



## WORLD INTELLECTUAL PROPERTY ORGANIZATION

34, chemin des Colombettes, P.O. Box 18, CH-1211 Geneva 20 (Switzerland)  
‡ (41-22) 338 91 11 – Facsimile (International Trademark Registry): (41-22) 740 14 29  
e-mail: [intreg.mail@wipo.int](mailto:intreg.mail@wipo.int) – Internet: <http://www.wipo.int>

### **PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

#### **Change of Practice regarding “Retail Services” in the United Kingdom**

During the Eighteenth Session of the Committee of Experts of the Special Union for the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Union), the United Kingdom delegation communicated a note to the Secretariat of the Committee outlining the new position of the United Kingdom Patent Office with regard to “retail services.” An extract of the note is reproduced in the Annex hereafter for the attention of users of the Madrid system who claim protection for “retail services” in international applications designating the United Kingdom. All the expressions mentioned in the note as acceptable by the United Kingdom Patent Office are accepted by the International Bureau.

February 5, 2001

**Extract from the note by the United Kingdom Patent Office**

...What Will Be Accepted?

Although there is no relevant entry in Schedule 3 to the Trade Mark Rules 2000, the 7<sup>th</sup> edition of the International Classification of Goods and Services (Nice Classification) includes an explanatory note that Class 35 includes:

“The bringing together, for the benefit of others, of a variety of goods (excluding the transportation thereof), enabling customers to conveniently view and purchase those goods.”

There is no corresponding entry in the alphabetical list of services in Class 35 indicating that the wording in the explanatory note is a general indication rather than a specific description of a service. The Registrar will not object to this description of services in Class 35 provided that the nature of the retail service and (where this is not clear from the nature of the retail service) the market sector are also indicated. In the absence of such indications, objection will be taken under Section 3(6) of the UK Trade Marks Act 1994, on the grounds that without an indication of the means of bringing together goods and displaying them, the description in the explanatory note is too wide to be a proper description of any one retailer’s services.

In the case of department stores, supermarkets, hypermarkets, convenience stores etc, the following specifications will be allowed in Class 35:

**The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store.**

Or

**The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a supermarket.**

In the case of specialist retail outlets, it will be necessary to specify the type of store by market sector, e.g.:

**The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail clothes store.**

Or

**The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail off licence store.**

Or

**The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail electrical store.**

Or

**The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail pharmacy.**

Or

**The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail furniture store.**

It is not appropriate to provide an exhaustive list of the goods brought together etc, because the specification should focus on the characteristics of the *service* provided. An indication of market sector is required but this is usually clear from the type of retail outlet specified.

### Mail Order and Electronic Shopping

The reasoning set out above suggests that it should be possible in some circumstances to register a trade mark in respect of the bringing together of goods through a catalogue or electronic shopping media. It is doubtful whether promoting one's own goods in a brochure or on an internet site provides any service. The Registrar will accept applications to register trade marks in respect of services comprising the bringing together of a variety of goods of other traders in a catalogue or through an electronic media, for the benefit of others.

As with retail store type registrations, some indication of the field of activity is necessary to avoid objections on the grounds that the descriptions are too broad and/or too vague. The Registrar will nevertheless accept specifications in Class 35 for:

**The bringing together, for the benefit of others, of a variety of goods, through a television shopping channel, enabling customers to conveniently view and purchase those goods by means of telecommunications.**

It is recognised that television shopping channels (like department stores) bring together a very wide and changing range of goods.

In other cases, e.g. catalogues, internet shopping, computer shopping, electronic shopping, online shopping, e-commerce etc, the mode of operation may not itself be sufficient to reveal the scope of the service and it will normally be necessary to specify the field of activity in order to avoid an objection under Section 3(6). For example:

**The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a clothing and accessories catalogue by mail order or by means of telecommunications.**

Or in the case of where a broader indication is justified, for example, when such services are provided in relation to a miscellaneous goods catalogue:

**The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order or by means of telecommunications.**

Similarly, in respect of services provided by a specialist e-commerce retailer through the internet, the following type of specification might be appropriate in the case of, for example, a sports goods supplier:

**The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from an internet web site specialising in the marketing of sports wear and equipment.**

Or if the e-tailer markets a wide range of miscellaneous goods, the following may be justified:

**The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise internet web site.**

### Wholesale

The same general practice will apply to providers of wholesale services. The Registrar will accept:

**The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a wholesale outlet.**

### What Won't Be Accepted

For reasons stated under paragraph 4 above, the statement “ the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods”, will not be accepted without further qualification.

In the case of Dee Corporation plc and Others Trade Mark Application [1990] RPC page 168, Falconer J said in relation to “retail services”:

*“Moreover, that definition is too indefinite to provide an identifiable specification of the service or services for a registration so that any person could know whether he would infringe or not”.*

Therefore, the following terms are considered too vague and/or too broad and are unable to serve as adequately defined statements of services:

Retail services;  
Retail store services;  
Retailing  
Department store services;  
Shops;  
Factory shops [shops on factory premises];  
Shopkeeping;  
Merchandising;  
Distributorship;  
Supply or provision of goods;  
Sales services;  
Direct selling;  
Mail order;  
Mail order catalogue services;  
Catalogue services;  
Television shopping;  
Electronic shopping;  
Internet shopping;  
Computer shopping;  
Online shopping;  
E-commerce;  
E-tailing.

This list is not exhaustive.

Objections will be taken against applications which include the above and similar terms under the Section 3(6) of the UK Trade Marks Act 1994 because these terms are too broad in their scope.

**As indicated by the examples shown in the preceding paragraphs of this notice, many of the above terms, if appropriately qualified, may be incorporated into specifications which are capable of providing sufficiently clear statements of services.**

[End of Annex and of document]