several territories with one international registration. The Madrid System is governed by the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (the Protocol).

To obtain an international registration, trademark owners must file an international application through the Trademarks Office of the Contracting Party (Office of origin) with which they have either filed an application or obtained a registration (basic mark). Moreover, brand owners must be nationals, domiciled or have a real and effective industrial or commercial establishment in that Contracting Party (entitlement).

The Office of Origin must certify the date on which it received the international application and that certain particulars appearing in that application correspond with those in the basic mark. Then,, the Office of origin must transmit the international application to the IB.

According to Article 3(2) of the Protocol, “[t]he applicant must indicate the goods and services in respect of which protection to the mark is claimed and also, if possible, the corresponding class or classes according to the classification established by the Nice Agreement [...]”

Moreover, according to the same Article, “[t]he indication of classes given by the applicant shall be subject to control by the International Bureau, which shall exercise the said control in association with the Office of origin.”

Finally, the Article indicates that, “[i]n the event of a disagreement between the said Office and the International Bureau, the opinion of the latter shall prevail.”

The publication of these guidelines seeks to inform the Madrid System users and Offices of the practices followed by the IB; support users when listing goods and services in international applications; increase the predictability of the outcome of the examination undertaken by the IB; and foster greater consistency among Office practices. In general terms, this should positively impact the processing of international applications.

It should be noted that these guidelines include only the **principles** applied by the IB and, therefore, provide only **general guidance** to the users of the Madrid System.

This document has three sections. The first section provides general information on the International Classification of Goods and Services (the Nice Classification) and the Madrid System. The second section deals with the classification principles applied by the IB. The third section delivers practical information on the acceptable format to list indications of goods and services (i.e., punctuation, brackets).

1. The International Classification of Goods and Services (The Nice Classification)

The Nice Agreement (from 1957) establishes a classification of goods and services for the purposes of registering trademarks (the Nice Classification). The States that are members of the Nice Agreement shall apply the Nice Classification for that purpose.

Although only some 80 States are party to the Nice Agreement, the Trademark Offices of more than 145 States and intergovernmental organizations use the Nice Classification.

The use of the Nice Classification is required for the international registration of marks effected by the IB under the Madrid System.

The Nice Classification contains 45 classes – 34 for goods and 11 for services.

More specifically the Nice Classification consists of the following:

1. *Class Headings*: the class headings are general indications relating to the field to which, in principle, the goods or services belong;
2. *Explanatory Notes*: the explanatory notes explain which goods or services are meant or not meant to fall under each particular class number;
3. *The Alphabetical List*: is a list of goods and services, in alphabetical order, with an indication of the class number under which they should be grouped;
4. *General Remarks*: the general remarks explain what criteria should be applied if a term is not found in the alphabetical list and cannot be classified in accordance with the explanatory notes.

The Alphabetical List of the Nice Classification is not exhaustive, as it covers only some 8,300 items under the 2016 version of its 10th edition. The real value of the Nice Classification lies in the criteria it establishes for classification, in the Explanatory Notes and in the General Remarks, in case a specific good or service cannot be found in the Alphabetical List.

The Nice Classification is amended and supplemented by a Committee of Experts, consisting of representatives from the Contracting States of the Nice Agreement.

The Committee decides on any changes to be incorporated in the Nice Classification, which are then published in the form of new editions every five years and new versions every year.

2. Control of the list of goods and services in international applications

The Office of Origin

International applications are received and certified by the Office of origin, who then shall forward them to the IB. The Office of Origin must certify that the items appearing in the international application correspond to those in the basic mark. In particular, the Office of origin must certify the list of goods and services that appears in the international application corresponds to or is covered by the corresponding list in the basic mark.

The IB

The IB must examine the international application for compliance with the applicable requirements. According to Rule 9(4)(a)(xiii) of the Common Regulations, “[t]he international application shall contain or indicate [...] the names of the goods and services [...] grouped in the appropriate classes of the International Classification of Goods and Services, each group preceded by the number of the class and presented in the order of the classes of that Classification”.

Moreover, the Rule requires that the goods and services be indicated “[...] in precise terms, preferably using the words appearing in the Alphabetical List of the said Classification.”

Where the IB finds that an international application does not comply with the requirements specified in Rule 9(4)(a)(xiii) of the Common Regulations (i.e. that the indications of classes is incorrect or that the terms are not precise enough) the IB must follow the procedures established in Rules 12 and 13 of the Common Regulations.

2.1. Legal basis

Rule 12

Rule 12 of the Common Regulations sets-out the procedure under which the IB shall determine the proper classification of the indications listed in the international application, in association with the Office of origin, where the former does not agree with the indications given by the applicant.

Under Rule 12, the IB shall notify its classification proposal to the Office of origin, stating the amounts of the fees due as a result of such proposal, if any. Within two months from the date of that notification, if no communication has been received from the Office of origin, the IB shall reiterate its proposal in a new communication.

The Office of origin shall communicate to the IB an opinion on its proposal within three months from the date on which this proposal was notified to that Office. Taking into account that opinion, the IB can either confirm or modify its proposal and shall notify the Office of origin accordingly.

The amounts of the fees due as a result of the IB’s proposal, if any, shall be paid within three months from the date of the notification in which the IB confirms or modifies its proposal. Where the Office of origin has not communicated an opinion to the IB, those amounts shall be paid within four months from the date of the notification of the original proposal.

