TMclass

A presentation to the CarIPI offices of the benefits and functionalities

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An overview of the centralised online tools of EUIPN

Search and Classification Tools

TMview

DESIGNview

TMclass

DESIGNclass

CENTRALISED TOOLS: IP office takes advantage of the existing application hosted at EUIPO to integrate its data.

✓ **No data exchange agreement is needed.**

✓ **No license agreement is needed.**

TMclass

TMclass - general benefits & key features

1. When you apply for the registration of a trade mark, you need to describe the goods and services you wish to protect with your trade mark.

2. TMclass is an online tool to help users to search, verify, translate and correctly classify goods and services before filing a trade mark application.

3. All goods and services in the tool are classified according to the Nice classification and its 45 classes.

4. TMclass includes <u>different</u> databases of goods and services from IP offices worldwide.

5. TMclass gives the user certainty in terms of which goods and services <u>each</u> participating IP office accepts.

6. Helps speeding up an IP office's trade mark examination and registration process.

7. Available 24/7/365.

8. Free of charge.

https://euipo.europa.eu/ec2
https://caribbean-tmclass.euipo.europa.eu/ec2

TMclass - types of integrations - with which list of G&S can a IPO join TMclass?

1. **Nice:**
   - ✓ The IP office uses and accepts the official Nice list.
     - ➤ **OCPI joined on 08/08/2018**

2. **Nice + local goods and services**:
   - ✓ Terms from other lists such as MGS, HDB or IDlist.
   - ✓ Local products and services.
     - ➤ **ABIPCO joined on 15/11/2021**

3. **HDB**:
   - ✓ The harmonised database of goods and services.
     - ➤ **ONAPI (DO) joined on 27/07/2020**
     - ➤ **IPOSKN (KN) joined on 05/07/2021**
     - ➤ **CIPO (VC) joined on 12/07/2021**
     - ➤ **BELIPO (BZ) joined on 13/09/2021**
     - ➤ **ROCIP (LC) joined on 25/10/2021**
     - ➤ **TTIPO (TT) joined on 13/12/2021**
     - ➤ **SPIMCI (HT) joined on 13/06/2022**

None of these models are exhaustive list of terms.
An IP office can accept goods and services not included.

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Classification issues during trademark application and examination

The user files the application

| The **user must describe and classify** the goods and services (G & S). | ➡ | **Often done manually** without any automated support. | ➡ | **Mistakes are likely to be made**, *e.g. unacceptable G&S or classify wrongly.* | ➡ | **Uncertainty for the user:** *Deficiencies? Will this slow down the application?* |

The office examines the application

| This may result in **user complaints** and workload issues for the staff. | ⬅ | This can lead to extra time needed for examination and **inconsistent** verification and classification of G&S | ⬅ | It can be **difficult to detect** unacceptable or wrongly classified G&S. It can become a **monotonous task**. | ⬅ | The IP office might not have automatic tools to examine G&S |

⬇ **Possible solution**

Nice list?
1. Still a short list.
2. Only updated once per year.
3. IPOs are not obliged to accept the complete Nice list.
4. The user will not know if the G&S applied for will be accepted.

