

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).

Revision of International Classification

Previously, the International Classification was revised once every five years.

At the 21st session of the Committee of Experts of the Nice Union (“the Committee”) held from 22 to 26 November 2010, the Committee had decided, among others, that:

- any amendments to the International Classification involving a transfer of goods or services from one class to another or the creation of any new class (“amendments to the International Classification”) would still be made within the five-year cycle⁵;
- any new version of the International Classification reflecting the updates in respect of additions, deletions and changes in the wording of indications in the alphabetical list would be published annually⁵; and
- for the purposes of publication of changes to the International Classification, the edition of the publication would be designated by the abbreviation NCL, which means “Nice Classification”, followed by the number of the edition and the year of entry into force of the version, e.g. –

NCL(10-2013) would mean “Nice Classification, 10th edition, version in force since January 1, 2013”.

At the 31st session of the Committee held from 19 to 23 April 2021, the Committee had decided, among others, that the next revision period for amendments to the International Classification would last for **three years**, instead of the five-year cycle (as decided in the aforesaid 21st session of the Committee).¹

The current edition and version of the International Classification is the ~~11th~~12th edition (*current year*) version, which is ~~used~~inapplied to the Hong Kong ~~SAR~~Special Administrative Region. Please refer to the section “How to classify my goods and services” at the IPD’s website for the details about the current edition and version of the International Classification.

Websites for classification

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

EUIPO: <http://euipo.europa.eu/ec2/>

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

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

IP Australia: <https://tmgns.search.ipaustralia.gov.au/>

UKIPO: <https://www.search-uk-trade-mark-classes.service.gov.uk/searchclasses>

USPTO: <https://idm-tmng.uspto.gov/id-master-list-public.html>

¹ See paragraph 25 of the Report of the 31st session of the Committee at https://www.wipo.int/edocs/mdocs/classifications/en/clim_ce_31/clim_ce_31_2.pdf.

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 current edition and version of the International Classification to determine the classification of the particular goods or services. The general principles are set out in the current edition and version under ~~the headings “General Remarks,”~~ with the headings of “GOODS”~~Goods, Services~~ and “SERVICES”. They are ~~summarised~~elaborated as follows:

- Finished products are classified according to their function or purpose, for example “surgical knives” are classified in classClass 10 and “electric knives” are classified in classClass 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~~clocks incorporating radios” are classified in classesClasses 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 classClass 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 classClass 20 and “fittings of metal for furniture” are classified in classClass 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 [eClassClass 17](#) and “unwrought silver” is classified in [eClassClass 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 [eClassClass 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 [eClassClass 6](#) and “doors principally made of wood” are classified in [eClassClass 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 [eClassClass 9](#).
- Services are classified according to the types of activity specified in the headings of the service classes (see [eClassesClasses 35 –to 45](#) of the International Classification) or by analogy with comparable services, for example “reservation services for catering” are classified in [eClassClass 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 [eClassClass 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.

- 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~~Class 35. Providing the advice, information or consultation by electronic means does not affect the classification of the services.
- 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)).

Changes to the International Classification under the ~~11th~~12th edition

The ~~11th~~12th edition of the International Classification which entered into force on 1 January ~~2017~~2023 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 ~~26th~~32nd Session (see http://www.wipo.int/meetings/en/details.jsp?meeting_id=39022https://www.wipo.int/meetings/en/details.jsp?meeting_id=68629).

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

- revisions concerning ~~medicated soap, disinfectant soap, medicated shampoos, etc.~~certain dispensing apparatus (see Annex 1)
- addition of new indications

New indications such as “~~smart rings~~dry suits” and “~~dive skins~~” classified in ~~class~~Class 9, “~~body fat monitor~~sear plugs for swimmers” classified in ~~class~~Class 10, “~~unlocking of mobile phones~~providing online virtual guided tours” classified in ~~class 42~~ and “~~dog walking services~~Class 41 and “~~rental of robots for preparing beverages~~” classified in ~~class 45~~Class 43 are added in the 11th12th edition of the International Classification.