Where the fees paid are insufficient, the IB shall consider the application abandoned and refund any fees paid to the party that made the payment, deducting 50 per cent of the applicable basic fee.

Where fees are sufficient and there are no further irregularities, the IB shall record the mark in the International Register with the classification and grouping that the IB considers to be correct.

Finally, while the applicant is informed of all the communications sent to the Office of origin, the applicant cannot send an opinion directly to the IB. The IB will disregard any communication sent directly by the applicant.

Rule 13

Rule 13 of the Common Regulations sets-out the procedure to clarify any term or expression that is listed in the international application and that the IB considers to be (i) too vague for the purposes of classification; (ii) incomprehensible; or, (iii) linguistically incorrect.

Under Rule 13, the IB shall notify the Office of origin and may suggest either a substitute term or expression or the deletion of the term or expression in question.

The Office of Origin shall communicate a proposal to the IB within three months from the date of the communication.

Where the proposal made by the Office of origin is acceptable, the IB shall record the mark taking into account this proposal.

Where a proposal is not acceptable or such proposal has not been made, the IB shall either (a) record the mark with the questioned term or expression and with an indication that the IB considers such term or expression to be too vague for its classification, incomprehensible or linguistically incorrect; or, (b) delete such term or expression, where no indication of class has been given.

As with the previous rule, while the applicant is informed of all the communications sent to the Office of origin, the applicant cannot send an opinion directly to the IB. The IB will disregard any communication sent directly by the applicant.

Example of a notice sent by the IB under Rules 12 and 13 of the Common Regulations

NOTICE CONCERNING AN INTERNATIONAL APPLICATION

ATTENTION:

The irregularity(ies) indicated in this notice is (are) to be remedied by the office of origin.

The response to this notice should be received by the International Bureau no later than **11 July 2016**. Please, indicate the WIPO Reference number **958515301** in all your communications with the International Bureau.

Re.: International application based on registration N° **402418**
for the mark **ROMARIN**
in the name of **ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE**

Date of receipt of the international application
by the Office of origin: 25 January 2016
by the International Bureau: 16 February 2016

Our ref. : EN-I/958515301/TN
Office ref. : MM201604860R
Applicant ref.: ER/YR/9201500203/SMS
Examiner: John Smith
Telephone N°: +412222222
E-mail: intreg.mail@wipo.int

We acknowledge receipt of the above-mentioned international application.

The examination of this application has revealed the irregularities which are listed hereafter:

IRREGULARITY(IES) CONCERNING THE CLASSIFICATION OF GOODS AND SERVICES: TO BE REMEDIED BY THE OFFICE OF ORIGIN (Rule 12).

1. The International Bureau considers that the goods and/or services listed in the international application are not grouped in the appropriate classes of the International Classification of Goods and Services (Rule 9(4)(a)(xiii)). The International Bureau proposes therefore to transfer the following terms:

"supply chain management" from class 39 to class 35

- please, kindly refer to our MGS - Madrid Goods and Services Manager at <http://www.wipo.int/mgs>.

The proposed grouping may entail the payment of further fees (see attached accounting statement).

An opinion on this proposal may be communicated to the International Bureau. Any such opinion must be communicated **THROUGH THE OFFICE OF ORIGIN within three months from the date of the present notification, that is, by 11 July 2016**.

Failing this, the mark will be registered **with the classification and grouping proposed by the International Bureau**. However, if this proposal entails the payment of further fees and such fees are not paid within four months from the date of the present notification, the international application will be considered **abandoned**.

Applicants are strongly encouraged to check the existence and classification of terms appropriate to their needs in the Madrid Goods & Services Manager at <http://www.wipo.int/mgs>.

IRREGULARITY(IES) CONCERNING THE INDICATION OF GOODS AND SERVICES: TO BE REMEDIED BY THE OFFICE OF ORIGIN

2. The International Bureau considers that the following term(s) of the list of goods and/or services is/are too vague for the purposes of classification (Rule 13):

- 1) "logistics" (class 39)
- 2) "ferry boat services" (class 39)
- 3) "provision of information relating to ports" (class 39)
- 4) "shipping agency services" (class 39)
- 5) "slipping of boats" (class 39)

The International Bureau suggests therefore the following:

- 1) "transportation logistics" (class 39)
- 2) "ferry-boat transport services" (class 39)
- 3) "provision of transport information relating to ports" (class 39)
- 4) "shipping agency services for arranging the transportation of goods" (class 39)
- 5) Please clarify the term "slipping of boats" (class 39)

YOUR ANSWER MUST NOT BE SENT DIRECTLY TO WIPO BUT THROUGH YOUR NATIONAL OFFICE.

A proposal as to different term(s) may be communicated to the International Bureau. Any such proposal must be communicated **THROUGH THE OFFICE OF ORIGIN, within three months** from the date of the present notification, **that is, by 11 July 2016**. If no proposal acceptable to the International Bureau is made within this period, the International Bureau will include in the international registration the term(s), as appearing in the international application, with an indication to the effect that, in the opinion of the International Bureau, the specified term(s) is/are too vague for the purposes of classification.

Applicants are strongly encouraged to check the existence and classification of terms appropriate to their needs in the Madrid Goods & services Manager at <http://www.wipo.int/mgs>.

