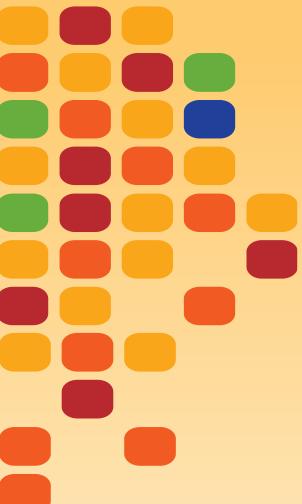




Workshop - The twelfth edition of the International Classification of Goods and Services for the Purposes of the Registration of Marks

15 December, 2022

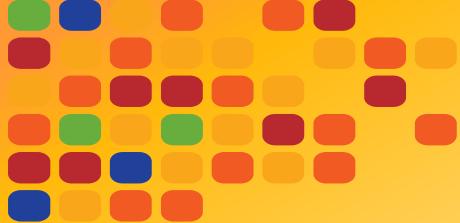


Agenda

- How is the International Classification updated?
- What revisions are to be made by the 12th edition of the International Classification (“12th edition”)?
- How will the 12th edition affect the Trade Marks Registry’s cross search list?
- How to reclassify goods and services of trade mark registrations in accordance with the 12th edition?



How is the International Classification updated?

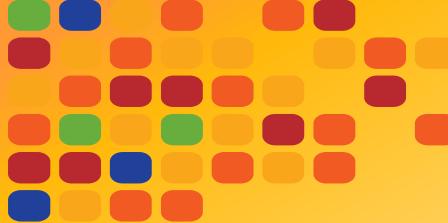


How is the International Classification updated?

- The World Intellectual Property Organization (the Committee of Experts of the Nice Union (“the Committee”)) revises the International Classification from time to time to keep it up to date.
- At the 21st session of the Committee held in 2010, the Committee had decided, among others, that:
 1. amendments 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 be made within the five-year cycle;
 2. a new version reflecting the updates in respect of additions, deletions and changes in the wording of indications would be published annually.
- The 12th edition will enter into force on 1.1.2023.
- At its 31st session held in 2021, the Committee had decided, among others, that the next revision period for amendments to the International Classification would last for three years. Therefore, the 13th edition of the International Classification will enter into force on 1.1.2026 (NCL (13-2026)).



What revisions are to be made by the 12th edition?

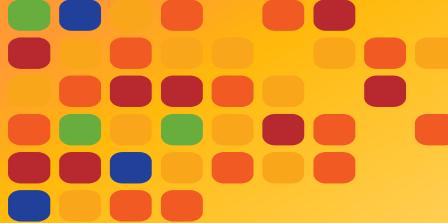


What revisions are to be made by the 12th edition?

1. Revisions concerning certain dispensing apparatus[#]
2. Addition of new indications
3. Deletion of indications
4. Change of indications
5. Transfer of indications*
6. Change and transfer of indications*
7. Addition, deletion, change, change and transfer of indications #
8. Changes to class headings and explanatory notes

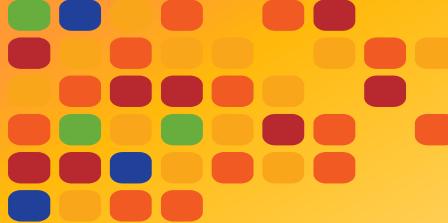
some revisions would affect cross search list

** affecting cross search list*



Revisions concerning certain dispensing apparatus (1)

- 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
- Classification of certain dispensing apparatus according to the function or purpose



Revisions concerning certain dispensing apparatus (2)

“ticket dispensers” in Class 9 (11th edition)



12th edition

Classification according to the material

Addition	Class 6	queue ticket dispensers of metal [#]
Addition	Class 20	queue ticket dispensers, not of metal

Classification according to the function or purpose

Addition	Class 7	ticket vending machines*
Change	Class 9	ticket dispensing terminals, electronic [^] (changed from “ticket dispensers”)

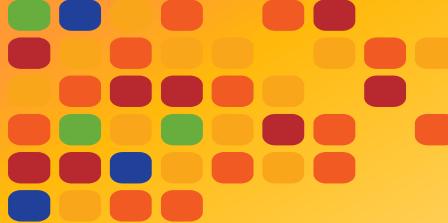
*See the picture in row 1 on page 2 of the proposals at the following web page for reference:

*See the pictures in row 1 on page 4 of the proposals at the following web page for reference:

