



Roundtable Irregularities

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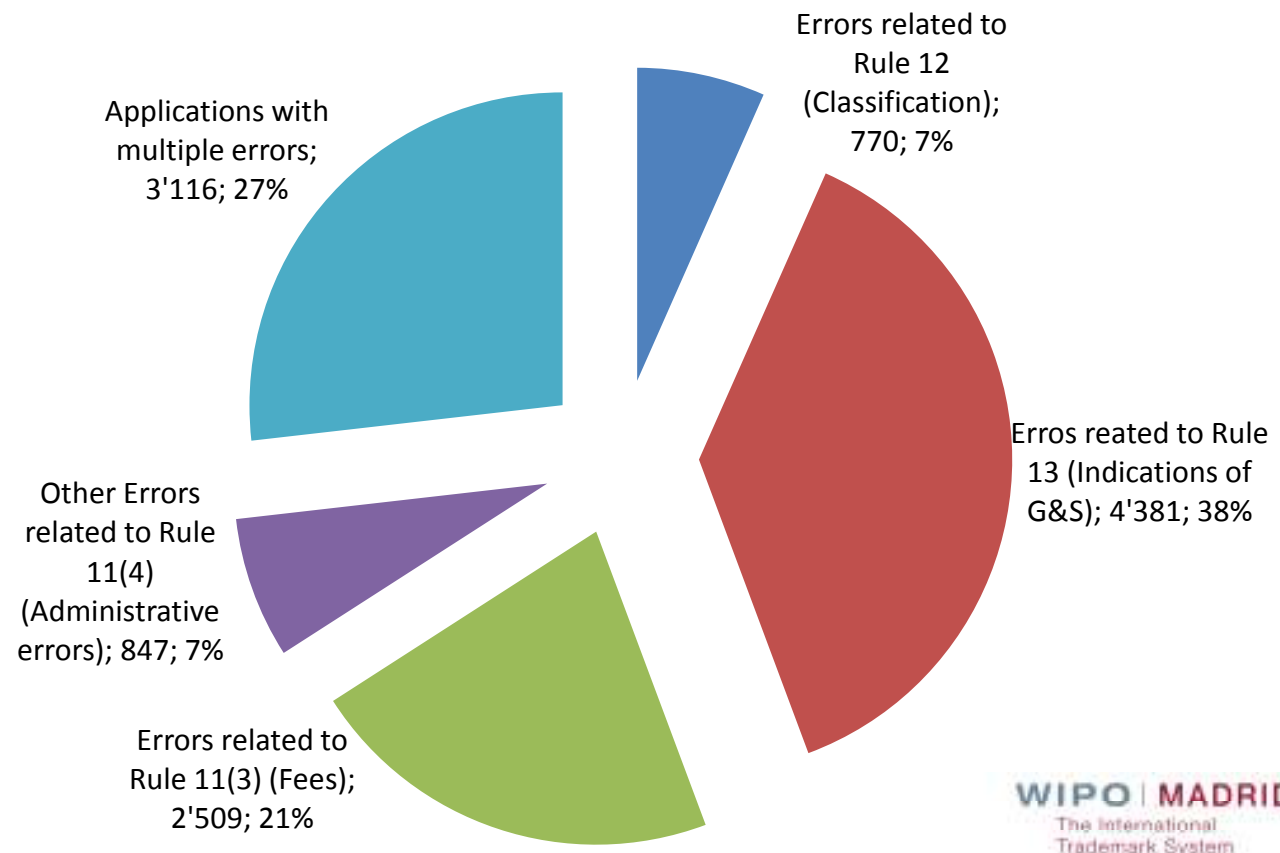
International Applications - Irregularities

Total Number of International Applications: 32.008 (January - August 2015)



Breakdown of Irregularity letters in the Madrid system (January – August 2015)

International applications filed 32,008
Total Number of Errors 11,060
Total Number of Irregularity Letters 11,623



Classification

- Important part of the registration process
- Specify the products and services to which a trademark will apply and defines the scope of protection the trademark will enjoy

Classification is a balancing act

- Terminology that describe the products/services precisely enough – not too narrow and not too broad
- Avoid irregularities from the IB and refusals in designated Contracting Parties



Classification – role of the IB

- The IB shall register the international applications “with the classifications and grouping that the IB considers to be correct”.
- Different practices among Contracting Parties