➡

What are the consequences?
1. For G&S not in Nice, IPOs could accept and classify differently.
2. Rather than convergence, this leads to divergence between IPOs.
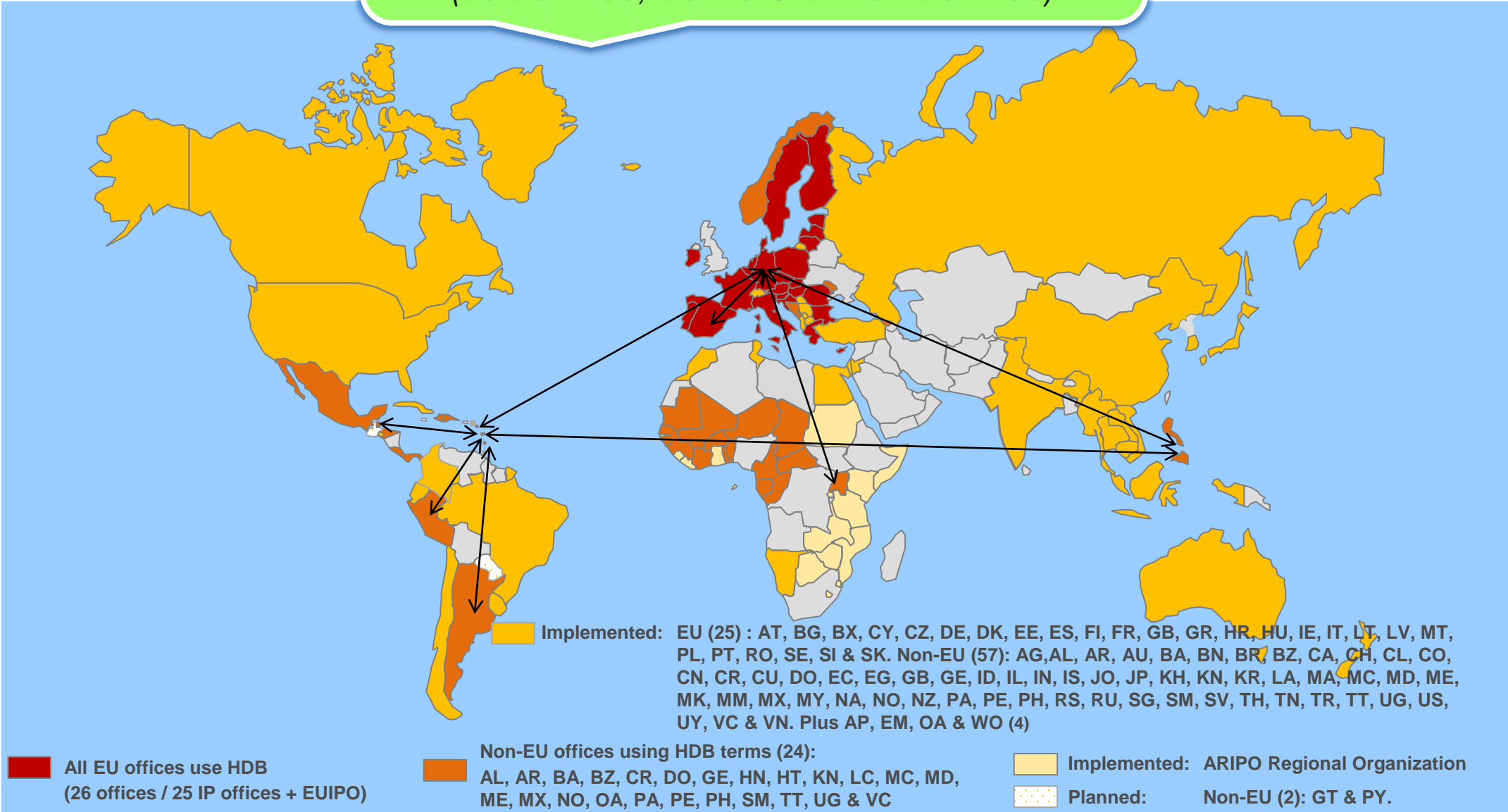3. Lack of precision and certainty for users.

➡

HDB can be a solution. Based on the Nice classification. List of pre-accepted and pre-classified G&S used and accepted by all participating offices.