**Annex to the irregularity notice concerning the international application
based on the national application or the national registration No 402418**

Our ref.: EN-I/958515301/TN
Office ref. : MM201604860R
Applicant ref.: ER/YR/9201500203/SMS

	Swiss Francs
Basic fee where any reproduction of the mark is in color (Protocol application):	903.00
Individual fee (international application): CN	249.00
Individual fee per additional class (international application): CN	125.00
Individual fee (international application): EM	912.00
Individual fee (international application): US	301.00
Individual fee per additional class (international application): US	301.00

Total due:	2,791.00

2.2. General principles for the control of the indications of goods and services listed in an international application

The IB controls that the indications of goods and services listed in an international application are grouped in accordance with the edition and version of the Nice Classification in force on the date on which the international application was received by the Office of origin, as certified in that application.

The Nice Classification consists of an Alphabetical List, Class Headings, Explanatory Notes for each class and General Remarks. When indications of goods and services are not found in the Alphabetical List, they must be classified with the help of the Explanatory Notes. Where this is not possible, the indication must be classified following the principles found in the General Remarks.

Classification of 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 similar 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.”
For instance, “leather jackets” are classified under class 25 because their function or purpose is as an article of clothing. The fact that they are made of leather does not mean they can also be classified under class 18.

Moreover, “clothing of leather”, which would encompass leather jackets, is in the Alphabetical List of the Nice Classification under class 25.

In principle, the material of which goods are made is a subsidiary consideration that should be taken into account only if the goods cannot be classified by their function or purpose.

A “figurine” is an example of a good in finished form that cannot be classified by its function or purpose. A figurine is a “statuette, especially one of a human form”¹, that may be used, for instance, for artistic, ornamental or religious purposes. As a result, figurines are classified according to the material of which they are made. The following examples are found in the Alphabetical List of the Nice Classification:

”Figurines [statuettes] of common metal” (NCL - Class 6)

“Figurines [statuettes] of precious metal” (NCL - Class 14)

“Figurines [statuettes] of papier mâché” (NCL - Class 16)

“Figurines [statuettes] of stone, concrete or marble” (NCL - Class 19)

“Figurines [statuettes] of wood, wax, plaster or plastic” (NCL - Class 20)

“Figurines [statuettes] of porcelain, ceramic, earthenware or glass”
(NCL - Class 21)

¹ “figurine, n.” Oxford living Dictionaries. 2016, Oxford University Press, <http://www.oxforddictionaries.com/definition/english/figurine> (accessed May 26, 2016).

- 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.”

Goods can have more than one function or purpose and in these cases the IB will accept them in all the classes that correspond to their function or purposes.

For example “clock radios” can be accepted under both class 9 and 14 because a radio is an “apparatus for receiving radio programmes”² and a clock is a “mechanical or electrical device for measuring time, indicating hours, minutes, and sometimes seconds by hands on a round dial or by displayed figures”³.

A more commonly used expression would be “radio alarm clocks”, which indeed is acceptable in both class 9 and 14 and is defined as a “combined radio and alarm clock, which can be set so that the radio switches on automatically at a chosen time”⁴.

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

Raw materials, whether unprocessed or semi-processed, do not have, *per se*, a function or a purpose. Accordingly, raw materials are classified according to the type of material of which they consist.

Certain finished products can be confused with raw materials. For instance, “cooking salt”, which is grouped under class 30 because it is intended to be used for seasoning food, shall not be confused with “raw salt”, which is grouped under class 1.

- 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.”

For example, “brushes for vacuum cleaners” are grouped under class 7 rather than under class 21, under which the majority of “brushes” are classified.

- 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.”

Accordingly, while “milk beverages, milk predominating” is in the Alphabetical List under class 29, “coffee beverages with milk” is also in the Alphabetical List under class 30 because milks is only added but it is not predominant.

² “radio, n.” Oxford living Dictionaries. 2016. Oxford University Press, <http://www.oxforddictionaries.com/definition/english/radio> (accessed May 26, 2016).

³ “clock, n.” Oxford living Dictionaries. 2016. Oxford University Press, <http://www.oxforddictionaries.com/definition/english/clock> (accessed May 26, 2016).

⁴ “radio alarm clock, n.” Oxford living Dictionaries. 2016. Oxford University Press, <http://www.oxforddictionaries.com/definition/english/radio-alarm-clock> (accessed May 26, 2016).

- f) “Cases adapted to the products for which they are intended to contain are in principle classified in the same class as the product”.

For instance, “cases for smartphones” is in the Alphabetical List under class 9 because “smartphones” is classified under that class and the case has been adapted to hold this product.

Similarly, while “bags for sport” is in the Alphabetical List under class 18, “bags for tennis racquets” would be classified under class 28 because “tennis racquets” correspond to that particular class.

Classification of services

- a) “Services are generally classified according to the branches of activity defined by the Class Headings for service classes and their explanatory notes or, otherwise, by analogy with other similar services appearing in the Alphabetical list.”

For example, services such as banking and financial planning are grouped under class 36 because these are financial services (e.g. “mortgage banking” and “online banking”).

- b) “Rental services are generally classified in the same classes as the ones where services provided by means of rented objects are classified (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).”

The IB will consider an expression listed in an international application to be too vague for the purposes of classification where such expression does not provide an indication of the branch of activity in which the service is provided. Accordingly, the IB would consider “providing a website” to be too vague because the nature of the service and, most importantly, the branch of activity would be unclear.

