

**GUIDELINES FOR EXAMINATION OF
EUROPEAN UNION TRADE MARKS**

**EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE
(EUIPO)**

Part B

Examination

Section 3

Classification

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1 Introduction

Recital 28, Regulation (EU) 2017/1001

Articles 4, 31, 33, 49 and 57 EUTMR

European Union trade mark protection is granted in relation to specific goods or services which determine the extent of protection afforded to the trade mark proprietor. It is, therefore, essential to lay down rules for the indication and the classification of goods and services and to ensure legal certainty.

The indication of goods and services corresponds to one of the essential characteristics of a trade mark (Article 4 EUTMR). For a filing date to be accorded, every EUTM application must contain a list of goods and services (Article 31(1)(c) 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 33(2) and (6) EUTMR).

The list of goods and services may be restricted or amended by the applicant in the application, provided that the restriction or amendment does not extend the list of goods and services (Article 49 EUTMR). After registration the trade mark may be surrendered in respect of some of the goods and services (Article 57 EUTMR).

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

The purpose of this Section of the Guidelines is to describe Office practice in examining the 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 for examining the list of goods and services.

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

- checking that each of the goods and services is sufficiently clear and precise;
- checking that each term belongs to the class in which it is listed;
- notifying any deficiency;
- refusing the application, in whole or in part, where the deficiency is not remedied (Article 41(4) and (8) EUTMR).

For information on the language from which the examination of classification and the translations are made, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 6.3, Reference language for translations.

2 The Nice Classification

Goods and services in respect of which trade mark registration is applied for are classified in accordance with the system of classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957 (the Nice Classification). The Nice Classification is administered by the World Intellectual Property Organization (WIPO) (Article 33(1) EUTMR).

Goods and services are organised in classes to facilitate pre-clearance searches before filing an application to avoid conflict, to allow surveillance searches and in order to monitor possible competition. In addition, the classes are taken into account to calculate class fees.

As a system aimed at reflecting market needs, the Nice Classification is updated on a regular basis. Minor improvements are published every year in versions of the current edition, while significant changes are incorporated in a new edition every 5 years.

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. Article 33 EUTMR requires every list of goods and services to:

- 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;
- be arranged according to the Nice Classification, with 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 contains guidance for classification.

1. **Class Headings** — these exist for each class and indicate in a general manner the fields to which, in principle, the goods or services belong.
2. **Explanatory Notes** — these exist for each class and clarify, in a more abstract manner, the criteria of which type or examples of goods or services are included, or not included, in the class.
3. **Alphabetical List** — this may be consulted in order to ascertain the exact classification of individual goods or services by analogy.
4. **General Remarks** — placed at the beginning of the Nice Classification, these are a short collection of basic principles explaining 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 WIPO's website at: <http://www.wipo.int>.

3 Other Administrative Tools for Classification Purposes

Communication No 1/13 of the President of the Office of 26/11/2013 concerning a new administrative tool for classification purposes (taxonomy) and the use of class headings of the Nice Classification.

When filing an electronic application, users can select preapproved terms to build their list of goods and services. These terms originate from the Harmonised Database (HDB) and will automatically be accepted for classification purposes. Using these preapproved terms will facilitate a smoother trade mark registration process. The HDB brings together terms that are accepted for classification purposes in all EU offices.

Should the applicant use a list of goods and services that has terms not found in the HDB, the Office will have to examine whether they can be accepted.

Before filing an application, users can search the content of the HDB using the Office's TMclass tool (<http://tmclass.tmdn.org>). This tool brings together classification databases of participating offices both within and outside the EU and shows whether a term is accepted by the office concerned. TMclass groups goods and services according to shared characteristics from a market perspective, starting from the more general and ending with the more specific. This offers users a simplified search and 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, since the scope of protection of an EUTM is always defined by the natural and usual meaning of the terms chosen, not by their position in the hierarchical structure of the Office's taxonomy (10/12/2015, T-690/14, Vieta, EU:T:2015:950, § 66).

Users can also use the Goods and Services Builder at: <https://euipo.europa.eu/ohimportal/en/gsbuilder>, which will guide them through the process of creating their list of goods and services on the basis of terminology from the HDB.

4 Building a List of Goods and Services

4.1 Choosing adequate scope of protection

The essential function of the protection afforded by a trade mark is to guarantee to the consumer an indication of origin of the goods or services, by enabling him or her, without any possibility of confusion, to distinguish the goods or services from others that have another origin.

Furthermore, the indication of goods and services may be restricted (Article 49 EUTMR) or surrendered (Article 57 EUTMR) at any time, but the initial scope of protection may never be broadened.

With that in mind, it is of crucial importance to carefully designate a list of goods and services that:

- not only covers the current interests in protection but takes into account also future possibilities, by indicating categories of goods or services the trade mark proprietor might be likely to expand to,
- but also reduces potential conflict with other marks and minimises the risk of becoming vulnerable to attack, by avoiding an overly broad or unnecessarily long list of goods and services.

As far as services for which trade mark protection can be sought are concerned, these are, in principle, generally offered independently to third parties and supplied for an economic consideration. Services connected with goods, such as the research and development of an undertaking's own products, do not constitute an external service for third parties. If a service is not provided to third parties, but is only an internal working of the undertaking, it would be redundant for it to be covered in the list of goods and services of the application (30/09/2016, T-355/15, ASTEX / ALPEX, EU:T:2016:591, § 37). The same applies to ancillary services, such as the manufacture, sale or advertising of an undertaking's own products.

4.2 Clarity and precision

4.2.1 General principles

The goods and services for which protection of the trade mark is sought must 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 protection sought (Article 33(2) EUTMR).

An indication of goods and services is sufficiently clear and precise when its scope of protection can be understood from its natural and usual meaning.

'Natural and usual meaning' refers to the general definition of a term, in other words how the term is commonly understood. It will frequently be defined by a grammatical interpretation in the language in which the application is filed, by definitions given in the Nice Classification, by use in dictionaries and encyclopaedias, and by the commercial language of traders.

The examination of the indication of goods and services as being clear and precise is independent of the examination as to absolute or relative grounds.

4.2.2 Influence of classification on the scope of protection

A correct classification should in principle be enough to allow for an unambiguous scope of protection. A particular term may be part of the description of goods and services in different classes, but equally it may be clear and precise in a particular

class without further specification. In this case its natural and usual meaning and the class number will leave no doubt as to the scope of protection.

For example, the natural and usual meaning of the term *clothing* is garments for humans with the purpose of covering the body for normal use. Therefore, this term would leave no doubt as to the scope of protection if applied for in Class 25 (see the Explanatory Note for Class 25).

If the scope of protection cannot be understood, sufficient clarity and precision may be achieved by further identifying factors such as characteristics, purpose and/or identifiable market sector. ⁽³⁾ Elements that could help to identify the market sector 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.

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: *clothing for protection against fire* (Class 9);

clothing for operating rooms (Class 10);

clothing for pets (Class 18);

clothing for dolls (Class 28).

From these examples it is obvious that the term *clothing* can be interpreted in various ways but must always be defined by purpose or market sector pertaining to a particular Nice class. In addition, it shows that *clothing* in Class 25 would **not** cover any of the categories of goods mentioned above.

In principle, the Office understands the class number as being indicative of the characteristics of the goods or services, such as the predominant material, the main purpose or the relevant market sector, considering the natural and usual meaning of each term at the same time. Each term is assessed in the context of the class in which it is applied for (25/01/2018, T-367/16, H HOLY HAFERL HAFERL SHOE COUTURE (fig.) / HOLY et al., EU:T:2018:28, § 50; 19/06/2018, T-89/17, NOVUS / NOVUS (fig.) et al., EU:T:2018:353, § 32-33).

Tools such as TMclass (<http://tmclass.tmdn.org/ec2/>), as well as the Goods and Services Builder functionality at: <https://euipo.europa.eu/ohimportal/en/gsbuilder>, both of which are based on the HDB, are available for determining whether the particular category of goods and services needs further specification or not.

³ 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.

4.2.3 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 as a restriction to the specific goods and services listed thereafter (04/10/2016, T-549/14, *Castello / Castellò* (fig.) et al., EU:T:2016:594, § 71). 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 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 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 by making it more specific, for example, by using 'namely' and a list of acceptable terms. Examples include *goods of common metal, namely, screws* for goods in Class 6 and *goods of precious metals, namely bracelets* for goods in Class 14.

The HDB does not currently support use of the terms 'namely' or 'in particular'. Therefore, if these terms are used in the list of goods and services, the classification will not be accepted automatically but will require verification, which may slow down the examination procedure.