[^]See the pictures in row 1 on page 5 of the proposals at the following web page for reference:

<https://www3.wipo.int/classifications/nice/nclef/public/en/project/NI066/annex/1/pdf>

Intellectual Property Department



Revisions concerning certain dispensing apparatus (3)

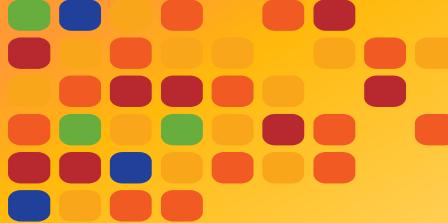
Examples of classification according to the material

Class 21		boxes for dispensing paper towels
Change and transfer	Class 6	boxes of metal for dispensing paper towels# (changed and transferred from “boxes for dispensing paper towels” in Class 21)
Addition	Class 20	boxes, not of metal, for dispensing paper towels*

#See the picture in row 3 on page 10 of the proposals at the following web page for reference:

*See the picture in row 2 on page 11 of the proposals at the following web page for reference:

<https://www3.wipo.int/classifications/nice/nclef/public/en/project/NI087/annex/21/pdf>



Revisions concerning certain dispensing apparatus (4)

Examples of classification according to the material

Class 21	toilet paper dispensers
-----------------	-------------------------

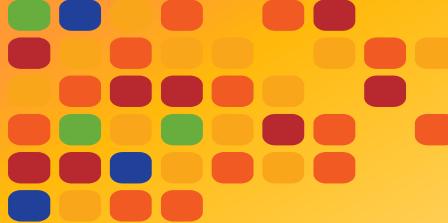


Change and transfer	Class 6	toilet paper dispensers of metal [#] (changed and transferred from “toilet paper dispensers” in Class 21)
Addition	Class 20	toilet paper dispensers, not of metal [*]

#See the pictures in row 2 on page 12 of the proposals at the following web page for reference:

*See the picture in row 1 on page 13 of the proposals at the following web page for reference:

<https://www3.wipo.int/classifications/nice/nclef/public/en/project/NI087/annex/21/pdf>



Revisions concerning certain dispensing apparatus (5)

Examples of classification according to the material:

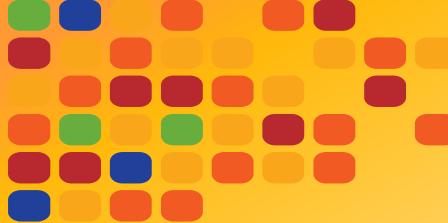
Change

Class 6	towel dispensers of metal [#] (changed from “towel dispensers, fixed, of metal”)
Class 20	towel dispensers, not of metal [*] (changed from “towel dispensers, fixed, not of metal / towel dispensers, not of metal, fixed”)

#See the pictures in row 1 on page 10 of the proposals at the following web page for reference:

*See the pictures in row 2 on page 10 of the proposals at the following web page for reference:

<https://www3.wipo.int/classifications/nice/nclef/public/en/project/NI087/annex/21/pdf>



Revisions concerning certain dispensing apparatus (6)

Examples of classification according to the material:

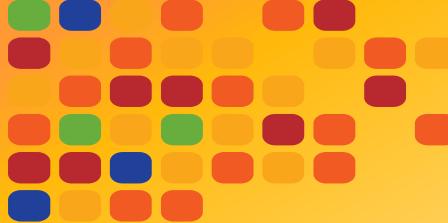
Change

Class 6	dispensers of metal for dog waste bags# (changed from “dispensers for dog waste bags, fixed, of metal”)
Class 20	dispensers, not of metal , for dog waste bags* (changed from “dispensers for dog waste bags, fixed, not of metal”)

#See the pictures in row 3 on page 7 of the proposals at the following web page for reference:

*See the picture in row 1 on page 8 of the proposals at the following web page for reference:

<https://www3.wipo.int/classifications/nice/nclef/public/en/project/NI087/annex/21/pdf>



Revisions concerning certain dispensing apparatus (7)

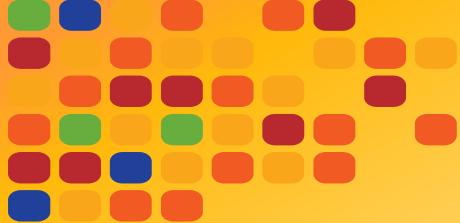
Examples of classification according to the function or purpose