- change of existing indications

Certain existing indications have been changed as a result of the ~~use~~application of the 11th12th edition of the International Classification, for example “~~dog washes~~information technology [IT] consultancy” classified in ~~class 5~~Class 42 has been changed to “~~dog washes [insecticides]~~information technology [IT] support services [troubleshooting of software]” in the same class.

- deletion of indications

Indications such as “~~dog lotions~~harpoon guns [sports articles]” in ~~class 5~~Class 28 and “~~audible warning systems for bicycles~~information technology services provided on an outsourcing basis” in ~~class 12~~Class 42 which were included in the previous editions have now been deleted from the International Classification.

- transfer of existing indications

Existing indications which have been transferred from one class to another in the 11th12th edition of the International Classification are listed in Annex 2.

- change and transfer of existing indications

Existing indications which have been changed and transferred from one class to another in the 11th12th edition of the International Classification are listed in

Annex 2.

- addition, deletion, change and transfer of indications

Some indications in certain classes have been deleted from the International Classification whereas other indications have been added, changed and/or transferred to ~~the~~ other classes. Hence, the latter indications now cover the former indications and entail cross search (see examples in Annex 2).

- changes in the class headings and explanatory notes

The class headings and explanatory notes of certain classes have been changed as a result of the use application of the 12th edition of the International Classification. For example, “personal and social services rendered by others to meet the needs of individuals” appearing in the class heading of Class 45 of the 11th edition of the International Classification. ~~For example, “soap” appearing in the class heading of class 3 of the 10th edition of the International Classification~~ has been replaced by “non-medicated soap” and dating services, online social networking services; funerary services; babysitting”. ~~“This class Class does not include, in particular: - table cutlery research in the field of education (Cl.8)” has 41)” and “This Class includes, in particular: - arbitration and mediation services”~~ have been introduced in the explanatory ~~note to class 24~~ notes to Class 42 and Class 45 respectively.

Certain amendments and changes made by the ~~11th~~ 12th edition involve transfer of class of some goods ~~and services~~ and require reclassification (see *Reclassification* and *Notice to reclassify specification* below).

Reclassification

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, the specification of any registered trade mark may be re-classified under rule 58 in light of changes made to the International Classification.

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 [eClassClass 35](#) we search not only [eClassClass 35](#) (and other relevant classes) but also [eClassClass 42](#), which was formerly the appropriate class for retail services.

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 repealed Trade Marks Rules (Cap. 43 subsidiary legislation) (“repealed 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 repealed Trade Marks Rules (Cap. 43 subsidiary legislation) (“repealed Schedule 4”).

Under the repealed Cap. 43, the conversion of specifications under the repealed Schedule 3 to classes under the repealed Schedule 4 was voluntary.

Under the Trade Marks Ordinance (Cap. 559), the conversion of the repealed Schedules 3 and 4 specifications is compulsory. Specifications of registered trade marks that were classified under the repealed Schedules 3 and 4 as well as under the other previous editions of the International Classification are reclassified to classes under the current edition of the International Classification after notice to the trade mark owner (section

58, Schedule 5 section 12; rules 58(a) and 59) (see *Notice to reclassify specification* below).

We reclassify specifications of registered trade marks after sending a notice to the trade mark owner (section 58; Schedule 5 section 12; rules 58(b) and 59) (see *Notice to reclassify specification* below). Usually we send notices to reclassify shortly after a registration is renewed.

Notice to reclassify specification

The process and the 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~~Class 49 of the repealed Schedule 3 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 after 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~~three 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 has given written notice that he will not make any objections (rule 60(1)).

- Has any notice of opposition to the proposed reclassification been filed (rule 61)? Was the notice of opposition filed within ~~3~~three 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~~three 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~~sections 38(2)(a)(iv) and 38(2)(b)(iii)) 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)).

and (3)).

Class heading

The ~~class~~ “headings” “Class Headings” are set out in the current edition and version of the International Classification. According to the “General Remarks” of the same document, the indications of goods and services appearing in the class headings are general indications relating to the fields to which, in principle, the goods or services belong.