Examples of acceptable use

Class 29: <i>Dairy products namely cheese and butter</i>	'Namely' restricts the goods to cheese and butter, excluding all other dairy products.
Class 41: <i>Provision of sports facilities, all being outdoors</i>	This restricts the services to the provision of outdoor sports facilities, excluding the provision of any indoor sports facilities.
Class 25: <i>Clothing, all being underwear</i>	The goods are restricted to those considered underwear, excluding all other types of clothing.

Specifications using 'namely' or 'being' in a manner that does not comply with the requirements of clarity and precision (e.g. *dairy products, namely peanut butter*) jeopardise the scope of protection and will therefore be objected to, and might eventually lead to a refusal of the same.

Examples of non-restrictive use

Other words or phrases may only point out that certain goods/services are important, and the inclusion of the term does not restrict the list in any way.

Class 29: <i>Dairy products, in particular cheese and butter</i>	This includes all dairy products; cheese and butter are probably the focus of the EUTM owner's operation, but not the only goods produced.
Class 41: <i>Provision of sports facilities, for example outdoor running tracks</i>	The coverage 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.

Specifications using 'in particular', 'such as', 'for example' or 'including' in a manner that does not comply with the requirements of clarity and precision (e.g. *dairy products, in particular peanut butter*) jeopardise the scope of protection, and will therefore be objected to, and might eventually lead to a refusal of the same.

For the correct use of restrictive wordings (e.g. 'excluding', 'except') please refer to the examples listed in paragraph 5.3.2.

4.2.4 Use of the term 'and/or'

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

Examples

- *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.*

4.2.5 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 may serve to separate enumerated items within a broader category or expression. For example, *flour and preparations made from cereals, bread, pastry and confectionery* in Class 30 means that the goods can be or are made from any of those materials, thus also including the rather nonsensical *preparations made from confectionery*. If the meaning of the part of the term after *preparations made from cereals* is nonsensical, the use of a comma after it is inappropriate, and a semicolon should be used instead.

The use of a semicolon means a separation between expressions. For example, *flour and preparations made from cereals; bread, pastry and confectionery* in Class 30. In this example, the terms *bread, pastry and confectionery* must be interpreted as being

independent from the other terms and not as being included in *preparations made from bread, pastry and confectionery*.

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 semicolon means that the term *agricultural machines* must be considered as an independent category of goods. However, *agricultural machines* are proper to Class 7. The term would have to be objected to by proposing the correct classification.

A further example would be *retail services in relation to clothing; footwear; headgear* in Class 35. The use of a semicolon means that the terms *footwear* and *headgear* refer to separate goods, not included in the retail services. In service classes, the goods listed in relation to the services for which protection is sought should always be separated by commas.

A colon can be used in a list of goods and services to explain or start an enumeration. In an enumeration following a colon, terms should be separated by a comma. An example in Class 9 is *Software for: computers, mobile phones, tablets*.

An expression between brackets is in most cases intended to define more precisely the text preceding the brackets where the latter is ambiguous.

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

Abbreviations and acronyms 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. To this end, examiners will carry out an internet search in order to determine whether the abbreviation needs to be expanded into words.

Example

Class 9: *EPROM cards*.

This could be expanded to:

Class 9: *Erasable programmable read-only memory cards*.

or

Class 9: *EPROM [erasable programmable read-only memory] cards*.

4.3 Terms lacking clarity and precision

4.3.1 General indications of Nice Classification class headings lacking clarity and precision

In accordance with Article 33(3) 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, as set out in Article 33(2) EUTMR.

For the sake of completeness, it is noted that, in accordance with Article 33(5) 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 term within the context of the class in which it is applied for. ⁽⁴⁾ 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.

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 Nice Classification class headings that are deemed not to be sufficiently clear and precise in accordance with Article 33(2) EUTMR.

The 197 general indications of the Nice class headings in the 2014 version of the 10th Edition of the Nice Classification were examined for the requisites of clarity and precision. Of these, 11 were considered not to have the clarity and precision required to specify the scope of protection that they would give. Consequently, they could not be accepted without further specification. The indications in question 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*

⁴ 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.

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***

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 general indications comply with the requisites of clarity and precision and are therefore acceptable for classification purposes.

The reasons why each of the 11 general indications of the Nice class headings 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, may require very different levels of technical capabilities and know-how to be produced and/or used, and 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, may require very different levels of technical capabilities and know-how to be produced and/or used, and 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, may require very different levels of technical capabilities and know-how to be produced, and 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, may require very different levels of technical capabilities and know-how to be produced and/or used, and 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, may require very different levels of technical capabilities and know-how to be produced and/or used, and 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, may require very different levels of technical capabilities and know-how to be produced and/or used, and 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, may require very different levels of technical capabilities and know-how to be produced and/or used, and 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, without stating 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.

Six general indications were deleted from the class headings of the 2016 version of the 10th edition of the Nice Classification. The indications in question are set out below in bold:

Class 7: ***Machines and machine tools***

Class 37: ***Installation and repair services***

Class 40: ***Treatment of materials***

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

EUTM applications that include any of the abovementioned general indications contained in the current or earlier versions or editions of the Nice Classification will be objected to as lacking clarity and precision. The applicant will be asked to make the unacceptable term more specific.

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

Not a clear and precise term	Example of a clear and precise term
Goods of common metal not included in other classes (Class 6)	Construction elements of metal (Class 6) Building materials of metal (Class 6)

Not a clear and precise term	Example of a clear and precise term
Machines (Class 7)	<u>Agricultural machines</u> (Class 7) Machines for processing plastics (Class 7) Milking machines (Class 7)
Goods in precious metals or coated therewith (Class 14)	Works of art of precious metal (Class 14)
Goods made from paper and cardboard (Class 16)	Filtering materials of paper (Class 16)
Goods made from rubber, gutta-percha, gum, asbestos and mica (Class 17)	Rings of rubber (Class 17)
Goods made of these materials [leather and imitations of leather] (Class 18)	Leather straps (Class 18)
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)	<u>Door fittings, made of plastics</u> (Class 20) Figurines of wood (Class 20)
Repair (Class 37)	Shoe repair (Class 37) Repair of computer hardware (Class 37)
Installation services (Class 37)	<u>Installation of doors and windows</u> (Class 37) Installation of burglar alarms (Class 37)
Treatment of materials (Class 40)	Treatment of toxic waste (Class 40) Air purification (Class 40)
Personal and social services rendered by others to meet the needs of individuals (Class 45)	Personal background investigations (Class 45) Personal shopping for others (Class 45) Adoption agency services (Class 45)

Unclear or general indications of services used in combination with unclear and general indications of goods may be acceptable if a market sector or a specific skill needed to provide such services is clearly distinguished. For example, the *repair of leather goods* would be considered sufficiently clear and precise, as the professionals carrying out those repairs would mostly be cobblers, regardless of further characteristics of the goods. The practice regarding retail services in connection with goods that are considered unclear and imprecise is explained further in the Annex, in 6.57 Retail and wholesale services.

Note that terms lacking clarity and precision cannot be made specific, or acceptable, by the addition of such terms as 'including', 'in particular', 'for example', 'featuring' or 'such

as', as well as 'included in this class' or 'not included in other classes'. The example *machines, including milking machines* would not be acceptable as it remains unclear and imprecise (see paragraph 4.2.3).

4.3.2 Other terms lacking clarity and precision

The same principles regarding clarity and precision as described under paragraph 4.2 are applicable to all the goods and services listed in an application. Terms that do not provide a clear indication of the goods or services covered should be objected to.

Examples

- *Merchandising articles*
- *Fair-trade goods*
- *Lifestyle accessories*
- *Gift articles*
- *Souvenirs*
- *Collectors' articles*
- *Housewares*
- *Electronic goods* (01/12/2016, T-775/15, Ferli, EU:T:2016:699), *electric/electronic apparatus/instruments*
- *Gadgets (electronic or not)*
- *Hobby articles*
- *Advertising articles*
- *Memorabilia*
- *Wellness goods*
- *Association services*
- *Facilities management services.*

All of these must be made more specific as described above, that is to say, by identifying factors such as characteristics, purpose and/or identifiable market sector.

It should be noted that the means by which a service is provided usually does not render a term sufficiently clear and precise. For classification purposes it is mostly irrelevant whether a service is provided online, on the telephone, by means of a catalogue, in a physical shop, or on-site in person.

More examples can be found in the Annex.

4.3.3 The claim for all goods/services in a class or all goods/services of the alphabetical list in a class

If applicants intend to protect all goods or services included in the alphabetical list of a particular class, they must indicate this by listing these goods or services explicitly and individually. The Office provides tools and functionalities, such as the Goods and Services Builder and TMclass, to guide applicants through the search for goods and services by providing them with suggestions for acceptable goods or services or by starting from the more general terms and ending with the more specific. Use of the

Goods and Services Builder and the TMclass hierarchical structure for guidance and search purposes is encouraged (see paragraph 3).

