



# CarIPI TM classification webinar

Thom Clark, 19<sup>th</sup> May, 2020



CARIFORUM



EU-CARIFORUM Regional project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

[www.caripi-hub.com](http://www.caripi-hub.com)

# CONTENT

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Nice Classification:

Trends, headings and terms

Terms lacking clarity and precision:

Class headings, case law, good practice

Databases

Terms, languages and uses

# The Nice Classification

# The Nice Classification

Administered by WIPO

11<sup>th</sup> Edition, 2020 version now in force

- Now one version per year
- New edition every 5 years

Committee of Experts

- Meeting every year
- 88 contracting parties
- EUIPO observer status



# The Nice Classification

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## EUIPO involvement:

- Changes to class headings
- Revision of explanatory notes
- Cooperation with WIPO
- Cooperation with National Offices

# The Nice Classification

## Class headings

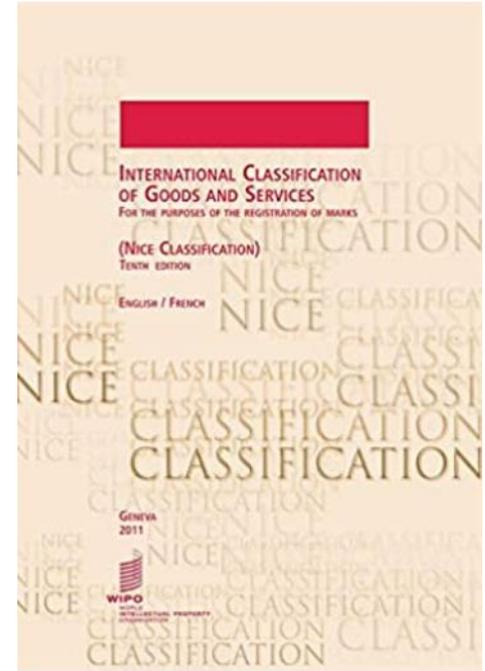
(general indications relating to the fields to which, in principle, the goods or services belong)

## Explanatory Notes

(describe in greater detail the types of products or services included in that class)

## Alphabetical list terms

(indications of goods or services)



# The Nice Classification

## Databases

++ + Browse terms  
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⚙ Results settings ▾

🔗 Link to this page

Show sources and offices ▾

🔊 Hide tree structure

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### EDITION-VERSION

11-2020 ▾

### OTHERS

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### CLASS INDEX

#### GOODS

1 2 3 4 5 6 7 8 9 10

11 12 13 14 15 16 17 18 19 20

21 22 23 24 25 26 27 28 29 30

controlling and monitoring aircrafts,  
watercrafts and unmanned vehicles

apparatus and instruments for  
controlling and monitoring unmanned  
vehicles

apparatus and instruments for  
controlling and monitoring  
watercrafts

apparatus and instruments for  
microscopy

Classes

Alphabetical

Class Headings

General Remarks

Modifications

Search

090307 **acid** hydrometers

090010 **acidimeters** for batteries

090014 **acoustic** alarms / **sound** alarms

090015 **acoustic** conduits

090593 **acoustic** couplers

090018 **actinometers**

090730 electrical **adapters**

090019 **adding** machines

090045 **aerials** / **antennas**

090020 **aerometers**

AC/DC power supplies

090627 abacuses

acoustic transformers

090018 actinometers

air traffic control systems

090037 amplifiers

amplifiers for bass guitars

animal signalling rattles

apparatus and instruments for controlling and monitoring aircrafts

apparatus and instruments for microscopy

	Harmonised	Harm	Nice	IDli	Grou	MGS
	✓	⊙				
	✓	⊙				
IS	✓	⊙				⊙
software	✓	⊙				
graphics	✓	⊙				
IS	✓	⊙				
	✓	⊙				

# The Nice Classification

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## Use of the class headings

- Clear and precise?
- Usual and literal meaning?
- Cover all terms?

## Use of explanatory notes

- Define scope?
- Clear and precise?

## Use of alphabetical list terms

- Obligatory?
- Indications only?
- Clear and precise?

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# Clear and precise?



Terms lacking clarity and precision

## Terms lacking clarity and precision

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### IP Translator (case C-307/10)

- Absolute grounds objection against application in Class 41: *Education; providing of training; entertainment; sporting and cultural activities*
- Office practice at the time: “the use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within this particular class” (Communication 4/03, point IV)

# Terms lacking clarity and precision

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## IP Translator (case C-307/10)

- Should goods and services be identified with clarity and precision? 
- Does this level of clarity and precision mean that the class headings should not be used? 
- Does this preclude the use of all the general indications of a class heading from being considered to be a claim with regard to all the goods/services of that class. 

