

***GUIDELINES FOR EXAMINATION IN THE
EUROPEAN UNION INTELLECTUAL
PROPERTY OFFICE ON EUROPEAN UNION
TRADE MARKS***

PART B

EXAMINATION

SECTION 3

CLASSIFICATION

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1 Introduction

Every EUTM application must contain a list of goods and services as a condition for a filing date to be accorded (Article 26(1)(c) EUTMR). The list must be classified in accordance with the Nice Agreement (Article 28 EUTMR).

The list of goods and services for which protection is sought must be (a) identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators to determine the extent of the protection sought, and (b) grouped according to the classes of the Nice Classification (Article 28(2) and (6) EUTMR).

The use of the Office's administrative IT tools for classification (see paragraph 3 below) is highly recommended. Any part of the list of goods and services which does not match the data from the tools will be examined following the principles as set out in these Guidelines. Whenever the applicant selects a term from the available tools, it will **not be examined** any further and will **speed up the registration procedure**.

The purpose of this part of the Guidelines is to describe Office practice in the examination of classification of goods and services.

The first part (paragraphs 1 to 4) sets out the principles applied by the Office. The second part (paragraph 5) summarises the procedure of examining the list of goods and services.

In short, when examining the classification of a list of goods and services the Office does four tasks:

- it checks that each of the goods and services is clear and precise enough;
- it checks that each term is proper to the class in which it is applied for;
- it notifies any deficiency;
- it refuses the application, in whole or in part, where the deficiency is not remedied (Rule 9(4) and (8) EUTMR).

2 The Nice Classification

The version of the classification under the Nice Agreement in force at the filing date will be applied to the classification of the goods or services in an application (available at: <http://tmclass.tmdn.org>). Article 28 EUTMR requires the applicant to provide a list of goods and services in the following manner.

- The list must be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators to determine the extent of the protection sought.
- The goods or services must be grouped according to the Nice Classification, each group preceded by the number of the class to which the goods or services belong and presented in the order of the classes.

The Nice Classification consists, for each class, of the following.

1. **Class headings:** the class headings are general indications relating to the field to which, in principle, the goods or services belong.
2. **Explanatory notes:** the explanatory notes explain which goods or services are meant or not meant to fall under the class headings and are to be considered an integral part of the classification.
3. **The alphabetical list:** the alphabetical list shows how individual goods or services are appropriate to a class.
4. **General remarks:** the general remarks explain what criteria should be applied if a term cannot be classified in accordance with the class headings or alphabetical list.

More information regarding the Nice Classification can be found on the website of the World Intellectual Property Organization (WIPO) at <http://www.wipo.int>.

3 Administrative Tools for Classification Purposes

When filing an electronic application through e-filing, users can select pre-approved terms to build their list of goods and services. All those selectable terms originate from a harmonised database and will automatically be accepted for classification purposes. Using these pre-approved terms will facilitate a smoother trade mark registration process. The harmonised database brings together terms which are accepted for classification purposes in all EU offices.

Should the applicant use a list of goods & services containing terms that are not found in the harmonised database, the Office will verify through an examination procedure whether they can be accepted.

Before filing an application the content of the harmonised database can be searched through the Office's tool TMclass (<http://tmclass.tmdn.org/ec2/>). This tool brings together classification databases of participating offices within and outside the EU and shows whether a term can be accepted by the office concerned. Within TMclass goods and services are grouped according to shared characteristics from a market perspective, starting from the more general and ending with the more specific. In this way, the user is provided with a simplified search, and is given a better overview of the content of each class, thus facilitating the selection of appropriate terms.

This grouping and ranking, also called Taxonomy, has no legal effect. In particular, the scope of protection of a European Union trade mark is always defined by the natural and usual meaning of the chosen terms, not by the position of the terms in the Office's classification tools.

4 Building a List of Goods and Services

4.1 Clarity and precision

4.1.1 General principles

The goods and services for which the protection of the trade mark is sought should be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection sought (Article 28(2) EUTMR).

A description of goods and services is sufficiently clear and precise when its scope of protection can be understood from its natural and usual meaning. If this scope of protection cannot be understood, sufficient clarity and precision may be achieved by identifying factors such as characteristics, purpose and/or identifiable market sector. Elements that could help to identify the market sector¹ may be, but are not limited to, the following:

- consumers and/or sales channels;
- skills and know-how to be used/produced;
- technical capabilities to be used/produced.

A term may be part of the description of goods and services in a number of classes; it may be clear and precise in a particular class without further specification. For example: *furniture* (Class 20), *clothing* (Class 25), *gloves* (Class 25).

If protection is sought for a specialised category of goods and services or a specialised market sector belonging to a different class, further specification of the term may be necessary.

For example: ***furniture especially made for medical purposes*** (Class 10);

furniture especially made for laboratories (Class 9);

protective clothing (Class 9);

clothing especially for operating rooms (Class 10);

clothing for pets (Class 18);

gardening gloves (Class 21);

baseball gloves (Class 28).

¹. Market sector describes a set of businesses that are buying and selling such similar goods and services that they are in direct competition with each other.

Tools such as TMclass (<http://tmclass.tmdn.org/ec2/>) are available to determine whether the particular category of goods and services needs this further specification or not.

4.1.2 Use of expressions (e.g. ‘namely’, ‘in particular’) to determine the scope of the list of goods/services

The use of the words ‘namely’ or ‘being’ is acceptable, but must be understood to be a restriction to the specific goods and services which are listed thereafter. For example, *pharmaceutical preparations, namely analgesics* in Class 5 means that the application only covers analgesics and not any other type of pharmaceuticals.

The expression ‘in particular’ can also be accepted as it serves to indicate an example of the goods and services which are applied for. For example, *pharmaceutical preparations, in particular analgesics* means that the application covers any kind of pharmaceuticals, with *analgesics* being an example.

The same interpretation applies to the use of the terms ‘including’, ‘including (but not limited to)’, ‘especially’ or ‘mainly’ as in the example *pharmaceutical preparations, including analgesics*.

A term that would normally be considered unclear or imprecise can be made acceptable provided that it is further specified, for example, by using ‘namely’ and a list of acceptable terms. An example would be *electrical apparatus, namely computers* for goods in Class 9.

Further examples of acceptable use

Class 29: <i>Dairy products namely cheese and butter</i>	This would restrict the goods to only cheese and butter and exclude all other dairy products.
Class 41: <i>Provision of sports facilities, all being outdoors.</i>	This would restrict the services to cover only outdoor facilities and exclude any indoor facilities.
Class 25: <i>Clothing, all being underwear</i>	This would restrict the goods covered to only that which is considered underwear and will exclude all other types of clothing.