Applications are sometimes filed with terms such as 'all goods in Class X', 'all services in Class X', 'all goods/services in Class X', 'all goods/services of the alphabetical list in Class X', either on their own, or together with an acceptable list of goods/services. These terms do not constitute a valid claim within the meaning of Article 33(2) EUTMR because they lack sufficient clarity and precision to determine the extent of the protection sought. The Office will invite the applicant to provide acceptable terms within a time limit set to that effect. Failure to do so will result in the application being rejected for such unclear and imprecise terms. It may proceed **only** for the acceptable part of the goods/services.

On other occasions, applications are filed merely stating the class number. This does not comply with Article 31(1)(c) EUTMR, whereby a list of the goods or services for which the registration is requested must be given. Consequently, in these cases, in the absence of a list of goods or services in respect of which registration is sought, no filing date will be accorded pursuant to Article 32 EUTMR. The Office will invite the applicant to remedy the deficiency with an objection on formalities. If the deficiency is remedied within the given time limit, the filing date will become the date on which a list of goods and services has been provided. See the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 4.1.

4.3.4 Reference to other classes within the list

References to other class numbers within a class are not acceptable for classification purposes. For example, the indications (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 is for the respective goods of Classes 32 and 33, and services of Classes 41 and 45 to be specified in more detail.

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

For example, *transport services of plastic materials for packaging (not included in other classes)* in Class 39 could not be accepted. The mention of *(not included in other classes)* must be deleted so that the term reads *transport services of plastic materials for packaging*.

4.3.5 Trade marks in lists of goods/services

Trade marks may not be used as generic terms or categories of goods. Therefore they will not be accepted as goods or services per se.

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 with enhanced capacity*) or Teflon™ (*non-stick coating based on polytetrafluoroethylene*). This list is not exhaustive and, if in doubt, examiners should refer cases to a relevant expert within the Office. If third parties are concerned about the generic use of a registered trade mark within a list of goods and services of an application, they may file observations to that effect.

The Office will object to the inclusion of such terms and request that they are replaced by a generic term for the goods or services in question.

4.3.6 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. Accordingly they cannot be classified properly. Each of the terms requires further qualification to become acceptable in its proper class. Such terms could be made acceptable by adding identifying factors such as characteristics, purpose and/or identifiable market sector. It should be noted that the protection afforded by such indications will be interpreted as being limited by the scope of the class. Parts and fittings, components or accessories not belonging to that class will not be understood as covered by such indications.

Examples of acceptable terms

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

In all cases the requirements of clarity and precision must also be met.

Adding the expression *parts and fittings for all the aforementioned goods* at the end of a list will be accepted as long as it can reasonably be applied to at least one of the goods in that class. In such a case, however, the parts and fittings will be considered to cover only the goods for which they can reasonably be pertinent. For example, if the wording of Class 9 reads *computers; mobile phones; software; parts and fittings for all the aforementioned goods*, then the parts and fittings can only concern *computers* and *mobiles phones*. As *software* relates to goods which are virtual, it is not seen as having *parts and fittings*.

Examples of what will **not** be accepted

- Class 5 — *Pharmaceutical preparations; parts and fittings for all the aforementioned goods.*

- Class 16 — *Paper and cardboard; accessories for all the aforementioned goods.*
- Class 29 — *Meat, fish, poultry and game; components of all the aforementioned goods.*

4.3.7 Use of indefinite qualifiers

The use of qualifiers such as 'the like', 'ancillary', 'associated goods', 'and related goods' or '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 Examination Procedure

5.1 Parallel applications

While the Office will always strive for consistency, the fact that a wrongly classified list of goods and services has previously been accepted does not have to lead to the same list being accepted in any subsequent applications. See the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 3.

5.2 Objections

Where the Office considers that there is a need to amend the list of goods and services according to its practice, it should, if possible, discuss the issue with the applicant and take comments and observations into account. Whenever reasonably possible, the examiner should propose a correct classification. If the applicant submits a long list of goods/services that is not grouped under class numbers or classified at all, then the examiner should simply object under Article 33 EUTMR and ask the applicant to provide a correct list.

The applicant's response must, under no circumstances, extend the scope or range of the goods or services originally applied for (Article 49(2) EUTMR).

Where the applicant has failed to identify any classes, or has incorrectly identified the class(es) for the goods or services, 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 can 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, taking into consideration the nature, purpose and method of use of the goods in question (23/01/2014, T-221/12, Sun fresh, EU:T:2014:25, § 31; appeal rejected 03/06/2015, C-142/14 P, SUN FRESH / SUNNY FRESH, EU:C:2015:371).

Where there is a need to amend the classification, the Office will send a reasoned communication pointing out the deficiencies detected in the list of goods and services. The applicant will be requested to amend the list and/or make it more specific; the Office may propose how the items should be classified and provide analogous examples from the HDB.

The objection should take into account the class applied for, and the class a term would otherwise belong to, if its natural and usual meaning can be determined.

Examples

- **Natural and usual meaning is clear, class number is obviously incorrect**

Where the applicant files for the term *shoes* in Class 3, he or she will be requested to transfer this term to Class 25, since the natural and usual meaning of this term would be coverings for human feet.

- **Natural and usual meaning is clear, however, the class number could give a different context**

Where the applicant files for the term *shoes* in Class 9, he or she should be asked to amend the classification in accordance with the natural and usual meaning (footwear belongs to Class 25) or to specify the nature or purpose of these goods (protective footwear). The applicant therefore has the following options:

either

- the term is specified to read *protective shoes* and remains in Class 9, since *footwear for protection against accident or injury* belongs to this class;

or

- the term *shoes* is transferred to Class 25, according to its natural and usual meaning.

It should be noted that only one of these options can be chosen:

- amending the term to properly reflect its nature or purpose in relation to the class originally applied for;
- transferring the term to the correct class according to its natural and usual meaning.

It is not possible to choose both as this would widen the scope of the application.

- **Natural and usual meaning is unclear, no context given by class number**

If the applicant files for the term *robots* in Class 25, he or she should be asked to define the nature or purpose of these goods, as this is not clear from the natural and usual meaning nor the class applied for. In such a case, a further specification in all applicable classes can be accepted, for instance as:

Class 7: *Robotic cleaners for household purposes; industrial robots for shaping metal*

Class 9: *Humanoid robots with artificial intelligence; laboratory robots*

Class 10: *Surgical robots; nanorobots for medical purposes*

Class 28: *Toy robots; smart robot toys.*

As the original meaning of the term was unclear, and the class number gave no additional information, this is not considered a widening of the list of goods and services as the original scope could not be defined.

Any additional information applicable to a term that needs to be transferred to a different class should also be taken into account, not only in order to prevent a broadening of the original scope, but also to avoid narrowing it down. For example, if the original list of goods in Class 12 reads *cars; car radios; parts and fittings for all the aforementioned goods*, as *car radios* are proper to Class 9, the applicant will be requested to transfer the term to Class 9, even if Class 9 was not listed in the original application. However, wherever appropriate, such a transfer should also include the *parts and fittings for all the aforementioned goods*.

The list of goods should therefore be amended as follows:

Class 9: *Car radios; parts and fittings for all the aforementioned goods*

Class 12: *Cars; parts and fittings for all the aforementioned goods.*

For example, but this time for a service class, the original list of services in Class 43 could read *travel agency services for arranging the transportation of travellers; travel agency services for making hotel reservations; information, advice and consultancy in relation to all aforementioned services*. As *travel agency services for arranging the transportation of travellers* are proper to Class 39, the applicant will be requested to transfer the term to Class 39, even if Class 39 was not listed in the original application. However, this transfer should also include the *information, advice and consultancy in relation to all aforementioned services*.

The list of services should therefore be amended as follows:

Class 39: *Travel agency services for arranging the transportation of travellers; information, advice and consultancy in relation to all aforementioned services*

Class 43: *Travel agency services for making hotel reservations; information, advice and consultancy in relation to all aforementioned services.*

The initial time limit of 2 months allowed for remedying the deficiencies can only be extended once. No further extensions will be granted unless exceptional circumstances apply (Article 101(4) EUTMR). See also the Guidelines Part A, General Rules, Section 8, *Restitutio in Integrum*.

The Office will send a letter informing the applicant of the list of goods and services as accepted following the amendments.

If the applicant does not remedy the deficiency(ies), the application will be rejected for the goods or services for which an objection has been made.

5.3 Amendment and restriction of a list of goods and services

Article 49(1) and (2) EUTMR allows for the restriction or amendment of an application before registration, provided that 'such a correction does not substantially change the trade mark or extend the list of goods and services'.

