



# CARIFORUM Intellectual Property Rights and Innovation TM CLASSIFICATION



Liina Puu EPA 26/10/2022



CARIFORUM



This Project is funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

[caripi-hub.eu](http://caripi-hub.eu)

# THE NICE CLASSIFICATION

## Class Headings

- indicate in a general manner the fields to which, the goods or services belong

## Explanatory Notes

- clarify the criteria of which type or examples of goods or services are included in the class

## Alphabetical List

- may be consulted in order to ascertain the exact classification of individual goods or services by analogy

## General Remarks

- a short collection of basic principles explaining what criteria should be applied if a term cannot be classified in accordance with the Class Headings or Alphabetical List

# CASE LAW (CJEU) PRAKTICER C-418/02

## Terms not presented in the Nice classification

The concept of '**services**' referred to by Directive to approximate the laws of the Member States relating to trade marks covers services provided in connection with retail trade in goods

For the purposes of registration of a trade mark for such services, it is not necessary to specify in detail the service(s) in question. However, details must be provided with regard to the goods or types of goods to which those services relate



# CASE LAW (CJEU) IP TRANSLATOR C-307/10

## Nice classification, class headings

An applicant who uses the general indications of a class heading of the Nice Classification must specify whether its application for registration is intended to cover all the goods or services included in the alphabetical list of that class or only some of those goods or services.

If the application concerns only some of those goods or services, the applicant is required to specify which of the goods or services in that class are intended to be covered.

# CASE LAW (CJEU) IP TRANSLATOR C-307/10

## Directive:

requires the goods and services to be identified with **sufficient clarity and precision** to enable the competent authorities and economic operators, to determine the extent of the protection conferred by the trade mark

does not preclude the use of the general indications of the class headings to identify the goods and services for which the protection of the trade mark is sought, provided that such identification is **sufficiently clear and precise**



# COMMON COMMUNICATION CP1 and CP2

CP 1 Common Practice on the Acceptability of Classification Terms and the General Indications of the Nice Class Headings

CP 2 Common Communication on the Interpretation of Scope of Protection of Nice Class Headings

# COMMON COMMUNICATION CP1

A description of goods and services is sufficiently clear and precise when its scope of protection can be understood from its natural and usual meaning

Identifying factors such as characteristics, purpose and/or identifiable market sector

consumers and/or sales channels

skills and know-how to be used/produced

technical capabilities to be used/produced

# COMMON COMMUNICATION CP 1

A term may be clear and precise in a particular class without further specification

If protection is sought for a specialised category of goods and services or a specialised market sector further specification of the term may be necessary, for example:

Furniture (cl 20)		Clothing (cl 25)	
Furniture especially made for medical purposes (cl 10)	Protective clothing (cl 9)		
Furniture especially made for laboratories (cl 9)	Clothing especially for operating rooms (cl 10)		



# CP 1 EXAMPLES

Not clear and precise term	Proposals / possible solutions: (examples from HDB)
Goods of common metal not included in other classes (cl 6)	Construction elements of metal (cl 6) ; Building materials of metal (cl 6)
Machines (cl 7)	Agricultural machines (cl 7) Machines for processing plastics (cl 7) Milking machines (cl 7)
Goods in precious metals or coated therewith (cl 14)	Works of art of precious metal (cl 14)
Goods made from paper and cardboard (cl 16)	Filtering materials of paper (cl 16)
Goods made from rubber, gutta-percha, gum, asbestos and mica (cl 17)	Rings of rubber (cl 17)
Goods made of these materials [leather and imitations of leather] (cl 18)	Briefcases [leather goods] (cl 18)

# CP 1 EXAMPLES

Not clear and precise term	Proposals / possible solutions: (examples from HDB)
Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics (cl 20)	Door fittings, made of plastics (cl 20) Figurines of wood (cl 20)
Repair (cl 37)	Shoe repair (cl 37) Repair of computer hardware (cl 37)
Installation services (cl 37)	Installation of doors and windows (cl 37) Installation of burglar alarms (cl 37)
Treatment of materials (cl 40)	Treatment of toxic waste (cl 40) Air purification (cl 40)
Personal and social services rendered by others to meet the needs of individuals (cl 45)	Personal background investigations (cl 45) Personal shopping for others (cl 45) Personal shopping for others (cl 45)