# Terms lacking clarity and precision

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Reassessment of scope of class headings

Reassessment of general indications in class headings

Reassessment of clarity and precision

# Terms lacking clarity and precision

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## SKYKICK (Case [C-371/18](#))

- Can a trademark be declared invalid on the ground that terms used to designate the goods and services lack in clarity and precision?
- If so, do terms such as ‘computer software’ meets that requirement of clarity and precision?
- Does it constitute bad faith to apply for goods and services which are not intended to be used?

## Terms lacking clarity and precision

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SKYKICK [Opinion](#) of the Advocate General:

- A trademark cannot be declared invalid on the grounds that the terms used lack clarity and precision.
- The requirement of clarity and precision may be covered by grounds for refusal or invalidity of marks which are contrary to public policy.
- Terms such as *computer software* do lack clarity and precision.
- Bad faith may be applicable if there is no intention to use the goods and services applied for.

## Terms lacking clarity and precision

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### SKYKICK (Case [C-371/18](#))

- Can a trademark may be declared invalid on the ground that terms used to designate the goods and services lack in clarity and precision? 
- If so, do terms such as 'computer software' meets that requirement of clarity and precision? 
- Does it constitute bad faith to apply for goods and services which are not intended to be used? 

# Terms lacking clarity and precision

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## Clarity and precision: application terms

Class 9      *Electronic apparatus and instruments*

Class 29     *Food*

Class 36     *Charitable services*

Class 40     *Manufacturing services*

Class 44     *Wellness services*

Class 45     *Humanitarian services*

# Terms lacking clarity and precision

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Clarity and precision: Nice

Unacceptable class headings:

Class 7      *Machines*

Class 37     *Repair; installation services*

Class 40     *Treatment of materials*

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

## Terms lacking clarity and precision

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### Clarity and precision: the application

- Scope of the original application
- Use of list of goods and services for comparisons purposes
- Comprehensible before relevant authorities

# Terms lacking clarity and precision

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## Clarity and precision: challenges for offices

- Long lists
- User-defined terms
- Manual examination of application

# Databases

## Databases

**EDITION-VERSION**

11-2020

**OTHERS**

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**CLASS IND**

**GOODS**

1 2 3 4

11 12 13 14

21 22 23 24

**Class 9**

9 Scientific, research, navigati  
teaching apparatus and instr  
electricity; apparatus and instr  
or analogue recording and storage mec  
divers' masks, ear plugs for divers, nos

090037 35mm cameras  
AC/DC power supplies

090627 abacuses

090018 acoustic transformers

090018 actinometers

090037 air traffic control systems

amplifiers

amplifiers for bass guitars

animal signalling rattles

apparatus and instruments for controlling and monitoring aircrafts

apparatus and instruments for microscopy

**Browse terms (Taxonomy)**

**Classification** 8.061

**Goods** 8.061

**Class 9** 8.061

- ▶ Recorded content
- ▶ Information technology and audio-visual, multimedia and photographic devices
- └ Magnets, magnetizers and demagnetizers
- └ Scientific and laboratory devices for treatment using electricity

Results settings ▾ Link to this page Show sources and offices ▾

Hide tree structure

Displaying 1 - 25 of 8,061 results Page 1 of 323

	Class	Term	Harmonised	Harm	Nice	IDli	Grou	MGS
<input type="checkbox"/>	9	2-in-1 laptops	✓	⊙				
<input type="checkbox"/>	9	3-D glasses	✓	⊙				
<input type="checkbox"/>	9	35mm cameras	✓	⊙				⊙
<input type="checkbox"/>	9	3D animation software	✓	⊙				
<input type="checkbox"/>	9	3D computer graphics software	✓	⊙				
<input type="checkbox"/>	9	3D eye glasses	✓	⊙				
<input type="checkbox"/>	9	3D glasses	✓	⊙				

## TMClass:

- 85.106 terms
- Terms divided into concepts (synonymous groupings)
- Concepts include master and variant terms
- Base language English
- All concepts exist in all EU languages
- Other translations available (38 languages in total)

