

Classification

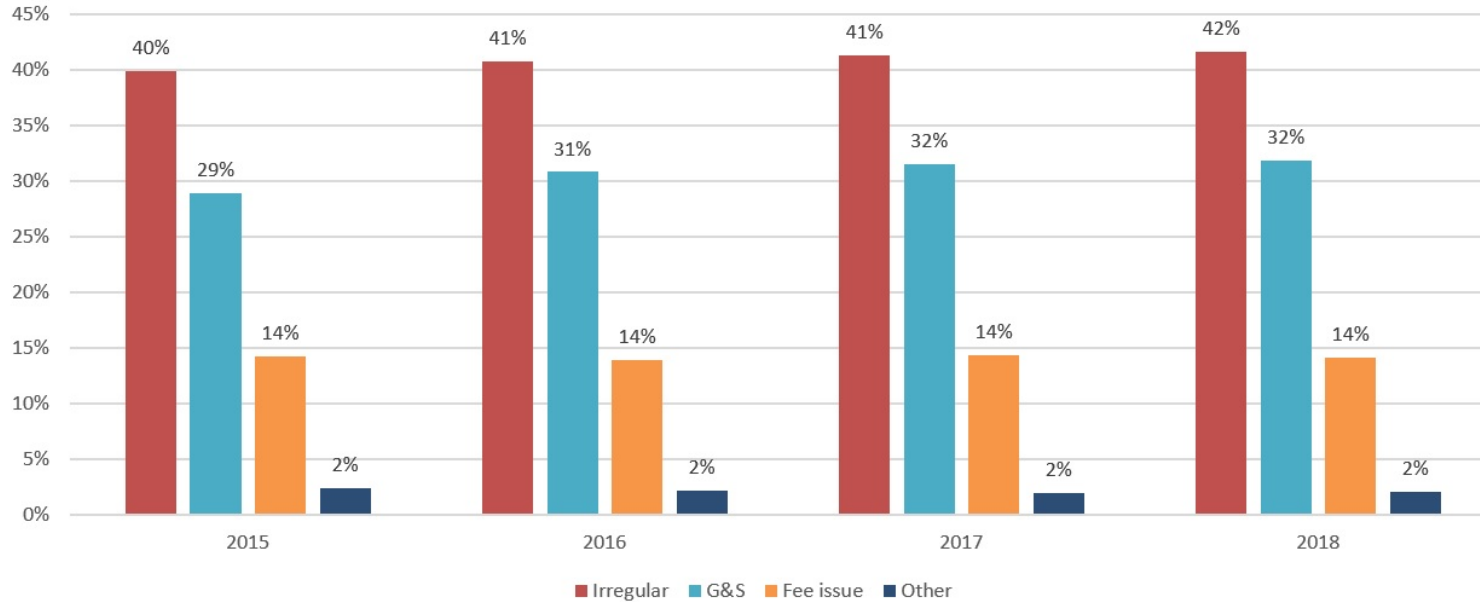
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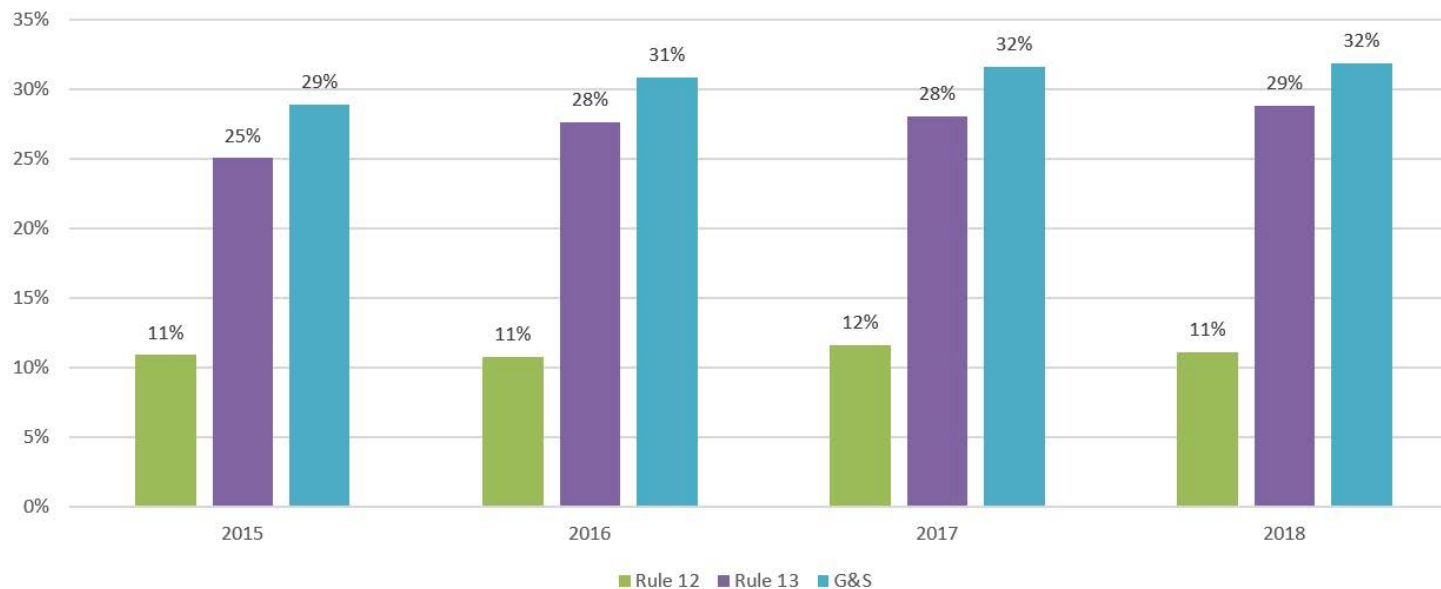
Irregularity rate