Addition

Class 7	fluid dispensing machines for industrial use
Class 9	dosage dispensers, not for medical use [measuring apparatus]
Class 10	dosage dispensers for medical use
Class 18	dog waste bag dispensers adapted for use with leashes

Change

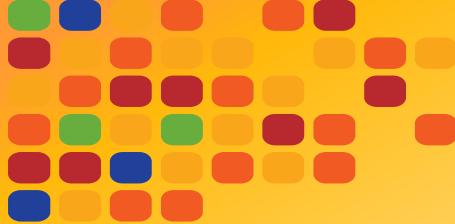
Class 21	soap dispensers -> soap dispensing bottles
-----------------	--



Addition of new indications

Examples

Class	New indication
3	serums for cosmetic purposes
7	semiconductor manufacturing machines
9	downloadable digital files authenticated by non-fungible tokens [NFTs]
10	ear plugs for swimmers
41	providing online virtual guided tours



“ear plugs for divers / swimmers”

Class 10 “ear plugs for swimmers”#

- “Ear plugs for swimmers” are used for protecting the health of the ear by preventing damage and discomfort to the ear.

Class 9 “ear plugs for divers”*

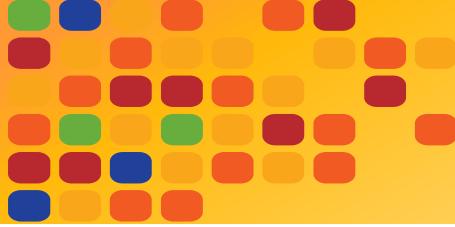
- “Ear plugs for divers” form part of the equipment used by a diver that is effectively aimed at preserving life.

#See the picture at the following web page for reference:

<https://www3.wipo.int/classifications/nice/nclrms/#/public/proposals/79859/comments>

*See the pictures at the following web page for reference:

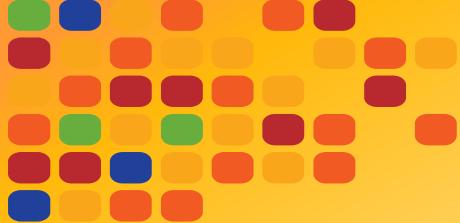
https://www.wipo.int/classifications/nice/nclpub/en/fr/?version=20230101¬ion=information_files&gors=100224&lang=en



Deletion of indications

Examples

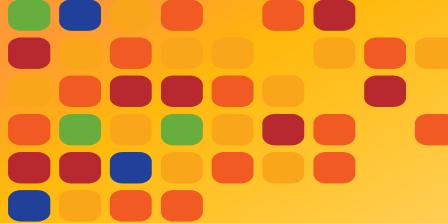
Class	Indication
7	superheaters
8	harpoons for fishing
42	information technology services provided on an outsourcing basis



Change of indications

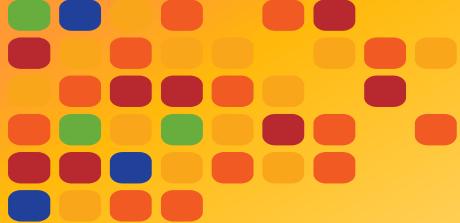
Examples

Class	The 11th edition	The 12th edition
3	cosmetic kits	make-up palettes containing cosmetics
9	ticket dispensers	ticket dispensing terminals, electronic
20	sew-on tags of plastic or rubber for clothing	sew-on tags of plastic for clothing
21	soap dispensers	soap dispensing bottles
29	fat-containing mixtures for bread slices	fat-based spreads for bread slices
42	information technology [IT] consultancy	information technology [IT] support services [troubleshooting of software]



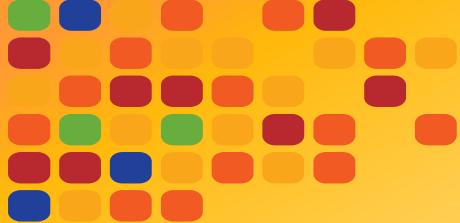
Transfer of goods from one class to another

Goods	Classification under the 11th edition	Classification under the 12th edition
needles for wool combing machines	Class 26	Class 7
hospital beds	Class 20	Class 10



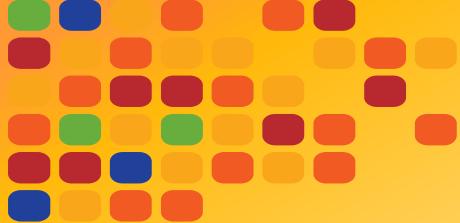
Change and transfer of goods from one class to another (1)