Under Article 49(1) EUTMR, the applicant may choose to **restrict** the list of goods and services in order to clarify the scope of protection, to overcome an objection under absolute grounds, to further specify unclear and imprecise indications, or to settle a dispute. The restriction can be effected by deleting a term, further specifying a broad term, or a subcategory of such a term, or excluding terms or subcategories of goods or services.

Amendments to the indication of goods and services before registration, under Article 49(2) EUTMR, can also be seen as a fine-tuning of the list of goods and services, and therefore can change the wording without necessarily limiting the scope of the application or changing the nature of the goods and services. However, any such fine-tuning may never broaden the scope of the application.

Restrictions made post-registration, however, must comply with the requirements of Article 57 EUTMR on partial surrender. Once the mark has been entered in the Register, changes to the list of goods and services can only seek to limit the scope of protection, and will be refused if no actual restriction is made. Under no circumstances may the change widen the list of goods and services.

5.3.1 Rules governing restrictions and amendments

A request for restriction or amendment of the list of goods and services in the context of Article 49 EUTMR takes effect when it is received by the Office and is therefore **formally binding**. This means that the goods or services excluded through a restriction cannot be reinserted into the list of goods and services at a later stage. In order for a request for restriction to be withdrawn, a corresponding declaration must reach the Office on the same day the request for restriction was received. Withdrawal of a restriction received after this date will be dismissed.

Certain **general criteria** must be respected at all times for a restriction or amendment to be acceptable.

- The request must be **explicit**. The absence of a reply to an official notification will never be considered an explicit request for restriction. Where a restriction is required by the Office, silence on the part of the applicant can, however, lead to the refusal of the terms objected to, or, eventually, to the refusal of the application in its entirety.

- The request must be **unconditional**. For instance, if the applicant only wants to restrict the application in return for a fee refund, the request will be considered inadmissible and the applicant informed accordingly. Otherwise, in this regard, similar rules to those for withdrawals apply (see the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 5.1.2).
- A list of goods and services should still be **clear and precise** after a restriction or amendment in order to comply with the requirements of Article 33 EUTMR, and must **not go against legal certainty**.

In any request for a restriction or amendment, the goods/services to be restricted or amended must be clearly indicated (see the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 5.2.1).

5.3.2 Wording of restrictions

A restriction should be understood as a clear limitation of the scope of protection.

A restriction can in principle follow one or several of the following approaches, provided they do not contradict each other.

1. **Deletion** of an existing term from the list.
2. **Specification** of a broader term in the list to specific goods or services covered by the broad term, or to one or several subcategories of this term.
3. **Exclusion** of specific goods or services from a broad term, or of one or more subcategories from such a term in the list.

Examples of valid restrictions (in Class 16):

1. **Deletion:** *newspapers; magazines; books* is restricted to read *newspapers; magazines*; the term *books* is completely deleted from the list.
2. **Specification:** *newspapers; magazines; books* is restricted to read *newspapers; magazines; books, namely dictionaries or newspapers; magazines; dictionaries; cookbooks*; the term *books* has been specified to cover only the narrow subcategory of books defined as *dictionaries*, or replaced by the subcategories *dictionaries* and *cookbooks*.
3. **Exclusion:** *newspapers; magazines; books* is restricted to read *newspapers; magazines; books, except dictionaries or newspapers; magazines; books, excluding dictionaries and cookbooks*; the coverage of the term *books* remains fairly broad while at the same time clearly excludes the subcategory of *dictionaries*, or both *dictionaries* and *cookbooks* (from the second wording).

Examples of **contradictory** restrictions (in Class 16), which should therefore be refused:

- *Newspapers; magazines; books* requested to read *newspapers; magazines; all the aforementioned goods except dictionaries or newspapers; magazines; all the aforementioned goods being dictionaries*; these restrictions cannot be accepted as, by excluding the broad category of *books*, the remaining goods to which the restrictions refer no longer contain the subcategory of *dictionaries*.

- *Newspapers; magazines; books, namely dictionaries* requested to read *newspapers; magazines; books, namely dictionaries; all the aforementioned goods except cookbooks*; this restriction cannot be granted as with the specification of the broader category of *books*, the remaining goods to which the restriction could refer, that is to say, *dictionaries*, or even *newspapers* and *magazines*, no longer contain the subcategory of *cookbooks* — or are not even considered to be *books* for that matter, as in the latter case of *newspapers* and *magazines*.

A restriction can result in the deletion of an entire class or, on the contrary, in entering a longer list of goods and services than what was originally applied for. *Newspapers; magazines; books* in Class 16 could, for instance, be restricted to read *newspapers; magazines; books, namely dictionaries, cookbooks, biographies, poetry, fairy tales and philosophy books*.

Furthermore, according to the criteria mentioned under paragraph 5.3.1, the following examples represent acceptable and unacceptable restriction scenarios:

- In order to be able to restrict them, the goods or services need to be **covered by the current list of goods and services** in the class applied for.

Examples of **acceptable** restrictions:

Class 16: *Books, namely dictionaries*;

Class 25: *Footwear, only being flip-flops*.

Examples of **unacceptable** restrictions concerning different classes:

Class 5: *Diagnostic preparations, all for scientific use*;

Class 7: *Milling machines, only for dental purposes*.

Although *diagnostic preparations* can be found both in Class 1 and Class 5, Class 5 would only cover those for medical or veterinary purposes. *Diagnostic preparations for scientific use* are proper to Class 1 and therefore cannot be included in Class 5.

Similarly, although *milling machines* could indeed also be used by dental technicians, such goods are not proper to Class 7 but to Class 10. Therefore, it is impossible to include them in Class 7, as they are not proper to that class.

Example of an **unacceptable** restriction within the same class:

Class 16: *Newspapers; magazines; books.*

Restriction request: Newspapers; magazines; books; all the aforementioned goods except pencils.

In this case, even if *pencils* were proper to the same class, the exclusion of a term that is clearly not covered by the original list of goods and services is nonsensical, and will therefore be objected to.

Class 35: *Retailing and wholesaling of wine* (08/10/2014, R 727/2013-1, E-WINE (fig.) / iWine (fig.).

The inclusion of a term clearly not covered by the original list (even if the remaining terms are deleted) will be seen as an unacceptable **broadening of the original scope**, even if it is proper to the same class.

5.3.2.1 References to trade marks

Generic **references to trade marks** will be objected to.

Example of an **unacceptable** restriction:

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

5.3.2.2 Territorial restrictions

Territorial restrictions contradicting the unitary nature of an EUTM are not allowed.

Example of an **unacceptable** request:

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

This example would be in contradiction to the principle of free movement of goods and uniform protection throughout the entire area of the European Union referred to in Article 28 of the Treaty on the Functioning of the European Union.

Territorial amendments that do not change the scope of protection, for example, *clothing made in Vietnam*, may be acceptable. See also paragraph 5.3.3.1 Amendments with territorial references.

Restrictions concerning the **origin** of goods are, in principle, acceptable, and, under certain circumstances, such as in relation to protected geographical indications (PGIs), might even be necessary. For further guidance on restrictions required on the grounds of Article 7(1)(j) to (l) EUTMR, see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal.

5.3.2.3 Ambiguity due to regulations

Restrictions that are **ambiguous** regarding the different national regulatory regimes across the European Union will not be accepted.

Example of an **unacceptable** restriction:

Class 5: *Medicines, only on prescription.*

This example would be considered to go against the judgment of 08/11/2013, T-536/10, Premeno, EU:T:2013:586. In particular, the criterion mentioned cannot be accepted due to the lack of uniform rules governing sales of medicines requiring prescription within the EU, as explained in paragraphs 31-32 and 47 of said judgment.

5.3.2.4 Clarity and precision

Restrictions must be **clear and precise**.

It should be clear which goods or services are excluded by the restriction and which will remain in the list of goods and services. Restrictions that appear completely nonsensical within the context of the current list of goods and services will not be allowed.

Examples of **unacceptable** nonsensical restrictions:

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

Where there is no possibility that the proposed limited use can be assured on the market, or where the proposed remaining scope of protection is blurred by a limitation that cannot be clearly linked to an existing or a potential market subcategory of the goods or services, the Office will raise an objection.

Example of an **unacceptable** restriction where the goods do **not possess such characteristics**:

Class 31: *Oranges, except smart oranges.*

The fresh fruit listed in the original indication will not cover any types of smart goods. Emphasising this fact by submitting such a disclaimer will not add relevant information to the term, and therefore has no effect on the current scope of protection.

Examples of **unacceptable** restrictions where the **remaining scope of protection** cannot be exactly determined:

Class 7: *Machines, in particular bulldozers.*

An unclear and imprecise term is not clarified or specified by simply mentioning an example of what it could cover; the term *machines* lacks clarity and precision, and merely giving examples of what this broad term may cover does not make it acceptable.