Irregularity Rate 2015-2018



Irregularity rate

Irregularity Rate - Goods & Services 2015-2018



MADRID GOODS & SERVICES MANAGER (MGS)

MGS - background

- Initially a project in 2009
- Aim:
 - Develop and deploy a database of acceptable indications of goods and services
 - Cooperating with interested Contracting parties on the translation of the database
 - Check acceptance information – added later

MGS - background

- IB's database of acceptable terms for goods and services
- Highest volume in English
- Fully aligned with the latest version of Nice 11th edition
- “Check acceptance” feature for 35 Member States
- “Similar group codes” feature for IP Offices of Japan and Republic of Korea (KIPO)

MGS - languages

- Available in 20 languages, as of 10 July 2019
 - 3 working languages – English, French and Spanish
 - 17 language versions – Arabic, Chinese (simplified), Dutch, Georgian, German, Hebrew, Italian, Japanese, Korean, Mongolian, Norwegian, Portuguese, Russian, Serbian, Turkish, Ukrainian and Vietnamese
 - In the pipeline – Khmer, Iranian, Indonesian and Laotian

MGS - size

- Indications of G&S acceptable to the IB (as of 10 July 2019)
 - 104,300 English indications
 - 63,500 French indications, and
 - 60,300 Spanish indications
 - Roughly an average of 520 EN, 515 FR and 550 ES indications of G&S added per month

MGS – feedback from users

■ Singapore IP Office:

“We try to incorporate the MGS terms into our internal goods and services checking system to aid our examiners in the checking of the acceptability of the list of goods and services. This has been very helpful to our examiners, especially for examining International Registrations designating Singapore. We also find that our users do consult the MGS and also use the “check acceptance by DCP” function. For this reason, we actively seek to update our acceptance status of the MGS terms and hence our frequent emails to request for the latest MGS lists”.

