

Classification

International Classification

Trade mark registrations for goods and services are classified in accordance with the International Classification of Goods and Services under the Nice Agreement (section 40(1); rule 2(1) (definition of “Nice Agreement”), and rule 5).

The current edition of the Nice International Classification is the 9th edition (with 45 class), which applies in Hong Kong.

The 9th edition of the Nice International Classification published by the World Intellectual Property Organization in English is available for reference at the front counter of the Registry. WIPO publications can be ordered on-line at <http://www.wipo.org/ebookshop> or by post :

World Intellectual Property Organization
34 chemin des Colombettes
P. O. Box 18 CH-1211
Geneva 20
Switzerland.

Websites for classification

Other trade mark offices provide useful information on classifying goods and services. Some useful websites are :

UK Patent Office : <http://www.patent.gov.uk/tm/t-find/t-find-class.htm>

IP Australia : <http://xeno.ipaustralia.gov.au/tmgoods.htm>

USPTO : <http://tess2.uspto.gov/netahtml/tidm.html>

General principles determining classification

The International Classification is made up of a list of classes with explanatory notes and an alphabetical list of goods and services.

Where goods or services are not specifically mentioned in the alphabetical list and cannot be classified with reference to the explanatory notes, you will need to apply the general principles explained in the International Classification, 9th edition to determine the classification of the particular goods or services. The general principles are set out on page 3 of the 9th edition under the headings General Remarks, Goods, Services and are summarised as follows :

- Finished products are classified according to their function or purpose, for example “surgical knives” are classified in class 10 and “electric knives” are classified in class 7.
- Finished products that are multipurpose, composite objects may be classified in all classes appropriate to each function or purpose of the goods, for example “clock incorporating radios” are classified in classes 9 and 14.
- Finished products that cannot be classified according to function or purpose are classified by analogy with comparable products, for example “bio-sands” are classified in class 1 by analogy with “chemicals for use in aquariums (other than pharmaceuticals)”.
- Finished products that cannot be classified according to function or purpose, or by analogy with comparable products, are classified according to the material they are made of, or the way they work. For example “furniture fittings, not of metal” are classified in class 20 and “ fittings of metal for furniture” are classified in class 6.

- Raw materials, unworked or semi-worked, are classified according to the material which they consist of, for example “semi-finished resins” are classified in class 17 and “unwrought silver” is classified in class 14.

- Spare parts are classified in the same class as the product for which the part is intended to fit, for example “saw blades” are “parts for hand tools” and are classified in class 8.

- Where it is appropriate to classify goods according to the material of which they are made, and they are made of various materials, they are classified according to the material that predominates. For example “doors principally made of metal” are classified in class 6 and “doors principally made of wood” are classified in class 19.

- Cases adapted to fit a particular product are classified in the same class as the product, for example “laptop computer cases” are classified in class 9.

- Services are classified according to the types of activity specified in the headings of the service classes (see classes 35 – 45 of the International Classification) or by analogy with comparable services, for example “reservation services for catering” are classified in class 43 by analogy with “providing of food and drink”.

- Rental services are classified in the same class as the service provided by means of the rented object, for example “rental of telecommunications apparatus” is classified in class 38.

- Services that provide advice, information or consultation are classified in the same class as the services that correspond to the subject matter of the advice, information or consultation, for example “business management consultancy” is classified in class 35. Providing the advice, information or consultation by

electronic means does not affect the classification of the services.

Changes to the International Classification

WIPO revises the International Classification from time to time (usually every 5 years). The current edition is the 9th edition, published in June 2006. The 9th edition came into force and was applied in Hong Kong on 1.1.2007.

An application for registration is classified in accordance with the classification prevailing at the time of application (see *Australian Wine Importers* (1889) 6 RPC 311; *Cal-U-Test* (1967) FSR 39). However we have the power to reclassify (rule 58(b)) and as a matter of policy, we will reclassify registrations so that they are consistent with the 9th edition (see *Reclassifying to the 9th edition* and *Reclassifying old registrations not founded on International Classification* below).

As the progress of reclassifying is gradual, we continue to take account of changes to the International Classification in our searches for earlier marks. For example, in examining an application to register a mark for retail services in class 35 we search not only class 35 (and other relevant classes) but also class 42, which was formerly the appropriate class for retail services.