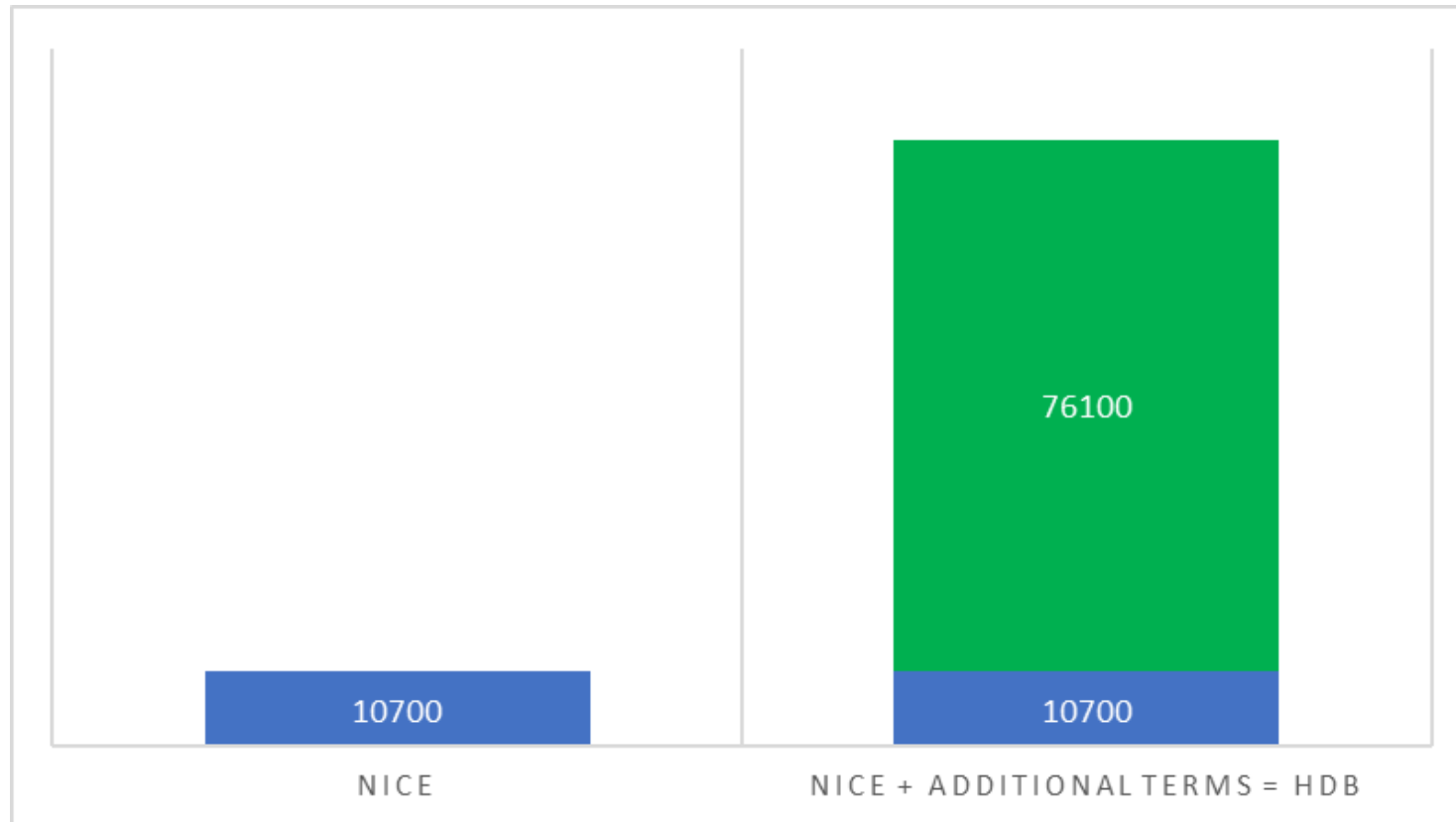## HDB benefits for the IPO's users/clients

1. Used and accepted by 50 IP offices (25 EU IPOs, EUIPO and 24 non-EU IPOs).

2. ~86800 <u>harmonised</u> and <u>pre-validated</u> and <u>pre-classified</u> terms in EN in one tool.

3. Updated monthly to keep up with new trends, technologies and market developments.

4. Zero risk that an IP office will object to the selection of G&S.

5. The user is assured that the same G&S from HDB will be accepted by all IP offices accepting HDB.

6. Even if the working language is different in the IP office, the same HDB terms will be accepted. The translation functionality in TMclass can be used.

7. Available 24/7/365.

8. Free of charge.

9. Saves time and money.

90 Implementations

50 IPOs using & accepting HDB terms
(25 EU IPOs, EUIPO & 24 non-EU IPOs)

Implemented: EU (25) : AT, BG, BX, CY, CZ, DE, DK, EE, ES, FI, FR, GB, GR, HR, HU, IE, IT, LT, LV, MT, PL, PT, RO, SE, SI & SK. Non-EU (57): AG, AL, AR, AU, BA, BN, BR, BZ, CA, CH, CL, CO, CN, CR, CU, DO, EC, EG, GB, GE, ID, IL, IN, IS, JO, JP, KH, KN, KR, LA, MA, MC, MD, ME, MK, MM, MX, MY, NA, NO, NZ, PA, PE, PH, RS, RU, SG, SM, SV, TH, TN, TR, TT, UG, US, UY, VC & VN. Plus AP, EM, OA & WO (4)

All EU offices use HDB
(26 offices / 25 IP offices + EUIPO)

Non-EU offices using HDB terms (24):
AL, AR, BA, BZ, CR, DO, GE, HN, HT, KN, LC, MC, MD, ME, MX, NO, OA, PA, PE, PH, SM, TT, UG & VC

Implemented: ARIPO Regional Organization
Planned: Non-EU (2): GT & PY.

HDB benefits for the IPO

1. **HDB is based on and respects the Nice classification and its 45 classes.**

2. **HDB includes all terms from the official, alphabetical list of Nice.**

	76100
10700	10700
NICE	NICE + ADDITIONAL TERMS = HDB

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HDB benefits for the IPO (cont.)