MGS: feedback from users

■ Japan IP Office:

“MGS provides us the color-coded acceptance by designated Contracting Party, so we can understand easily whether each indication of goods or services is accepted by them. Also, MGS has useful functions like translating function to multiple languages and search function in multiple languages. Thanks to MGS, we can consider JPO’s practices with referring to WIPO and other Offices’ points of view”.

MGS – feedback from users

- *It is clear and helps us to obtain clarification and precision about the descriptions*
- *I think that most of the times is really easy to find the terms you are searching*
- *This brings solutions to uncommon terms and a rather exhaustive vision of the classes to aim and libellated that can be filed with respect to this or that term*
- *It is a very intuitive and smart tool. It is updated to the last version of the Nice Edition.*
- *We appreciate the fact that MGS allows to export lists of goods/services in word format and that it is a very useful tool for translating many terms, very quickly*

For Offices with National G&S Databasis

- IB welcomes your participation in our MGS database. Should you be interested in being part of this wonderful classification tool, please contact:

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2019 EXAMINATION GUIDELINES

Background

- Introduced in the Roundtable of the Working Group for the Legal Development of the Madrid System in June 2016. (1st version)
- Contracting Parties of the Madrid System and users' organizations were given opportunities to send their comments
- Following the same procedure, updated versions were introduced in the Roundtable meetings of June 2017 and July 2018. (2nd and 3rd version, respectively)

Background

- Series meetings held to discuss new development of practice at the IB as well as comments / feedback received from member offices and user organizations.
- The 2019 Examination Guidelines (4th version) was updated and made available online.
- To be made available in French, Spanish, Chinese, Arabic and Russian.

Policy of updating

- Feedback from private users and Offices is asked
- Yearly update is intended to continue
- For the present update, a series of formal meetings summarized the practices of the International Bureau
- 4 Team meetings were also needed to summarize the comments received from Offices and private users

Comments received in 2018

- 10 feedbacks / comments received from Member Offices and observers, including a prospective member
 - CH, EM, JP, MD, NO, SG, US, CA
 - ECTA, MARQUES

Comments received in 2018

Contracting Parties	Guideline Section Heading											
	2.2	2.3	2.4	2.5.1	2.5.3	2.5.4	2.6	2.7	3.1	3.2	3.5	OC
CH						X	X	X				X
EM	X	X	X	X			X	X				X
JP			X									
MD												X
NO			X				X					
SG				X	X		X				X	
US	X		X				X					X

Other Organizations	Guideline Section Heading											
	2.2	2.3	2.4	2.5.1	2.5.3	2.5.4	2.6	2.7	3.1	3.2	3.5	OC
ECTA	X	X	X	X	X	X		X	X	X		X
MARQUES						X	X	X				

Upcoming Member	Guideline Section Heading											
	2.2	2.3	2.4	2.5.1	2.5.3	2.5.4	2.6	2.7	3.1	3.2	3.5	OC
CA				X			X					

Comments received in 2018

- 2.2. General principles for the control of the indications of goods and services listed in an international application – *3 feedbacks*
- 2.3. Class headings – *2 feedbacks*
- 2.4. Indications that can be classified in more than one class – *5 feedbacks*
- 2.5.1. Use of “in particular”, “namely”, “i.e.” and similar expressions – *4 feedbacks*

Comments received in 2018

- 2.5.3. Claims for “all goods” or “all other services” in a given class – *2 feedbacks*
- 2.5.4. Reference to other classes within the list – *3 feedbacks*
- 2.6. Classification of specific goods and services – *7 feedbacks*
- 2.7. Use of proprietary names – *4 feedbacks*

Comments received in 2018

- 3.1. Punctuation – *1 feedback*
- 3.2. Use of capital letters and special characters – *1 feedbacks*
- 3.5. Use of the definite article – *1 feedback*
- Other comments – *5 feedbacks*

Changes in Version 2019

❖ Examples added to illustrate better the examination policy

■ 2.4. Indications that can be classified in more than one class

1. Purpose: When a particular product may be classified in more than one class according to its intended purpose and any of the applicable classes has been indicated, the International Bureau will accept this indication.