Reclassifying to the 9th edition

The 9th edition of the International Classification introduced a number of amendments and other changes, as a result of the Reports adopted by the Committee of Experts of the Nice Union at its 19th and 20th Sessions (see http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=18683 and http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=52419).

The main amendments and other changes adopted by the Committee include:

- classification of existing indications of goods “made of precious metal” and “not made of precious metal” – goods “made of precious metals” are, in principle, classified in various classes according to their function or purpose instead of being classified in Class 14. For example, “cruet stands for oil vinegar” are classified in class 21 even if they are made of precious metal.
- transfer of the class heading “legal services” and related indications from class 42 to class 45. The class headings of class 42 and class 45 are changed as follows:

Class 42: scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software

Class 45: legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals

Legal services–related indications such as “arbitration services”, “copyright management”, “intellectual property consultancy”, “intellectual property watching services”, “legal research”, “licensing of computer software [legal services]”, “licensing of intellectual property”, “litigation services” and “registration of domain names [legal services]” are classified in class 45.

- addition of new indications

New indications such as “refractory construction materials of metal” classified in class 6, “refractory construction materials, not of metal” classified in class 19, “computer virus protection services” classified in class 42 and “pharmacists’ services to make up prescriptions” classified in class 44 are included in the International Classification.

- change of existing indications

Certain existing indications have been changed as a result the entry into force

of the 9th edition of the International Classification, for example “games other than those adapted for use with television receivers only (Apparatus for electronic -)” classified in class 28 is changed to “games other than those adapted for use with an external display screen or monitor (Apparatus for -)”

- deletion of indications

Indications such as “wall plaques, not of textile (Decorative -) [furniture]” in class 20 and “starch products for food” in class 30 are deleted from the International Classification.

- transfer of existing indications

Existing indications which have been transferred from one class to another in the 9th edition of the International Classification are listed in the following table:

Goods / Services	Classified under Nice Classification 8th edition	Classified under Nice Classification 9th edition
Liquid rubber Rubber (Liquid -)	class 1	class 17
Rubber solutions	class 1	class 17
Wallpaper removing preparations	class 2	class 1
Glaziers' putty Putty (Glaziers' -)	class 2	class 1
Oil cement [putty] Cement (Oil -) [putty]	class 2	class 1

<p>Money clips (Changed from “Money clips of common metal” and transferred to class 16)</p> <p>Clips (Money –) (Changed from “Clips (Money –) of common metal” and transferred to class 16)</p>	class 6	class 16
<p>Indoor aquaria</p> <p>Aquaria (Indoor –)</p> <p>Tanks [indoor aquaria]</p>	class 16	class 21
<p>Aquarium hoods</p>	class 16	class 21
<p>Indoor terrariums [vivariums]</p> <p>Terrariums (Indoor –) [vivariums]</p>	class 16	class 21
<p>Asbestos screens for firemen</p> <p>Firemen (Asbestos screens for –)</p> <p>Screens for firemen (Asbestos –)</p>	class 17	class 9
<p>Duckboards, not of metal</p>	class 20	class 19
<p>Jewellery cases [caskets] (Changed from “Jewellery cases [caskets], not of precious metal” and transferred to class 14)</p> <p>Jewelry cases [caskets] (Changed from “Jewellery cases [caskets], not of precious metal” and transferred to class 14)</p>	class 20	class 14
<p>Cloths impregnated with a detergent for cleaning</p>	class 21	class 3
<p>Garden herbs, preserved [seasonings] (Changed from “Garden herbs, preserved” and transfer from class 29)</p>	class 29	class 30
<p>Fulling of cloth</p>	class 37	class 40

- changes in the class headings and explanatory notes

The class headings and explanatory notes of certain classes are changed as a result of the entry into force of the 9th edition of the International Classification. For example, “preserved, dried and cooked fruits and vegetables” appearing in the class heading of class 29 is replaced by “preserved, frozen, dried and cooked fruits and vegetables” and “This class does not include, in particular: - wooden flooring (Cl. 19)” is introduced in the explanatory note to class 27.

As a matter of policy, we reclassify registrations to be consistent with the 9th edition after notice to the trade mark owner (section 58; Schedule 5 section 12; rules 58(b) and 59) (see *Notice to reclassify specification* below). In practice, we send notices to reclassify shortly after a registration is renewed.