Specifying goods and services

It is essential that an applicant’s specification should be clear, because the scope of trade mark owners’ rights depends on the specification of goods or services. 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 terms 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 <u>Class</u> 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> ; <u><i>etc</i></u> below)
all services in this class	(see <i>Application for “all goods” or “all services”</i> ; <u><i>etc</i></u> below)
commercial services	commercial financing services (class <u>Class</u> 36) renting of commercial premises (36)
consultancy services	consultancy services relating to telecommunications (class <u>Class</u> 38) interior design consultancy services (42)
dealership services	motor dealer services (class <u>Class</u> 35) retailing of clothing (35) foreign currency dealing (36)
health products	nutritional supplements (class <u>Class</u> 5)
information / on-line <u>online</u> information services	provision of information relating to (<i>indicate field of activity</i>) communication services for the transmission of information (class <u>Class</u> 38) information services relating to computer systems and applications (42)
information technology / technical support services	<u>information technology support services [troubleshooting of software] (Class 42)</u> computer systems and applications consultancy services (class 42) technical support services relating to computer -software and applications (42)
Internet / on-line <u>online</u> services	Telecommunication services (class <u>Class</u> 38) on-line <u>online</u> ordering services (35)
logistic services	transport, packaging and storage of goods (class <u>Class</u> 39)

multi-media products / services	computers (eClassClass 9) printing, scanning and fax machines (9) production of multi-media entertainment programmes services (41)
personal services	personal financial planning advisory services (eClassClass 36) personal shopping services rendered by others to meet the needs of individuals (45) dating services (45)
rental / leasing services	rental of advertising space (eClassClass 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>) (eClassClass 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 introduction events (eClassClass 45) health care services (44) social introduction agency services rendered by others to meet the needs of individuals (45) online social networking services (45)
web services	creating and maintaining websites (eClassClass 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~~was 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 “-bins” in [eClassClass 6](#) do not extend to “-bins of wood or plastic” properly classified in [eClassClass 20](#). It follows that an applicant cannot widen his specification after filing. See the following examples.

- An applicant who applies for “clothing” in [eClassClass 25](#) cannot amend his application to include “protective clothing” in [eClassClass 9](#).
- An applicant who has filed a multi-class application in respect of “food products” in Class 29, “coffee” in Class 30 and “live animals” in Class 31, can amend “food products” in Class 29 to “cooked fruits” in Class 29. However, he cannot add “bread” in Class 30 and/or “foodstuffs for animals” in Class 31 even if he is prepared to delete “food products” from Class 29 since the “food products” originally applied for do not include food products which fall outside Class 29 and allowing the applicant to amend the specification to “bread” in Class 30 and/or “foodstuffs for animals” in Class 31 would widen his specification in Class 30 and/or Class 31 respectively.
- An applicant who has filed a multi-class application in respect of the services “consultancy services” in Class 3, “real estate management” in Class 36 and “transport of goods” in Class 39 has to delete “consultancy services” and Class 3 from the application since ~~“consultancy services”~~ are unclear and do not fall within Class 3. He will not be permitted to seek amendment by adding “real estate management consultancy services” in Class 36 or “consultancy services for transport of goods” in Class 39 since this would widen his specification in Class 36 or Class 39.

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~~websites”.

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~~online from computer databases or Internet”, “electronic game services provided on Internet”, “~~on-line~~online electronic publications provided by viewing computer ~~data-bases~~databases or ~~web-sites~~websites”, and “publication of electronic books and journals ~~on-line~~online”.

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~~websites”, and “providing search engines for the Internet”.

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

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

Class 45 is the appropriate class for “personal introduction agency services provided ~~on-line~~online from a computer database or Internet”, “intellectual property consultancy services provided ~~on-line~~online 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 classClass 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 the 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 should be avoided in practice or which should only be used in a certain way? (See *Specifying ~~particular~~ goods and services* above.)
- Is the specification repetitive? For example, “sports shoes, shoes for sport in ~~class~~Class 25”.
- Is the punctuation clear? (See *Punctuation, qualification, exclusion* below.)
- Has any exclusion been properly worded? (See *Punctuation, qualification, exclusion* below.)
- Have any restriction of specification been clearly expressed? (See *Restricting specification* 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~~sections 38(2)(a)(iv) and 38(2)(b)(iii); 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~~Class 21”, and “luxury goods in ~~class~~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(1)(a)). This could have the effect of the lapse of his priority claim.

