

1st September. 1994.

Circular No. 9 of 1994

Classification and Specification of Goods & Services

INTRODUCTION

This Circular is intended to provide some basic practice directions with regard to classification of goods and services and in framing or editing specifications, with the help of examples where necessary and applicable.

CLASSIFICATION

2.1 How to determine the correct class for goods and services

2.1.1 Goods:

- (i) If the item of goods in question comes within the embrace of a general term e.g. "household articles" in Class 21, it will be logical & proper to classify the item in the same class as the general term

E.g. toothpicks) will both be classified in 21 because they are household chopsticks)
articles

- (ii) The purpose of the goods often determines the correct class:

E.g. "Knives" are proper to Class 8 whereas "surgical knives" fall under Class 10

- (iii) Materials of the goods concerned.

E.g. The following goods are classified by material

	<u>made of non-precious metal</u>	<u>made of precious metal</u>
pen holders	16	14
table ware	21	14
cigarette boxes	34	14
cutlery (knives, forks, spoons)	8	8

N.B. Details on how to find the correct class for specific items are given in para. 7.36 of Chapter 7 of the Revised UK Work Manual and in the Explanatory Notes to the respective classes in the Introductory Part I of the "WIPO List of International Classification of Goods & Services".

2.1.2 Services:

Since services such as repair, maintenance, rental, training, advisory, consultancy, financing, travel agency are by nature intangible, abstract and in most cases unspecific or ambiguous in coverage, classification is not solely dependent on the overall terms. Due regard will have to be paid to the field or business activities in which the specific services take place as well as to the actual type or line of service on offer. In other situations, the activities, objects or tools with which the services are involved might also help to determine their classes.

The following are some examples:

- | | | |
|-----|--|----------|
| i | <u>Rental services</u> of office machines or computer | Class 42 |
| | Rental, leasing services of real estate | Class 36 |
| ii | <u>Travel agency</u> providing booking of accommodation | Class 42 |
| | Travel agency providing transport service | Class 39 |
| iii | <u>Organizing Conferences</u> | |
| | --- for commercial promotions, trade, business, entertainments | Class 35 |
| | --- for educational purposes | Class 41 |
| | --- other than the above purposes | Class 42 |
| iv | <u>Electricity ...</u> | |
| | Electricity distribution and supply services | Class 39 |
| | Electricity generation | Class 40 |

It is therefore important for the applicants and agents to be well-conversant with the basic or fundamental classification of services. They require to have a good understanding and general knowledge of the types of services proposed for registration as well as the business or any activities involved or associated with the provision of the services in order to correlate the services concerned to the principal or leading activity and then to the proper class concerned. Very often, they will have to identify the actual type or coverage of the services in question and refrain from using overall or unspecific terms e.g. training services, management services, travel services ... etc. It is also important to provide information on the additional related services covered by the general term for classification purposes.

Samples of commonplace services classifications and specifications are found at Annex " A " .

3. No widening of ambit of specification after filing of application

Once an application has been filed, the Registry will not allow widening or extension of the ambit of goods or services covered by the original specification. Any widening of specification would necessitate another search to be conducted and it could also disadvantage other applicants should their application contain the subsequently added items of goods or services to the earlier applications requesting for extension of specification.

4. Situations inviting the Registrar's objections or enquiries under Rule 10 of the Trade Marks Rules

4.1 It is a settled principle of trade mark law that there shall be a bona fide intention to use the mark as propounded in Ducker's Trade Mark Application (45 RPC 397 in particular the judgement by Lord Hanworth at Page 400). Therefore the Registrar has to be satisfied that the specification is justified by use of the mark on goods or services which the applicant has already made or intends to make or provide if and when the mark is registered.

4.2 The following wordings used in specifications usually prompt the Registry to raise a "Rule 10" objection :-

- i where the application is for "all goods in Class / all services in Class ; or
- ii where the application is for all or nearly all the class heading in "WIPO's International Classification of Goods and of Services" and in Schedule 4 to the Hong Kong Trade Marks Rules; or
- iii where multiple classes applications have been made by the same applicant for registration of the same mark although he might not necessarily claim the whole class heading in every application as. filed, i.e. where doubts arise as to whether the application trades in all the classes applied for.

4.3 The following are exceptions

- i Class headings for classes in Class 15, 23, 24, 25, 26, 32, 33 and 34 can normally be accepted;
- ii applications filed by established companies reputed to be a manufacturer or trader producing or marketing a very wide range of goods or providing a very large and varied range of services could reasonably be expected to extend their commercial activities to cover a wider range of goods or services.

4.4 In class 9, an "all class" claim can hardly be justified. Likewise, it is neither likely for any leading car manufacturer to claim and justify registration of "Vehicles" at large for Class 12.

4.5 The services classes 35-42 are each very wide in scope and it is unlikely that any one business or enterprise would provide all the services included in any one class of services. For example "construction and repair services" in Class 37 will include services as diverse, as "repair of watches", "repair of plumbing system", "construction of houses". Thus an all class claim in Class 37 heading should never be accepted.