Other words or phrases may only point out that certain goods are important, and the inclusion of the term does not restrict the further listing in any way. Examples include:

Class 29: <i>Dairy products, in particular cheese and butter</i>	The coverage would include all dairy products; cheese and butter are probably the TM owner’s most successful goods.
Class 41: <i>Provision of sports facilities, for example outdoor running tracks.</i>	The coverage now merely gives an example of one of several possibilities.
Class 25: <i>Clothing, including underwear</i>	The coverage extends to all clothing and not just underwear.

4.1.3 Use of the term 'and/or'

The use of oblique strokes is acceptable in lists of goods and services; the most common use is in the phrase '*and/or*', meaning that both goods/services referred to fall in the same class. For example:

- *chemical/biochemical products;*
- *chemical and/or biochemical products;*
- *chemicals for use in industry/science;*
- *chemicals for use in industry and/or science;*
- *import/export agency services.*

4.1.4 Punctuation

The use of correct punctuation is very important in a list of goods and services, almost as important as the words.

The use of commas serves to separate items within a similar category or expression. For example, *flour and preparations made from cereals, bread, pastry and confectionery* in Class 30 must be read as that the goods can be or are made from any of those materials.

The use of a semi-colon means a separation between expressions. For example, *flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder* in Class 30 must be interpreted that the terms *honey and treacle* are independent from the other terms and do not form part of *preparations made from ...*

The separation of terms with incorrect punctuation can lead to changes in meaning and incorrect classification.

Take the example of *computer software for use with textile machinery; agricultural machines* in Class 9. In this list of goods and services the inclusion of a semi-colon means that the term *agricultural machines* must be considered as an independent category of goods. However, these are proper to Class 7, regardless of whether the intention was to protect computer software to be used in the field of textile machinery and agricultural machines.

A further example would be *retail services in relation to clothing; footwear; headgear* in Class 35. The use of a semi-colon renders the terms *footwear* and *headgear* as goods, which are separate and not included in the retail services. In such cases, the terms should be separated by commas.

4.1.5 Inclusion of abbreviations and acronyms in lists of goods and services

Abbreviations within lists of goods and services should be accepted with caution. Trade marks could have an indefinite life, and the interpretation of an abbreviation could vary over time. However, provided that an abbreviation has only one meaning in relation to the class of goods or services applied for, it can be allowed. The very well-known examples *CD-ROMs* and *DVDs* are acceptable in Class 9. If the abbreviation is well known in the field of activity it will be acceptable, but a more practical solution would be for examiners to initially carry out an internet search for the abbreviation to determine whether it needs to be expanded into words or the abbreviation or acronym followed by the abbreviation in square brackets (following WIPO's example).

Example

Class 45 *Services offering advice on the application and registration of EUTMs.*

This could be expanded to:

Class 45 *Services offering advice on the application and registration of European Union Trade Marks;*

or

Class 45 *Services offering advice on the application and registration of EUTMs [European Union Trade marks].*

Acronyms can be accepted in a list of goods or services as long as they are comprehensible and appropriate to the class applied for.

4.2 General indications and terms and expressions lacking clarity and precision

4.2.1 General indications of the class headings of the Nice Classification which are deemed not to be sufficiently clear and precise

In accordance with Article 28(3) and (5) EUTMR, general indications included in the class headings of the Nice Classification or other general terms may be used provided that they comply with the requisite standards of clarity and precision set out in Article 28(2) EUTMR.

The use of general terms, including general indications of the class headings of the Nice Classification, will be interpreted as including all goods or services clearly covered by the literal meaning of the indication or term². The use of such terms or indications will not be interpreted as comprising a claim to goods or services that cannot be understood in this way.

² The Office's former practice, according to which use of all the general indications listed in the class heading of a particular class constituted a claim to all goods or services falling under the class was abandoned in June 2012, following the judgment of 19/06/2012, C-307/10, 'IP Translator'.

In collaboration with the Trade Mark Offices of the European Union, other (inter)national organisations, offices and various user associations, the Office has established a list of general indications of the class headings of the Nice Classification which are deemed not to be sufficiently clear and precise in accordance with the judgment of 19/06/2012, C-307/10, 'IP Translator'.

In February 2014 the 197 general indications of the Nice class headings were examined with respect to the requisites of clarity and precision. Of these, 11 were considered to lack the clarity and precision to specify the scope of protection that they would give, and consequently cannot be accepted without further specification. These are set out below in bold.

- Class 6 **Goods of common metal not included in other classes.**
- Class 7 **Machines and machine tools.**
- Class 14 **Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes.**
- Class 16 **Paper, cardboard and goods made from these materials [paper and cardboard], not included in other classes.**
- Class 17 **Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials [rubber, gutta-percha, gum, asbestos and mica] and not included in other classes.**
- Class 18 **Leather and imitations of leather, and goods made of these materials [leather and imitations of leather] and not included in other classes.**
- Class 20 **Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerscham and substitutes for all these materials, or of plastics.**
- Class 37 **Repair.**
- Class 37 **Installation services.**
- Class 40 **Treatment of materials.**
- Class 45 **Personal and social services rendered by others to meet the needs of individuals.**

The remaining 186 Nice class heading terms comply with the requisites of clarity and precision and are therefore acceptable for classification purposes.

The reasons why each of the 11 Nice class heading terms were not found clear and precise are described below.

- Class 6 **Goods of common metal not included in other classes.**

In light of the need for clarity and precision, this term does not provide a clear indication of what goods are covered as it simply states what the goods are made of, and not what the goods are. It covers a wide range of

goods that may have very different characteristics and/or purposes, that may require very different levels of technical capabilities and know-how to be produced and/or used, could target different consumers, be sold through different sales channels, and therefore relate to different market sectors.

Class 7 ***Machines and machine tools.***

In light of the need for clarity and precision, the term *machines* does not provide a clear indication of what machines are covered. Machines can have different characteristics or different purposes, they may require very different levels of technical capabilities and know-how to be produced and/or used, could target different consumers, be sold through different sales channels, and therefore relate to different market sectors.

Class 14 ***Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes.***

In light of the need for clarity and precision, the term *goods in precious metals or coated therewith, not included in other classes* does not provide a clear indication of what goods are covered, as it simply states what the goods are made of or coated with, and not what the goods are. It covers a wide range of goods that may have very different characteristics, that may require very different levels of technical capabilities and know-how to be produced, could target different consumers, be sold through different sales channels, and therefore relate to different market sectors.

Class 16 ***Paper, cardboard and goods made from these materials, not included in other classes.***

In light of the need for clarity and precision, the term *goods made from these materials [paper and cardboard], not included in other classes* does not provide a clear indication of what goods are covered, as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and/or purposes, that may require very different levels of technical capabilities and know-how to be produced and/or used, could target different consumers, be sold through different sales channels, and therefore relate to different market sectors.

Class 17 ***Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes.***

In light of the need for clarity and precision, the term *goods made from these materials [rubber, gutta-percha, gum, asbestos and mica] and not included in other classes* does not provide a clear indication of what goods are covered as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and/or purposes, that may require very different levels of technical capabilities and know-how to be produced and/or used, could target different consumers, be sold through different sales channels, and therefore relate to different market sectors.