Using the expressions ‘including’, ‘in particular’, ‘for example’ or ‘such as’, as well as ‘included in this class’ or ‘not included in other classes’, **does not constitute a valid restriction** or specification of the preceding goods or services. For further information see paragraph 4.2.3.

5.3.2.5 Subjectivity

Restrictions that involve **subjective characteristics** will not be accepted.

Examples of **unacceptable** restrictions:

Class 12: *Luxury cars*

Class 29: *Tasty fruit*

Class 33: *Expensive wine.*

5.3.2.6 Targeted public

Restrictions specifying or excluding a part of the public can only be accepted if they are **relevant** to the goods or services in question, and if the scope of protection remains **clear and precise**.

Examples of **acceptable** restrictions:

Class 25: *Clothing, except clothing for children*

Class 41: *Education for the visually impaired.*

Examples of **unacceptable** restrictions:

Class 28: *Roller skates, exclusively designed for surfers*

Class 45: *Legal services, not provided to hairdressers.*

5.3.2.7 Intended use or purpose

Restrictions asking to specify or exclude the intended use or purpose of the goods or services can only be accepted if they are **relevant** to the goods or services in question and change their nature, and if the scope of protection remains **clear and precise**.

Examples of **acceptable** restrictions:

Class 9: *Operating systems, except operating systems for mobile phones*

Class 39: *Collection of domestic waste for recycling purposes.*

Examples of **unacceptable** restrictions:

Class 16: *Books, only for use with lamps*

Class 42: *Scientific research services, not for the purpose of social networking.*

5.3.2.8 Restrictions specifying subject matter

Restrictions specifying or excluding subject matter can only be accepted if they are **relevant** to the goods or services in question and change their nature, and if the scope of protection remains **clear and precise**. This is in principle only possible for goods or services that can have content. Previous comments on the generic use of registered **trade marks** in the description of goods or services also apply.

Examples of **acceptable** restrictions:

Class 9: *CDs, recorded with music*

Class 9: *MP3 files, all containing jazz*

Class 16: *Printed comics, all related to science fiction*

Class 41: *Entertainment conventions, relating to role-playing games*

Class 41: *Musical concert services for the music of Beethoven.*

5.3.3 Wording of amendments

An amendment is seen as a means to exemplify some goods or services, without changing the scope of protection or affecting the nature of the goods or services.

An amendment can follow one or several of the following approaches, provided they do not contradict each other:

1. **exemplifying items already covered** by the current scope;
2. **removal of items still covered** by the remaining scope;
3. **specification** of a **characteristic**;
4. **exclusion** of a **characteristic**.

Examples of valid amendments (in Class 30):

1. **Inclusion of items already covered:** *Sweets, in particular flavoured with strawberry and apricot flavour*. Since the scope of protection is *sweets* in general, highlighting possible characteristics by introducing some examples does not change the initial scope of protection.
2. **Removal of items still covered:** *Sweets, in particular flavoured with strawberry*. Despite deleting the example from the wording, it will implicitly remain covered by the broader term – the scope of protection remains the same.
3. **Specification:** *Sweets flavoured with strawberry*. Since strawberry-flavoured sweets are not a recognisable subcategory of confectionery nor a specific market sector, and since the description of the characteristics of sweets will not change the nature of these goods, the specification will be understood as an amendment.
4. **Exclusion:** *Sweets, not flavoured with strawberry*. Similarly, since strawberry-flavoured sweets are not a recognisable subcategory of confectionery nor a specific market sector, and since excluding some characteristics of sweets will not change the nature of these goods, the exclusion will be understood as an amendment.

An amendment must be **clear and precise** in order to be acceptable.

If excluding specific characteristics does not allow the scope of protection of the remaining goods or services to be understood with clarity and precision, the exclusion must be rejected.

Amendments specifying subcategories that may not be contained within the relevant class will be dealt with as follows.

Examples of **acceptable** amendments:

Class 5: *Diagnostic preparations, except for scientific use*.

Although *diagnostic preparations* can be found both in Class 1 and Class 5, Class 5 would only cover those for medical or veterinary purposes. *Diagnostic preparations for scientific use* would be proper to Class 1. The exclusion of the subcategory only clarifies the scope of the goods in Class 5. Even if this would not be a restriction, as it does not change the scope of protection, it can be accepted as an amendment as it exemplifies what is not covered.

Class 7: *Milling machines, except for dental purposes*.

Similarly, although *milling machines* could indeed also be used by dental technicians, such goods would not be proper to Class 7 but instead would be proper to Class 10. The exclusion of the subcategory only clarifies the scope of the goods in Class 7. Even if this would not be a restriction, as it does not change the scope of protection, it can be accepted as an amendment as it exemplifies what is not covered.

Example of an **unacceptable** exclusion:

Class 35: *Services of direct-mail campaigns and the issue of postage stamps provided they are not connected with a post office* does not allow the remaining goods and services to be understood with clarity and precision (12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 18, 115).

5.3.3.1 Amendments with territorial references

Amendments relating to the **origin** of goods are, in principle, acceptable.

Example of an **acceptable** amendment indicating origin:

Class 25: *Clothing made in Vietnam.*

Such amendments are acceptable from the perspective of the examination of classification, as they do not broaden the scope of protection. However, the application may become subject to other objections (e.g. under Article 7(1)(g) EUTMR).

5.3.3.2 Amendments specifying theme

Amendments specifying or excluding theme can only be accepted if they are **relevant** to the goods or services in question, and if the scope of protection remains **clear and precise**. This is in principle only possible for goods or services which do not have content. See also paragraph 5.3.2.8 Restrictions specifying subject matter.

Examples of **acceptable** amendments:

Class 25: *T-shirts, bearing the image of Marilyn Monroe*

Class 16: *Pen cases with pictures of cartoon characters*

Class 21: *Mugs, showing pictures of Paris.*

5.3.4 Influence of punctuation on restrictions and amendments

Punctuation also plays an important role in determining the scope of a restriction or amendment, as explained in paragraph 4.2.5. This is especially important in connection with formulations such as ‘*all the aforementioned goods except for use in connection with [...]*’ or ‘*the aforementioned services exclusively related to [...]*’:

- Thus, a restriction in Class 9 reading *operating systems; text processing applications; games software; all the aforementioned goods for the sole use with tablet computers* will be interpreted as intending to **limit all these goods, equally due to the use of a semicolon** separating the specification from the rest of the list.
- However, a restriction in Class 9 reading *operating systems; text processing applications; games software, all the aforementioned goods for the sole use with tablet computers* will be interpreted as limiting only the use of games software, since, if **separated with a comma, the specification merely involves the last preceding term** delimited by a semicolon.

A request to add ‘*all the aforementioned goods, excluding [...]*’ or ‘*all the previously mentioned services, only with regard to [...]*’ at the end of the specification within a

class and separated by a semicolon will be interpreted as referring only to those preceding goods or services to which such an exclusion can reasonably apply, and will therefore be accepted as long as it can reasonably be applied to at least one good or service it refers to in that class. At the same time the criteria mentioned under paragraph 5.3.1 need to be observed.

5.3.5 Provisions for implementation

Should one part of a restriction or an amendment request be acceptable, and another not, the restriction will be objected to in its entirety. The Office will inform the applicant and set a time limit of 2 months for remedying deficiencies. If the deficiencies are not remedied within the given time limit, the restriction or amendment request will be refused in its entirety, and the proceedings will then continue on the basis of the original list of goods and services.

For information on the language of the request, see the Guidelines, Part B, Examination, Section 1, Proceedings, paragraphs 5 and 5.1.1.

5.3.6 Interpretation going beyond the general criteria

Restrictions and amendments need to be taken into account in the context of the proceedings in which they are requested.

Depending on the stage of proceedings, various additional principles and rules based on specific case-law might need to be followed.

For more detailed information on different proceedings, each respective part of the Guidelines should be consulted as appropriate – Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 10, Trade marks in Conflict with Designations of Origin and Geographical Indications (Article 7(1)(j) EUTMR); Part C, Opposition, Section 1, Opposition Proceedings, and Section 2, Double Identity and Likelihood of Confusion, Chapter 1, General Principles; Part E: Register Operations, Section 1, Changes in a Registration, and Section 2: Conversion; and Part M, International Marks.

5.4 Addition of classes

Under the provisions of Article 49(2) EUTMR, 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 the goods or services have been clarified and need to be classified in other class(es).

For example, the original list of goods in Class 33 reads *alcoholic beverages including beer, wines and spirits*.

Since *beer [alcoholic beverages]* 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, the application will then cover the said goods in Classes 32 and 33.

