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

13 December 2011

Agenda

- How is the International Classification updated?
- What revisions are to be made by the tenth edition?
- How will the tenth edition affect the Trade Marks Registry's cross search list?
- How to reclassify goods and services of trademark registrations in accordance with the tenth edition?

How is the International Classification updated?

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- The World Intellectual Property Organization revises the International Classification from time to time to keep it up to date (revision for every 5 years for transfer of goods/services or creation of new class).
- The Committee of Experts set under the Nice Agreement decides on all changes in the International Classification.
- At its 21th session, the Committee of Experts adopted amendments and other changes to the ninth edition (http://www.wipo.int/meetings/en/details.jsp?meeting_id=20194).
- The tenth edition will enter into force on 1.1.2012.

What revisions are to be made by the tenth edition?

What revisions are to be made by the tenth edition? (1)

1. Revisions concerning game and amusement apparatus*
2. Revisions concerning dietary supplements, food additives and certain foodstuffs*
3. Addition of new indications
4. Deletion of indications
5. Change of indications

*Some revisions affect cross search list.

What revisions are to be made by the tenth edition? (2)

6. Transfer of indications*
 7. Change and transfer of indications*
 8. Addition, deletion, change and transfer of indications*
 9. Changes to class headings and explanatory notes
 10. Changes to general remarks
- * Affects cross search list

Revisions concerning game and amusement apparatus (1)

- Both “game and amusement apparatus adapted for use with an external display screen or monitor” and “game and amusement apparatus other than those adapted for use with an external display screen or monitor” are in Class 28.

Revisions concerning game and amusement apparatus (2)

Class 9

Deletion of the following indications:

- Apparatus for games adapted for use with an external display screen or monitor
- Amusement apparatus adapted for use with an external display screen or monitor

Revisions concerning game and amusement apparatus (3)

Class 28

- Deletion of “games other than those adapted for use with an external display screen or monitor”
- Change of “apparatus for games other than those adapted for use with an external display screen or monitor” to “apparatus for games”

Revisions concerning game and amusement apparatus (4)

Class 28

- Addition of the following indications:
 - video game machines
 - portable games with liquid crystal displays
 - arcade video game machines

Revisions concerning dietary supplements, food additives and certain foodstuffs (1)

Some examples of revisions:

- Class 5
Addition of some indications e.g. “enzyme dietary supplements”
- Class 29
Change of some indications e.g. change of “albumen for food” to “albumen for culinary purposes”

Revisions concerning dietary supplements, food additives and certain foodstuffs (2)

Some examples of revisions (continued)

- Class 30
Addition of some indications e.g. “gluten additives for culinary purposes”
- Class 31
Change of some indications e.g. change of “yeast for animals” to “yeast for animal consumption”

Addition of new indications

Examples

Class	New indication
3	drying agents for dishwashing machines
9	portable media players
38	transmission of digital files
45	planning and arranging of wedding ceremonies

Deletion of indications

Examples

Class	Indication
6	pins for wheels, etc
9	capacity measures
41	digital imaging services

Change of indications

Examples

Class	The ninth edition	The tenth edition
5	deodorants, other than for personal use	deodorants, other than for human beings or for animals
19	arbours [structures]	arbours [structures not of metal]
41	film production	film production, other than advertising films

Transfer of goods from one class to another

Examples

Goods	Classification under the ninth edition	Classification under the tenth edition
Distribution machines, automatic	Class 9	Class 7
Fire hose	Class 17	Class 9
Drinking straws	Class 20	Class 21

Change and transfer of goods/services from one class to another

Examples

Goods/Services	Classification under the ninth edition	Changed to	Classification under the tenth edition
Electroplating apparatus	Class 9	Electroplating machines	Class 7
Babies' diaper-pants of paper and cellulose, disposable	Class 16	Babies' diaper-pants	Class 5
Evaluation of wool	Class 35	Financial evaluation of wool	Class 36

Addition, deletion, change and transfer of goods

Example:

Flat irons

- Deletion of “flat irons, electric” from Class 9
- Change of “flat irons, non-electric” in Class 8 to “flat irons”
=> “flat irons” (whether electric or non-electric) are in Class 8.

Changes to class headings and explanatory notes (1)

Examples

Class headings

- Class 7: Add “automatic vending machines” at the end
- Class 32: Replace “Agricultural, horticultural and forestry products and grains not included in other classes;” with “Grains and agricultural, horticultural and forestry products not included in other classes;”

Changes to class headings and explanatory notes (2)

Examples

Explanatory notes

- Class 3: Under “*This Class includes, in particular:*” add “*room fragrancing preparations*”
- Class 38: Under “*This Class does not include, in particular:*”, add “*telephone marketing (telemarketing) services (Cl. 35).*”

Changes to general remarks (1)

The following remarks are added.

- 1) 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.

Changes to general remarks (2)

- 2) 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)).

How will the tenth edition affect the Registry's cross search list?

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- We take account of transfer of goods/services from one class to another and other revisions made 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.