If an applicant fails to remedy the deficiency within two months after 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 often, 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, we will also 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 52(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 and services providing recreation for the general public (entertainment)” would include services as diverse as from “teaching English as a foreign language”, to “running an amusement park or arcade”, and to “organizing an athletics competition”. 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 objection would not be raised lightly, account being taken of the capacity of most applicants to trade in a wide range of goods and/or services. It might be raised where the range of goods and/or services claimed is so unrealistically broad in commercial terms that it is unlikely that the applicant would trade in such a full range of goods and/or services.

To overcome the objection, an applicant has to show that he honestly intends to use or in fact uses the mark in relation to the goods and/or services applied for. Each case will be considered on its own merits in relation to the actual specifications.

It is open to the applicant to submit any documents, information or evidence which it considers to be relevant for demonstrating that the broad specification(s) as claimed is/are justified. Examples of what an applicant may submit with a view to overcoming an objection under rule 7(4) may include:

- material indicating the applicant's line of business is extensive in range covering the goods and services applied for or similar goods and services, ~~or~~ material showing the applicant's intention to trade across the full range of the goods and services applied for. Catalogues, brochures, prospectuses, annual reports or marketing plans, or evidence of use of the mark by the applicant outside Hong Kong, etc. ~~may~~ be relevant indication that the applicant has the ability, capacity or intention to use the mark in respect of the same or similar goods and services in Hong Kong;
- material showing the mark has been licensed or is intended to be licensed for use in respect of the applied for goods and services or similar goods and services, e.g. license agreements, distributorship agreements.

On the other hand, a statutory declaration which merely confirms an intention to use the mark on all the goods or services specified is unlikely to assist, as it adds nothing to the applicant's statement of use or intention to use already required in the application form.

An alternative way to overcome the objection is by restricting the specification of goods and/or services to those in relation to which the mark has been used or is intended to be used (see *Restricting Specification* below).

Even if no objection under rule 7(4) is raised by the Registrar at the examination stage, a broad specification of goods and/or services 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 two 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 two 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 after 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 Deficiencies checking.)

Application 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 two months.

If the applicant fails to remedy the deficiency within two months after 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 Deficiencies checking.)

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 2two months (see rules 7(1), 11(1) and (2)).

The applicant can remedy the deficiency by completing and filing Form **T5A** within 2two months. For example, an applicant who applies for “cosmetics” in classClass 5 (the correct class is classClass 3) can delete it from the application, transfer it to class 3 (if the application already covers classClass 3), or add classClass 3 for “cosmetics” (with payment of the prescribed fee for addition of class). However, an applicant who applies for “screwdrivers in classClass 8” (the class appropriate to hand tools) cannot correct his application to “screwdrivers in classClass 7” (the class appropriate to electric tools).

If the applicant fails to remedy the deficiency within 2two months after 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 Deficiencies checking.)

Application listing goods or services under the 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 2two months (see rules 7(1), 11(1) and (2)).

The applicant can remedy the deficiency by completing and filing Form **T5A** within 2two 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 classClass 28 can be transferred to the applicant’s list of goods under classClass 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 2two months after 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 Deficiencies checking.)

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 [eClassClass 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 to “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 such circumstances, it may be necessary to:

- restrict the specification to the particular product, for example a mark incorporating the name “CHAMPAGNE” in [eClassClass 33](#) should be registered for the restricted specification “champagne” only (similarly COGNAC).
- restrict the specification to products of a particular origin, for example marks incorporating MÜNCHEN LAGER in [eClassClass 32](#), SWISS CHRONOMETRIC EQUIPMENT in [eClassClass 14](#), CHOCOLATERIE DE BELGIQUE in [eClassClass 30](#) should be restricted to goods “produced in

Germany”, “Switzerland” and “Belgium”, respectively.

