

# 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 cycle;
- 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 annually; 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).<sup>1</sup>

The current edition and version of the International Classification is the 12th edition (*current year*) version, which is applied to the Hong Kong 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: <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>

## **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

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<sup>1</sup> 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](https://www.wipo.int/edocs/mdocs/classifications/en/clim_ce_31/clim_ce_31_2.pdf).

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 “General Remarks” with the headings of “GOODS” and “SERVICES”. They are elaborated as follows:

- Finished products are classified according to their function or purpose, for example “surgical knives” are classified in Class 10 and “electric knives” are classified in Class 7.
- Finished products that are multipurpose composite objects may be classified in all classes appropriate to each function or purpose of the goods. However, if the goods have primary function or purpose, they should be classified in the class appropriate to such function or purpose, for example “barometers incorporating watches” and “watches incorporating barometers” are classified in Classes 9 and 14 respectively.
- Finished products that cannot be classified according to function or purpose are classified by analogy with comparable products, for example “bio-sands” are classified in Class 1 by analogy with “chemicals for use in aquariums (other than pharmaceuticals)”.
- Finished products that cannot be classified according to function or purpose, or by analogy with comparable products, are classified according to the material they are made of, or the way they work. For example “furniture fittings, not of metal” are classified in Class 20 and “fittings of metal for furniture” are classified in Class 6.
- Raw materials, unworked or semi-worked, are classified according to the material which they consist of, for example “semi-finished resins” are classified in Class 17 and “unwrought silver” is classified in Class 14.

- Spare parts are classified in the same class as the product for which the part is intended to fit, for example “saw blades” being “parts for hand tools” are classified in Class 8.
  
- Where it is appropriate to classify goods according to the material of which they are made, and they are made of various materials, they are classified according to the material that predominates. For example “doors principally made of metal” are classified in Class 6 and “doors principally made of wood” are classified in Class 19.
  
- Cases adapted to fit a particular product are classified in the same class as the product, for example “laptop computer cases” are classified in Class 9.
  
- Services are classified according to the types of activity specified in the headings of the service classes (see Classes 35 to 45 of the International Classification) or by analogy with comparable services, for example “reservation services for catering” are classified in Class 43 by analogy with “providing of food and drink”.
  
- Rental services are classified in the same class as the service provided by means of the rented object, for example “rental of telecommunication apparatus” is classified in Class 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 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 12th edition**

The 12th edition of the International Classification which entered into force on 1 January 2023 introduced a number of amendments and other changes, as a result of the Reports adopted by the Committee at its 32nd Session (see [https://www.wipo.int/meetings/en/details.jsp?meeting\\_id=68629](https://www.wipo.int/meetings/en/details.jsp?meeting_id=68629)).

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

- revisions concerning certain dispensing apparatus (see Annex 1)
- addition of new indications

New indications such as “dry suits” and “dive skins” classified in Class 9, “ear plugs for swimmers” classified in Class 10, “providing online virtual guided tours” classified in Class 41 and “rental of robots for preparing beverages” classified in Class 43 are added in the 12th edition of the International Classification.

- change of existing indications

Certain existing indications have been changed as a result of the application of the 12th edition of the International Classification, for example “information technology [IT] consultancy” classified in Class 42 has been changed to “information technology [IT] support services [troubleshooting of software]” in the same class.

- deletion of indications

Indications such as “harpoon guns [sports articles]” in Class 28 and “information technology services provided on an outsourcing basis” in 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 12th 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 12th 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 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 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 has been replaced by “dating services, online social networking services; funerary services; babysitting”. “This Class does not include, in particular: - research in the field of education (Cl. 41)” and “This Class includes, in particular: - arbitration and mediation services” have been introduced in the explanatory notes to Class 42 and Class 45 respectively.

Certain amendments and changes made by the 12th edition involve transfer of class of some goods 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 Class 35 we search not only Class 35 (and other relevant classes) but also Class 42, which was formerly the appropriate class for retail services.