Class 18 *Leather and imitations of leather, and goods made of these materials and not included in other classes.*

In light of the need for clarity and precision, the term *goods made of these materials [leather and imitations of leather] and not included in other classes* does not provide a clear indication of what goods are covered, as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and/or purposes, that may require very different levels of technical capabilities and know-how to be produced and/or used, could target different consumers, be sold through different sales channels, and therefore relate to different market sectors.

Class 20 *Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.*

In light of the need for clarity and precision, this term does not provide a clear indication of what goods are covered as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and/or purposes, that may require very different levels of technical capabilities and know-how to be produced and/or used, that could target different consumers, be sold through different sales channels, and therefore relate to different market sectors.

Class 37 *Repair.*

In light of the need for clarity and precision, this term does not provide a clear indication of the services being provided, as it simply states that these are repair services, and not what is to be repaired. As the goods to be repaired may have different characteristics, the repair services will be carried out by service providers with different levels of technical capabilities and know-how, and may relate to different market sectors.

Class 37 *Installation services.*

In light of the need for clarity and precision, this term does not provide a clear indication of the services being provided, as it simply states that these are installation services, and not what is to be installed. As the goods to be installed may have different characteristics, the installation services will be carried out by service providers with different levels of technical capabilities and know-how, and may relate to different market sectors.

Class 40 *Treatment of materials.*

In light of the need for clarity and precision, this term does not give a clear indication of the services being provided. The nature of the treatment is unclear, as are the materials to be treated. These services cover a wide range of activities performed by different service providers on materials of different characteristics requiring very different levels of technical capabilities and know-how, and may relate to different market sectors.

Class 45 *Personal and social services rendered by others to meet the needs of individuals.*

In light of the need for clarity and precision, this term does not give a clear indication of the services being provided. These services cover a wide range of activities performed by different service providers requiring very different levels of skill and know-how, and may relate to different market sectors.

With the deletion of six general indications from the 2016 version of the 10th edition of the Nice Classification, the list of unacceptable general indications is reduced to five:

Class 7 *Machines and machine tools.*

Class 37 *Repair.*

Class 37 *Installation services.*

Class 40 *Treatment of materials.*

Class 45 *Personal and social services rendered by others to meet the needs of individuals.*

EUTM applications including any of the abovementioned 11 general indications contained in the current or earlier editions of the Nice Classification will be objected to as being too vague. The applicant will be asked to specify the vague term.

Non-acceptable general indications can become clear and precise if the applicant follows the principles set out under paragraph 4.1 above. The following is a non-exhaustive list of acceptable specifications.

Not a clear and precise term	Example of a clear and precise term
<i>Goods of common metal not included in other classes (Class 6)</i>	<i>Construction elements of metal (Class 6)</i> <i>Building materials of metal (Class 6)</i>
<i>Machines (Class 7)</i>	<i>Agricultural machines (Class 7)</i> <i>Machines for processing plastics (Class 7)</i> <i>Milking machines (Class 7)</i>
<i>Goods in precious metals or coated therewith (Class 14)</i>	<i>Works of art of precious metal (Class 14)</i>
<i>Goods made from paper and cardboard (Class 16)</i>	<i>Filtering materials of paper (Class 16)</i>
<i>Goods made from rubber, gutta-percha, gum, asbestos and mica (Class 17)</i>	<i>Rings of rubber (Class 17)</i>
<i>Goods made of these materials [leather and imitations of leather] (Class 18)</i>	<i>Briefcases [leather goods] (Class 18)</i>
<i>Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics (Class 20)</i>	<i>Door fittings, made of plastics (Class 20)</i> <i>Figurines of wood (Class 20)</i>
<i>Repair (Class 37)</i>	<i>Shoe repair (Class 37)</i> <i>Repair of computer hardware (Class 37)</i>

Not a clear and precise term	Example of a clear and precise term
<i>Installation services</i> (Class 37)	<i>Installation of doors and windows</i> (Class 37) <i>Installation of burglar alarms</i> (Class 37)
<i>Treatment of materials</i> (Class 40)	<i>Treatment of toxic waste</i> (Class 40) <i>Air purification</i> (Class 40)
<i>Personal and social services rendered by others to meet the needs of individuals</i> (Class 45)	<i>Personal background investigations</i> (Class 45) <i>Personal shopping for others</i> (Class 45) <i>Adoption agency services</i> (Class 45)

Note that vague terms would not be made specific, or acceptable, by the addition of such terms as *including* or *in particular*. The example *machines, including milking machines* would not be acceptable as it remains vague (see paragraph 4.1.2 above).

4.2.2 Vague terms

The same principles regarding clarity and precision as described above are applicable to all the goods and services listed in the application. Terms which do not provide a clear indication of the goods covered, should be objected to. Examples of such expressions are:

- *Electric/electronic apparatus/instruments;*
- *Association services;*
- *Facilities management services.*

They all must be specified as described above, that is to say, by identifying factors such as characteristics, purpose and/or identifiable market sector.

4.2.3 The claim for all goods/services in this class or all goods/services of the alphabetical list in this class

If the applicant intends to protect all goods or services included in the alphabetical list of a particular class, it has to expressly indicate this by listing these goods or services explicitly and individually. In order to assist applicants, the use of the hierarchical structure (see paragraph 3 above, Administrative Tools for Classification Purposes) is encouraged.

Applications are sometimes submitted for *all goods in Class X, all services in Class X, all goods/services in this class* or *all goods/services of the alphabetical list in this class* (or the like). This specification does not comply with Article 26(1)(c) EUTMR which requires a list of the goods or services in respect of which the registration is requested. Consequently, no filing date is awarded.

On other occasions the applicant has correctly listed some goods and/or services to be covered and added, at the end of the listing in each class, the expression *and all other goods/services in this class* or *and all goods/services of the alphabetical list in this class* (or the like). Such expressions do not constitute a valid claim within the meaning of Article 28(2) EUTMR and will be rejected. In those cases, the application may proceed **only** for the part of the goods and/or services that is correctly listed. The

Office will inform the applicant that those statements are not acceptable for classification purposes and thus will be deleted.

4.2.4 Reference to other classes within the list

References to other class numbers within a class are not acceptable for classification purposes. For example, the descriptions (in Class 39) *transport services of all goods in Classes 32 and 33* or (in Class 9) *computer software in the field of services in Classes 41 and 45* are not acceptable as in both cases the terms are considered to be unclear and imprecise and lack legal certainty as to what goods and services are covered. The only way to overcome the objection to these lists of goods and services will be for the respective goods of Classes 32 and 33, and the services of Classes 41 and 45 to be specified.

The term ... *goods not included in other classes* ... is not acceptable in service classes because this expression only has a sense in its original goods class.