Goods	Classification under the 11th edition	Changed to	Classification under the 12th edition
loading apparatus for furnace	Class 11	furnace loading machines	Class 7
bags for microwave cooking	Class 16	bags for use in cooking	Class 21
insulating gloves	Class 17	insulating gloves for protection against accidents	Class 9



Change and transfer of goods from one class to another (2)

Goods	Classification under the 11th edition	Changed to	Classification under the 12th edition
boxes for dispensing paper towels	Class 21	boxes of metal for dispensing paper towels	Class 6
toilet paper dispensers	Class 21	toilet paper dispensers of metal	Class 6
wet suits for water-skiing	Class 25	wet suits	Class 9



Addition, deletion, change, change and transfer of indications (1)

Example

Wet suits#, Dry suits*, Dive skins^

- Addition of “dry suits” and “dive skins” in Class 9
- Change and transfer of “wet suits for water-skiing” in Class 25 to “wet suits” in Class 9

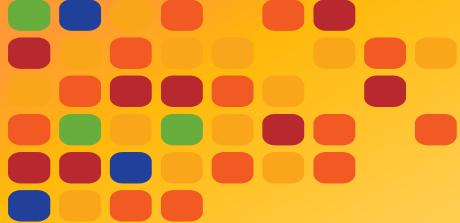
=> “wet suits, dry suits, dive skins” are classified in Class 9

#See the pictures of “wet suits” on pages 13 and 17 of the proposals at the following web page for reference:

*See the pictures of “dry suits” on pages 13 and 17 of the proposals at the following web page for reference:

^See the pictures of “dive skins” on page 19 of the proposals at the following web page for reference:

<https://www3.wipo.int/classifications/nice/nclef/public/en/project/NI104/annex/17/pdf>



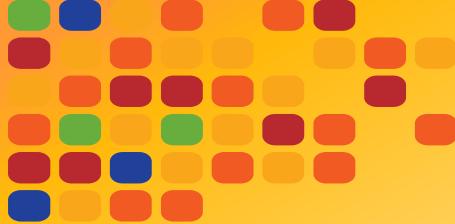
Addition, deletion, change, change and transfer of indications (2)

Example

Harpoon guns

- Deletion of “harpoon guns [sports articles]” from Class 28
- Deletion of “harpoons for fishing” from Class 8
- Change of “harpoon guns [weapons]” in Class 13 to “harpoon guns”

=> “harpoon guns” (whether for sport or commercial use) are in Class 13.

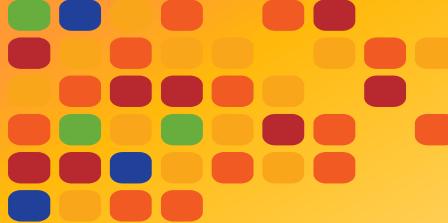


Changes to class headings and explanatory notes (1)

Examples

Class headings

- Class 36: Replace “real estate affairs” with “real estate **services**”
- Class 45: Replace “personal and social services rendered by others to meet the needs of individuals” with “**dating services, online social networking services; funerary services; babysitting**”



Changes to class headings and explanatory notes (2)

Example

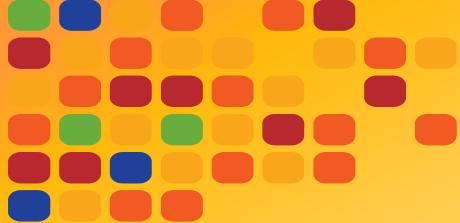
Explanatory notes

Class 6

- Under “*This Class includes, in particular*”, add “*certain dispensing apparatus of metal, automatic or non-automatic, for example, towel dispensers, queue ticket dispensers, dispensers for dog waste bags, toilet paper dispensers*”.
- Under “*This Class does not include, in particular*”, add “*certain dispensing apparatus that are classified according to their function or purpose, for example, fluid dispensing machines for industrial use (Cl. 7), ticket dispensing terminals, electronic (Cl. 9), dosage dispensers for medical use (Cl. 10), adhesive tape dispensers (Cl. 16)*”.