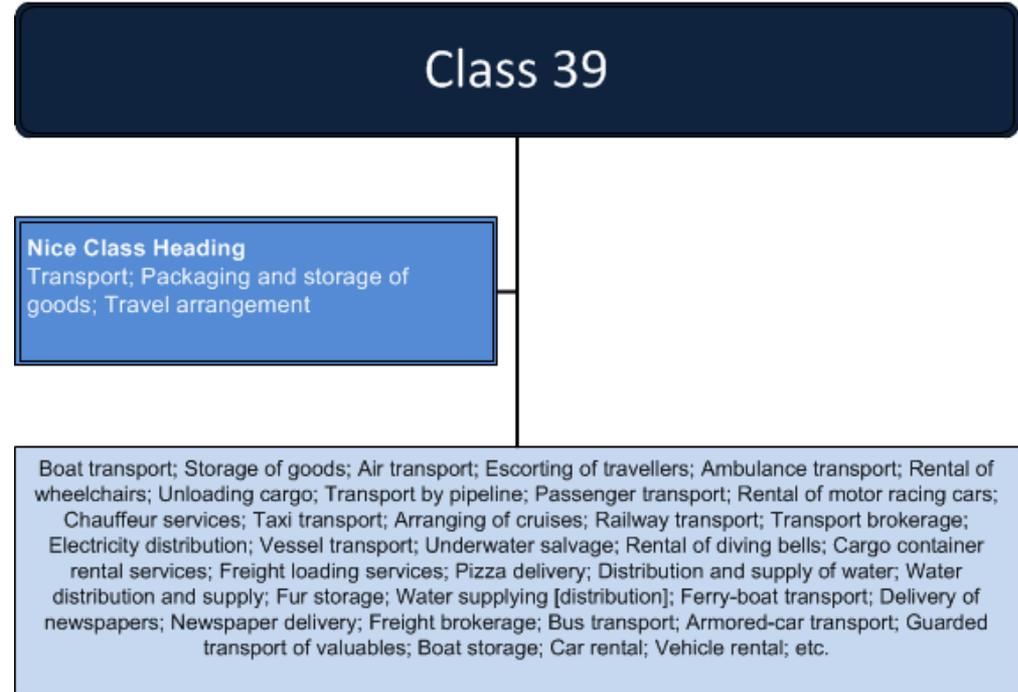
## Sources:

- Nice alphabetical list
- MGS terms
- ID List (CNIPA, JPO, KIPO, USPTO)
- User suggestions
- Frequently-used terms

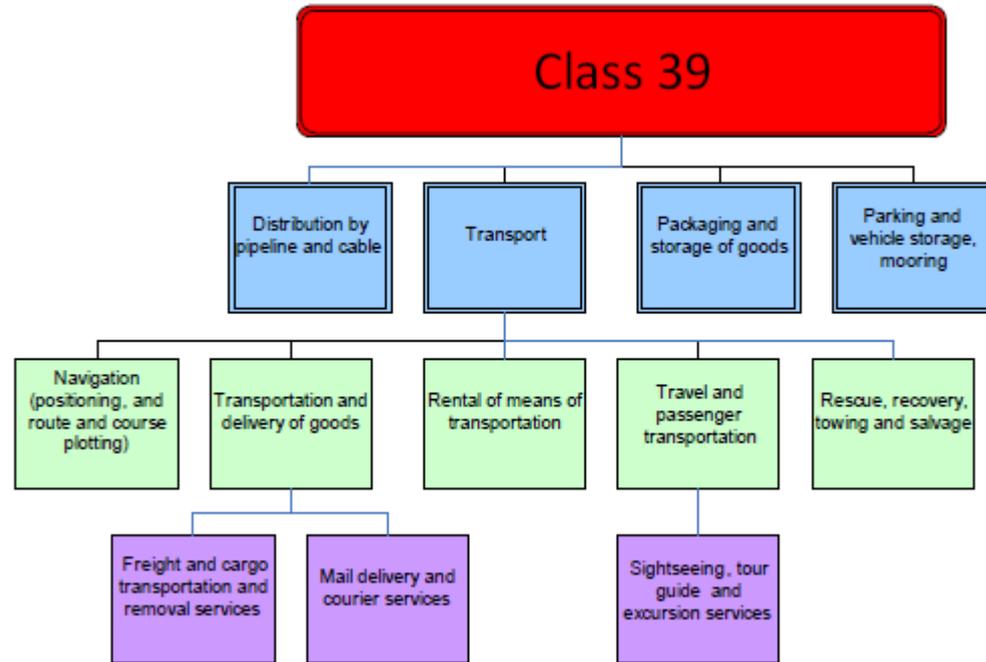
Taxonomy:

hierarchical grouping of terms in each class

Grouping using the class heading:



Grouping using taxonomy:



Taxonomy:

visibility in TMClass:

- **Class 39** 1.861
  - └─ Distribution by pipeline and cable
  - Transport
    - └─ Navigation (positioning, and route and course plotting)
    - Transportation and delivery of goods
    - └─ Rental of means of transportation
    - Travel and passenger transportation
    - └─ Rescue, recovery, towing and salvage services
  - Packaging and storage of goods
    - └─ Filling of machines and containers
    - └─ Loading and unloading of vehicles
  - └─ Vehicle parking and storage

## Uses of databases:

- Help for users
- Help for examiners
- International registrations
- Searching



THANK YOU  
GRACIAS  
MERCÍ  
BEDANKEN



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