

# Workshop – The ninth edition of the International Classification of Goods and Services for the Purposes of the Registration of Marks

*30 November 2006*

## Agenda

- How is the International Classification updated?
- What classification changes are to be made by the ninth edition?
- How will the ninth edition affect IPD's cross search list?
- How to reclassify goods and service of trademark registrations in accordance with the ninth edition?
- What changes are to be made to Application Form T2?

## How is the International Classification updated?

## How is the International Classification updated?

- The World Intellectual Property Organization revises the International Classification from time to time (usually every 5 years) to keep it up to date
- The Committee of Experts set under the Nice Agreement decides on all changes in the International Classification
- At its 19<sup>th</sup> and 20<sup>th</sup> sessions, the Committee of Experts adopted amendments and other changes to the eighth edition ([http://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=18683](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](http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=52419))
- The ninth edition will enter into force on 1.1.2007

## What classification changes are to be made by the ninth edition?

## What classification changes are to be made by the ninth edition? (1)

- Amendments and changes include:
  - 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

## What classification changes are to be made by the ninth edition? (2)

- transfer of goods/services from one class to another
  - changes, deletion and addition of indications
  - changes in the class headings and explanatory notes
- Some classification changes will affect reclassification of goods and services of trademark registrations

## Changes resulting from the classification of goods “made of precious metal” and “not made of precious metal” according to their function or purpose (1)

- Classification under the eighth edition:
  - Goods made of precious metal are classified in Class 14
  - Goods not made of precious metal are classified in various classes [other than Class 14] according to their function or purpose

## Changes resulting from the classification of goods “made of precious metal” and “not made of precious metal” according to their function or purpose (2)

- Examples:
  - candlesticks of precious metal: Class 14  
candlesticks, not made of precious metal: Class 21
  - boxes of precious metal for needles: Class 14  
boxes for needles, not made of precious metal: Class 26
  - cigarette cases of precious metal: Class 14  
cigarette cases, not made of precious metal: Class 34

## Changes resulting from the classification of goods “made of precious metal” and “not made of precious metal” according to their function or purpose (3)

- Classification under the ninth edition:
  - goods “made of precious metal” and “not made of precious metal” are classified according to their function or purpose
  - Examples:
    - (a) candlesticks: Class 21
    - (b) boxes for needles: Class 26
    - (c) cigarette cases: Class 34

## Transfer of the class heading “legal services” and related indications from Class 42 to Class 45 (1)

### Examples (1)

Class 45: legal services  
arbitration services  
copyright management  
intellectual property consultancy

## Transfer of the class heading “legal services” and related indications from Class 42 to Class 45 (2)

### Examples (2)

Class 45: licensing of computer software [legal services]  
licensing of intellectual property  
litigation services  
registration of domain names [legal services]

## Transfer of goods/services from one class to another

### Examples

Goods/Services	Classification under the eighth edition	Classification under the ninth edition
cloths impregnated with a detergent for cleaning	Class 21	Class 3
indoor aquaria	Class 16	Class 21
fulling of cloth	Class 37	Class 40

## Change of indications

### Examples

Class	The eighth edition	The ninth edition
9	electronic games and amusement apparatus adapted for use with television receivers	electronic games and amusement apparatus adapted for use with an external display screen or monitor
28	games other than those adapted for use with television receivers only (Apparatus for electronic -)	games other than those adapted for use with an external display screen or monitor (Apparatus for -)
39	storage of electronically-stored data or documents	storage (Physical -) of electronically-stored data or documents

## Deletion of indications

### Examples

Class	Indication
19	refractory materials
30	Starch products for food
35	Statistical information

## Addition of new indications

### Examples

Class	Indication
6	refractory construction materials of metal
19	refractory construction materials, not of metal
42	computer virus protection services
44	pharmacists' services to make up prescriptions

## Change in the class headings and explanatory notes (1)

### Examples

#### Class headings

- transfer of “legal services” from the class heading of Class 42 to that of Class 45
- replace “preserved, dried and cooked fruits and vegetables” appearing in the class heading of Class 29 by “preserved, frozen, dried and cooked fruits and vegetables”

## Change in the class headings and explanatory notes (2)

### Explanatory notes

- introduce “This Class does not include, in particular: - wooden flooring (Cl.19)” in the explanatory note to Class 27

## How will the ninth edition affect IPD's cross search list?

## How will the ninth edition affect IPD's cross search list?

- We take account of changes to the International Classification in our searches for earlier marks
- The list sets out, in principle, the classes in which the registry would normally search in respect of particular goods or services to help examiners to identify earlier marks for identical or similar goods or services