In summary, the amendments and changes made by the 9th edition, affecting reclassification, are as follows :

- changes resulting from the classification of goods “made of precious metal” and “not made of precious metal” according to their function or purpose;
- transfer of the class heading “legal services” and related indications from class 42 to class 45
- transfer of existing indications from one class to another listed in the table above.
- change, deletion and addition of indications.

Reclassifying old registrations not founded on International Classification

Before 1955, registrations for goods (registration for services was not available in

Hong Kong until 2 March 1992) were classified under classes listed in Schedule 3 to the old Trade Marks Rules (Cap. 43 subsidiary legislation) (“old Schedule 3”).

Since 1955, registrations have been classified under a list of classes which was internationally recognised and which was later formalised in the International Classification under the Nice Agreement of 1957. The classes were listed in Schedule 4 to the old Trade Marks Rules (Cap. 43 subsidiary legislation) (“old Schedule 4”).

Under the old law, the conversion of old Schedule 3 specifications to classes under the old Schedule 4 was voluntary.

Under the new law, the conversion of old Schedule 3 specifications is compulsory. Registrations classified under the old Schedule 3 are reclassified to classes under the International Classification 9th edition after notice to the trade mark owner (section 58, Schedule 5 section 12; rules 58(a) and 59) (see *Notice to reclassify specification* below).

Notice to reclassify specification

Factors to be considered in issuing notices to reclassify specifications, examining registered owners’ written objections and in hearing any person’s opposition to a proposed reclassification are listed in the following paragraphs.

- Send notice of proposed reclassification to the registered owner (rule 59(1)). The notice is dated and sent out immediately because time for the owner to make written objections runs from the date of the notice. A proposed reclassification cannot extend a registered owner’s rights. For example, a registration for “games” in class 49 of Schedule 3 to the repealed Trade Marks Rules (Cap. 43 subsidiary legislation) cannot be reclassified to include “computer games software” which did not exist at the date of registration.

- Has the registered owner made written objections, stating the grounds of his objections, within three months of the date of the notice (rule 59(2)(a))? If yes, consider the objections and, as appropriate, publish the proposals, or the proposals as amended (rules 60(2), 60(3) and 60(4)).

- If the registered owner has not made written objections within 3 months after the date of the notice or any extension of the period, publish the proposals (rule 60(1)). Publish the proposals earlier if the registered owner gives written notice that he will not make any objections (rule 60(1)).

- Has notice of opposition to the proposed reclassification been filed (rule 61)? Was the notice of opposition filed within 3 months after the date of publication of the proposed reclassification (rule 61(1))? **The time limit cannot be extended** (rule 95(1)(o)).

- Is the notice of opposition on Form **T6** and does it state the grounds of opposition and, in particular, how the proposed reclassification would be contrary to section 58(5)?

- If a notice of opposition is filed, we can require or admit evidence on the issue (rule 61(4)).

- If no notice of opposition is filed within 3 months after the date of the publication of the proposed reclassification, or if any opposition has been determined against the opponent, enter in the register the amendments to the classification and the date on which the amendments were made (rule 61(5)). Reclassified specifications that fall into more than one class will become multiclass registrations. (See chapter on Objections and opposition to change of classification of goods or services.)

Application for registration

An application for the registration of a trade mark must include a statement of the goods or services for which the mark is to be registered (section 38(2)(c)) and must specify the class or classes to which it relates (rule 7(1)).

An application for more than one class must set out the classes in consecutive numerical order and list under each class the goods or services appropriate to that class (rule 7(2), (3)).

Application for class heading

The International Classification 9th edition, pages 4 to 6 set out the class “headings”. Applicants may specify the class heading in their applications for registration, for example “clothing, footwear, headgear (class 25)”, **or part of the class heading**, for example “stationery; adhesives for stationery purposes; artists’ materials; paint brushes; office requisites (class 16)”.

Specifying particular goods and services

As an alternative to specifying the class heading in an application for registration, an applicant may specify particular goods or services.

Because the scope of trade mark owners’ rights depend on the specification of goods or services, it is essential that an applicant’s specification should be clear. An applicant should clearly define his goods or services by using terms as listed in the International Classification, or as appearing in authoritative, general and specialist dictionaries and established terms in the relevant trade.

The following table lists some terms we would object to as imprecise and suggests

alternatives (rules 7(2) and 11(1)(a)).