# CP 1 GENERAL INDICATIONS OF THE NICE CLASS HEADINGS

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

# CASE LAW (CJEU) SKYKICK C-371/18

Directive must be interpreted as meaning that

- Community trade mark or a national trade mark cannot be declared wholly or partially invalid on the ground that terms used to designate the goods and services in respect of which that trade mark was registered lack clarity and precision
- Terms such as computer software do lack clarity and precision



# ADMINISTRATIVE TOOL FOR CLASSIFICATION



Terms that are  
accepted for  
classification  
purposes in all EU  
offices

Classification  
databases of  
participating offices  
EU and outside the  
EU

# TMclass

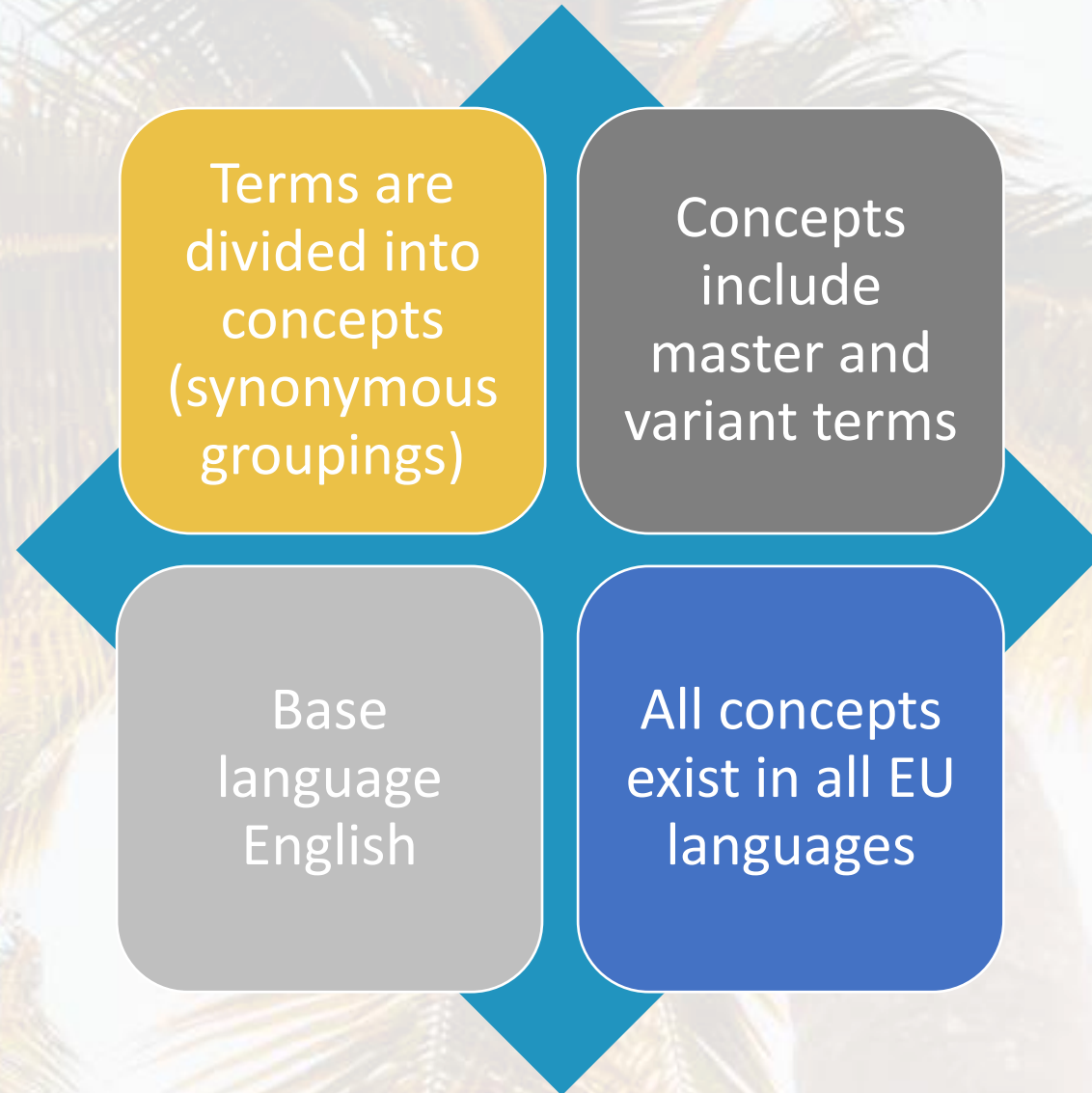
Tmclass enables search for the goods and services the mark will be used for