On the contrary, the IB would accept expressions such as “providing access to a website” under class 38, understood as being a service in telecommunications, or the expression “hosting a website” under class 42, understood as being a technological service.

2.3. Class headings

Nice class headings indicate, in general terms, the fields to which the goods and services under a particular class belong.

The Committee of Experts of the Nice Union approves changes to the class headings.

Class headings are comprised of a number of “general indications” which are the descriptions of goods or services delimited by semicolons.

For example, the heading for class 12 reads as follows:

“Vehicles; apparatus for locomotion by land, air or water”

The heading for class 12 is comprised of two general indications: “vehicles” and “apparatus for locomotion by land, air or water”.

Examination policy

The IB considers that Class headings or their general indications are comprehensible, linguistically correct and sufficiently precise and that their use constitutes a proper specification of goods and services for the purposes of classification.

Therefore, the IB accepts class headings when listed as indications of goods and services in international applications. Class headings may be listed in their entirety or partially with only some of the general indications.

Consequently, when the general indications or the entire class headings as provided for in the Nice Classification are listed in an international application, the IB will not raise an irregularity.

Once a mark is registered, changes to a particular class heading would not have an impact on international registrations that list an older version of that class heading (i.e., changes would not be applied retroactively to international registrations).

The IB’s policy of accepting class headings may differ from the practice that is followed by some national or regional Offices. Some of those Offices do not accept class headings and may require that the holder of the international registration further specify the goods or services for which it seeks protection.

Other Offices, while accepting class headings, have different interpretations concerning its scope of protection. For these Offices, the fact that the IB accepts class headings and certain indications in those headings does not, in any way, prejudice the decision of the Office as to the determination of the scope of protection.

2.4. Indications that can be classified under more than one class

Certain indications for a product or a service may be classified under more than one class.

For example, “deodorants” could be either classified under class 3 (understood as “deodorants for human beings or for animals”) or under class 5 (understood as “deodorants, other than for human beings or for animals”).

Examination policy

According to the Common Regulations, the IB shall require that the goods and services listed in an international application be comprehensible, linguistically correct and sufficiently precise for their correct classification.

Goods

According to the General Remarks of the Nice Classification, finished products are grouped under a given class according to their purpose or function, as specified in the corresponding class heading and in its Explanatory Notes. Where the purpose or function of a given finished product is not mentioned in any class heading, the product may be classified according to its material or mode of operation.

A particular finished product may be classified under more than one class, depending on the way in which that product is qualified.

For the purposes of classification, the IB will take into account the class number indicated in the international application, which provides the context within which the product is to be considered.

The IB will take into account the common understanding of an indication in the context of the class specified in the international application. Where an indication has sufficient meanings in the context of a class, it can be grouped under that class without further specification.

As a consequence, the following classification principles shall apply:

1. Purpose:

When a particular product may be classified in more than one class according to its intended purpose but only one of the applicable classes has been indicated, the IB will not consider this irregular.

For example:

“Deodorising apparatus” would be accepted under

- Class 11, understood as “deodorising apparatus, not for personal use”
- Class 21, understood as “deodorising apparatus for personal use”

“Sea water” would be accepted under

- Class 5, understood as “sea water for medicinal bathing”
- Class 30, understood as “sea water for cooking”

2. Material:

When a particular product may be classified in more than one class according to the material of which it is made but only one of the applicable classes has been indicated, the IB will not consider this irregular.

For example:

“Drain traps” would be accepted under

- Class 6, understood as “drain traps [valves] of metal”
- Class 19, understood as “drain traps [valves], not of metal or plastic”
- Class 20, understood as “drain traps [valves] of plastic”

“Gift bags” would be accepted under

- Class 16, understood as “gift bags made of paper”
- Class 22, understood as “gift bags made of textile/fabric”

3. Function:

When a particular product may be classified in more than one class according to its function but only one of the applicable classes has been indicated, the IB will not consider this irregular.

For example:

“Mobiles” would be accepted under

- Class 20, understood as “mobiles [decoration]”
- Class 28, understood as “mobiles [toys]”

“Contraceptives” would be accepted under

- Class 5, understood as “chemical contraceptives”
- Class 10, understood as “contraceptives, non-chemical”

4. Mode of operation:

When a particular product may be classified in more than one class according to its mode of operation but only one of the applicable classes has been indicated, the IB will not consider this irregular.

For example:

“Door openers” would be accepted under

- Class 6, understood as “door openers, non-electric”
- Class 7, understood as “door openers, electric” or “pneumatic” or “hydraulic”

5. Nature:

When a particular product may be classified in more than one class according to the fact that it is either unprocessed, semi-processed or processed, but only one of the applicable classes has been indicated, the IB will not consider this irregular.

For example:

“berries” would be accepted under

- Class 31, understood as “berries, fresh”
- Class 29, understood as “berries, processed” etc.

“acrylic resins” would be accepted under

- Class 1, understood as “unprocessed acrylic resins”
- Class 17, understood as “semi-processed acrylic resins”

6. Mixed criteria:

However, when a particular product may be classified in more than one class according to more than one of the five criteria mentioned above, but only one of the applicable classes has been indicated, the IB will raise an irregularity requesting further specification.