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 to registered owners notices to reclassify specifications, examining registered owners' written objections (if any) and hearing any person's opposition to a proposed reclassification are listed in the following paragraphs.

- Send a 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 file written objections runs from the date of the notice. A proposed reclassification cannot extend a registered owner's rights. For example, a registration for "games" in Class 49 of the repealed Schedule 3 cannot be reclassified to include "computer games software" which did not exist at the date of registration.
- If the registered owner has filed written objections to the proposed reclassification, stating the grounds of his objections, within three months after the date of the notice (rule 59(2)(a)), consider the objections and, as appropriate, abandon the proposals, publish the proposals, or the proposals as amended (rules 60(2), 60(3) and 60(4)).
- If the registered owner has not filed written objections within three months after the date of the notice or any extension of the period, publish the proposals (rule 60(1)); if the registered owner has, before the expiry of the aforesaid three-month period, given written notice of his intention not to make any objections, publish the proposals earlier (rule 60(1)).
- Has any notice of opposition to the proposed reclassification been filed within 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 may require or admit evidence on the issue (rule 61(4)).
- If no notice of opposition is filed within 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 (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” 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)).

<b>Imprecise terms</b>	<b>Examples of precise definition</b>
advisory services	advisory services relating to business management (Class 35) advisory services relating to real estate valuations (36) computer system design advisory services (42)
all other related services	(see <i>Application for "all goods" or "all services" etc below</i> )
all services in this class	(see <i>Application for "all goods" or "all services" etc below</i> )
commercial services	commercial financing services (Class 36) renting of commercial premises (36)
consultancy services	consultancy services relating to telecommunications (Class 38) interior design consultancy services (42)

dealership services	motor dealer services (Class 35) retailing of clothing (35) foreign currency dealing (36)
downloadable goods  goods in metaverse environments  virtual goods <sup>2</sup>	downloadable multimedia files (Class 9) downloadable electronic publications (9)  downloadable image files for metaverse environments (9)  downloadable virtual bags for virtual worlds (9) downloadable virtual clothing for virtual environments (9) downloadable virtual food for virtual worlds (9) downloadable virtual toys for virtual environments (9)
health products	nutritional supplements (Class 5)
information / online information services	provision of information relating to ( <i>indicate field of activity</i> ) communication services for the transmission of information (Class 38) information services relating to computer systems and applications (42)
information technology / technical support services	information technology support services [troubleshooting of software] (Class 42) computer systems and applications consultancy services (42) technical support services relating to computer software and applications (42)
Internet / online services	online ordering services (Class 35) telecommunications services (38)
logistic services	transport, packaging and storage of goods (Class 39)

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<sup>2</sup> The term “downloadable goods” / “goods in metaverse environments” / “virtual goods” without specifying the broad and unclear description “goods” is imprecise.

metaverse / virtual services <sup>3</sup>	<p>arranging and conducting of interactive virtual auctions (Class 35)</p> <p>arranging and conducting of seminars in virtual environments (41)</p> <p>virtual construction services provided in metaverse environments for entertainment purposes (41)</p> <p>hosting metaverse platforms on the Internet (42)</p>
multi-media products / services	<p>computers (Class 9)</p> <p>multifunction printers for use with computers (9)</p> <p>production of multi-media entertainment programmes services (41)</p>
non-fungible tokens [NFTs] <sup>4</sup>	<p>downloadable digital files authenticated by non-fungible tokens [NFTs] (Class 9)</p> <p>clothing authenticated by non-fungible tokens [NFTs] (25)</p> <p>providing an online marketplace for buyers and sellers of digital files authenticated by non-fungible tokens [NFTs] (35)</p> <p>training relating to the creation of non-fungible tokens [NFTs] (41)</p> <p>providing online non-downloadable software for minting non-fungible tokens [NFTs] (42)</p>

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<sup>3</sup> Services provided in online and/or virtual environments are classified according to the established principles of classification, having regard to their underlying nature, and their purposes in the physical world. For example, “virtual construction services provided in metaverse environments for entertainment purposes” involve the creation of three-dimensional models of buildings or structures that are not physically present for the purposes of entertainment in the physical world, and therefore the term would be proper to Class 41 rather than Class 37.