For example, the heading of Class 22 reads *ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes)*. In that context the reference to ... *not included in other classes* is meaningful. However, if that same term is used in a service class list of goods and services it cannot make sense. For example, *transport services of ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes)* in Class 39 could not be accepted. The mention of ... (*not included in other classes*) must be deleted.

4.2.5 Trade marks in a list of goods/services

Trade marks cannot appear within a list of goods and services as if they were a generic term or a category of goods. In such cases, the Office will object to the inclusion of the term, and request its replacement by a generic term for the goods or services.

Example

Class 9: *Electronic devices for transmission of sound and images; video players; CD players; iPods.*

Since iPod™ is a trade mark, the applicant will be requested to replace it by a synonym such as *a small portable digital audio player for storing data in a variety of formats including MP3.*

Other examples are Caterpillar™ (the correct classification would be *crawler type vehicle*), Discman™ (*portable compact disc player*), Band-Aid™ (*sticking plasters*), Blu Ray discs™ (*optical storage discs*) or Teflon™ (*non-stick coating based on polytetrafluoroethylene*). This list is not exhaustive and in cases of doubt examiners should refer cases to a relevant expert within the Office.

4.2.6 Inclusion of the terms *parts and fittings*; *components* and *accessories* in lists of goods and services

The terms *parts and fittings*; *components* and *accessories* are, on their own or in combination with each other, neither clear nor precise enough for classification purposes. Each of the terms requires further qualification to become acceptable in its proper class. Such terms would become acceptable by identifying factors such as characteristics, purpose and/or identifiable market sector. For example:

- *Parts and fittings for motor vehicles* is acceptable in Class 12;
- *Building components made of wood* is acceptable in Class 19;
- *Musical accessories* is acceptable in Class 15.

4.2.7 Use of indefinite qualifiers

The use of qualifiers such as: ‘the like’; ‘ancillary’, ‘associated goods’; ‘and related goods’ and ‘etc.’ in a list of goods or services is unacceptable, since they do not comply with the requirements of clarity and precision (see paragraph 4.1).

5 Procedure of Examination

5.1 Parallel applications

While the Office will always strive for consistency, the fact that a list of goods and services has been previously accepted, but which is wrongly classified, does not have to lead to the acceptance of the same list in any subsequent applications.

5.2 Objections

Where the Office considers that there is a need to amend the list of goods and services it should, if possible, discuss the issue with the applicant. Whenever reasonably possible the examiner should offer a proposal for a correct classification. If the applicant submits a long list of goods/services which is not grouped under class numbers or classified at all, then the examiner should simply object under Article 28 EUTMR, and ask the applicant to provide the list in a form that complies.

The response from the applicant must, under no circumstances, extend the scope or range of goods or services (Article 43(2) EUTMR).

Where the applicant has failed to identify any classes, or has incorrectly identified the class(es) for the goods or services, then any further explanation of the scope of the application may extend the number of classes required to accommodate the list of goods and services. It does not automatically follow that the list itself has been extended.

Example

An application covering *beer, wine and tea* in Class 33 should be corrected to:

Class 30: *Tea*;

Class 32: *Beer*;

Class 33: *Wine*.

Although there are now three classes covering the goods, the list of goods has not been extended.

When the applicant has correctly attributed a class number to a particular term, this limits the goods to those falling under that class. For example, an application for *tea* in Class 30 may not be amended to *medicinal tea* in Class 5 as that would extend the goods beyond those applied for.

Where there is a need to amend the classification, the Office will send a reasoned communication pointing out the error(s) detected in relation to the list of goods and services. The applicant will be requested to amend and/or to specify the list and the Office may propose the way in which the items should be classified.

The original time limit allowed to submit observations on the classification deficiency letter can only be extended once. No further extensions will be granted unless exceptional circumstances apply.

The Office will send a letter informing the applicant of the definitive agreed list of accepted terms.

5.3 Amendments

See also the Guidelines, Part E, Register Operations, Section 1, Changes in a Registration.

Article 43(1) and (2) EUTMR allows for the amendment of an application. This includes the amendment of the list of goods and services provided that 'such a correction does not substantially change the trade mark or extend the list of goods and services'.

The amendment can be listed in either positive or negative terms, the following examples are both acceptable:

- *Alcoholic beverages all being whisky and gin;*
- *Alcoholic beverages none being whisky or gin.*

Since an amendment cannot extend the list of goods and services, it must be in the nature of a restriction or deletion of some of the terms originally contained in the application. Once such amendments (deletions) have been received (and later accepted) by the Office, the deleted terms cannot be re-introduced, nor can the remaining list of goods and services be extended.

A restriction should respect certain criteria:

1. The applicant cannot exclude goods and services that are not covered in the application and/or not covered by the relevant class.

For example the following would **not** be acceptable:

Class 32: *Syrups (original application) to syrups with the exception of fruit juices.*

Class 3: *Cosmetics with the exception of disinfecting substances (Class 5).*

2. The restriction must be **comprehensible** and give a sufficiently clear and precise (see also paragraph 4.2 above) indication of the goods or services to be excluded in the list or a sufficiently clear and precise indication of those goods and services which remain after the restriction.

For example the following would **not** be acceptable:

Class 16: *Typewriters, only related to financial services.*

3. The restriction must not contain references to trade marks.

For example the following would **not** be acceptable:

Class 9: *Apparatus for the reproduction of sound, namely iPods.*

4. The restriction must not contain a territorial limitation which contradicts the unitary nature of the EUTM.

For example the following would **not** be acceptable:

Class 7: *Washing machines, only for sale in France.*

A restriction may result in a longer list of goods and services than that filed. For example, the original list of goods and services may have been filed as *alcoholic beverages*, but it could be restricted to *alcoholic beverages being wines and spirits, but not including whisky or gin and not including liqueurs, cocktails or combinations of beverages containing elements of whisky or gin.*

5.4 Addition of classes

Under the provisions of Article 43(2) CMTR (listed above), it is possible to add a class or classes to an application, but only where the goods or services detailed in the original application were clearly included in the wrong class or when a good or service has been clarified and needs to be classified in new class(es).

For example, assume the original list of goods reads:

Class 33: *Alcoholic beverages including beer, wines and spirits.*

Since *beer* is proper to Class 32, the applicant will be requested to transfer the term to Class 32, even if Class 32 was not listed in the original application. If the applicant agrees then the application will cover goods in Classes 32 and 33.

When classes are added, additional fees may be payable and the applicant must be informed accordingly.

6 Annex 1

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Introduction

When classifying the general principles of the Nice Classification must be applied.

The purpose of this Annex is to clarify the classification of certain problematic terms. It also provides notes on classification practice (including words or phrases that should not be used).

The Office's classification database TMclass is available at <http://tmclass.tmdn.org>

Advertising services

In principle, advertising services belong to Class 35. The main entries on advertising services in the list of services in the Nice Classification are:

- *Advertising*
- *Radio advertising*
- *Radio commercials*
- *Television advertising*
- *Television commercials*
- *Layout services for advertising purposes*
- *Publication of publicity texts*
- *Production of advertising films.*

These entries cover the design of advertising material and production of commercials, as they are services which will be provided by advertising agencies.