Imprecise terms	Examples of precise definition
advisory services	advisory services relating to business management (class 35) advisory services relating to real estate valuations (36) computer systems design advisory services (42)
all other related services	(see <i>Application for “all goods” or “all services”</i> , below)
all services in this class	(see <i>Application for “all goods” or “all services”</i> , below)
commercial services	commercial financing services (class 36) renting of commercial premises (36)
consultancy services	consultancy services relating to telecommunications (class 38) interior design consultancy services (42)
dealership services	motor dealer services (class 35) retailing of clothing (35) foreign currency dealing (36)
health products	nutritional supplements (class 5)
information / on-line information services	provision of information relating to (<i>indicate field of activity</i>) communication services for the transmission of information (class 38) information services relating to computer systems and applications (42)
information technology / technical support services	computer systems and applications consultancy services (class 42) technical support services relating to computer software and applications (42)

Internet / on-line services	Telecommunication services (class 38) on-line ordering services (35)
logistic services	transport, packaging and storage of goods (39)
multi-media products / services	computers (class 9) printing, scanning and fax machines (9) multi-media games software production services (41)
personal services	personal financial planning advisory services (class 36) personal services rendered by others to meet the needs of individuals (45)
rental / leasing services	rental of advertising space (class 35) rental of computers (42)
retailing and wholesaling services / distributorship services	retail and wholesale of (<i>indicate particular goods or the means of providing the service</i>) (class 35)
related products / services	<i>applicant needs to indicate particular goods / services of interest (See Application for “all goods” or “all services” etc below.)</i>
social services	organisation of social events (class 45) health care services (44) social services rendered by others to meet the needs of individuals (45)
web services	creating and maintaining websites (class 42) hosting computer websites (42)

General principles in specifying goods and services

Terms in a specification are given their ordinary and natural meaning (*Ofrex* [1963] RPC 169-171) subject to the principle that the words must be construed by reference to their context (*Beautimatic International Ltd v Mitchell International*

Pharmaceuticals Ltd [2000] FSR 267, where “skin lightening cream” was held to be within the term of “cosmetics”, and “dry skin lotion” within the terms “cosmetics” and “toilet preparations” : neither “skin lightening cream” nor “dry skin lotion” were in the nature of medicines or pharmaceutical products).

Goods or services are limited by the class number specified in the application. This means that an applicant’s goods or services must fall within the class or classes specified in the application. For example, the goods of an applicant who applies for “bin” in class 6 do not extend to “bins of wood or plastic” properly classified in class 20. It follows that an applicant cannot widen his specification after filing. For example, an applicant who applies for “clothing” in class 25 cannot amend his application to include “protective clothing” in class 9.

Any question as to the class in which goods or services fall, is determined by the Registrar (section 40(2)).

Internet products and services

Internet products and services are varied, and accordingly are classified in various classes.

Class 9 is the appropriate class for products obtained by downloading from the Internet, for example “computer software and publications in electronic form supplied on-line from computer databases or web sites”.

Class 35 is the appropriate class for “advertising and business information services provided on-line from a computer database or Internet”, “on-line shopping services”, and “Internet shopping malls”.

Class 36 is the appropriate class for “real estate information services provided on-line from a computer database or Internet”.

Class 37 is the appropriate class for “information services relating to building construction provided on-line from a computer database or Internet”.

Class 38 is the appropriate class for the core activities of Internet service providers, for example “providing telecommunications connections to a global computer network”, “providing telecommunications access to a global computer network”, “providing telecommunications access to Internet”, “telecommunication of information, computer programs and any other data”, and “electronic mail services”.

Class 41 is the appropriate class for “information relating to entertainment or education provided on-line from computer databases or Internet”, “electronic game services provided on Internet”, “on-line electronic publications provided by viewing computer data bases or web sites”, and “publication of electronic books and journals on-line”.

Class 42 is the appropriate class for “drawing and commissioned writing, all for the compilation of web pages on Internet”, “creating and maintaining web sites”, and “providing search engines for the Internet”.

Class 43 is the appropriate class for “hotel accommodation reservation services provided on-line from a computer database or Internet”.

Class 44 is the appropriate class for “medical advisory services provided on-line from a computer database or Internet”.

Class 45 is the appropriate class for “personal introduction agency services provided on-line from a computer database or Internet”, “intellectual property consultancy services provided on-line from a computer database or Internet”, and “registration of domain names [legal services]”.