## Changes resulting from the classification of goods “made of precious metal” and “not made of precious metal” according to their function or purpose

### Examples

Goods/Services	Cross search against
Class 21: boxes for sweetmeats	Class 14: boxes of precious metal for sweetmeats (cite only marks filed before 1.1.2007)
Class 21: urns; vases	Class 14: urns of precious metal; vases of precious metal (cite only marks filed before 1.1.2007)
Class 26: needle cases	Class 14: needle cases of precious metal (cite only marks filed before 1.1.2007)

## Changes resulting from the transfer of the class heading “legal services” and related indications from Class 42 to Class 45

Goods/Services	Cross search against
Class 45: Arbitration services, copyright management, intellectual property consultancy, intellectual property watching services, legal research, legal services, licensing of computer software [legal services], licensing of intellectual property, litigation services, registration of domain names [legal services]	Class 42: Arbitration services, copyright management, intellectual property consultancy, intellectual property watching services, legal research, legal services, licensing of computer software [legal services], licensing of intellectual property, litigation services, registration of domain names [legal services] (cite only marks filed before 1.1.2007)

## Changes resulting from the transfer of goods/services from one class to another

### Examples

Goods/Services	Cross search against
Class 3: cloths impregnated with a detergent for cleaning	Class 21: cloths impregnated with a detergent for cleaning (cite only marks filed before 1.1.2007)
Class 17: liquid rubber, rubber solutions	Class 1: liquid rubber, rubber solutions (cite only marks filed before 1.1.2007)
Class 40: fulling of cloth	Class 37: fulling of cloth (cite only marks filed before 1.1.2007)

## Changes resulting from change, deletion and addition of indications

### Examples

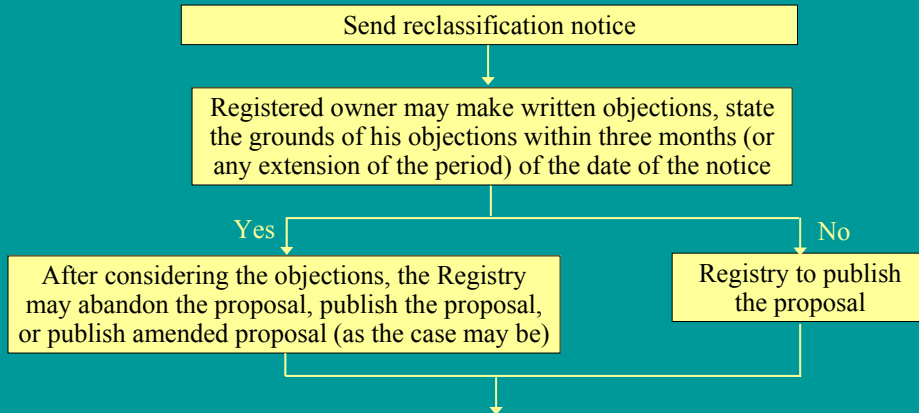
Goods/Services	Cross search against
Class 9: Electronic games and amusement apparatus adapted for use with an external display screen or monitor	Class 28: Electronic games and amusement apparatus (other than those adapted for use with an external display screen or monitor)
Class 19: Non-metallic buildings, non-metallic building materials, parts and fittings; refractory construction materials, not of metal	Class 6: Metallic buildings, metallic building materials, parts and fittings; refractory construction materials of metal
Class 18: horse shoes, stirrups	Class 6: horse shoes of metal, stirrups of metal (cite only marks filed before 1.1.2007)

## How to reclassify goods and services of trademark registrations in accordance with the ninth edition?

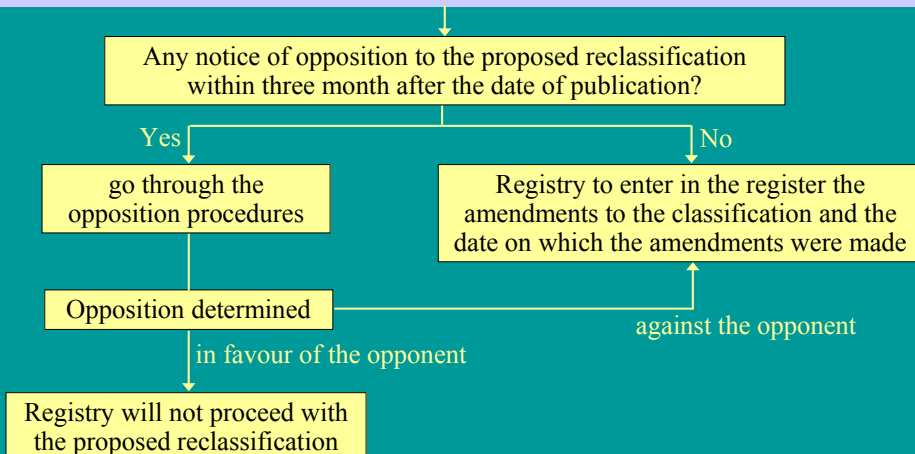
## How to reclassify goods and services of trademark registrations in accordance with the ninth edition?