Air freshening and perfuming preparations

See *perfuming and air freshening preparations*.

Amusement apparatus and electronic games

Following changes to the Nice Classification on 1 January 2012 (10th edition), all *games* (whether electronic or not) are classified in Class 28.

These are shown in the alphabetical list as follows:

- *Games (Apparatus for-)*
- *Video game machines*
- *Arcade video game machines.*

Most of these Class 28 devices come loaded with the games. However, if these games are not loaded on the devices, they will be recorded on data carriers or they will be downloadable. In these cases, the games are considered to be game programmes which are especially adapted for use with gaming devices and thus will be classified in Class 9.

See also *computer games*.

Association services or services provided by an association to its members

These, and similar terms are too vague to be acceptable. The type, or scope, of the service being provided needs to be mentioned. Examples of **acceptable** specifications are:

Class 35: *Association services in the nature of business administration services*

Class 45: *Services provided by an association to its members in the form of legal services*

See also *charitable services*.

Beauty apparatus

Class 7: *Sprayers (machines) for applying artificial sun tanning preparations*

Class 8: *Hand-operated instruments/tools for beauty purposes
Tattooing needles/apparatus
Depilatory apparatus (electric and non-electric)*

Class 10: *Massage apparatus
Microdermabrasion apparatus
Apparatus for the treatment of cellulite
Lasers for cosmetic beauty treatments
Laser hair removal apparatus
Photoepilation apparatus.*

Photoepilation is a procedure carried out by pulsed light devices. These devices use the same principle as lasers (i.e. heating up the hair follicle), yet they are not lasers.

Class 11: *Ultra-violet ray lamps for cosmetic purposes
Sun beds
Steam apparatus for cleaning the skin*

Class 21: *Cosmetic brushes and applicators.*

Bringing together of services

See *ordering of services* and *retail and wholesale services*.

Broadcasting and/or transmission services

These services are proper to Class 38; both mean the same thing. The services provided in this area only cover the provision of the means of communication (e.g. the provision of a network of fibre optic cables; the provision of broadcasts or

transmissions via geo-stationary satellite transmission facilities, the rental of communications apparatus and systems). Class 38 does **not** cover any programmes, advertising, information or advice which may be transmitted by means of telecommunications or broadcasting technology. Those services would remain in the appropriate classes.

Brokerage services

These are services provided by an individual or company whereby they buy and sell commodities for a fee or commission. The fee may be charged to the buyer or the seller of the commodity (or both). The broker may never see the goods or services in question.

There are three listed classes for brokerage services. These are:

Class 35: *Brokerage of name and address based lists*

Class 36: *[A large number of listings for] brokerage of futures, carbon offsets, real estate, bonds, securities and other financial based items*

Class 39: *Brokerage services relating to distribution, transport, and storage.*

Cases (and carrying bags)

Cases (and bags) adapted to carry or transport the product they are intended to contain are in principle, classified in the same class as the product they are adapted to carry. For instance *laptops bags* are proper to Class 9.

All non-adapted carrying bags are in Class 18.

Charitable services

This term is too vague to be accepted in any class without further qualification.

Charitable services are defined by the service which is being offered. Therefore, they can be classified in any of the service classes, given the correct definition. For example:

Class 35: *Charitable services, namely administration and general office work*

Class 36: *The organisation of charitable collections; charitable fund raising*

Class 38: *Telecommunications services for charitable purposes*

Class 39: *Charitable services, namely ambulance transport*

Class 40: *Charitable services, namely water treatment services*

Class 41: *Charitable services, namely education and training*

Class 42: *Charitable services, namely environmental protection services*

Class 43: *Charitable services, namely providing food and drink and temporary accommodation*

Class 44: *Charitable services, namely providing medical services*

Class 45: *Charitable services, namely mentoring [personal or spiritual].*

Collection and storage services

In the case of physical goods, both collection and storage services would be proper to Class 39. This class includes *transport* and *warehousing* in its listings. This would also include the collection and physical storage of data, whether in written form or recorded on media (the Nice Classification has *physical storage of electronically stored data or documents* in Class 39).

Office services of electronically collecting, collating and manipulating data are all proper to Class 35.

Storage of digital data and *electronic data storage* are seen to be in analogy with hosting services, and so are proper to Class 42. *Cloud computing data storage services* are also proper to Class 42.

Computer games and computer games apparatus

The terms *computer games* and *video games* are highly similar and are treated as the same way.

The dictionary reference for computer games is as follows:

- 1 **(Noun)** 'any of various games, recorded on cassette or disc for use in a home computer, that are played by manipulating a mouse, joystick, or the keys on the keyboard of a computer in response to the graphics on the screen' (*Collins English Dictionary*).

The terms *computer games* / *video games*, as such, are therefore only acceptable in Class 9. The dictionary reference of the term clearly states that it must be a game, thus software. The terms can therefore be accepted in Class 9 without any further clarification.

Games which are acceptable in Class 28 come loaded with the games software. For example, the following terms can all be accepted in Class 28:

- *Arcade games*
- *Arcade video machines*
- *Computer game consoles*
- *Games (apparatus for)*
- *Hand held computer game devices*
- *Video game machines.*

Curtains and blinds

Blinds, in all their forms, can be used on windows both internally and externally. The classification of these goods depends upon the purpose of the product and its material composition.

Curtains are normally found in use indoors and they are similarly classified according to their material composition.

Examples of acceptable entries are:

Class 6: *Outdoor blinds of metal*
External metal blinds as part of a building for security purposes.

Class 17: *Curtains of asbestos (safety-)* (The material and purpose determine the classification).

Class 19: *Blinds [outdoor] not of metal and not of textile.* (These goods are probably made of wood).

Class 20: *Blinds (slatted indoor)*
Venetian and vertical window blinds
Indoor window blinds
Blinds (indoor window) [shades] [furniture]
Curtains (bamboo-)
Paper blinds
Curtains (bead-)[for decoration].

Class 24: *Outdoor blinds of textile.*

The vast majority of curtains will fall under Class 24 since most domestic curtains (sometimes referred to as 'drapes') are made of textiles or plastic.

Care should be taken with any references to curtain walling, or curtain walls. These refer to a type of construction technique relating to buildings and the associated goods are building materials and are proper to Class 6 (for metal goods) or Class 19 (for non-metallic goods).

Custom manufacture/manufacturing for third parties

See *manufacturing services*.

Data services

The term cannot be accepted on its own. It must be qualified.

The provision of data can be proper to several classes depending on the way in which the data is provided or the nature of the data being provided. In each case the exact nature of the service being offered will need to be stated, *the provision of data* is not

enough. The following are examples of acceptable terms and their relevant classification:

Class 44: *Provision of data (information) relating to the use of pharmaceuticals.*
(This would refer to the systemised provision of data which could only be interpreted by someone with specialised medical training.)