4.6 It used to be the practice of the Registrar to issue a standard enquiry letter where an application was submitted for a whole class claim or a broad range of services. This will no longer be done and a formal objection under Rule 10 will be issued. [see Circular No.8 of 1994 and Supplement thereto.]

5. Specifications of Goods and Services

5.1 Editing Specification - Clarity is required

5.1.1 Specifications of goods/services are required to be framed and edited so as to avoid, wherever possible, obvious tautology, ambiguity, or redundancy. Concise and precise wording of specifications is what is actually required to enable all users of the Register (including public searchers as well as the Court in an infringement action) to determine without difficulty the exact goods or services covered by the specification. The rights attached to a mark conferred by a registration can only be clearly determined with certainty from a clear and concise specification.

5.1.2 Applicants are discouraged from using unduly lengthy specifications, and to avoid use of repeated qualifications, tautology. It is however left to the discretion of the applicants to use either specific or general terms.

E. g.

	<u>General terms</u>	<u>Specific terms</u>
Class 34	Smoker's articles lighters, pipes And/or requisites	cigarette holders, ash trays
Class 25	Articles of outer Clothing	jeans, pants, dresses, skirts, shirts, T-shirts, blouses

5.1.3 Where amendment of the specification is necessary, it is the standard and normal practice for the Registry to seek the confirmation of the applicants or agents on any proposed specification and request filing of Form TM-No. 33 to effect amendment accordingly.

5.2.1 List of "DOs" in framing and editing specifications

- i. Use plural form for virtually all items of goods except the following :-

Apparatus

Stationery

Furniture, bedding

Software, hardware

Printed matter

Glassware, earthenware, tableware

(The above list is by no means exhaustive.)

- ii. Use "parts and fittings thereof" or "parts and fittings for (all) the aforesaid goods included in Class ____ " upon ascertaining that the parts and fittings do fall in the class concerned.
- iii. Use the words " Wholly or principally" in relation to goods classified by material.
E.g. "conduits, pipes, all made wholly or principally of metal and all included in class 6"
- iv. Use the phrase or qualification "Wholly or substantially wholly" normally to overcome a Section 12(1) objection in respect of a constituent material.
E.g. "gloves, mittens, socks, all being wholly or substantially made of cotton."

5.2.2 List of "DO NOTs" in framing and editing specifications

i. The following "descriptive" words or terms are not allowed in specifications:-

- a Laudatory and descriptive terms e.g. "First Class" furniture
"high-powered" batteries
- b Generically used terms e.g. "Stone-washed" jeans
"Lights" cigarettes
- c Other proprietors' Trade Marks e.g. "HOOVER" in place of vacuum cleaner
"WALKMAN" in place of portable cassette radios
"MATCHBOX" in place of miniature toy vehicles
- d Descriptive words/terms that might mislead classification e.g. "air conditioning fans"

"Fans" fall under Class 11 whereas air conditioners fall under Class 9. Ventilating fans appear to be the appropriate description if the claim is intended in Class 11 whereas if Class 9 is intended, "air conditioning apparatus" will be the proper term.

ii Use of the following words or expressions which amount to ambiguity will not be allowed:-

"including", "namely", "such as", "covering", "for example", "i.e.", "specifically,"

"including ... but not excluding or limited to", "and the like", "ancillary", "related", "similar"

Examples

Unsatisfactory Specification

Recommended Specification

Dairy products namely Cheese and butter

Cheese and butter

Machine tools namely metal cutters

Metal cutters, being machine tools
(NB metal cutters could be other than machine tools)

Insecticides including biocides, pesticides

Insecticides, biocides and pesticides

(Insecticides/biocides are distinguishable in kind and use, therefore separate mention is allowed)

The following terms should NOT be used:-

- System - This is a vague and abstract term and more appropriately replaced by "apparatus"
- Equipment - "Apparatus" is the suitable alternative
- Media - Being a vague term, it is unacceptable in Class 9 or 16
- Peripheral - Exact items can be and should be itemised
- Accessories - Except in Class 28 i.e. accessories for dolls
- Machinery - To be altered to "... machines" (exact type to be specified for clear & precise identification of the goods)
- Kits - e. g.
 - Diagnostic Test kit)
 -)
 - Tool kit)
 -)
 - Cosmetic kit)

The exact goods which fall under different classes are not identified

The alternative is to have the exact goods specified and followed by "all packed or available in kit form and all included in Class _____".

iv "All goods/services included in Class _____"

This is not allowed because the exact goods/services have not been defined. Unfamiliar users of the Register might not know the class heading or goods/services covered in a particular class.

Without identifying the exact goods or services, dispute could arise at a later date as to whether as at the date of registration specific goods or services which make inroads to the market subsequent to registration should also be covered.

v Do NOT exclude goods or services which are not included in the specification or in the class concerned

(a) "shirts, blouses, trousers, *but not including socks or neckties"

*The exclusion is unnecessary because the preceding items have been identified per se and they do not cover socks or neckties or any other additional items.