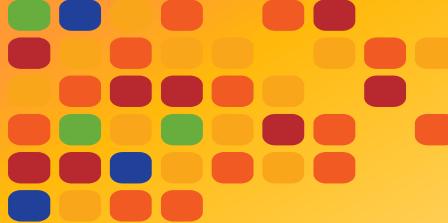


How will the 12th edition affect the Registry's cross search list?



How will the 12th edition affect the Registry's cross search list?

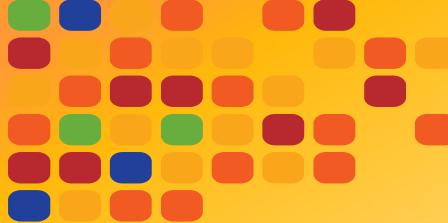
- We take account of changes to the International Classification in our searches for earlier marks.
- The list sets out, in principle, the classes in which the Registry would normally search in respect of particular goods or services to identify earlier marks for identical or similar goods or services.



Revisions concerning certain dispensing apparatus (1)

Examples

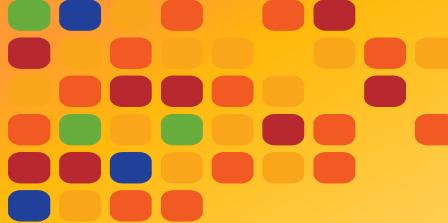
Goods	Cross search against
<u>Class 6</u> boxes of metal for dispensing paper towels	<u>Class 21</u> boxes for dispensing paper towels (cite only marks filed before 1.1.2023)
<u>Class 20</u> boxes, not of metal, for dispensing paper towels	



Revisions concerning certain dispensing apparatus (2)

Examples

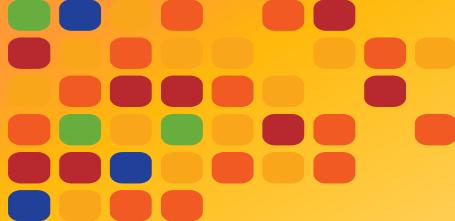
Goods	Cross search against
<u>Class 6</u> toilet paper dispensers of metal	<u>Class 21</u> toilet paper dispensers (cite only marks filed before 1.1.2023)
<u>Class 20</u> toilet paper dispensers, not of metal	



Revisions concerning certain dispensing apparatus (3)

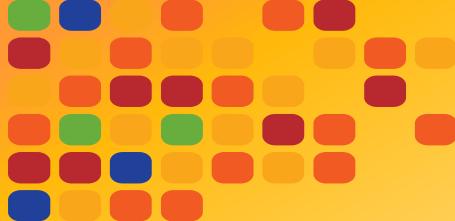
Examples

Goods	Cross search against
<u>Class 6</u> queue ticket dispensers of metal	
<u>Class 7</u> ticket vending machines	<u>Class 9</u> ticket dispensers (cite only marks filed before 1.1.2023)
<u>Class 20</u> queue ticket dispensers, not of metal	



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

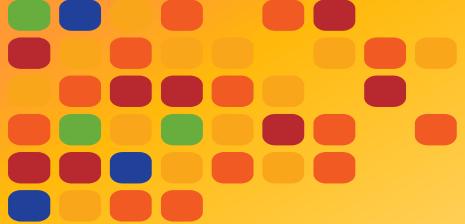
Goods	Cross search against
<u>Class 7</u> needles for wool combing machines	<u>Class 26</u> needles for wool combing machines (cite only marks filed before 1.1.2023)
<u>Class 10</u> hospital beds	<u>Class 20</u> hospital beds (cite only marks filed before 1.1.2023)



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

Examples

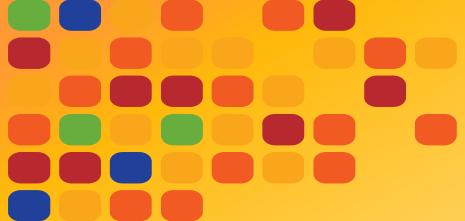
Goods	Cross search against
<u>Class 7</u> furnace loading machines	<u>Class 11</u> loading apparatus for furnace (cite only marks filed before 1.1.2023)
<u>Class 9</u> insulating gloves for protection against accidents	<u>Class 17</u> insulating gloves (cite only marks filed before 1.1.2023)
<u>Class 21</u> bags for use in cooking	<u>Class 16</u> bags for microwave cooking (cite only marks filed before 1.1.2023)



Revisions resulting from Addition, deletion, change, change and transfer of indications (1)