The IB principles – Classification of G&S

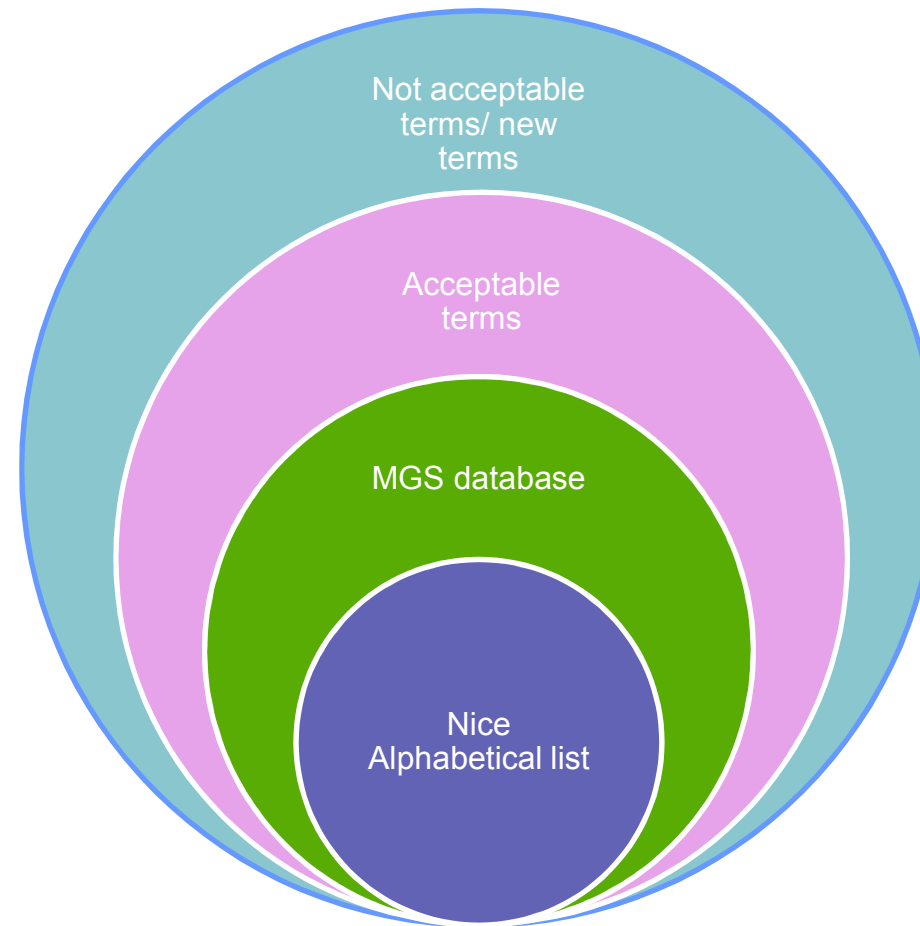
- Alphabetical list of the NICE classification
- Explanatory notes to the NICE classification
- The “General remarks” for G&S in the NICE classification
- The class number defines the scope of the product/service
(with exceptions)
- Internal guidelines

Principles – Classification of G&S

- Internal guidelines - examples
 - Singular/Plural terms
 - AU, GB or US English accepted indifferently
 - Brackets and inversions
 - Doubles

- Obvious spelling errors – correct ex officio?

Internal database



Examples - irregularities

Too vague terms

IT services in class 42

Incomprehensible terms – Rule 13(2)(b)

- “administrative goods and office wares” in class 35
- “anti-inject water pipe month” in class 7

Linguistically incorrect/ incomprehensible - Irregularities?

- “live jackets” in class 9 > “life jackets”
- “jackets of hood” in class 25 > “hooded jackets”

Inconsistent practices - examples

- Nice alphabetical list
 - Many Contracting Parties accept the full list
 - Some Contracting Parties reject terms in the list
- Nice class headings
 - Many Contracting Parties accept all the terms in the Class headings
 - Some Contracting Parties reject terms
- Brackets
 - Acceptable or not
- Duplicates
 - Accepted or not

Discrepancy ?

- Five of the eleven terms are rejected by OHIM but will not change in the Nice version 2016

- Class 7: machines and machine tools
- Class 37: repair
- Class 37: installation services
- Class 40: treatment of materials
- Class 45: personal and social services rendered by others to meet the needs of individuals

- Terms accepted by WIPO but refused by EU states and OHIM

Discrepancy?

- 6 terms were changed *in the class headings*, examples;
 - plastic materials for packaging [not included in other classes] > **plastic materials for packaging**
 - ...precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes > **precious metals and their alloys**

- Are the old terms acceptable?