(b) "cakes, pastries, biscuits included in Class 30 *but not including biscuits for animals"

*The exclusion is unnecessary and improper since biscuits for animals fall in Class 31, hence exclusion is senseless.

vi The following terms in the respective classes will NOT normally be accepted

6 - "Goods of common metal" at large

7 - "Machines" at large

9 - "Electrical and electronic apparatus" at large

10 - "Surgical, medical, dental and veterinary apparatus" simply

12 - "Vehicles" simply

25 - "Clothing" or "Articles of clothing" simply

29 & 30 - "Foodstuffs" simply

35 - "Business services" - must be more specific

36 - "Financial services" - only accept from large financial institutions

37 - "Building services") - (or similar services in
"Construction services") - Class 37) Few if any
"Renovation services") - companies will have the
"Repair services") - capability to repair or
"Servicing") - construct all goods. It
"Installation") - therefore important to
) - specify the areas of
) - interest

- 38 - "Communications services" - ask to specify means of communication on offer
 - 39 - "Transport services" at large
 - 40 - "Material treatment services" at large
 - 41 - "Educational or training services" at large
"Entertainment services" at large
 - 42 - "Design or "Consultations (non-business)" or "technical services" or "Preparation of reports" or similar without further qualification as to the field of interest
- vii Do not use vague and unspecific terms or adjectives: "Electrical products", "technical products, technical oils".
- viii "And/or" , "Oblique strokes".

Oblique strokes should never be used in specification except in the phrase "and/or". Where an oblique stroke appears between items of goods or services, it should be replaced by the term "and/or".

E.g.

<u>Unacceptable</u>	<u>Acceptable</u>
Chemical/biochemical products	chemical and/or biochemical products
chemicals for use in industry/ science	chemicals for use in industry and/or science

5.3 Use of the qualification "all included in Class _"

- i The practice of adding this qualification all included in Class ____“ was introduced in the UK in 1987, also gradually adopted in Hong Kong. The phrase "all included in Class ____” added at the end of every specification makes it clear that the goods or services are limited to those of the class named and applied for.
- ii It follows that the qualification should in future to be added to specifications where the goods or services concerned also fall in other classes than the one applied for. For example wines falling in Class 33 are inclusive of low alcoholic wines proper to Class 32; "travel agency services" falling in Class 39 are inclusive of travel agency services for arranging accommodation which will be specifically allotted to Class 42. The effect of adding the qualification "all included in Class 33/39", as the case might be, will make it clear that the goods or services covered by the registration are limited to those of the class under application.

- iii Hence, when adopting the qualification "all included in Class ____", the applicants/agents will have to satisfy the Registry that the goods or services so stated are clearly in the class applied for under application. For example, if a general term such as "travel agency services" is given which could possibly be classified in more than one class, the Registry will have to ask for more details on the exact line or type of travel agency services before assigning the proper class to the services concerned.

Miscellaneous:

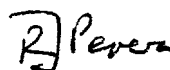
- (a) Avoid double qualification. There is no need to add the qualification to individual items.
- (b) Remove a class qualification from the middle of a specification.
- (c) Use a semi-colon before "all included in Class ____" in order to achieve the desired effect of qualifying all goods/services which precede the qualification. E.g. 'Beaching preparations, substances for laundry use, cosmetics; all included in Class 3'. The class qualification refers to all the preceding goods.

6. Punctuation used in specifications

It is important, for the applicants/agents to ensure that the punctuation as used in the specification is absolutely correct because the misplacing of a comma or a semi-colon can easily affect the extent of qualification, coverage and interpretation.

- E.g.
- i All the limitations or exclusions or qualifications have a comma prior to them indicating that such limitations ...etc. only affect use" are only intended to qualify those goods between that comma and the preceding semi-colon. "pharmaceutical preparations ; plasters, bandages, all for surgical use". The words "all for surgical use" only refer to the words "plasters, bandages"
 - ii Limitations or exclusions with semi-colons before them would mean that the whole of the specifications are affected. "bleaching preparations, substances, cosmetics; all included in Class 3" (the class qualification refers to all the goods)
 - iii Limitations or exclusions with commas used instead of semi-colons would mean that the limitations would refer to the immediately preceding item. "meat, fish, poultry and game; jams; fruit and vegetables, all being preserved" (i.e. "all being preserved" only refer to fruit and vegetables")

7. This circular is intended for the guidance and instruction of the internal staff of the Trade Marks Registry. Its terms in no way fetter the discretion given to the Registrar of Trade Marks under the Trade marks Ordinance, Chapter 43. Laws of Hong Kong. All cases dealt with by the Registry will be decided under the Ordinance on their own facts and within the guidance of the Courts and the Registrar's discretion, where appropriate.



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for Registrar of Trade Marks