For example:

“Pipes” can fall under seven different classes, either according to their material (e.g. steel pipes) or purpose (e.g. water-pipes) or function (e.g. tobacco pipes):

- Class 6: “pipes of metal”, “steel pipes”, “drain pipes of metal”, “gutter pipes of metal”, “water-pipes of metal”, “pipes of metal for central heating installations”
- Class 7: “cutting blow pipes”, “soldering blow pipes”, “automotive exhaust pipes”
- Class 11: “water-pipes for sanitary installations”, “boiler pipes for heating installations”
- Class 15: “wind pipes for organs”, “music pitch pipes”
- Class 17: “canvas hose pipes”, “non-metallic flexible pipes”
- Class 19: “drain pipes, not of metal”, “rigid pipes, not of metal”, “gutter pipes, not of metal”, “water-pipes, not of metal”
- Class 34: “tobacco pipes”

“Doors” can fall under five different classes, either according to their material (e.g. doors of metal) or purpose (e.g. doors for furniture):

- Class 6: “doors of metal”
- Class 11: “shower doors”
- Class 12: “doors for vehicles”
- Class 19: “non-metal doors”
- Class 20: “doors for furniture”

Services

According to the General Remarks of the Nice Classification, services are, in principle, grouped under a given class according to their branches of activities, as specified in the corresponding class heading and in its explanatory notes.

As with finished products, a particular service may be classified under more than one class, depending on the way in which that service is qualified. In such cases, the IB will follow a practice similar to that followed for finished products, *mutatis mutandis*.

Accordingly, the IB would accept indications of services, where the indication has sufficient meaning in the context of a given class, which allows it to be grouped under that class without further specification.

The following are examples of indications of services that the IB would accept in more than one class without further specification.

“Accommodation bureau services” would be accepted under

- Class 36, understood as “accommodation bureau services [apartments]”
- Class 43, understood as “accommodation bureau services [hotels, boarding houses]”

“Booking of seats” would be accepted under

- Class 39, understood as “booking of seats for travel”
- Class 41, understood as “booking of seats for shows”

“Vermin exterminating” would be accepted under

- Class 37, understood as “vermin exterminating, other than for agriculture”
- Class 44, understood as “vermin exterminating, for agriculture, horticulture and forestry”

“Layout services” would be accepted under

- Class 35, understood as “layout services for advertising purposes”
- Class 41, understood as “layout services, other than for advertising purposes”

“Organization of exhibitions” would be accepted under

- Class 35, understood as “organization of exhibitions for commercial or advertising purposes”
- Class 41, understood as “organization of exhibitions for cultural or educational purposes”

“Publication” would be accepted under

- Class 35, understood as “publication of publicity texts”
- Class 41, understood as “publication of books” or “publication of texts, other than publicity texts”

“Organization of fashion shows” would be accepted under

- Class 35, understood as “organization of fashion shows for promotional purposes”
- Class 41, understood as “organization of fashion shows for entertainment purposes”

General terms

A general term is a term that appears in the Alphabetical List of the Nice Classification in relation to a particular class (known as its “natural class”) and in connection with other classes, depending on the way in which such term is qualified. General terms are indicated in the Alphabetical List with an asterisk.

Some examples of general terms are acids, under class 1; abrasives, class 3; anchors, class 6; alarms, class 9; bags, class 18; urns, class 21; felt, class 24; mats, class 27; construction, class 37; writing of texts, class 41; and, rental of transportable buildings, class 43.

Examiners shall raise an irregularity where a general term has been listed in an international application under a class other than its “natural class”, without any further qualification. In this particular case, the applicant would be required to further specify the product or service for which protection is sought, so it can be properly classified.

For example, while the IB would accept “clothing” under class 25, it would not accept it under class 9. In this particular case, the applicant would be required to further qualify the term. The applicant could, for instance, indicate that protection is sought for “clothing for protection against fire”.

As another example, while the IB would accept “brokerage” under class 36, it would not accept it under class 39. In this case, the applicant could, for instance, specify that protection is sought for “freight brokerage services”.

2.5. Use of certain expressions in the list of goods and services

2.5.1. Use of “namely”, “in particular” or “i.e.” to specify products or services

Applicants frequently include certain expressions in the list of goods and services to further specify or restrict the scope of protection of a product or a service. The IB accepts the expressions “namely”, “in particular” and “i.e.”, when they are included after a broad indication and are followed by the names of specific goods or services.

However, the IB does not accept the expression “such as”. This expression is commonly used to introduce examples that merely illustrate the indication that precedes it.

2.5.2. Use of expressions such as “and the like” or “etc.”

Expressions such as “and the like” or “etc.” are sometimes used by applicants, with a view to extending the protection to goods or services of a similar nature as the ones already indicated in a class, though without specifying them.

The IB does not accept the use of above-mentioned expressions which lack accuracy and do not allow for a clear identification of the goods and services for which the protection is sought.

2.5.3. Claims for “all goods” or “all other services” in a given class

The IB does not accept the use of expressions such as “all goods in class X”, “all services in this class”, “all other goods in this class”. According to Rule 9(4)(xiii) of the Common Regulations, applicants must indicate “the names of the goods and services for which the international registration of the mark is sought”.

Where those expressions appear either by itself (i.e., no goods or services were listed) or along with actual names of goods or services, examiners will raise an irregularity under Rule 13 of the Common Regulations.

2.5.4. Reference to other classes within the list

A clear description is essential to the proper identification and correct classification of goods and services. Some definitions of goods and services which are based upon a reference to what is contained in another class may be acceptable, while others are not.