<sup>4</sup> The Collins English Dictionary defines “Non-fungible token [NFT]” as “a unique digital certificate, registered in a blockchain, that is used to record ownership of an asset such as an artwork or a collectible”. The term “Non-fungible tokens [NFTs]” without specifying the assets to which it relates is imprecise. On the other hand, the descriptions of certain services such as “providing online non-downloadable software for minting non-fungible tokens [NFTs]” and “training relating to the creation of non-fungible tokens [NFTs]” are considered precise given the nature of such services.

personal services	personal financial planning advisory services (Class 36) personal shopping for others (45) dating services (45)
rental / leasing services	rental of advertising space (Class 35) rental of computers (42)
retailing and wholesaling services / distributorship services	retail and wholesale of ( <i>indicate particular goods or the means of providing the service</i> ) (Class 35)
related products / services	<i>applicant needs to indicate particular goods / services of interest (See Application for “all goods” or “all services” etc below)</i>
social services	nursing care services (Class 44) organisation of social introduction events (45) social introduction agency services (45) online social networking services (45)
web services	creating and maintaining websites for others (Class 42) hosting computer websites (42)

## General principles in specifying goods and services

Terms in a specification are given their ordinary and natural meaning (*Ofrex* [1963] RPC 169-171) subject to the principle that the words must be construed by reference to their context (*Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd* [2000] FSR 267, where “skin lightening cream” was held to be within the term of “cosmetics”, and “dry skin lotion” within the terms “cosmetics” and “toilet preparations” : neither “skin lightening cream” nor “dry skin lotion” 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 Class 6 do not extend to "bins of wood or plastic" properly classified in Class 20. It follows that an applicant cannot widen his specification after filing. See the following examples.

- An applicant who applies for "clothing" in Class 25 cannot amend his application to include "protective clothing" in Class 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 online from computer databases or websites”.

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

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

Class 37 is the appropriate class for “information services relating to building construction provided online 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 online from computer databases or Internet”, “electronic game services provided on Internet”, “online electronic publications provided by viewing computer databases or websites”, and “publication of electronic books and journals online”.

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

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

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

Class 45 is the appropriate class for “personal introduction agency services provided online from a computer database or Internet”, “intellectual property consultancy services provided 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 goods and services* above). Retail services are classified in Class 35.

## Writing or examining specifications

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

- Are the goods and/or services listed by class numbers in numerical order? (See *Application for registration* above.)
- Is it clear what the specification is meant to cover? (See *Application for registration, Specifying 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 goods and services* above.)

- Is the specification repetitive? For example, “sports shoes, shoes for sport in Class 25”.
- Is the punctuation clear? (See *Punctuation, qualification, exclusion* below.)
- Has any exclusion been properly worded? (See *Punctuation, qualification, exclusion* below.)
- Have any 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 (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 21” and “luxury goods in Class 14”.

An applicant can remedy the deficiency by completing and filing Form **T5A** within two months (paying a fee for any additional classes). **A filing date cannot be accorded** until the applicant files a proper statement of goods or services (section 39(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 two months (see rules 7(1), 11(1) and (2)).

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

If the applicant fails to remedy the deficiency within 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 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 two months (see rules 7(1), 11(1) and (2)).

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

If the applicant fails to remedy the deficiency within 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.)