For example, the term “sea water / [seawater](#)” would be accepted in

- [Class 1](#), which includes “[seawater for industrial purposes](#)”
- [Class 5](#), which includes “sea water for medicinal bathing”
- [Class 30](#), which includes “sea water for cooking”

Changes in Version 2019

■ 2.4. Indications that can be classified in more than one class

3. Function: When a particular product may be classified in more than one class according to its function and any of the applicable classes has been indicated, the International Bureau will accept this indication.

For example, the term “robots” would be accepted in

- Class 7, which includes industrial robots
- Class 9, which includes “humanoid robots with artificial intelligence”, “laboratory robots”, “teaching robots”, “security surveillance robots” and “telepresence robots”
- Class 10, which includes surgical robots
- Class 28, which includes toy robots

Changes in Version 2019

■ 2.5.1. Use of “in particular”, “namely”, “i.e.” and similar expressions

Applicants frequently include certain expressions in the list of goods and services to further specify, (for example “in particular”, “especially”, “including”) or to restrict (for example “namely”, “i.e.”) the list of goods and services. The International Bureau accepts these expressions when they are followed by the names of specific goods or services.

For example:

- Class 9: Computer software, in particular computer game software
- Class 12: Cars, namely, sports cars
- Class 21: Fitted picnic baskets, including dishes

Changes in Version 2019

❖ Additional texts to illustrate better the examination policy

■ Added texts as the last two paragraphs for Section 2.6.(g) Kits

Similarly, the International Bureau would not accept kits that have a stated purpose and are composed of goods that can be classified in various classes. In this particular case, the applicant would have to list each good under its appropriate class. Examiners shall raise an irregularity under Rule 12 where the list of goods in an international application contains the word “kit” or “kits” followed by a list of goods that can be classified in different classes.

Changes in Version 2019

❖ Additional texts to illustrate better the examination policy

■ Added texts as the last two paragraphs for Section 2.6.(g) Kits

For example, “cosmetic kits comprising foundations, concealers, mascara, eyeliners, tissues of paper for removing make-up, make-up brushes and make-up sponges” shall be classified as follows: “cosmetic kits comprising foundations, concealers, mascara and eyeliners” in Class 3; “tissues of paper for removing make-up” in Class 16; “make-up brushes and make-up sponges” in Class 21.

Changes in Version 2019

■ 2.7. Use of proprietary names

Some international applications, **certified by the Office of Origin**, include proprietary names in the list of goods and services for which registration is sought.

Examination policy

The International Bureau **accepts** the use of any proprietary names **which identify** the product for which registration is sought in a manner that **allows or enables** its proper classification in accordance with the Nice Classification.

Changes in Version 2019

■ 2.7. Use of proprietary names

For example:

- Class 12: Caterpillar tractors
- Class 25: Adidas shoes

Otherwise, the International Bureau will consider the term irregular under Rule 13 as too vague for the purposes of classification.

Notable feedbacks / comments

- The use of proprietary names, appellations of origin or geographical indications is unacceptable and contrary to the fundamental principles of trademark law.
- All examples provided in the Examination Guidelines should be found in the Alphabetical List. Several of the examples provided are not found in the Alphabetical List and therefore the examples may not agree with the practices followed by the national offices.
- IB's practice in considering all Class Headings or their general indication is not in line with the practice of some Offices

Notable feedbacks / comments

- It is unclear from the deletion of Section 2.6.(j) whether or not the term “repair services” remains acceptable to the International Bureau.
- The IB has indicated that the use of the definite article “the” to precede an indication of goods or services is not necessary and should therefore be avoided. More clarity on whether the IB will accept the description or issue an irregularity notice in such cases.