Revisions concerning game and amusement apparatus

Examples

Goods	Cross search against
Class 28: apparatus for games	Class 9: <ul style="list-style-type: none"> • apparatus for games adapted for use with an external display screen or monitor • amusement apparatus adapted for use with an external display screen or monitor (cite only marks filed before 1.1.2012)

Revisions concerning dietary supplements, food additives and certain foodstuffs

Example

Goods	Cross search against
Class 5: Yeast dietary supplements	Class 30: Yeast in pill form, not for medical uses (cite only marks filed before 1.1.2012)

Revisions resulting from the transfer of goods from one class to another

Examples

Goods	Cross search against
Class 7: Electric welding apparatus	Class 9: Electric welding apparatus (cite only marks filed before 1.1.2012)
Class 21: Tea cosies	Class 26: Tea cosies (cite only marks filed before 1.1.2012)
Class 28: Swimming jackets	Class 9: Swimming jackets (cite only marks filed before 1.1.2012)

Revisions resulting from the change and transfer of goods/services from one class to another

Examples

Goods/Services	Cross search against
Class 7: Electroplating machines	Class 9: Electroplating apparatus (cite only marks filed before 1.1.2012)
Class 21: Make-up removing appliances	Class 9: Make-up removing appliances, electric (cite only marks filed before 1.1.2012)
Class 36: Financial evaluation of standing timber	Class 35: Evaluation of standing timber (cite only marks filed before 1.1.2012)

Revisions resulting from addition, deletion, change and transfer of indications

Example

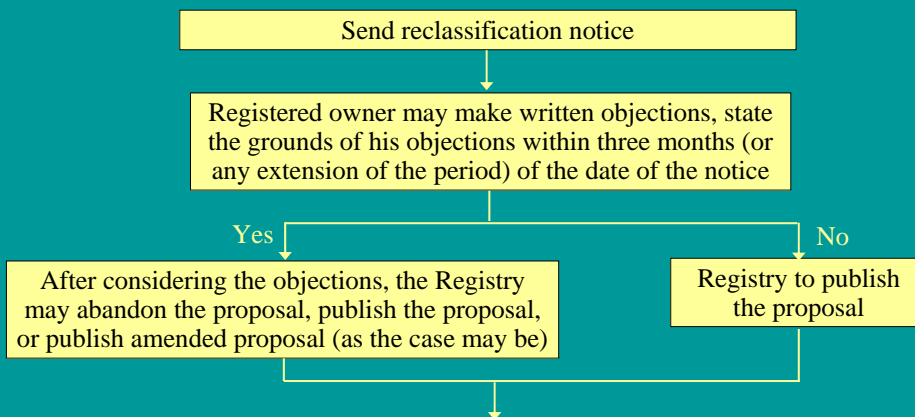
Goods	Cross search against
Class 6: Turnstiles (changed from “turnstiles, non-automatic”)	Class 9: Turnstiles, automatic (deleted under the tenth edition) (cite only marks filed before 1.1.2012)

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

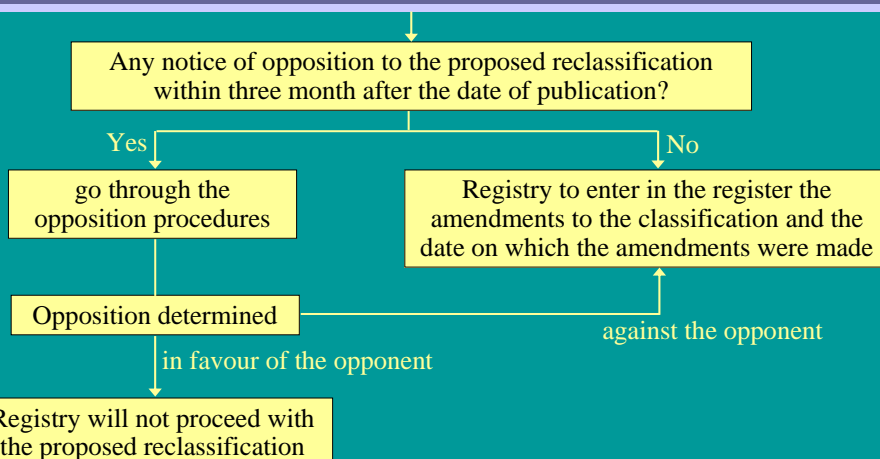
How to reclassify goods and services of trademark registrations in accordance with the tenth edition?

- We will reclassify registrations to be consistent with the tenth 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 tenth edition
 - registrations classified in accordance with the ninth edition of the International Classification that will be affected by the classification changes to be made by the tenth edition

Workflow of reclassification (1)



Workflow of reclassification (2)



WIPO publication and PDF file on the tenth edition of the International Classification

- The WIPO publication on the tenth edition of the International Classification can be ordered at WIPO's e-bookshop (<http://www.wipo.int/ebookshop/>).
- The PDF file of the tenth edition of the International Classification can be found at http://www.wipo.int/classifications/nice/en/news/2011/news_0002.html.

How to obtain further information on the tenth edition of the International Classification after it has come into force on 1.1.2012?

- WIPO's website
<http://www.wipo.int/classifications/en/>
- IPD's website
 - Trade Marks Registry Work Manual Chapters on "Classification" and "Cross search list"
http://www.ipd.gov.hk/eng/intellectual_property/trademarks/registry.htm
 - How to classify my goods/services?
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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