Example

Goods	Cross search against
<u>Class 9</u> Wet suits; dry suits; dive skins	<u>Class 25</u> Wet suits for water-skiing (cite only marks filed before 1.1.2023)



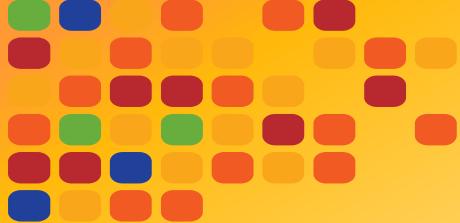
Revisions resulting from Addition, deletion, change, change and transfer of indications (2)

Example

Goods	Cross search against
<u>Class 13</u> Harpoon guns	<u>Class 8</u> harpoons for fishing (cite only marks filed before 1.1.2023)
	<u>Class 28</u> harpoon guns [sports articles] (cite only marks filed before 1.1.2023)

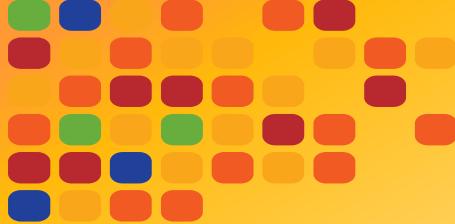


How to reclassify goods and services of trade mark registrations in accordance with the 12th edition?



How to reclassify goods and services of trade mark registrations in accordance with the 12th edition?

- We will reclassify registrations to be consistent with the 12th edition.
- Reclassification includes:
 - registrations classified under classes listed in Schedule 4 to the old Trade Marks Rules (Cap.43 subsidiary legislation) that are not consistent with the 12th edition
 - registrations classified in accordance with the 11th edition of the International Classification that will be affected by the classification changes to be made by the 12th edition



Workflow of reclassification (1)

Send reclassification notice



Registered owner may make written objections, state the grounds of his objections within three months (or any extended period) after the date of the notice.