When transferring a term from one class to another, the scope of protection originally applied for, defined by additional information, also needs to be taken into account. In the example above, the simple addition of the term *beer* to Class 32 would in fact mean an unacceptable broadening of the original scope of protection, since the application only includes *alcoholic beverages*. As such, the term *beer* in Class 32 would, however, also cover *non-alcoholic beer*, thus going beyond the original scope of protection. Therefore, to illustrate the principle, the term to be transferred to Class 32 should specifically read *beer [alcoholic beverages]*.

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

5.5 Timing of objections

Classification objections should be raised as early as possible during the examination process, before publishing the application. As a general rule, it is not Office practice to reassess the classification of an application after publication.

There are, however, occasions when raising a late objection is justified in order to avoid manifest errors of law or assessment, such as when the error is clearly against the provisions of Article 33 EUTMR and could prevent competent authorities or economic operators from identifying competition/determining the exact scope of protection.

Thus, in accordance with Article 44(3) EUTMR, where the publication of the application contains an error attributable to the Office, the Office will correct the error and publish the correction of its own motion or at the request of the applicant.

Article 46(2) EUTMR and Articles 2 to 10 EUTMDR apply *mutatis mutandis* where the correction concerns the list of goods or services of the mark.

6 Annex

6.1 Introduction

When classifying goods and services, 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, the HDB, is available through TMclass at <http://tmclass.tmdn.org>. The Goods and Services Builder can be found at <https://euipo.europa.eu/ohimportal/en/gsbuilder>.

6.2 Accessories for vehicles

If the list reads *vehicles; cars; parts, fittings, components and accessories for all the aforementioned goods* in Class 12, it will be accepted. However, parts, fittings, components and accessories for vehicles and cars that are not proper to Class 12, such as, for instance, *car air fresheners* (Class 5), *aircraft engines* (Class 7), *bicycle helmets* (Class 9), *car radios* (Class 9), *furniture for caravans* (Class 20), *car mats* (Class 27), will not be covered by that specification. If protection is sought for parts, fittings, components and accessories for vehicles and cars that are not proper to Class 12, these goods need to be specified separately, and applied for in the proper class or classes.

The term accessories for vehicles may be accepted in relation to services as long as there is a clearly recognisable market sector for that specification. For instance, if the list reads *retail of **cars**, and parts, fittings, components and **accessories** for the aforementioned goods* in Class 35, or *retail of **bicycles**, and parts, fittings, components and **accessories** for the aforementioned goods* in Class 35, it will be accepted, since these specific sectors are well defined on the market.

6.3 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 for all kinds of media, as they are services that will be provided by advertising agencies.

6.4 Air freshening and perfuming preparations

See *Perfuming and air freshening preparations*.

6.5 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 the games are not loaded on the devices, they will be recorded on data carriers or will be downloadable. In such cases, the games are considered to be game programs especially adapted for use with gaming devices; they will therefore be classified in Class 9.

See also *Computer games*.

6.6 Assembly services

These services in Class 40 cover the aspect of made-to-order manufacturing processes where several components are put together and interconnected to form finished or semi-finished goods.

Assembly services in Class 37 can only refer to the installation of goods and must be specified in more detail to that effect.

Note that the assembly of ready-built houses will be understood as construction services and therefore will only be correct in Class 37.

See also *Manufacturing services*.

6.7 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 provided needs to be mentioned.

Examples of acceptable specifications:

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*.

6.8 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) but 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.*

6.9 Blogging services

These services - providing information in blogs as well as provision of blogs - are considered vague and must be specified in more detail, defining the actual nature of the service or the subject matter of the information provided. See *providing information*.

Examples of acceptable specifications that define the subject matter of the information provided via a blog:

Class 35: *Providing corporate blogs*

Class 39: *Providing travel blogs*

Class 41: *Providing educational blogs*

Class 43: *Providing culinary art blogs.*

Examples of acceptable specifications that define the actual nature of other services related to blogs:

Class 38: *Providing the means to communicate by online blogs*

Providing access to online blogs

Class 41: *Services of entertainment through video blogs*

Class 42: *Hosting of online blogs*

Providing software for creation of blogs.

6.10 Bringing together of services

See *Ordering of services* and *Retail and wholesale services*.

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

6.12 Brokerage services

These are services provided by an individual or company whereby these latter 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:

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.*

6.13 Cases (and carrying bags)

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

Cases and bags adapted to carry or transport goods should not be confused with non-adapted carrying bags, which are classified in Class 18, whilst disposable paper and plastic shopping bags and garbage bags are in Class 16, and laundry bags are in Class 22.

6.14 Charitable services

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

Charitable or humanitarian services are services provided for non-monetary benefit, serving the public interest or common good and are defined by the actual service offered. Therefore, they can be classified in any of the service classes, giving the correct definition.

Examples:

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: *Providing clothing to needy persons [charitable services].*

6.15 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 listing. 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.

6.16 Consulting and advisory services

See *Providing information*.

6.17 Commercial intermediation services

These are understood as third-party services of an agent for, or arranger of, a business contract between two trading parties for a commission or a fee. Since the principal activity would be aimed at closing trade agreements for others, such services are considered proper to Class 35.

However, it is important to distinguish between such commercial intermediation, which is strictly a business service, and the arranging of services for others as such, which would in general be seen as an integral part of the provision of those services themselves, and classified analogously.

6.18 Computer games and computer games apparatus

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

The dictionary reference for computer games is:

1. **(Noun)** 'any of various electronic games that are played by manipulating an input device in response to the graphics on the screen' (*Collins English Dictionary*).

Class 9 covers the software necessary for computer and video games, Class 28 covers the apparatus. If the terms *computer games* or *video games* are applied for as such, the class will define the nature of the goods covered.

See also *amusement apparatus and electronic games*.

Games that are acceptable in Class 28 can come loaded as part of the 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*.

6.19 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 goods and their material composition.

Curtains are normally used indoors and are classified similarly according to their material composition.

Examples of acceptable entries:

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 22: *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 proper to Class 6 (for metal goods) or Class 19 (for non-metallic goods).

6.20 Custom manufacture/manufacturing for third parties

See *Manufacturing services*.

6.21 Customer services

Although many businesses have departments dedicated to *customer services*, this term on its own is considered vague and must be explained further. An example of an

acceptable specification in Class 35 would be *providing advice and support to clients for sales purposes and to achieve customer loyalty*.

6.22 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 on 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.

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 that 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, the classification would be proper to other classes, for example, Class 42 for measuring or scientific reasons.)

See also *Providing information*.

6.23 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 they are both advertising services.

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

6.24 Digital imaging services

The term *digital imaging services* was deleted from Class 41 in the 10th edition of the Nice Classification. Consequently, the term cannot be accepted in Class 41 without further details. 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.

Examples of acceptable terms:

- *digital imaging (photo editing)* in Class 41;
- *medical imaging services* in Class 44;
- *rendering of computer graphics (digital imaging services)* in Class 42.

6.25 Downloadable goods

All material that is downloadable is proper to Class 9. This includes publications, music, ring tones, pictures, photographs, films or film extracts and digitalised information in general. Downloaded material is saved onto a memory unit or computer drive, telephone, tablet or other wearable device. It can then be used independently of its source. These goods can also be called *virtual goods*. All these downloadable goods can be retailed.

6.26 Electricity and energy

The following is a guide to some of the goods and services related to electricity and energy in general.

Class 4: *Electrical energy*

Class 7: *Electrical generators*

Wind turbines

Hydroelectric installations for generating electricity

Class 9: *Apparatus and instruments for conducting, switching, transforming, accumulating, regulating, or controlling electricity*

Solar cells for electricity generation

Photovoltaic cells and modules

Class 11: *Heat generating apparatus*

Solar collectors for heating

Class 35: *Procurement of contracts concerning energy supply*

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

Class 37: *Recharging of batteries*

Class 39: *Distribution of electricity*

Storage of electricity

Class 40: *Generation of electricity*

Class 42: *Measuring services with regard to energy consumption.*

Note that *retail or wholesale of energy* will not be accepted since the selling of energy is considered to be trading in commodities. This term must be rephrased to reflect this and classified in Class 36.

See also *Solar power*.

6.27 Electronic and electric apparatus

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

Specifications of *electronic and electric apparatus, devices or instruments*, such as the examples listed below, are also considered too vague:

- *electronic and electric apparatus for controlling the environment*
- *electronic and electric apparatus for household purposes*
- *electronic and electric apparatus for use in hairdresser salons*
- *consumer electronics.*

6.28 Electronic cigarettes

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

Electronic parts, such as batteries and microcomputer-controlled circuits for electronic cigarettes, are not acceptable in these classes and belong - as usual - to Class 9.

6.29 Expert opinion services

The area of expertise has to be indicated for this type of service; classification will depend on the area of expertise indicated (see by analogy *Providing information*).