For example, in class 29 the expression “vegetables other than those listed in class 31” is not accepted by the IB. On the other hand, cross references are suitable when connecting classes for given services to those for the related goods, as long as doing so allows for a clear identification and correct classification of the object of the protection sought by an applicant.

For example, in class 37 “Installation services in relation to goods above-mentioned in class 11” is acceptable.

2.6. Classification of specific goods and services

The classification of certain indications of goods and services can be more challenging. The following explanations aim at providing clarifications as to their proper classification.

a. Electronic games

As from January 2012 (NICE 10), all electronic games apparatus are classified under class 28. Game software and programs remain in class 9, irrespective of the nature of the game itself.

b. Low alcohol beverages or wines

“Low alcohol beverages” and “low alcohol wines” fall under class 33 irrespective of the level of alcohol they might contain. The Nice Classification does not establish the amount of alcohol that a beverage or wine should contain to be considered either alcoholic or non-alcoholic. It simply states that all alcoholic beverages should be classified under class 33, except for beers which belong to class 32.

c. Filters and filtering materials

Filters are finished products and are classified according to their function or purpose or, where this is not possible, according to their material, e.g. “filters as parts of engines or machines” (class 7), “filters for ultra violet rays for medical purposes (class 10), “filters as parts of electric coffee machines or water supply apparatus” (class 11), “filters (cigarette)” (class 34).

Filtering materials are classified according to their material of which they are made, e.g. “filtering materials of paper” (class 16), “filtering materials of textile” (class 24), and “filtering materials (semi-processed foams or films of plastic)” (class 17).

d. Valves

Valves are finished products and are classified according to their function or purpose, e.g. “valves as parts of machines”(class 7), “valves for feeding bottles” (class 10), “valves for vehicle tyres” (class 12), “valves as parts of musical instruments” (class 15)

Where the above is not possible, valves are classified according to the materials from which they are made, e.g. “valves made of leather” (class 18), “valves made of rubber or vulcanized fiber” (class 17), “water pipe valves of plastics” (class 20).

e. Manufacturing of goods

The IB would not accept the general expression “manufacturing of goods”. Applicants should specify the goods that they intend to manufacture and for which the international registration is sought.

However, the IB would accept the expression “custom manufacturing of goods for others” as a service classified under class 40, since the custom manufacturing of goods is expressly considered to be under this class as indicated in the Explanatory Notes.

f. Association services

An association is “a group of people organized for a joint purpose”⁵. Some associations may provide educational services as well as advocacy and lobbying in areas of interest to the members of the association. Other associations may have social or entertainment pursuits. Therefore, each association decides for itself its purpose and the services that it may offer to its members.

Services provided by an association to its members are, in principle, classified according to the nature of the service provided. The IB shall consider qualifying wording, usually provided after the word “namely” to define the specific nature of the activities being performed.

For instance, “education or entertainment services provided by an association to its members” will fall under class 41; “arranging of tours by an association to its members” under class 39; and, “underwriting insurance for its members” under class 36.

However, the IB will consider the expression “association services, namely promoting the interests of its members” as being too vague for the purposes of classification. Moreover, expressions such as “services included in this class rendered by an association to its members” or “services rendered by an association to its members” would need to have the services specified more precisely.

Finally, the nature of the service should be specified as to whether it is for commercial purposes (class 35) or for non-commercial purposes (class 45).

g. Kits

The IB classifies “kits” either according to their purpose (e.g. “cosmetic kits” in class 3, “first-aid kits” in class 5 or “craft kits for painting” in class 16) or by their composition (e.g. “kits comprised of fabrics for making quilts” in class 24, “dental care kits comprising toothbrushes and floss” in class 21), the latter provided that all the goods comprised in the kit can be classified under the same class.

Accordingly, kits that have no stated purpose need to list the items of which the kit is composed. Examiners shall raise an irregularity under Rule 13 where the list of goods and services in an application contains the word kit without either a stated purpose or a list of the goods comprised in the kit.

⁵ “association, n.” Oxford Living Dictionaries. 2016. Oxford University Press, <http://www.oxforddictionaries.com/definition/english/association> (accessed May 26, 2016).

Moreover, the IB would not accept kits that have no stated purpose and are composed of goods that can be classified under various classes. In this particular case, the applicant would have to list each good under its appropriate class. Examiners shall raise an irregularity under Rule 12 where the list of goods and services in an international application contains the word kit followed by a list of goods that can be classified under different classes.

h. Parts and fittings (or accessories)

The IB does not accept expressions such as “parts and fittings” or “parts and accessories” without further specification because these expressions, by themselves, do not adequately identify the goods to be covered.

Accordingly, applicants should further specify the goods for which the parts or fittings are intended. For example, an adequate expression would be “parts and fittings for motor vehicles” under class 12 or “computers and parts and fittings thereof” under class 9.

i. Wholesale and retail store services

According to the explanatory notes for class 35, “wholesale and retail store services” should be classified under this particular class. Therefore, the IB accepts the expressions “retail sale” and “wholesale” when they are listed in an international application under class 35 without any further specification.

2.7. Use of trademarks, geographical indications or appellations of origin

Some international applications include registered trademarks, geographical indications or appellations of origin in the list of goods and services for which registration is sought.