An applicant can delete goods or services from his specification, restrict his specification, or offer an appropriate limitation (see chapter on Geographical origins) to overcome an objection that the mark is likely to deceive. “Variation clauses” which were occasionally used under the repealed Cap. 43 to obtain registration of a mark that would otherwise have been considered deceptive under former practice, are now redundant (see the repealed Trade Marks Rules (Cap. 43 subsidiary legislation) rule 7(2) which has no counterpart under the Trade Marks Rules (Cap. 559A)).

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 foodstuff in class 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).

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~~ Words that are registered trade marks should not be used in a specification, for example “Hoover”, “Jacuzzi”, “Karaoke”, “Rollerblade”, and “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.)

* * *

**Revisions concerning ~~medicated soap, certain dispensing apparatus~~
~~disinfectant soap, medicated shampoos, etc.~~**

- **classification of certain dispensing apparatus according to the material of which they are made: “of metal” in Class 6, “not of metal” in Class 20**

See the following examples:

Class 3

- ~~Transfer of the following indications to Class 5:~~

- ~~“medicated soap”~~
- ~~“disinfectant soap”~~

- ~~Changes in the class heading:~~

<u>From Class</u>	<u>Goods To</u>
soaps <u>6</u>	<ul style="list-style-type: none"> - non-medicated soaps <u>Addition of “queue ticket dispensers of metal”</u> - Change and transfer of “boxes for dispensing paper towels” in Class 21 to “boxes for dispensing paper towels” in Class 6 <u>Change and transfer of “boxes for dispensing paper towels” in Class 21 to “boxes of metal for dispensing paper towels” in Class 6</u> - Change and transfer of “toilet paper dispensers” in Class 21 to “toilet paper dispensers” in Class 6 <u>Change and transfer of “toilet paper dispensers” in Class 21 to “toilet paper dispensers of metal” in Class 6</u> - Change of “towel dispensers, fixed, of metal” to “towel dispensers of metal” <u>Change of “towel dispensers, fixed, of metal” to “towel dispensers of metal”</u>
hair lotions <u>20</u>	<ul style="list-style-type: none"> - non-medicated hair lotions <u>Addition of “queue ticket dispensers, not of metal”</u> - <u>Addition of “boxes, not of metal, for</u>

	<p><u>dispensing paper towels</u></p> <p>- <u>Addition of “toilet paper dispensers, not of metal”</u></p> <p>- <u>Change of “towel dispensers, fixed, not of metal / towel dispensers, not of metal, fixed” to “towel dispensers, not of metal”</u></p>
dentifrices	non-medicated dentifrices

▪ classification of certain dispensing apparatus according to their function or purpose

See the following examples:

- ~~Addition of indications:~~
 - ~~eye washes, not for medical purposes~~
 - ~~shampoos for animals [non-medicated grooming preparations]~~
- ~~Change of “shampoos for pets” to “shampoos for pets [non-medicated grooming preparations]”~~

Class 5

- ~~Change of “eye washes” to “medicated eye washes”~~
- ~~Addition of indications:~~
 - ~~“medicated shampoos”~~
 - ~~“medicated dry shampoos”~~
 - ~~“medicated toiletry preparations”~~

- ~~“medicated hair lotions”~~
- ~~“medicated dentifrices”~~
- ~~“antibacterial soap”~~
- ~~“antibacterial handwashes”~~
- ~~“medicated shampoos for pets”~~

<u>Class</u>	<u>Goods</u>
<u>7</u>	- <u>Addition of “fluid dispensing machines for industrial use”</u> - <u>Change of “adhesive tape dispensers [machines]” to “tape dispensing machines for industrial use”</u>
<u>9</u>	- <u>Addition of “dosage dispensers, not for medical use [measuring apparatus]”</u> - <u>Change of “ticket dispensers” to “ticket dispensing terminals, electronic”</u>
<u>10</u>	- <u>Addition of “dosage dispensers for medical use”</u>
<u>18</u>	- <u>Addition of “dog waste bag dispensers adapted for use with leashes”</u>