YES

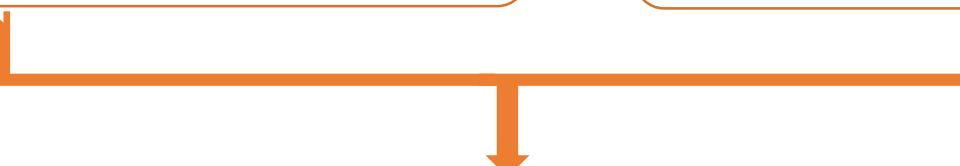


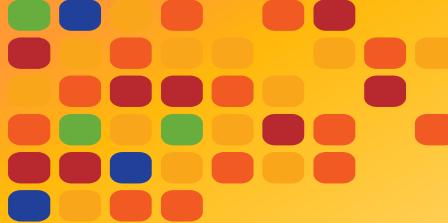
NO



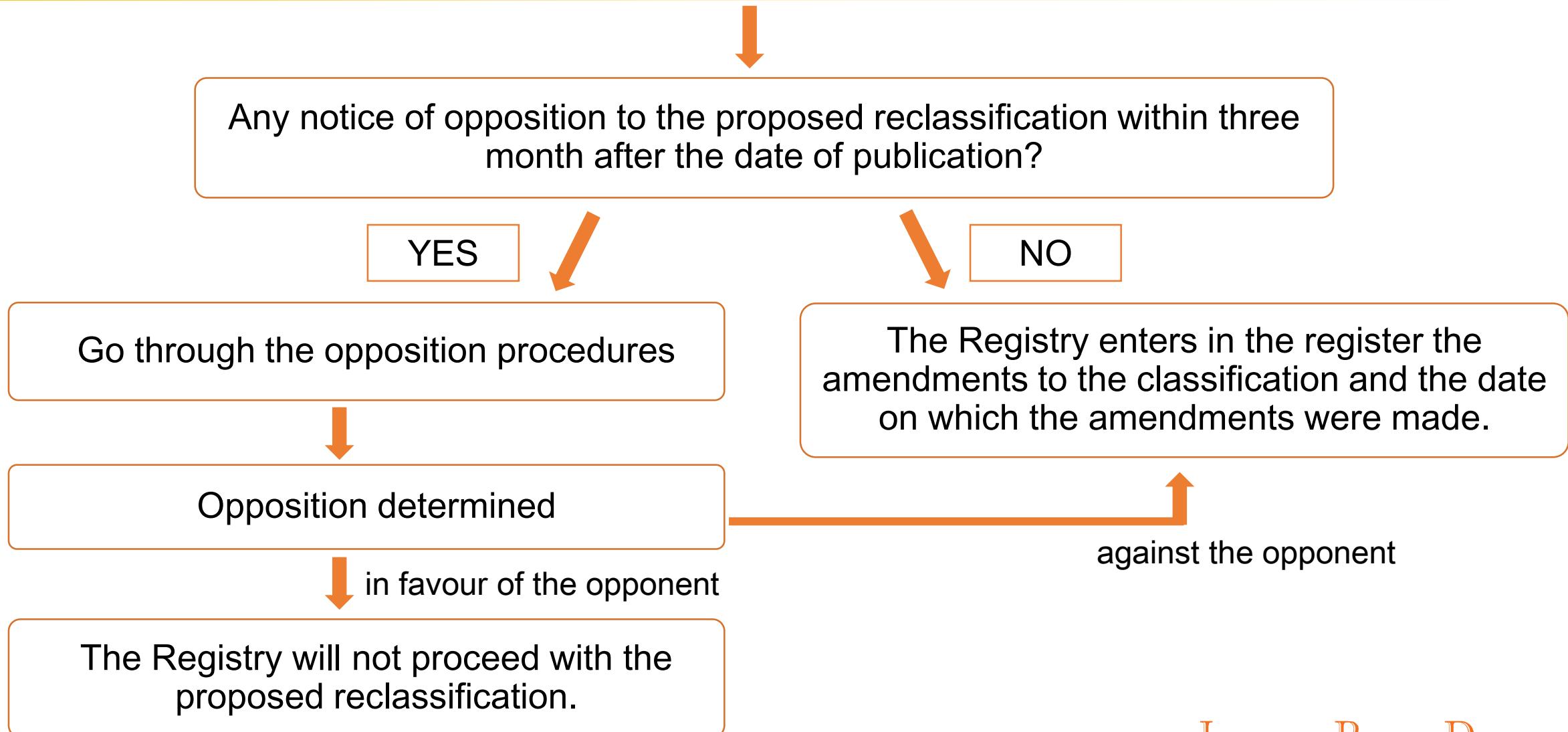
After considering the objections, the Registry may abandon the proposal, publish the proposal, or publish amended proposal (as the case may be).

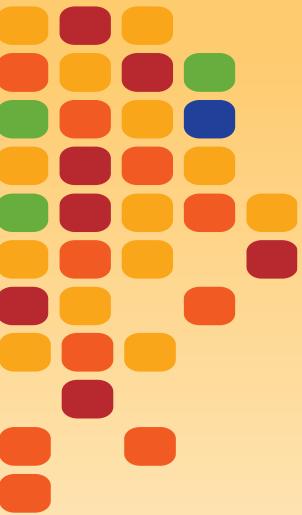
The Registry publishes the proposal.





Workflow of reclassification (2)

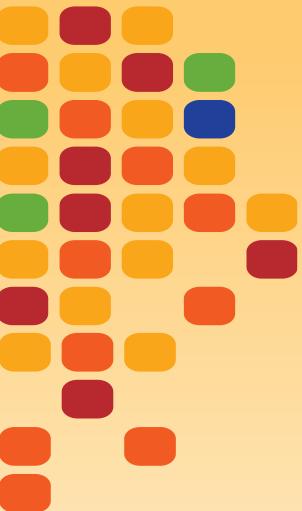




Documents on the 12th edition

Relevant details of the 12th edition can be found at

https://www.wipo.int/classifications/en/news/nice/2022/news_0003.html.



How to obtain further information on the 12th edition after it has entered into force on 1.1.2023?

IPD's website

- Trade Marks Registry Work Manual Chapters on “Classification” and “Cross search list”
http://www.ipd.gov.hk/eng/intellectual_property/trademarks/registry.htm (existing link)
<https://ipd.gov.hk/en/trade-marks/trade-marks-registry-work-manual/index.html> (updated link tentatively in Jan 2023)
- How to classify my goods/services?
http://www.ipd.gov.hk/eng/intellectual_property/trademarks/how_to_classify.htm (existing link)
<https://ipd.gov.hk/en/trade-marks/apply-for-a-trade-mark/how-to-classify-my-goods-services/index.html> (updated link tentatively in Jan 2023)
- Trade mark search – Goods/Services Classification Search
<http://ipsearch.ipd.gov.hk/trademark/jsp/main.jsp>



END