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

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

## **Restricting specification**

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

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

The fact that a specification is broader than the description conveyed by the mark does

not necessarily make a mark deceptive, for example TETRATEA in Class 30 would not be deceptive in relation to a specification that includes a broader range of goods than tea. Similarly, a restriction is unlikely to be necessary in relation to marks incorporating words describing materials or desirable qualities of a product or service where there is adequate scope within the specification for legitimate use of the mark and where in practical terms deception is unlikely. For example WOOLTECH for “yarns and threads” need *not* be restricted 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 Class 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 Class 32, SWISS CHRONOMETRIC EQUIPMENT in Class 14, CHOCOLATERIE DE BELGIQUE in Class 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 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 apparatus; measuring apparatus; signaling 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**

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

## **Convention claims**

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

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

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Revisions concerning certain dispensing apparatus

- **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:

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

- **classification of certain dispensing apparatus according to their function or purpose**

See the following examples:

<b>Class</b>	<b>Goods</b>
<b>7</b>	<ul style="list-style-type: none"> <li>- Addition of <b>“fluid dispensing machines for industrial use”</b></li> <li>- Change of “adhesive tape dispensers [machines]” to <b>“tape dispensing machines for industrial use”</b></li> </ul>
<b>9</b>	<ul style="list-style-type: none"> <li>- Addition of <b>“dosage dispensers, not for medical use [measuring apparatus]”</b></li> <li>- Change of “ticket dispensers” to <b>“ticket dispensing terminals, electronic”</b></li> </ul>
<b>10</b>	<ul style="list-style-type: none"> <li>- Addition of <b>“dosage dispensers for medical use”</b></li> </ul>
<b>18</b>	<ul style="list-style-type: none"> <li>- Addition of <b>“dog waste bag dispensers adapted for use with leashes”</b></li> </ul>

**Other revisions**

▪ **Transfer of existing indications**

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

▪ **Change and transfer of existing indications**

<b>Goods</b>	<b>Class number under International Classification 11th edition</b>	<b>Changed to</b>	<b>Class number under International Classification 12th edition</b>
loading apparatus for furnace	11	furnace loading machines	7
bags for microwave cooking	16	bags for use in cooking	21
insulating gloves	17	insulating gloves for protection against accidents	9
boxes for dispensing paper towels	21	boxes of metal for dispensing paper towels	6
toilet paper dispensers	21	toilet paper dispensers of metal	6
wet suits for water-skiing	25	wet suits	9

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

See the following examples:

<b>Revision of indications under International Classification 12th edition</b>		<b>Remarks</b>	<b>Cross search</b>
Change of “harpoon guns [weapons]” in Class 13 to <b>“harpoon guns”</b>	Deletion of “harpoons for fishing” from Class 8 and “harpoon guns [sports articles]” from Class 28	“harpoon guns” in Class 13 cover “harpoons for fishing” and “harpoon guns [sports articles]”.	Cross search of <b>“harpoon guns”</b> in Class 13 against “harpoons for fishing” in Class 8 and “harpoon guns [sports articles]” in Class 28 (for applications filed before 1.1.2023)
Change and transfer of “boxes for dispensing paper towels” in Class 21 to <b>“boxes of metal for dispensing paper towels”</b> in Class 6	Addition of <b>“boxes, not of metal, for dispensing paper towels”</b> in Class 20	“boxes of metal for dispensing paper towels” in Class 6 and “boxes, not of metal, for dispensing paper towels” in Class 20 are covered by “boxes for dispensing paper towels”.	Cross search of <b>“boxes of metal for dispensing paper towels”</b> in Class 6 and <b>“boxes, not of metal, for dispensing paper towels”</b> in Class 20 against “boxes for dispensing paper towels” in Class 21 (for applications filed before 1.1.2023)
Change and transfer of “toilet paper dispensers” in Class 21 to <b>“toilet</b>	Addition of <b>“toilet paper dispensers, not of metal”</b> in	“toilet paper dispensers of metal” in Class 6	Cross search of <b>“toilet paper dispensers of</b>

<b>Revision of indications under International Classification 12th edition</b>		<b>Remarks</b>	<b>Cross search</b>
<b>paper dispensers of metal</b> in Class 6	Class 20	and “toilet paper dispensers, not of metal” in Class 20 are covered by “toilet paper dispensers”.	<b>metal</b> in Class 6 and “ <b>toilet paper dispensers, not of metal</b> ” in Class 20 against “toilet paper dispensers” in Class 21 (for applications filed before 1.1.2023)