Other revisions

- **Transfer of existing indications**

<u>Goods</u>	<u>Class number under International Classification 11th edition</u>	<u>Class number under International Classification 12th edition</u>
<u>needles for wool combing machines</u>	<u>26</u>	<u>7</u>
<u>hospital beds</u>	<u>20</u>	<u>10</u>

See the following examples:

<u>Goods</u>	<u>Class number under International Classification 10th edition</u>	<u>Class number under International Classification 11th edition</u>
xylol	4	†
xylene	4	†
benzene	4	†
benzol	4	†
anti-rheumatism bracelets	5	10
anti-rheumatism rings	5	10
bracelets for medical purposes	5	10
needle threaders	8	26
sugar tongs	8	21
nutcrackers	8	21

Goods	Class number under International Classification 10th edition	Class number under International Classification 11th edition
socks, electrically heated	9	11
rosaries	16	14
chaplets	16	14
reins for guiding children	26	18
wax for skis	28	4
scrapers for skis	28	8
piccalilli	29	30

- **Change and transfer of existing indications**

See the following examples:

Goods	Class number under International Classification 10th11th edition	Changed to	Class number under International Classification 11th12th edition
ladles loading apparatus for wine furnace	811	ladles for serving wine furnace loading machines	247
gut bags for making sausages microwave cooking	1816	sausage casings, natural or artificial bags for use in cooking	2921
sleeping bags for camping insulating gloves	2017	sleeping bags insulating gloves for protection against accidents	249
pig bristles boxes for	21	pig bristles boxes of	226

Goods	Class number under International Classification <u>10th11th</u> edition	Changed to	Class number under International Classification <u>11th12th</u> edition
<u>dispensing paper towels</u>		<u>metal for dispensing paper towels</u>	
<u>milk of almonds</u> [beverage] <u>toilet paper dispensers</u>	<u>3221</u>	<u>almond milk-based beverages</u> toilet paper dispensers of metal	<u>296</u>
<u>peanut milk</u> [non-alcoholic beverage] <u>wet suits for water-skiing</u>	<u>3225</u>	<u>peanut milk-based beverages</u> <u>wet suits</u>	<u>299</u>

▪ **Addition, deletion, change and transfer of indications**

See the following examples:

Revision of indications under International Classification <u>11th12th</u> edition		Remarks	Cross search
Change of “ vice benches, not of metal <u>harpoon guns [weapons]</u> ” in <u>class 20Class 13</u> to “ vice benches <u>{furniture}harpoon guns</u> ”	Deletion of “ vice benches of metal <u>harpoons for fishing</u> ” from <u>class 6Class 8 and “harpoon guns [sports articles]” from Class 28</u>	“ vice benches {furniture}harpoon guns ” in <u>class 20Class 13</u> cover “ vice benches of metal <u>harpoons for fishing</u> ” and “ <u>harpoon guns [sports articles]</u> ”.	Cross search of “ vice benches <u>{furniture}harpoon guns</u> ” in <u>class 20Class 13</u> against “ vice benches of metal <u>harpoons for fishing</u> ” in <u>class 6Class 8 and “harpoon guns [sports articles]” in Class 28</u>

Revision of indications under International Classification 11th <u>12th</u> edition	Remarks	Cross search
		(for applications filed before 1.1.2017) <u>2023</u>)
Change of “meat chests, not of metal” in class 20 to “meat safes”	Deletion of “meat safes of metal” from class 6	“meat safes” in class 20 cover “meat safes of metal”. Cross search of “meat safes” in class 20 against “meat safes of metal” in class 6 (for applications filed before 1.1.2017)
Change and transfer of “tool handles of metal boxes for dispensing paper towels” in class 6 <u>Class 21</u> to “handles for hand-operated hand tools boxes of metal for dispensing paper towels” in class 8 <u>Class 6</u>	Deletion <u>Addition</u> of “tool handles boxes, not of metal” from class, <u>for dispensing paper towels”</u> in Class 20	Cross search of “handles boxes of metal for hand-operated hand tools dispensing paper towels” in class 8 against “tool handles of metal” in class <u>Class 6</u> and “tool handles boxes, not of metal, for dispensing paper towels” in Class 20 (for applications filed before 1.1.2017) <u>2023</u>)