- We will reclassify registrations to be consistent with the ninth edition
- Reclassification includes:
  - registrations classified under classes listed in Schedule 3 to the old Trade Marks Rules (Cap.43 subsidiary legislation)
  - registrations classified under classes listed in Schedule 4 to the old Trade Marks Rules (Cap.43 subsidiary legislation) that are not consistent with the ninth edition to be introduced by the ninth edition
  - registrations classified in accordance with the eighth edition of the International Classification that will be affected by the classification changes to be made by the ninth edition

## Workflow of reclassification (1)



## Workflow of reclassification (2)



## What changes are to be made to Form T2 ?

## What changes are to be made to Form T2 ?

- Deletion of the reference to “8th edition” from Note 2
- Indication of URL “<http://ipsearch.gov.hk>” for search of both International Classification (ninth edition) and IPD accepted specification of goods/services
- Combination of Form T2 and T2S to avoid affixation of different marks
- Amendment of Notes 3 and 4 to remind applicants that PO Box address and “care of” address are not acceptable as address for service and agent’s address

T2-2<sup>4</sup>

**02 Trade-Mark<sup>4</sup>**

Place a representation of your trade mark in the box.<sup>4</sup>

If you claim colour(s) as a trade mark or as element(s) of a trade mark, the representation of your trade mark must be in the colour(s) for which the claim is made. Complete also Part 07 and attach Form T2A.<sup>4</sup>

**Series-Marks<sup>4</sup>**  
If the request relates to a series of marks, please indicate in the following box the number of marks in the series (not more than 4).<sup>4</sup>

**For official use only<sup>4</sup>**

Device mark classification<sup>4</sup>

Category <sup>4</sup>		Division <sup>4</sup>		Section <sup>4</sup>		Category <sup>4</sup>		Division <sup>4</sup>		Section <sup>4</sup>	

T2-4<sup>1</sup>

**Note 2** → Goods and services are classified in accordance with the Nice Classification. This can be viewed at <http://ipsearch.ipd.gov.hk/>. A copy is also available at the counter of the Trade Marks Registry.<sup>1</sup>

**05 Goods and/or services covered by this application (Note 2)**  
List the class number(s) in consecutive numerical order and the goods or services appropriate to that class.<sup>2</sup>

Class no(s) <sup>4</sup>	Specification of goods and/or services <sup>4</sup>

Total number of class(es)<sup>3</sup>

**Note 3** → You must provide details of an address for service in Hong Kong, China. Please note that a P.O. Box or 'care of' address is not acceptable...

**08 Signature**

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Signature	Name and Official Capacity of Signatory	Date (DD-MM-YYYY)
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**09 Address for service in Hong Kong, China (Note 3)**

**Name**

**Address**

Your reference	Telephone no.	
Facsimile no.	E-mail address	

**Note 4** → If you are an agent, you must provide details of an address in Hong Kong, China where you reside or carry on your business activities... Please note that a P.O. Box or 'care of' address is not acceptable...

**10 Agent's address (Note 4)**

**11 State the number of additional sheet(s) attached to this form**

## How to place order for WIPO publication on the ninth edition of the International Classification?

- WIPO's e-bookshop

<http://www.wipo.int/ebookshop/>

## How to obtain further information on the ninth edition of the International Classification after it has come into force on 1.1.2007?

- WIPO's website  
<http://www.wipo.int/classifications/en/>
- IPD's website
  - Trade Marks Registry Work Manual Chapter on Classification  
[http://www.ipd.gov.hk/eng/intellectual\\_property/trademarks/registry/Classification.PDF](http://www.ipd.gov.hk/eng/intellectual_property/trademarks/registry/Classification.PDF)
  - How to classify my goods/services?  
[http://www.ipd.gov.hk/eng/intellectual\\_property/trademarks/how\\_to\\_classify.htm](http://www.ipd.gov.hk/eng/intellectual_property/trademarks/how_to_classify.htm)
  - Trademark search – Goods/Services Classification Search  
<http://ipsearch.ipd.gov.hk/trademark/jsp/main.jsp>



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知識產權署

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# Thank you