6.30 Food additives and supplements

These goods should in principle be classified according to the function group they belong to.

- Composition/consistency. Chemical and organic compositions used in the manufacture of food, such as binders, emulsifiers, stabilisers, thickeners, gelling agents or preservatives, are proper to Class 1. They are used to enhance or otherwise alter the consistency and durability of the food.
- Colour. Colourants in general are classified in Class 2.
- Flavour. Essential oils for enhancing flavour belong to Class 3.
- Health related. Veterinary or medical additives and nutritional supplements, such as digestives, anti-parasitics, antacids, trace element preparations or vitamin supplements, are meant to sustain or improve the health condition of humans or animals. They are therefore proper to Class 5.

- *Fillers/bulking agents for animal feed*. Class 31 contains complementary foodstuffs, or additional foods, used mostly as bulk fillers with little or no nutritional value. Examples of such goods would be corncobs, peanut hulls or cereal by-products.

6.31 Foodstuffs, snacks, prepared meals

The term *foodstuffs* without any further specification will be objected to regardless of the class in which it is applied for. The same will apply for *snacks* or *prepared meals*. Although in relation to retail services they are seen as a single category of products, these goods as such can belong to various classes of goods. Therefore, it is necessary to indicate the nature of these goods more precisely.

According to the Nice Classification explanatory notes, Class 29 includes mainly foodstuffs of animal origin, as well as vegetables and other horticultural comestible products that are prepared for consumption or conservation. Class 30 includes mainly foodstuffs of plant origin prepared for consumption or conservation, as well as auxiliaries intended to improve the flavour of food. Class 31 includes mainly agricultural and aquacultural products not having been subjected to any form of preparation for consumption; live animals and plants; and foodstuffs for animals.

Food for babies, medical meal replacements and dietetic food, adapted for medical or veterinary use, can be found only in Class 5. However, if not specifically adapted for medical or veterinary purposes, foodstuffs enhanced with or lacking a specific ingredient, such as *dairy-free chocolate*, *gluten-free bread*, *sugar-free sweets*, *calcium-fortified milk*, *sodium-free salt* or *vitamin/mineral-enriched breakfast cereals*, do not belong to Class 5 and are classified following the instructions in the Nice Classification general remarks.

It should be noted that the term *foodstuffs* specified by indicating the principal ingredient or substance of the goods is not necessarily acceptable if this ingredient or substance does not clearly and precisely determine the nature of the goods.

Examples of acceptable terms:

- Class 29: *Fish-based foodstuffs*
- Class 30: *Foodstuffs made from cereals*.

Examples of unacceptable terms:

- *foodstuffs based on proteins*
- *foodstuffs based on carbohydrates*.

In neither case does the specification of the unclear term *foodstuffs* make the nature of the goods clear and precise.

6.32 Franchising

The verb 'to franchise' refers to the giving or selling of a franchise to another party. As a noun, 'franchise' means 'an authorisation granted to an individual or group to trade in a particular area for a stated period' (*Oxford English Dictionary*).

According to the general remarks in the Nice Classification (11th edition), 'Services rendered in the framework of franchising are in principle classified in the same class as the particular services provided by the franchisor (e.g. business advice relating to franchising (Cl. 35), financing services relating to franchising (Cl. 36), legal services relating to franchising (Cl. 45)).'

Without any more detailed 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.

In order to classify the term properly, it is necessary to understand the actual nature of the service.

Services rendered by the franchisor **and** provided to the franchisee most commonly include business and marketing assistance (Class 35), financial management (Class 36), training (Class 41) and, to some extent, legal assistance (Class 45). This is reflected in the Nice Classification general remarks.

Examples of how the services provided by a restaurant franchisor could be classified:

Class 35: *Business assistance relating to starting and running a restaurant franchise*

Class 36: *Financial consultancy relating to franchising*

Class 45: *Licensing services relating to franchising.*

Example of how the services rendered in the context of a franchised restaurant could be classified:

Class 43: *Restaurant services; provision of food and drink.* (This would be the principal business activity of the applicant, and the subject of the franchise.)

It is not necessary to mention that such services are provided by a franchise.

However, services provided by a franchising agency offering to find proper third-party candidates for signing a franchising contract belong to Class 35 (by analogy to procurement of commercial contracts for others). Most services rendered by franchising agencies would fall into Class 35 as being business assistance.

6.33 Gadgets

The term *gadgets (electronic or otherwise)* is considered vague in all classes and must be specified in more detail.

6.34 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 that provide the telecommunications that run the services (Class 38) and those that provide information via a 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 done as part of a telecommunication service it will be proper to Class 38. If, however, it is done as part of a criminal investigation service it will be proper to Class 45.

Other services 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 that 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.

Examples of 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 telephones 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: *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.

6.35 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] - these could also be gas operated; *crimping irons for the hair*, etc.). Exceptions are:

Class 11: *Hair dryers*

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

Class 26: *Hair curlers/rollers, other than hand implements* (e.g. clip-on, sponge or hook-and-loop fastener type).

6.36 Hire services

See *Rental services*.

6.37 Hotline services

Also services of call centres. See *Providing information*.

6.38 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*).

6.39 Internet services, online services

The term *internet services* is not sufficiently clear and precise to be accepted in any class. It must be further defined.

A range of services, offered by individuals and businesses to other individuals and businesses, relate to the setting up, operation and servicing of websites. These are covered by appropriate entries in a number of classes.

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

The Nice Classification system generally applies regardless of whether the service is provided face-to-face, on dedicated premises, over a telephone or online via a database or website. See paragraph 4.2.2.

Examples of acceptable terms:

Class 35: *Advertising services provided over the internet*

Class 36: *On-line banking services*

Class 38: *Internet service provider services*

Class 41: *On-line gaming services*

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

Class 45: *Online social networking services.*

6.40 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 that 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 great impact on (1) the acceptability as a collection of goods and (2) the appropriate classification.

A 'kit' can mean either:

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

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

Examples of the use of 'kits':

Class 3: *Cosmetic kits*

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

It sometimes happens that the individual goods that make up the kit or set would normally be classified in more than one class. However, the Office will not object to such collective terms, provided that they make sense and are in common usage on the market.

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 something is to be constructed from its components, what the finished article will be.

Examples of acceptable terms:

Class 8: *Manicure and pedicure sets*

Class 9: *Hands free kits for phones*

Class 12: *Tyre repair kits*

Class 27: *Rug making kit*

Class 28: *Scale model kits [toys]*

Toy model kits

Class 32: *Beer making kits*

Class 33: *Wine making kits.*

If coverage is sought for the specific parts of the kit, these should be specified and classified according to their function or purpose.

6.41 Leasing

According to the general remarks in the Nice Classification (11th edition), '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 Cl. 36 as a financial service.'

Note that, although the definition of *leasing* might differ across languages, for the sake of consistency it will be interpreted as indicated above, based on the meaning of the term *leasing* in English.

See also *Rental services*.

6.42 Mail order

See *Retail and wholesale services*.

6.43 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 on the manufacturer's website.

Examples:

Class 9: *Manuals in electronic format for computer software*

Class 16: **Printed** *manuals for computer software.*

6.44 Manufacturing services

Manufacturing is only seen as a service when it is undertaken for third parties. Custom manufacturing of certain single, 'one-off', goods 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.

See also *Assembly services*.

6.45 News services

'News' has no boundaries; the subject could be anything. Therefore, the term *news services* as such lacks clarity and precision, and should be specified.

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.

Other examples:

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 that are proper to Class 9.

6.46 Online services

See *Internet services*.

6.47 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 that offer services 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 analogous with the Nice Classification entry *procurement of services for others [purchasing goods and services for other business]*.

6.48 Perfuming and air freshening preparations

There are preparations, and associated apparatus, that serve merely to mask unpleasant smells (perfume) or chemically 'wrap up' and remove unpleasant odours (deodorisers). They are properly classified as follows:

Class 3: *Air fragranting 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*

Class 21: *Perfume burners*

Vaporizers for perfume sold empty.

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

6.49 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 sufficiently clear and precise and will not be accepted by the Office. See also paragraph 4.2.

The applicant needs to make the wording more specific.

Many personal and social services are classifiable but are proper to classes other than Class 45.

Examples:

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 shopping services

Concierge services.

6.50 Personal assistant services

This term is considered to be vague and needs to be explained further. Personal assistants offer assistance in managing their employer's personal and/or business life by taking over specific tasks, which, however, are not clearly defined. The activities involved could cover services proper to various different classes such as:

- *Appointment scheduling services* (Class 35)
- *Telephone answering* (Class 35)
- *Personal trainer services [fitness training]* (Class 41)
- *Personal reminder services in the area of upcoming important dates and events* (Class 45)
- *Personal fashion consulting services* (Class 45)
- *Dog walking services* (Class 45).