Retail services

Marks can be registered for retail services, even though retail services are ancillary to the trade in goods (section 3(3)). But the description “retail services” should be properly defined and if not, we will send a notice to the applicant to remedy the deficiency (rules 7(2) and 11(1)(a)). An applicant’s **specification should state the goods retailed**, for example “retailing of clothing”, **or the means of providing the service**, for example “retailing and wholesaling service provided via a global computer network” (see *Specifying particular goods and services* above). Retail services are classified in class 35.

Writing or examining specifications

Factors to be considered in writing or examining specifications are listed in the following paragraphs.

- Are the goods and/or services listed by class numbers in numerical order? (See *Application for registration* above.)
- Is it clear what the specification is meant to cover? (See *Application for registration*, *Specifying particular goods and services* above and *Application for “all goods” or “all services” etc* below.)
- Does the specification use words that are registered trade marks? (See *Avoiding words that are registered trade marks* below.)
- Is it clear which class the goods or services are in? (See *Application omitting class*, *Application stating the wrong class* and *Application listing goods or services under wrong class* below.)

- Is it necessary to transfer goods or services between classes in the application?
- Does the specification include goods or services which do not fall within the class or classes specified in the application? Has a request been made to add extra classes, or is there a need to add extra classes? (See *Application including goods or services not falling within class* below.)
- Does the specification use words which it is in practice to avoid or to use only in a certain way? (See *Specifying particular goods and services* above.)
- Is the specification repetitive? For example, “sports shoes, shoes for sport in class 25”.
- Is the punctuation clear? (See *Punctuation, qualification, exclusion* below.)
- Has any exclusion been properly worded? (See *Punctuation, qualification, exclusion* below.)
- Have any market or geographical limitations been clearly expressed? (See *Restricting specification* and *Market limitations* below.)
- Has the specification been widened during editing? (See *General principles in specifying goods and services* above and *Application for “all goods” or “all services” etc* below.)
- If the application claims Convention priority, what details need to be checked? (See *Convention claims* below.)

Application for “all goods” or “all services” etc

Occasionally, we may receive an application for “all goods” or “all services” in any class, or an application **so vague that we cannot determine *any* of the goods or services it intends to cover**. In these circumstances, we will send notice to the applicant to remedy the deficiency on the ground that he has not included a statement of goods or services in his application (section 38(2)(c); rule 11(1)(b)).

Examples of specifications so vague that they do not amount to a statement of goods or services would be “prizes in class 21”, “luxury goods in class 14”.

An applicant can remedy the deficiency by completing and filing Form **T5A** within two months (paying a fee for any additional classes). **A filing date cannot be accorded** until the applicant files a proper statement of goods or services (section 39(2)). This could have the effect that his priority claim lapses.

If an applicant fails to remedy the deficiency within two months from the date of the notice, the application is deemed never to have been made (rule 11(2)(b)). **The time limit cannot be extended** (rule 95(1)(a)). (See chapter on Deficiencies checking.)

More usually, an application for registration appropriately specifies **some** goods or services but includes additional phrases such as “all other goods in the class”, “all other related services”, “and related services”, or “and supporting services”. In these circumstances also, we will send notice to the applicant to remedy the deficiency (see rule 7(2)). **An applicant should delete the phrases** by completing and filing Form T5A accordingly. An applicant cannot replace the phrases with additional goods or services because he cannot widen the range of goods or services in the specification.

Similar considerations apply to an application for registration that appropriately specifies some goods or services but includes additional phrases so vague that we cannot determine the goods or services they intend to cover.

Application for a whole class heading in many classes or for a wide range of goods or services in many classes

Registered trade marks (except defensive trade marks) must be used. If they are not used, they are subject to revocation, which supports the view that an applicant's specification of goods or services should not be too broad. (See sections 38(3) and 50(2)(a); *Mercury Communications* (1995) FSR 850; *Roadrunner* (1996) FSR 818. See also *Cine Classics* (15 January 1999) an unreported decision of the UK Registry that a specification for "teaching and training services, educational and entertainment services, and cultural and sporting activities" would include services as diverse as "teaching English as a foreign language". Even the largest of companies would be unlikely to supply this range of services.)