Class 45: *Provision and interpretation of data relating to animal tracking.*
(This would refer to services in relation to the relocation of a lost or stolen animal. If the data were for other purposes, then the classification would be proper to other classes, for example, Class 42 for measuring or scientific reasons.)

Design services

Design services are, as such, proper to Class 42.

Design of advertising and *design of brand names* are both proper to Class 35 as these are both part of advertising services.

Likewise *landscape design*, *floral design*, *turf design* and *planning [design] of gardens* are proper to Class 44 as these are horticultural services.

Digital imaging services

The term *digital imaging services* has been deleted from Class 41 in the 10th edition of the Nice Classification. Consequently, the term cannot be accepted in Class 41 without any specification. This is because digital imaging can be classified in more than one class depending on the field the service refers to, for example, medical, information technology or photography.

Acceptable terms include:

- *Digital imaging (photo editing)* in Class 41
- *Medical imaging services* in Class 44
- *Digital imaging (IT services)* in Class 42.

Downloadable goods

All material which is downloadable is proper to Class 9. This includes publications, music, ring tones, pictures, photographs, films or film extracts. The result of the download is that the material is captured onto the drives or memory of a computer, telephone or PDA where it operates independently of the source from whence it came. These can also be called *virtual goods*. All these downloadable goods can be retailed.

Electricity and energy

The following is a guide to some of the goods and services which surround electricity.

Class 4: *Electrical energy*

Class 7: *Electrical generators*

Class 9: *Apparatus and instruments for conducting, switching, transforming, accumulating, regulating, or controlling electricity*
Solar cells for electricity generation
Photovoltaic cells and modules

Class 36: *Brokerage of electricity* (see also note under *brokerage services*).

Class 39: *Distribution of electricity*
Storage of electricity

Class 40: *Generation of electricity*.

See *solar power*.

Electronic and electric apparatus

The term *electronic and electric apparatus/devices/instruments* is too vague for classification purposes; it is not acceptable in any goods class, and should be specified.

Please be aware that specifications of *electronic and electric apparatus/devices/instruments* such as listed below are considered too vague as well:

- for controlling the environment
- for household purposes
- for use in hairdresser salons.

Electronic cigarettes

Electronic cigarettes, e-cigarettes or e-cigs are — for classification purposes — acceptable only in Class 34, even if they would serve a medical purpose. Non-electronic parts of these types of cigarettes, like cartridges, atomisers or (aroma) substances for these cigarettes are also classified in Class 34.

The electronic parts like batteries and a microcomputer controlled circuits for electronic cigarettes are not acceptable in these classes and belong — as usual — to Class 9.

Franchising

The verb 'franchise' refers to the giving or selling of a franchise to another party. As a noun 'franchise' means 'the authorisation granted to an individual or group by a company to sell its products or services in a particular area' (*Oxford English Dictionary*).

Without any further specification, the office will not accept the term *franchise service* or *franchising services* in Class 35. In order to be acceptable a clarification is required.

For example:

Class 35: *Business advice relating to franchising*

Class 36: *Financing services relating to franchising*

Class 45: *Legal services relating to franchising.*

GPS systems – location, tracking and navigating

GPS and satellite navigation systems (Class 9) provide location, tracking and navigating services, to provide the user with information.

The easiest way to classify these services is to divide them into those services which provide the telecommunications which run the services (Class 38) and those services which provide information via the GPS device. The range of information provided goes beyond mere travel route information (Class 39). It can include information regarding restaurants and accommodation (Class 43), information regarding shopping outlets (Class 35) or telephone numbers (Class 38).

The use of GPS devices in relation to the movement of vehicles and people can also lead to classifications over a range of classes. Route planning services (Class 39) have already been mentioned. This classification would also extend to logistic or freight moving companies keeping track of their vehicles using the same devices.

GPS systems can also be used in conjunction with other technology, to locate the source of a mobile telephone signal. If this is being done as part of a telecommunication service it will be proper to Class 38. If, however, it is being done as part of a criminal investigation service it would be proper to Class 45.

There are other services that can be associated with the services listed above. For example, the creation of maps for GPS systems is proper to Class 42. The downloadable applications which run the service or provide alternative 'voices' are proper to Class 9. The retail services for providing the downloadable applications are proper to Class 35.

The examples below demonstrate how these and other terms are classified.

Class 35: *Compilation and provision of commercial directory information regarding service providers for GPS navigation*

Class 38: *Satellite transmissions*
Providing public subscribers directory information for GPS navigation
Providing access to general information supplied via satellite transmission
Telecommunications services for location and tracking of persons and objects
Tracking of mobile telephone via satellite signals
Location of mobile telephones via satellite signals
Providing access to GPS navigation services via satellite transmission

Satellite transmission of navigation data

Class 39: *Providing GPS navigation services*
Providing traffic information services via satellite transmission
Providing road information services via satellite transmission
Location services for logistics purposes of vehicles and goods
Tracking services for logistics purposes of vehicles and goods.

Class 42: *Providing weather information via satellite transmission*
Creation of GPS maps

Class 45: *Providing public amenity and civic directory information for GPS navigation*
Tracing and locating of missing persons via satellite transmission
Tracking of persons carrying electronic tagging devices
Security tracking services of vehicles
Security location services of vehicles.

Hair styling

Most *electric and non-electric hair styling apparatus* is classified in Class 8 (e.g. *electric hair curling irons; hair tongs [non-electric hand implements]; crimping irons for the hair etc.*). Except:

Class 26: *Electric hair curlers/rollers (e.g. CARMEN™ CURLERS)*

Class 26: *Hair curlers/rollers, other than hand implements*

Class 11: *Hair dryers*

Class 21: *Combs and brushes (non-electric and electric).*

Hire services

See *rental services*.

Humanitarian aid services

Office practice on *humanitarian aid services* is the same as that on *charitable services*; the nature of the services must be specified (see *charitable services*).

Internet services, on-line services

The term *internet services* is neither clear nor precise for acceptance in any class. It must be further defined.

There are a range of services, offered by individuals and business to other individuals and businesses, which relate to the setting up, operation and servicing of internet web-sites and these are covered by appropriate entries in a number of classes.

There is an even wider range of services offered to customers through the medium of telecommunications including via the internet. It is possible to shop over the internet, obtain banking advice, learn a new language, or listen to a 'local' radio station which is situated on the other side of the world.

The application of the Nice Classification system generally applies regardless of whether the service is provided face-to-face, in dedicated premises, over a telephone, on-line from a database or from an internet web site.

Acceptable terms include:

Class 35: *Advertising services provided over the internet*

Class 36: *On-line banking services*

Class 38: *Internet provider services*

Class 41: *On-line gaming services*

Class 42: *Providing on-line support services for computer program users*

Class 45: *On-line social networking services.*

Kits and sets

It is common in trade for certain goods to be sold in groups of more than one item. If the items are all the same, for example, a pack of three toothbrushes, then the classification is simple. However, sometimes the collection of goods could be component parts of another item, or have a function which is not defined by the individual goods. These groups of goods sometimes have collective names such as kit or set. These small words can have a big impact on (1) the acceptability as collection of goods and (2) the appropriate classification.