Examination policy

The IB accepts the use of any indication, including trademarks, when they identify the product for which registration is sought in a manner that is sufficient for its proper classification in accordance with the Nice Classification. Moreover, since geographical indications and appellations of origin serve to designate very specific goods, the IB accepts geographical indications and appellations of origin listed in international applications under their corresponding class number of the Nice Classification.

3. Formatting the list of goods and services

3.1 Punctuation

The appropriate use of punctuation marks in the list of the goods and services for which the applicant seeks protection is very important, as it facilitates their understanding, classification and subsequent translation.

In particular, semicolons have historically been used by most national offices to clearly distinguish between different categories of goods and services within a class. The use of commas alone cannot enable this distinction.

Accordingly, the MM2 form instructs applicants to use semicolons to clearly specify the indications of goods and services:

Please make consistent use of a semicolon (;) to clearly specify the goods and services indications in your list, e.g.:

09 Scientific, optical and electronic apparatus and instruments; screens for photoengraving; computers.

35 Advertising; compilation of statistics; commercial information agencies.

Moreover, full stops should be used exclusively at the end of the list under a particular class to indicate that the list is complete for that given class.

Punctuation examples

The use of semicolons, as instructed above, facilitates the correct interpretation of the goods and services listed in an international application.

Any misuse of a comma or a semicolon is likely to lead to a misinterpretation of the goods and services listed in the international application, both at the examination and translation stages, as shown in the following examples:

Class 1

Vitamins; proteins for use in the manufacture of food supplements

In the list, as it appears above, “*vitamins*” would not be related to “*for use in the manufacture of food supplements*”; therefore, vitamins should be reclassified under class 5. Alternatively, the indication could have been worded as follows:

Vitamins, proteins for use in the manufacture of food supplements

Class 41

Publication of books; magazines

The list, as it appears above, would imply that “*magazines*” is not related to “*publication*” services and, consequently, it should be reclassified under class 16. Alternatively, the indication could have been worded as follows:

Publication of books, magazines

Similarly, appropriate use of commas and semicolons should be made when expressing a limitation or providing further specification; for instance:

Class 12

Tires for automobiles, motorcycles and bicycles

In the list, as it appears above, protection would be sought for tires for three types of vehicles.

Tires for automobiles; motorcycles and bicycles

In the example above, protection would be sought, on the one hand, for tires for automobiles and, on the other hand, for two types of vehicles, namely, motorcycles and bicycles.

Class 20

Tables, chairs, furniture frames; all aforementioned goods of wood

In the list, as it appears above, the limitation would refer to all the listed goods.

Tables; chairs, furniture frames, all aforementioned goods of wood

In the example above, the limitation would refer to chairs and frames only.

Class 25

Silk shirts, trousers and dresses

The list, as it appears above, would imply that all the goods listed are made of silk.

Silk shirts; trousers and dresses

In the example above, protection would be sought, on the one hand, for shirts made of silk and, on the other hand, for two clothing items, namely, trousers and dresses, without restrictions.

Examination policy

Examiners shall not, *ex officio*, amend the list of goods and services in international applications, as certified and transmitted by the Office of origin, by adding or changing punctuation marks.

The general principles of examination apply.

Examiners shall not raise an irregularity regarding the list of goods and services where all indications are sufficiently clear for the purpose of classification and are grouped under the appropriate class number of the Nice Classification.

Examiners shall raise an irregularity under Rule 13 of the Common Regulations where, following examination, it appears that an indication listed in the international application is not sufficiently clear for the purpose of classification.

Finally, examiners shall raise an irregularity under Rule 12 of the Common Regulations where, following examination, it appears that an indication listed in the international application has been grouped under the incorrect class number of the Nice Classification.

The Office of origin may reply to an irregularity notice by correcting the punctuation in the list of goods and services of the international application. For instance, in the examples above concerning “vitamins” under class 1 and “magazines” under class 41, the Office of origin could indicate that the semicolon should be replaced by a comma.

3.2. Use of capital letters and special characters

The use of capital letters in a list of goods and services should be restricted to the first letter of the first good or service at the beginning of each new class listed, and to acronyms and abbreviations. Consequently, any list of goods and services presented to the IB and consisting of only uppercase indications will be reformatted during the examination stage to feature lowercase characters, with uppercase letter used only as detailed above.

3.3. Duplicate indications of goods and services

Some international applications list terms or expressions for goods or services more than once under a given class. While this might be an error made by the applicant and overlooked by the Office of origin, it may also well be a deliberate decision.

Examination policy

Under the current legal framework, the IB is required to control the proper classification of the indications of goods and services listed in an international application. The IB cannot question nor interpret the intent of the applicant.

Accordingly, when an indication for a good or service is listed in an international application under the proper class more than once, examiners shall neither raise an irregularity nor, *ex officio*, amend the list of goods and services in that application, as certified and transmitted by the Office of origin, by removing the identical instance or instances.

3.4. Names of goods and services in singular or plural form

Goods are most often found in their plural form in international applications. For example, “computers” is used instead of “computer”. Conversely, collective or uncountable goods will be listed using their singular form, as is the case, for instance, for the use of the term “bread” rather than “breads”.

With respect to services, both plural and singular forms may be found in international applications, depending upon the nature and the common expression of listed services, e.g. repair services, telecommunications, museums, office functions, public relations, on the one hand; and accountancy, advertising, transport, on the other.