We have power to ask an applicant to justify his intention to use the mark for his specification (section 38(3); rules 7(4) and 11(1)(b) and see rule 89 that allows us to require documents, information or evidence). In practice, the question is unlikely to arise in examination, unless circumstances clearly indicate and applicant's business cannot justify such a broad specification, for example, where an individual or a small company applies for essentially the whole class heading in, for example, several unrelated services classes.

Although the question of broad specifications is unlikely to arise in the context of examination, a broad specification may invite opposition, or revocation proceedings.

Application including goods or services not falling within class

Where an applicant includes goods or services in his application for registration not falling within the classes listed in the application for registration, we will send him notice to remedy the deficiency within 2 months (see rules 7(1), 11(1) and (2)).

The applicant can remedy the deficiency by completing and filing Form **T5A** and the additional class fees within 2 months (rule 7(5) and (6)). The applicant should complete the form by adding the additional classes and by listing the relevant goods or services under the additional classes. An applicant cannot use the form to widen the range of goods or services in his original specification. (As an alternative to adding the additional classes, the applicant can delete the goods or services from his application.)

If the applicant fails to remedy the deficiency within two months from the date of the notice, the part of the application relating to the goods or services the specification of the class or classes for which is deficient is treated as abandoned (rules 7(1) and 11(2)(aa)). **The time limit cannot be extended** (rule 95(1)(a)). (See chapter on Amendment of applications.)

Applications omitting class

Where an applicant includes a statement of goods or services in his application for registration but does not specify the class or classes, we will send him a notice to remedy the deficiency within two months (see rules 7(1), 11(1) and (2)).

The applicant can remedy the deficiency by completing and filing Form T5A together with the relevant fee for any additional class within 2 months.

If the applicant fails to remedy the deficiency within two months from the date of the notice, the part of the application relating to the goods or services the specification of the class or classes for which is deficient is treated as abandoned (rules 7(1) and 11(2)(aa)). **The time limit cannot be extended** (rule 95(1)(a)). (See chapter on Amendment of applications.)

Application stating the wrong class

Where an applicant includes a statement of goods or services in his application for registration but he wrongly states the class, we will send him a notice to remedy the deficiency within 2 months (see rules 7(1), 11(1) and (2)).

The applicant can remedy the deficiency by completing and filing Form **T5A** within 2 months. For example, an applicant who applies for “screwdrivers in class 8” (the class appropriate to hand tools) cannot correct his application to “screwdrivers in class 7” (the class appropriate to electric tools).

If the applicant fails to remedy the deficiency within 2 months from the date of the notice, the part of the application relating to the goods or services the specification of the class or classes for which is deficient is treated as abandoned (rules 7(1) and 11(2)(aa)). The time limit cannot be extended (rule 95(1)(a)). (See chapter on Amendment of applications.)

Application listing goods or services under wrong class

Where an application relates to more than one class and specifies the relevant classes but the applicant mistakenly lists particular goods or services under the wrong class, we will send him a notice to remedy the deficiency within 2 months (see rules 7(1), 11(1) and (2)).

The applicant can remedy the deficiency by completing and filing Form **T5A** within 2 months to transfer the goods or services to the list under the appropriate class. Transfer is possible only where goods cannot fall within the particular class. For example “computer games software” mistakenly listed under class 28 can be transferred to the applicant’s list of goods under class 9. Some goods may fall into more than one class but that is not a reason for transfer. (See Altecnic Ltd’s Application [2002] RPC 639: the mistake must be obvious to allow a change of class under section 39 of the UK 1994 Act, equivalent to section 46 of the Ordinance.)

If the applicant fails to remedy the deficiency within 2 months from the date of the notice, the part of the application relating to the goods or services the specification of the class or classes for which is deficient is treated as abandoned (rules 7(1) and 11(2)(aa)). **The time limit cannot be extended** (rule 95(1)(a)). (See chapter on Amendment of application.)

Deleting a class or classes, or goods or services, from an application

An applicant can delete a class or classes, or goods or services, from his application at any time by completing and filing Form **T5A**.

Restricting specification

A mark that is clearly descriptive of a characteristic of the goods or services (for example the nature, quality or geographical origin) and which is realistically likely to deceive consumers if the goods or services of the specification do not conform to the description, is objectionable under section 11(4)(b).

