Classification of goods and services

- Important part of the trademark registration process

- To specify the goods and services to which a trademark will apply and define the scope of protection the trademark will enjoy
Classification is a balancing act

- Terminology that describe the goods & 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 indication of classes given by the applicant shall be subject to control by the International Bureau” (Article 3.2. of the Protocol)
Role of the IB

- Check if goods and services in international applications are:
  - grouped in the appropriate classes of the Nice Classification
  - the goods and services are indicated in precise terms
- Rule 12 and Rule 13 of the Common Regulations
International Applications: irregularities

With errors; 19,207; 39%

With no errors; 30,085; 61%
Breakdown of irregularity letters

- Rule 13 (Indications of G&S): 51%
- Rule 11(3) (Fees): 28%
- Other Errors related to Rule 11(4) (Administrative errors): 11%
- Rule 12 (Classification): 10%
Nice Classification

- Nice Agreement of 1957
- 149 States & WIPO follow the classification
- 10 editions and new versions every year
- 11 edition in 2017
- Changes to 12 class headings
“Source” for classification

- Class headings
- Alphabetical list of the Nice Classification
- Explanatory notes to the Nice Classification
- The “General remarks” for G&S in the Nice Classification
- Guidelines
- Madrid Goods & Services Manager (MGS)
Guidelines

- Requested by Member States in the Roundtable in November 2015
- Introduced as a draft to the Members of the Madrid System in the Roundtable 17th of June 2016
- For discussion and comments until 1st of October 2016
Guidelines

The purpose:

- Inform the Madrid System users of the practices followed by the IB
- Support users when listing goods and services
- Increase the predictability of examination in the IB
- Set an example for the practices in the Member States
Guidelines

- Include only the principles applied by the IB
- Provide general guidance to the users of the Madrid System
Guidelines
Three main Sections

- General information about the Nice Classification and the Madrid System
- Classification principles applied by WIPO
- Practical information on the acceptable format to list indications of goods and services
Guidelines - Classification principles

- Class headings
  - The IB accepts the Class headings and the general indications in the Class headings
Guidelines - Classification principles II

- Indications that can be classified in more than one class
- The IB takes into account the class number indicated in the international application which provides the context within which the product is to be considered.
Specification needed for indications that can be classified in **more than one class** according to **more than one** of the following criteria: *purpose*, *material*, *function*, *mode of operation* or *nature*. 
Use of certain expressions (namely, all other services..)

Classification of specific goods and services (kits, electronic games…)

Use of trademarks, geographical indications or appellations of origin in the list of goods and services
Guidelines – Formatting the list

• Punctuation
• Use of capital letters
• Duplicate indications
• Names of goods and services in singular or plural form
• Use of abbreviations or acronyms
• Use of brackets
Classification Guidelines

Draft Examination Guidelines Concerning the Classification of Goods and Services in International Applications