A kit can mean either:

1. a set of parts ready to be made into something (for example: *a kit for a model plane*) or
2. a set of tools or equipment that is to be used for a particular purpose (for example: *a first-aid kit*).

A set is a number of articles that are thought of as a group. This may have a defined number or not (e.g. *a set of keys, a set of saucepans, a set of golf clubs; a cutlery set*).

Kits appear in the Nice Classification, for example, as in the following example:

Class 3: *Cosmetic kits.*

Class 5: *First aid kits* (seen as a collection of plasters and treatments)

It sometimes happens that the individual goods which make up the kit or set would normally be classified in more than one class. However, the Office will not object to

acceptance of such collective terms, provided that they make sense and/or are in common usage.

When determining the correct classification for a kit or set, it is necessary to understand either; what the kit is going to be used for, or alternatively, if it going to make or construct something from its components, what the finished article will be.

Examples of acceptable terms would be:

Class 8: *Manicure and pedicure sets*

Class 9: *Hands free kits for phones*

Class 12: *Tyre repair kits* (for repairing a vehicle part that is in Class 12)

Class 27: *Rug making kit*

Class 28: *Scale model kits [toys]*
Toy model kits

Class 32: *Beer making kits*

Class 33: *Wine making kits.*

Leasing

The general remarks in the Nice Classification (10th edition) say, '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.'

See also *rental services*.

Mail order

See *retail and wholesale services*.

Manuals (for computers, etc.)

Electronic items such as computers, printers, photocopiers and other electronic items are often delivered as new goods to the customer with a list of operating instructions. The instructions can be in paper (printed) format, or in an electronic format, such as a recording on a disc, or as a downloadable or non-downloadable document available at the manufacturer's web-site.

Examples of this would be:

Class 9: *Computer software and hardware and associated manuals **in electronic format** sold as unit therewith*

Class 16: *Manuals sold as a unit with computer software and hardware.*

Manufacturing services

Manufacturing is only seen as a service when it is undertaken for third parties and must be specified as such. Custom manufacturing of certain single, 'one-off' products for third parties, for example a sailing boat or a sports car, by a specialist in that field would be proper to Class 40. Custom construction of, for example, made-to-measure kitchen units would be included in Class 40, but their installation would be proper to Class 37.

News services

News agency services are proper to Class 38. They are essentially a hub or collection point through which journalists and others can file and obtain newsworthy materials (in the form of stories, script or photographs). They do not perform any other function such as editing or verification services.

News reporting services are proper to Class 41. News has no boundaries, the subject could be anything.

Other examples include:

Class 38: *News broadcasting services*

Class 40: *Printing of newspapers*

Class 41: *Presentation of news (programmes)*
Publication of news
Editing of news.

As far as electronic news publications are concerned, *downloadable news pod casts, news clips, news items, news publications*, etc. are all goods which are proper to Class 9.

On-line services

See *internet services*.

Ordering of services

The ordering of goods/services for others can be accepted in Class 35 as a business service/office function. There are individuals and companies who offer services of providing solutions to a variety of problems on behalf of others; for example, if you need a leaking tap to be fixed, the intermediary (service provider) will arrange the services of a plumber for you. This classification is in analogy with the Nice Classification entry *procurement of services for others [purchasing goods and services for other business]*.

Perfuming and air freshening preparations

There are preparations which serve to merely mask unpleasant smells (perfume) and there are also preparations which chemically 'wrap-up' and remove unpleasant odours (deodorisers) and their apparatus. They are properly classified as follows:

Class 3: *Air fragrancng preparations*
Incense
Potpourris [fragrances]
Sachets for perfuming linen
Scented wood
Fumigation preparations [perfumes]
Room sprays.

Class 5: *Air deodorising preparations*
Air purifying preparations

Class 11: *Air deodorising apparatus*

Other goods which may release pleasant odours include *perfumed candles* which are proper to Class 4 (the release of perfume is a secondary characteristic) and *perfumed drawer liners* (proper to Class 16 as being analogous to *packaging material* and usually made of paper).

Personal and social services rendered by others to meet the needs of individuals

The general indication *personal and social services rendered by others to meet the needs of individuals* is not clear and precise enough and will not be accepted by the Office (see also paragraph 4.2).

The wording needs to be specified by the applicant.

There are many personal and social services that are classifiable, but are proper to classes other than Class 45. These include:

Class 36: *Personal insurance services* (such as life assurance)

Class 41: *Personal tuition*

Class 44: *Personal medical services*

Class 45: *Personal body guarding*
Consultancy services relating to personal appearance
Personal tour guide services
Personal shopping services.

Precious metal goods

The general indication *goods of precious metals or coated therewith, not included in other classes* in Class 14 is not clear and precise enough and will not be accepted by the Office (see also paragraph 4.2). The applicant needs to specify the wording of the term.

Caution needs to be applied when classifying goods made from precious metals.

Historically, virtually all goods which were made from, or coated with, precious metals were grouped together in Class 14. It was considered that the material had an influence on why the goods were bought, and that in turn determined where the goods were classified.

Since 1 January 2007, the classification of many goods that would have been in Class 14 has been re-classified. The reclassification of the goods is based upon their function, rather than the material from which they are made.

The following goods are examples of goods which are classified according to their function or purpose:

Class 8: *Cutlery of precious metal.*

Class 16: *Pen nibs of gold.*

Class 21: *Teapots of precious metal.*

Class 34: *Cigarette and cigar boxes made of precious metals.*

Protective clothing

If items that are worn (or sometimes carried) have their **primary** function as the prevention of serious and/or permanent injury, or death or if that protection is offered against, for example contact with or exposure to extremes of temperature, chemicals, radiation, fire, or environmental or atmospheric hazards, then those goods would be proper to Class 9.

Examples of such protective goods would include hard-hats worn on building sites, and helmets worn by security guards, horse riders, motorcyclists, and American football players. Bullet-proof vests, metal toe-capped shoes, fireproof jackets and metal butchers' gloves are examples of these: they are not clothing as such. Aprons, smocks and overalls which merely protect against stains and dirt are not proper to Class 9 but to Class 25 as general clothing. Protective sporting articles (except helmets) are proper to Class 28: none of these protect against loss of life or limb.

Rental services

Rental or hire services are classified, in principle, in the same class as the services provided. For example, the rental of cars falls in Class 39 (*transport*), rental of telephones in Class 38 (*telecommunications*), rental of vending machines in Class 35

(*retail services*). The same principle applies to *leasing services* which are found on TMclass in all of the service classes.

Retail and wholesale services

A retail service is defined as 'The action or business of selling goods in relatively small quantities for use or consumption' (*Oxford English Dictionary*); this defines the scope of the services covered by this term.