We should not object where there is no realistic likelihood of deception (see for example *Carlton & United Breweries Ltd v Royal Crown Draft Co Inc* (2001) 53 IPR 599 where the word “draft” in the mark ROYAL CROWN DRAFT in respect of soft drinks and syrups, concentrates and extracts for making soft drinks was not likely to deceive purchasers into thinking the product was alcoholic). Realistically, a mark is only likely to deceive if it amounts to a misrepresentation in relation to the goods or services.

The fact that a specification is broader than the description conveyed by the mark does not necessarily make a mark deceptive, for example TETRATEA in class 30 would not

be deceptive in relation to a specification that includes a broader range of goods than tea.

Similarly, a restriction is unlikely to be necessary in relation to marks incorporating words describing materials or desirable qualities of a product or service where there is adequate scope within the specification for legitimate use of the mark and where in practical terms deception is unlikely. For example WOOLTECH for “yarns and threads” need *not* be restricted “all made wholly or principally of wool”. For the same reasons, THERAFLU for “pharmaceutical preparations” need not be restricted “for the treatment of influenza”.

But there are circumstances in which a mark will be deceptive unless the specification is restricted. A restriction may be necessary in relation to marks incorporating place names or symbols used as an indication of geographical origin where the place has a reputation for the goods or services, or for closely related goods or services. In the circumstances it may be necessary to :

- restrict the specification to the particular product, for example a mark incorporating the name “CHAMPAGNE” in class 33 should be registered for the restricted specification “champagne” only (similarly COGNAC).

- introduce a limitation into the specification, for example marks incorporating MÜNCHEN LAGER in class 32, SWISS CHRONOMETRIC EQUIPMENT in class 14, CHOCOLATERIE DE BELGIQUE in class 30 should be limited to goods “produced in Germany”, “Switzerland” and “Belgium”, respectively.

An applicant can delete goods or services from his specification, restrict his specification by a limitation, (or offer an appropriate condition of registration) to overcome an objection that the mark is likely to deceive. “Variation clauses” which were occasionally used under the old law to obtain registration of a mark that would otherwise have been considered deceptive under former practice, are now redundant (see the old Trade Marks Rules (Cap. 43 subsidiary legislation) rule 7(2) which has no counterpart under the new Rules).

Because of the restrictions on amending marks, an applicant cannot remove descriptive elements from the mark itself to overcome an objection that the mark is likely to deceive.

The question of whether a mark is likely to deceive is wider than the question of restricting a specification. It is not always possible to overcome an objection of deceptiveness by restricting the specification. For example, an objection to a mark incorporating the words “VETERINARIANS’ RECOMMENDED” for animal food in class 31 could not realistically be overcome by a restriction purporting to limit the product to “foodstuff approved by veterinarians” (outside the safeguards offered by regulations in support of registration as a certification trade mark).

Market limitations

In certain circumstances, marks may be limited for export to particular markets.

Punctuation, qualification, exclusion

Commas or semi-colons are used to separate goods or services listed in the specification. For example, the following specification can be punctuated by using either commas or semi-colons: “meat, fish, poultry and game”, or “meat; fish; poultry and game”, or “meat; fish; poultry, and game”.

Where goods or services are subject to a qualification, a semi-colon is used to show which goods are qualified. In the example “meat, fish, poultry and game; fruits and vegetables, all being preserved”, only “fruits and vegetables” are limited by the qualification “preserved”. In the example “photographic; measuring and signaling apparatus and instruments; all for maritime use”, the qualification “all for maritime use” applies to all the goods.

Where goods or services are subject to an exclusion, a semi-colon is used to separate the list of goods or services from the exclusion, for example “insurance; property valuation; but not including marine insurance services”.

Usually, the exclusion is placed at the end of a specification, for example “rental of advertising space; arranging newspaper subscriptions; but not including any such services for advertising by television or radio”. But an exclusion can also be placed next to the goods or services affected, for example “rental of advertising space but not including any such services for advertising by television or radio; arranging newspaper subscriptions”.

Avoiding words that are registered trade marks

A specification should not use words that are registered trade marks, for example “Hoover”, “Jacuzzi”, “Karaoke”, “Rollerblade”, “Walkman”, and “Yo-Yo”.

Convention claims

Where an applicant claims priority and his claim challenges an earlier filed conflicting application, we will send him a notice to file his priority documents to ensure that his specification is not wider than his Convention specification.

If the applicant’s specification is wider than his Convention specification, he can divide his application so as to proceed separately with the goods or services covered by the Convention application. (See chapter on Claim to priority.)

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