A similar assessment will be applied to the *lifestyle management* as this is also considered to be too vague for classification purposes.

6.51 Precious metal goods

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

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

Historically, virtually all goods 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, many goods that would have been in Class 14 have been reclassified. This reclassification of the goods is based on their function rather than the material from which they are made.

Examples of goods 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.*

6.52 Protective clothing

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

Examples of such protective goods 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 further examples: they are not clothing as such. Aprons, smocks and overalls merely protect against stains and dirt and are not proper to Class 9 but to Class 25 as general clothing. Protective sporting articles (except helmets) are proper to Class 28 as none of them protect against loss of life or limb.

6.53 Providing a website

Unless specified as website development or as hosting of the content (Class 42), these services are understood as being analogous to providing information and are classified in accordance with the subject matter they are dedicated to.

See also *Providing information*.

6.54 Providing an online platform

These services are proper to Class 42 since they are understood to refer to the provision of a computing platform. They could also refer to the provision of an operating system, a browser, an application, a virtual machine or cloud - all being software solutions.

6.55 Providing downloadable content

Provision of downloadable content is classified according to the nature of the content (see *Providing information*); the wording of the term should make this clear.

Class 41 examples:

- *Providing downloadable electronic books* (Class 41)
- *Provision of downloadable electronic games* (Class 41)
- *Providing downloadable digital music* (Class 41).

Class 42 examples:

- *Providing downloadable applications (Class 42)*
- *Providing downloadable computer operating systems (Class 42).*

As with the term *provision of information*, *provision of downloadable content* without further specification is too vague.

The retail/wholesale of downloadable content is different - this would refer to bringing together a variety of downloadable content for the benefit of third parties, making it available to users to select from and purchase.

Class 35 examples:

- *Retail services in relation to downloadable electronic publications*
- *Retail services in relation to downloadable music files*
- *Wholesale services in relation to downloadable computer software.*

6.56 Providing information

According to the general remarks in the Nice Classification (11th edition), 'Services that provide advice, information or consultation are in principle classified in the same classes as the services that correspond to the subject matter of the advice, information or consultation, e.g., transportation consultancy (Cl. 39), business management consultancy (Cl. 35), financial consultancy (Cl. 36), beauty consultancy (Cl. 44).'

Services of providing information as such are considered to be vague and must be objected to. The applicant has to define the subject matter and classify it analogously. The fact that information is provided by electronic means (e.g. telephone, computer - email, website or blog) does not affect the classification of these services.

Providing advice, consultancy and information with regard to the aforesaid services at the end of the indication of any service class will be accepted.

6.57 Rental services

According to the Nice Classification general remarks (11th edition), 'Rental services are in principle classified in the same classes as the services provided by means of the rented objects (e.g., Rental of telephones, covered by Cl. 38).'

The same principle applies to *leasing services*, which can be found in the HDB in all of the service classes.

6.58 Retail and wholesale services

Retail is defined as '[t]he 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 the term 'retail services'.

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 those goods’ is acceptable in Class 35. *Retail services* are classified analogously with 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 the judgment of 07/07/2005, C-418/02, Praktiker, EU:C:2005:425: 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 (01/12/2016, T-775/15, Ferli, EU:T:2016:699).

The 11th edition of the Nice Classification includes *retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies*, which shows how these terms can be expressed.

Examples of categories of goods that do not fulfil the requirements of clarity and precision can be found under paragraph 4.2.2.

The general indications of the class headings that are not acceptable (see paragraph 4.2.1) are also not acceptable for retail services for those same general indications. For example, the Office will not accept *retail services for machines*. However, *retail services in relation to agricultural machines* is sufficiently precise and therefore acceptable.

As regards ‘retail of services’ (i.e. *services that consist of the 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 worded with sufficient clarity and precision to allow the competent authorities and other economic operators to know what services the applicant intends to bring together (10/07/2014, C-420/13, Netto Marken Discount, EU:C:2014:2069).

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, EU:C:2005:425).

Terms expressing this should satisfy two requirements. Firstly, they should include familiar terms (i.e. ‘bringing together’, ‘for the benefit of others ...’ or ‘enabling customers to compare and purchase ...’) in order to ‘frame’ the services being brought together and describe the actual retail activity itself. Secondly, the terms used to describe the services being brought together must be understood and accepted in their own right (e.g. legal services, broadcasting services, slimming club services.).

In order to meet the fundamental requirements for clarity and precision under Article 33(2) EUTMR, any claim to the retailing or ‘bringing together’ of services must be worded in this manner.

Examples that will be considered 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.

Examples that will 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 of obtaining duplicate protection for 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 of providing protection for the advertising of one's own services. Therefore, 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 so as to enable consumers to compare and purchase those services conveniently.

Finally, it is not sufficiently precise to specify the goods or services using terms such as 'including', 'in particular', 'for example', 'featuring' or 'such as', since all these terms mean, in principle, 'for example'. They do not restrict the goods or services that follow. Consequently, the abovementioned terms should be replaced by 'namely' or 'being', as they do restrict the goods or services that follow.

6.59 Retail of pre-paid cards

The term *retail of pre-paid cards* without a further specification lacks clarity and precision; the nature of the cards is not clear. Therefore, the exact market sector for which the cards are meant should be specified.

Examples of **acceptable** terms:

Class 35: *Retail of third-party pre-paid cards for the purchase of entertainment services*

Class 35: *Retail pre-paid cards for the purchase of clothing.*

6.60 Robots

The term *robots* lacks clarity and precision; therefore, the nature of the goods has to be specified.

Examples of **acceptable** terms:

Class 7: *Industrial robots*

Class 9: *Humanoid robots with artificial intelligence*

Class 10: *Surgical robots.*

6.61 Satellite tracking

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

6.62 Sets

See *Kits and sets.*

6.63 Smartwatches and activity bracelets

The Nice Classification shows *smartwatches* in Class 9. These goods are seen as having the function more of communication devices than horological instruments; other similar additions in Class 9 are the terms *wearable activity trackers*, *connected bracelets [measuring instruments]* and *smartglasses*, all of which clearly show that the primary function and purpose of the goods dictate their classification.

6.64 Social networking services

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

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

Class 38: *The operation of chat room services*

The provision of online forums.

6.65 Software publishing

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

6.66 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*.

6.67 Statistics

Regardless of the subject matter, *compilation of statistics* is proper to Class 35 as it is analogous to 'compiling of data'.

Nevertheless, statistics have to be treated as information. Therefore, *providing statistics* will also be considered vague unless the subject matter is defined. Consequently, the classification once again depends on the subject matter.

Examples:

Class 35: *Providing market research statistics*

Class 39: *Providing statistics on traffic flow*

Class 42: *Providing statistics with regard to rainfall.*

Other services connected with statistics may be classified differently and include:

Class 38: *Providing access to statistical data*

Class 41: *Publication of statistics*

Class 42: *Scientific analyses of research statistics.*

6.68 Storage services

See *Collection and storage services*.

6.69 Supply of ...

Care should be taken in accepting 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, which are proper to Class 35.

6.70 Systems

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

It can be accepted only when qualified in a clear and unambiguous way.

Examples of acceptable terms:

Class 7: *Exhaust systems*

Class 9: *Telecommunication systems*

Computer systems

Alarm systems

Class 16: *Filing systems*.

6.71 Tickets (for travel, entertainment, etc.)

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

Examples:

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.

6.72 Tourist/Holiday services

The terms *tourist services*, *holiday services* as well as *tourist office services* are not sufficiently clear or precise, as they can relate to different areas of activity, and services belonging to different classes. The terms must be defined further.

Examples of **acceptable** terms:

Class 39: *Providing tourist travel information*

Class 43: *Tourist agency services for booking accommodation.*

6.73 Video games

See *Computer games*.

6.74 Virtual environment

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

Examples of acceptable terms:

Class 38: *Providing a virtual chatroom*

Providing access to a virtual environment

Class 42: *Hosting of a virtual environment*

Maintenance of a virtual environment.

6.75 Wellness services

The term *wellness services* is not sufficiently clear or precise, and needs to be specified in more detail. This is because there is currently no definition of such services that would put them into one - and only one - class. Despite being a known market phenomenon, the interpretation of the scope of this service is not entirely clear and can differ from one enterprise to another.

Note that *wellness services provided in beauty salons* or similar indications will not render the term acceptable.

Examples of acceptable clarifications:

Class 41: *Instruction in exercise as wellness club services*

Teaching of meditation as part of a wellness programme

Class 44: *Wellness services for the purpose of beauty care*

Health spa services for wellness

Relaxing massage in wellness centres

Class 45: *Spiritual consultancy aimed at wellness.*

Obsolete