There is an indication in the explanatory note to the listing of Class 35 in the Nice Classification that the term *the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase these goods* is acceptable in Class 35. *Retail services* are classified in analogy to this entry.

However, as regards *retail services* or similar services in Class 35 relating to the sale of goods, such as *wholesale services*, *mail order services* and *e-commerce services*, the Office applies judgment of 07/07/2005, C-418/02, 'Praktiker': the term *retail services* is only acceptable where the type of goods or services to be sold or brought together for the benefit of others, is indicated with sufficient clarity and precision (see paragraph 4.1). The term *retail services of a supermarket* and, by extension, *retail services of a department store* and similar terms are not acceptable as the goods to be sold are not defined.

The 10th edition of the Nice Classification (version 2013) includes *retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies*, which shows how terms can be expressed.

Examples of categories of goods which do not fulfil the requirements of clarity and precision:

- *Merchandising articles*
- *Fair-trade goods*
- *Lifestyle accessories*
- *Gift articles*
- *Souvenirs*
- *Collectors' articles*
- *Housewares.*

Retail services for non-acceptable general indications of the class headings (see paragraph 3.4.2) are not acceptable. For example, the Office will not accept *retail services for machines*. However, *retail services in relation to agricultural machines* would be sufficiently precise and acceptable.

As regards 'retail of services', (i.e. *services which consist of bringing together, for the benefit of others, of a variety of services, enabling consumers to conveniently compare and purchase those services*), the Court has held that these must also be formulated with sufficient clarity and precision so as to allow the competent authorities and other economic operators to know which services the applicant intends to bring together (see judgment of 10/07/2014, C-420/13 'Netto Marken-Discount').

This decision confirms that the '*bringing together of services*' is an activity that is entitled to protection. The Court placed greater emphasis on the importance of defining the services being brought together, than on defining the action of 'bringing together' itself (thereby echoing its earlier judgment of 07/07/2005, C-418/02, 'Praktiker').

Terms expressing this should satisfy two requirements, firstly, using the familiar terms '*bringing together, for the benefit of others... enabling customers to compare and purchase...*' in order to 'frame' the services being brought together and describe the actual retail activity itself, and secondly, in describing the services which are being brought together, employing terms which are understood and acceptable in their own right (e.g. legal services, broadcasting services, slimming club services etc.). In order to meet the fundamental requirements for clarity and precision under Article 28(2) EUTMR, any claim to the retailing or 'bringing together' of services must be worded in this manner.

The following are example specifications which will now be deemed acceptable:

The bringing together, for the benefit of others, of a variety of legal services, enabling customers to conveniently compare and purchase those services.

The bringing together, for the benefit of others, of slimming club services, video-on-demand services, and detective agency services, enabling customers to conveniently compare and purchase those services.

The bringing together, for the benefit of others, of a variety of broadcasting services, enabling customers to conveniently compare and purchase those services.

In the case of the bringing together of services, wordings including '*retail services connected with...*', '*retail services connected with the sale of...*' and '*electronic shopping retail services connected with...*' do not provide a clear distinction between the retailing of services and the provision of those services in their own right.

The following examples will therefore not be accepted and will be subject to an objection:

Retail services connected with takeaway services.

Retail services connected with the sale of legal services.

Mail order retail services connected with the sale of detective agency services.

The CJEU's ruling is not to be interpreted as providing a means for obtaining duplicative protection of services intended to be provided in their own right (whether proper to Class 35 or elsewhere). Nor should it be perceived as an alternative means for providing protection for the advertising of one's own services. Thus, if an application covers '*the bringing together for the benefit of others of telecommunication services enabling customers to conveniently compare and purchase those services*', these services do not cover the actual provision of telecommunication services (which belongs to Class 38), but only the bringing together of a variety of telecommunication service providers enabling consumers to conveniently compare and purchase those services.

Finally, the specification of the goods or services by terms such as 'including, in particular, for example, featuring, specifically, such as, is not precise enough since all these terms mean, in principle, 'for example'. They do not restrict the goods or services which follow. Consequently, the abovementioned terms should be replaced by 'namely or being' as it will restrict the goods or services which follow those terms.

Satellite tracking

See *GPS systems – location, tracking and navigating*.

Sets

See *kits and sets*.

Social networking services

Social networking services is an acceptable term in Class 45. It would be seen as a personal service which includes the identification and introduction of like-minded people for social purposes.

There are other aspects of the *social networking* industry which could be proper to classes other than Class 45, for example:

Class 38: *The operation of chat room services*
The provision of on-line forums.

Software publishing

Software publishing belongs to Class 41. A software publisher is a publishing company in the software industry between the developer and the distributor. Publishing, according to its definition, includes *newspaper publishing* and *software publishing*.

Solar power

Solar power is energy that is derived from the sun and converted into heat or electricity.

Goods relating to the generation and storage of electricity from solar energy are classified in Class 9.

Goods relating to the generation and storage of heat from solar energy are classified in Class 11.

Services relating to the generation of electricity from solar energy are classified in Class 40.

Class 9: *Photovoltaic cells*

Solar panels, modules and cells.

Class 11: *Solar collectors for heating.*

Class 40: *Production of energy.*

See *electricity and energy.*

Storage services

See *collection and storage services.*

Supply of ...

Care should be taken in the acceptance of this term when it is used to qualify services. It is acceptable in some circumstances, for example, *supply of electricity* in Class 39, where the term is often closely allied to *distribution*. It is also acceptable in the term *catering services for the supply of meals* (in Class 43) because the material being supplied, and the nature of the service, have both been given.

In the term *supply of computer software* (in Class 42) it is not clear what services are being provided. Whilst this class does include the services of *design, rental, updating and maintaining computer software*, it is not clear if any of those services are included in the general term *supply*. The word is often used as an apparent synonym for retail services but Class 42 does not include such services, they would be proper to Class 35.

Systems

This is another term which can be too unclear or too imprecise to be accepted.

It can be accepted only when qualified in a way that has a clear and unambiguous meaning. For example, the following are acceptable:

Class 7: *Exhaust systems.*

Class 9: *Telecommunication systems*
Computer systems
Alarm systems.

Class 16: *Filing systems.*

Tickets (for travel, entertainment etc.)

A ticket is a 'promise to supply' in relation to a service, or a reservation service, the right to a service. Examples include:

Class 39: *Issuing of airplane tickets.*

Class 41: *Ticket agency services (box office).*

Note that tickets are not seen as goods retailed in Class 35.

Video games

See *computer games*.

Virtual environment

The term *providing a virtual environment* is neither clear nor precise enough as it can relate to different areas of activities and classes. The term must be further defined.

Acceptable terms include:

Class 38: *Providing a virtual chatroom*
Providing access to a virtual environment.

Class 42: *Hosting of a virtual environment*
Maintenance of a virtual environment.