3. HDB improves the IP office's trade mark examination process.

4. Less manual work and more automated processes.

5. The manual examination can be skipped if all goods and services used in the trade mark applications come from the HDB.

6. Saves time and money.
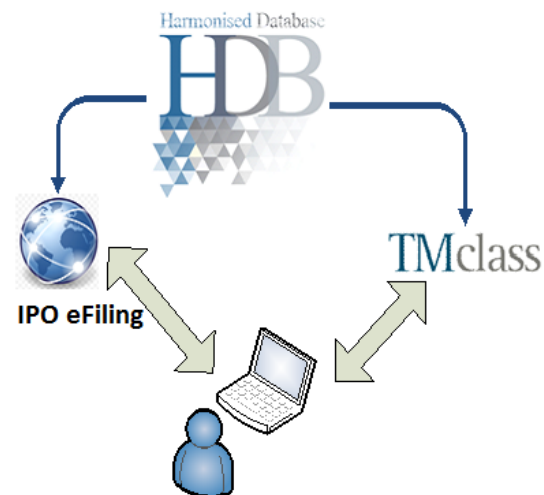
HDB - how to promote its use?

How can a IPO get its clients to use HDB?

Encourage its use:

1. Offer advantages for its use: e.g. shorter duration in the examination process → fast track.

Facilitate its use:

2. Integrate HDB in the online trademark application system.

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Evolution of the usage of HDB

- 2018:
  - 80% of all the goods and services used in EUTMs applications came from the HDB.
    - ➢ G&S automatically accepted by EUIPO. Flagged in the system. No need to examine them again.

  - 50% of the EUTMs used exclusively pre-accepted terms from the HDB.
    - ➢ Examiners did **not** have to examine the acceptability and classification of the G&S in these applications.
    - ➢ Applications jumped to the next step in the workflow.

  - 14% of classification deficiency rate in EUTMs.

- Q4 2021:
  - **87%** of all the goods and services used in EUTMs applications came from the HDB.
    - ➢ G&S automatically accepted by EUIPO. Flagged in the system. No need to examine them again.

  - **56%** of the EUTMs used exclusively pre-accepted terms from the HDB.
    - ➢ Examiners did **not** have to examine the acceptability and classification of the G&S in these applications.
    - ➢ Applications jumped to the next step in the workflow.

  - Only **12%** of classification deficiency rate in EUTMs.

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TMclass (HDB) - costs descriptions for adopting HDB

Installation costs for the IPO:

1. Software installation at the IPO.
✓ **There is nothing to install. TMclass is hosted at EUIPO.**

2. Connection to the IPO's systems.
✓ **There are no connections to be set up between TMclass and the IPO's systems.**

3. Translation of the static texts for the TMclass interface in the language of the IPO. *
✓ **Not necessary. They are already translated.**

4. Initial translation of all goods and services in Nice or HDB. **
✓ **Not necessary. Both lists are already translated in TMclass.**

Maintenance costs for the IPO:

5. Revision of translations of new Nice or HDB terms.
✓ **Not necessary. EUIPO is responsible for English. OEPM is responsible for Spanish. INPI-FR is responsible for French. INPI-PT is responsible for Portuguese.**

HDB integration process (working language of the IP office is an EU language)

1. The IP office (IPO) agrees to the terms and conditions for its participation in HDB, mainly:
   - The IPO <u>must</u> accept all terms presently in HDB.
   - The IPO <u>must</u> accept all future changes in HDB being new, modified and/or deleted terms in the database.

2. The IPO assigns a classification expert to the project and sends to EUIPO: Its contact details, logo and public IP used to access the Internet.

3. EUIPO configures TMclass TEST with the IPO's contact details and logo. There is no software to be installed in the premises of the IPO or any connections to the IPO's systems.

4. The IPO verifies its details and confirms that expected terms can be searched (UAT).

5. EUIPO prepares IPO in TMclass PROD. A user account is created with access to an AdminTool (TMC). EUIPO provides knowledge transfer.

6. Go-live and announcements in the IPO's and EUIPO's different media.

✓ After the Go-live:
   - The EEA/Candidate/Potential Candidate countries can participate in the workflow proposing changes in the database.
   - Other non-EU countries will be included in the workflow with access to TMC in order to receive information on the changes in HDB.

Questions?

www.euipo.europa.eu

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Thank you