Revision of indications under International Classification 11th <u>12th</u> edition	Remarks	Cross search	
Change and transfer of “knife handles of metal” in class 6 to “knife handles” in class 8	Deletion of “knife handles, not of metal” from class 20	“knife handles” in class 8 cover “knife handles, not of metal”.	Cross search of “knife handles” in class 8 against “knife handles of metal” in class 6 and “knife handles, not of metal” in class 20 (for applications filed before 1.1.2017)
Change and transfer of “scythe handles of metal” in class 6 to “scythe handles” in class 8	Deletion of “scythe handles, not of metal” from class 20	“scythe handles” in class 8 cover “scythe handles, not of metal”.	Cross search of “scythe handles” in class 8 against “scythe handles of metal” in class 6 and “scythe handles, not of metal” in class 20 (for applications filed before 1.1.2017)
Change and transfer of “broom handles of metal” in class 6 to “broom handles” in class 21	Deletion of “broom handles, not of metal” from class 20	“broom handles” in class 21 cover “broom handles, not of metal”.	Cross search of “broom handles” in class 21 against “broom handles of metal” in class 6 and “broom handles, not of metal” in class 20 (for applications filed before 1.1.2017)

Revision of indications under International Classification 11th12th edition	Remarks	Cross search	
Change and transfer of “ <u>flagpolestoilet paper dispensers</u> ” in <u>class 20Class 21</u> to “ <u>flagpoles, nottoilet paper dispensers of metal</u> ” in <u>class 19Class 6</u>	Addition of “ <u>flagpolestoilet paper dispensers, not of metal</u> ” in <u>class 6Class 20</u>	“ <u>flagpolestoilet paper dispensers</u> of metal” in <u>classClass 6</u> and “ <u>flagpolestoilet paper dispensers, not of metal</u> ” in <u>class 19Class 20</u> are covered by “ <u>flagpolestoilet paper dispensers</u> ”.	Cross search of “ <u>flagpolestoilet paper dispensers of metal</u> ” in <u>classClass 6</u> or “ <u>flagpolesand toilet paper dispensers, not of metal</u> ” in <u>class 19Class 20</u> against “ <u>flagpolestoilet paper dispensers</u> ” in <u>class 20Class 21</u> (for applications filed before 1.1.20172023)
Change of “mantlepieces” in class 19 to “fireplace mantles, not of metal”	Addition of “fireplace mantles of metal” in class 6	“fireplace mantles of metal” in class 6 are covered by “mantlepieces”.	Cross search of “fireplace mantles of metal” in class 6 against “mantlepieces” in class 19 (for applications filed before 1.1.2017)
Change of “armour-plating” (or armor-plating) in class 6 to “armour-plating of metal” (or “armor-plating of metal”)	Addition of “armour-plating, not of metal” (or “armor-plating, not of metal”) in class 19	“armour-plating, not of metal” (or “armor-plating, not of metal”) in class 19 are covered by “armour-plating” (or armor-plating).	Cross search of “armour-plating, not of metal” (or “armor-plating, not of metal”) in class 19 against “armour-plating” (or armor-plating).

Revision of indications under International Classification 11th <u>12th</u> edition		Remarks	Cross search
			plating) in class 6 (for applications filed before 1.1.2017)
Change of “stakes for plants or trees” in class 20 to “stakes, not of metal, for plants or trees”	Addition of “stakes of metal for plants or trees” in class 6	“stakes of metal for plants or trees” in class 6 are covered by “stakes for plants or trees”.	Cross search of “stakes of metal for plants or trees” in class 6 against “stakes for plants or trees” in class 20 (for applications filed before 1.1.2017)