As a consequence, while it is generally recommended to refer to countable goods and services in the plural form when applying for the registration of a trademark, examiners shall not flag an irregularity for an inconsistent use of singular or plural form in a list of goods and services, nor alter such a list to adopt a consistent use of the singular or plural form.

3.5. Use of abbreviations or acronyms

An abbreviation is a “shortened form of a word or phrase”⁶ (e.g. APPs for applications). An acronym is an “abbreviation formed from the initial letters of other words”⁷ (e.g. SUV for sport utility vehicle). Some abbreviations and acronyms are frequently used in the indication of goods and services and are commonly known to the public, such as *CD-ROM*, *DVD*, *TV sets*, etc., or to a specific industry or field of specialty, such as *DNA chips*, *PVC films*, *AC-DC converters*, etc. Sometimes, abbreviations and acronyms are also used as nouns and, therefore, found in plural form (e.g. DVDs, CDs).

⁶ “abbreviation, n.” Oxford living Dictionaries. 2016. Oxford University Press.
<http://www.oxforddictionaries.com/definition/english/abbreviation> (accessed April 20, 2016).

⁷ “acronym, n.” Oxford living Dictionaries. 2016. Oxford University Press.
<http://www.oxforddictionaries.com/definition/english/acronym> (accessed April 20, 2016).

Examination policy

An abbreviation or acronym, used in a list of goods and services, is acceptable where it enables the accurate and unequivocal identification of the good or service concerned for the purpose of classification.

If an abbreviation or acronym is not known by the public, it should be presented to the IB in its developed form, followed by the abbreviation or acronym in upper cases and square brackets, *e.g. automated teller machines [ATM]*. Such presentation would allow their correct classification and translation. The following indication available in the Nice Classification includes an acronym preceded by its developed form:

“Global Positioning System [GPS] apparatus” (NCL - Class 9)

Abbreviations and acronyms are also acceptable on their own if they are widely known, easily understandable and unequivocal for the purpose of classification. Examples of this are *software for GPS navigation systems* or *rental of GPS equipment for navigational purposes*.

In the examination of lists of goods and services under Rules 12 and 13 of the Common Regulations, the examiner would need to determine whether any abbreviation or acronym used would be acceptable. The examiner cannot change any abbreviation or acronym *ex officio*, since this would risk modifying the intended scope. If the examiner cannot clearly understand or identify any abbreviation or acronym used in the list of goods and services, the examiner may only raise this issue in an irregularity notice under Rule 13.

3.6. Use of brackets

Round brackets

Round brackets were used in the Alphabetical List of the Nice Classification to list a different indication of a product or a service that was also listed in its appropriate place (cross-reference). For instance “Adhesives for dentures”, listed under the letter “A”, was cross-referenced as “Dentures (Adhesives for –)”, under the letter “D”; “Cooking salt”, listed under “C”, was cross-referenced as “Salt (Cooking –)”, under “S”.

Round brackets were also used to list expressions that begun with a term under which the product or service could not be listed because it was considered to be too general. In those cases, the most important part was used to list the expression, followed by the rest of the expression between round brackets. For example, “Apparatus for measuring the thickness of skins” was not listed under the letter “A”; instead, it was listed under the letter “S” as “Skins (Apparatus for measuring the thickness of –)”. “Compositions for the manufacture of technical ceramics was listed, under the letter “C” but as “Ceramics (Compositions for the manufacture of technical –)”.

In some cases, the most important part could be considered to be in the middle of the expression, such as “Cooking (Preparations for stimulating –) for industrial purposes” or “Patches (Adhesive rubber –) for repairing inner tubes.”

Round brackets made it easier to find indications in the Alphabetical List when the Nice Classification was published in printed format.

As of January 2013, the Nice Classification is published exclusively online. Search functionalities available in the online publication made the use of round brackets unnecessary and the Committee of Experts of the Nice Union decided to remove them all from the Alphabetical List.

Square brackets

Square brackets are used in the Alphabetical List of the Nice Classification to include expressions that are meant to define more precisely a term that precedes them. For instance, “Blinkers [harness]” (class 18) or “Blinkers [signaling lights]” (class 9); “Vehicle breakdown assistance [repair]”(class 37) or “Vehicle breakdown assistance [towing] (class 39).

Square brackets are also used in the English version of the Alphabetical List to denote the corresponding American expression of the term that precedes them. For example, “Plaster bandages for orthopaedic purposes [casts (Am.)]” or “Bullet-proof waistcoats [vests (Am.)]”.

Examination policy

The use of round and square brackets is acceptable when listing the goods and services in international applications. Examiners shall not alter the list of goods and services in an international application, as certified and transmitted by the Office of origin, by adding, changing or removing round or square brackets or by reordering the terms in an expression.

The general principles of examination apply.

Examiners shall not raise an irregularity concerning indications of goods and services that contain either round or square brackets where those indications are sufficiently clear for the purposes of classification and are grouped under the appropriate class number of the Nice Classification.

Examiners shall raise an irregularity under Rule 13 of the Common Regulations where, following examination, it appears that an indication that contains either round or square brackets is not sufficiently clear for the purpose of classification.

Finally, examiners shall raise an irregularity under Rule 12 of the Common Regulations where, following examination, it appears that an indication that contains either round or square brackets has been grouped under the incorrect class number of the Nice Classification.

[End of Guidelines]