Build a list of goods and services by selecting terms from available databases

Translate a list of goods and services



# TMclass



# TMclass

TMclass Classification Tools ▾ Classification Resources ▾ Translation Tools ▾ My List: You have made no selection

OAPI (UK)  IPOPHL (PH)  USPTO (US)

**Disclaimer** **Advanced criteria** ⌵

**Browse terms (Taxonomy)** Result

<b>Classification</b>	82.533
▸ <b>Goods</b>	61.886
▸ <b>Services</b>	20.647
▸ <b>Class 35</b>	2.704
▸ <b>Class 36</b>	2.441
▸ <b>Class 37</b>	2.687
▸ <b>Class 38</b>	1.168
▸ <b>Class 39</b>	1.856
└─ Distribution by pipeline and cable	
▸ <b>Transport</b>	
└─ Navigation (positioning, and route and course plotting)	
▸ Transportation and delivery of goods	
▸ <b>Rental of means of transportation</b>	
▸ Travel and passenger transportation	
└─ Rescue, recovery, towing and salvage services	
▸ Packaging and storage of goods	
└─ Vehicle parking and storage	
▸ <b>Class 40</b>	1.279
▸ <b>Class 41</b>	3.510
▸ <b>Class 42</b>	2.741

**Class 39 > Transport > Rental of means of transportation**

Pin results  Hide tree structure  Results settings ▾  Link to this page  Show sources and offices ▾

Displaying 1 - 25 of 194 results Page 1 of 8

	Class	Term	Harmonised	Harm	Nice	IDli	Grou	MGS
<input type="checkbox"/>	39	Aeroplane rental	✓	●		●		●
<input type="checkbox"/>	39	Air charter brokerage services	✓	●				
<input type="checkbox"/>	39	Aircraft charter brokerage	✓	●				
<input type="checkbox"/>	39	Aircraft chartering	✓	●				●
<input type="checkbox"/>	39	Aircraft chartering services	✓	●				●
<input type="checkbox"/>	39	Aircraft rental	✓	●	●	●		●
<input type="checkbox"/>	39	Aircraft (Rental of -)	✓	●				
<input type="checkbox"/>	39	Airplane chartering	✓	●				●
<input type="checkbox"/>	39	Airplane rental	✓	●				●
<input type="checkbox"/>	39	Arrangement of vehicle rental	✓	●				
<input type="checkbox"/>	39	Arranging car hire as part of package holidays	✓	●				●
<input type="checkbox"/>	39	Arranging of car hire	✓	●				
<input type="checkbox"/>	39	Arranging of vehicle hire	✓	●				
<input type="checkbox"/>	39	Arranging of vehicle rental	✓	●				
<input type="checkbox"/>	39	Arranging vehicle hire	✓	●				



# CASE LAW T-690/14

Nice classification

TMclass

Taxonomy, has no legal effect, since the scope of protection of an EUTM is always defined by the natural and usual meaning of the terms chosen, not by their position in the hierarchical structure of the Office's taxonomy T-690/ 14 § 66.

## CASE LAW (CJEU) BASIC C-400/14 P

The Nice Classification cannot determine, in itself, the nature and characteristics of the services

The explanatory note to Class 39 of the Nice Agreement does not constitute an exhaustive enumeration of the services § 56

## CASE LAW T-367/16 and T-89/17

Each term is assessed in the context of the class in which it is applied for T-367/16 § 50; T-89/17 § 32-33



# CASE LAW (CJEU) EDISON C-121/19 P

<https://curia.europa.eu/juris/document/document.jsf?text=&docid=231103&pageIndex=0&doclang=en&mode=req&dir=&occ=first&part=1>



# Thank you \* Gracias \* Merci \* Bedankt

## Email Address

caripi@euipo.europa.eu

## Website

caripi-hub.com

**carIPI**

Intellectual  
Property Rights &  
Innovation



@EUIPcooperation



EUIPcooperation



euipcooperation



CARIFORUM



This Project is funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

[caripi-hub.eu](http://caripi-hub.eu)