

# 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 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 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”.

The current edition and version of the International Classification is the 11<sup>th</sup> edition (*current year*) version, which is used in the Hong Kong SAR. 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>

## **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, Goods, Services and are summarised 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, for example “clock incorporating radios” are classified in classes 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 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” are “parts for hand tools” and 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 – 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 telecommunications 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 11<sup>th</sup> edition**

The 11<sup>th</sup> edition of the International Classification which entered into force on 1 January 2017 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 Session (see [http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=39022](http://www.wipo.int/meetings/en/details.jsp?meeting_id=39022)).

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

- revisions concerning medicated soap, disinfectant soap, medicated shampoos, etc. (see Annex 1)

- addition of new indications

New indications such as “smart rings” classified in class 9, “body fat monitors” classified in class 10, “unlocking of mobile phones” classified in class 42 and “dog walking services” classified in class 45 are added in the 11<sup>th</sup> edition of the International Classification.

- change of existing indications

Certain existing indications have been changed as a result of the use of the 11<sup>th</sup> edition of the International Classification, for example “dog washes” classified in class 5 has been changed to “dog washes [insecticides]” in the same class.

- deletion of indications

Indications such as “dog lotions” in class 5 and “audible warning systems for bicycles” in class 12 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

11<sup>th</sup> 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 11<sup>th</sup> 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 of the 11<sup>th</sup> edition of the International Classification. For example, “soap” appearing in the class heading of class 3 of the 10<sup>th</sup> edition of the International Classification has been replaced by “non-medicated soap” and “This class does not include, in particular: - table cutlery (Cl.8)” has been introduced in the explanatory note to class 21.

Certain amendments and changes made by the 11<sup>th</sup> 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 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 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 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 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 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 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 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), (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 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 systems design advisory services (42)
all other related services	(see <i>Application for “all goods” or “all services”</i> , below)
all services in this class	(see <i>Application for “all goods” or “all services”</i> , below)
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)
health products	nutritional supplements (class 5)
information / on-line 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	computer systems and applications consultancy services (class 42) technical support services relating to computer software and applications (42)
Internet / on-line services	Telecommunication services (class 38) on-line ordering services (35)
logistic services	transport, packaging and storage of goods (class 39)

multi-media products / services	computers (class 9) printing, scanning and fax machines (9) production of multi-media entertainment programmes services (41)
personal services	personal financial planning advisory services (class 36) personal services rendered by others to meet the needs of individuals (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	organisation of social introduction events (class 45) health care services (44) social services rendered by others to meet the needs of individuals (45)
web services	creating and maintaining websites (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” were 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 on-line from computer databases or web sites”.

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

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

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

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

Class 45 is the appropriate class for “personal introduction agency services provided on-line from a computer database or Internet”, “intellectual property consultancy services provided on-line 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 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 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 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 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 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”, “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 2 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 2 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 2 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 2 months (see rules 7(1), 11(1) and (2)).

The applicant can remedy the deficiency by completing and filing Form **T5A** within 2 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 2 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 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 2 months (see rules 7(1), 11(1) and (2)).

The applicant can remedy the deficiency by completing and filing Form **T5A** within 2 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 2 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 “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; 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 that are registered trade marks, for example “Hoover”, “Jacuzzi”, “Karaoke”, “Rollerblade”, “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,  
disinfectant soap, medicated shampoos, etc.**

See the following examples:

Class 3

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

- “medicated soap”
- “disinfectant soap”

- Changes in the class heading:

<b><u>From</u></b>	<b><u>To</u></b>
soaps	non-medicated soaps
hair lotions	non-medicated hair lotions
dentifrices	non-medicated dentifrices

- 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”

**Other revisions**

▪ **Transfer of existing indications**

See the following examples:

<b>Goods</b>	<b>Class number under International Classification 10<sup>th</sup> edition</b>	<b>Class number under International Classification 11<sup>th</sup> edition</b>
xylol	4	1
xylene	4	1
benzene	4	1
benzol	4	1
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
socks, electrically heated	9	11
rosaries	16	14
chaplets	16	14
reins for guiding children	26	18

<b>Goods</b>	<b>Class number under International Classification 10<sup>th</sup> edition</b>	<b>Class number under International Classification 11<sup>th</sup> edition</b>
wax for skis	28	4
scrapers for skis	28	8
piccalilli	29	30

- **Change and transfer of existing indications**

See the following examples:

<b>Goods</b>	<b>Class number under International Classification 10<sup>th</sup> edition</b>	<b>Changed to</b>	<b>Class number under International Classification 11<sup>th</sup> edition</b>
ladles for wine	8	ladles for serving wine	21
gut for making sausages	18	sausage casings, natural or artificial	29
sleeping bags for camping	20	sleeping bags	24
pig bristles	21	pig bristles	22
milk of almonds [beverage]	32	almond milk-based beverages	29
peanut milk [non-alcoholic beverage]	32	peanut milk-based beverages	29

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

See the following examples:

<b>Revision of indications under International Classification 11<sup>th</sup> edition</b>		<b>Remarks</b>	<b>Cross search</b>
Change of “vice benches, not of metal” in class 20 to “ <b>vice benches [furniture]</b> ”	Deletion of “vice benches of metal” from class 6	“vice benches [furniture]” in class 20 cover “vice benches of metal”.	Cross search of “ <b>vice benches [furniture]</b> ” in class 20 against “vice benches of metal” in class 6 (for applications filed before 1.1.2017)
Change of “meat chests, not of metal” in class 20 to “ <b>meat safes</b> ”	Deletion of “meat safes of metal” from class 6	“meat safes” in class 20 cover “meat safes of metal”.	Cross search of “ <b>meat safes</b> ” 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” in class 6 to “ <b>handles for hand-operated hand tools</b> ” in class 8	Deletion of “tool handles, not of metal” from class 20	“handles for hand-operated hand tools” in class 8 cover “tool handles, not of metal”.	Cross search of “ <b>handles for hand-operated hand tools</b> ” in class 8 against “tool handles of metal” in class 6 and “tool handles, not of metal” in class 20 (for applications filed before 1.1.2017)

Revision of indications under International Classification 11 <sup>th</sup> edition	Remarks	Cross search	
Change and transfer of “knife handles of metal” in class 6 to <b>“knife handles”</b> 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 <b>“knife handles”</b> 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 <b>“scythe handles”</b> 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 <b>“scythe handles”</b> 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 <b>“broom handles”</b> 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 <b>“broom handles”</b> 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 11 <sup>th</sup> edition		Remarks	Cross search
Change and transfer of “flagpoles” in class 20 to <b>“flagpoles, not of metal”</b> in class 19	Addition of <b>“flagpoles of metal”</b> in class 6	“flagpoles of metal” in class 6 and “flagpoles, not of metal” in class 19 are covered by “flagpoles”.	Cross search of <b>“flagpoles of metal”</b> in class 6 or <b>“flagpoles, not of metal”</b> in class 19 against “flagpoles” in class 20 (for applications filed before 1.1.2017)
Change of “mantlepieces” in class 19 to <b>“fireplace mantles, not of metal”</b>	Addition of <b>“fireplace mantles of metal”</b> in class 6	“fireplace mantles of metal” in class 6 are covered by “mantlepieces”.	Cross search of <b>“fireplace mantles of metal”</b> 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 <b>“armour-plating of metal”</b> (or “armor-plating of metal”)	Addition of <b>“armour-plating, not of metal”</b> (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 <b>“armour-plating, not of metal”</b> (or “armor-plating, not of metal”) in class 19 against “armour-plating” (or armor-plating) in class 6 (for applications filed before 1.1.2017)

Revision of indications under International Classification 11 <sup>th</sup> edition		Remarks	Cross search
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)