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## 1. Introduction

The registration system in the United Kingdom is based on an internationally agreed system of classes covering different areas of trade in goods and provision of services. This guide sets out the purpose of classification, the legal framework and general principles to observe in classification.

## 2. The purpose of classification

In order to allow efficient searching of trade marks the UK uses “The International Classification of Goods and Services”, also known as the “Nice Classification”. The International Classification is administered by the World Intellectual Property Organisation (WIPO) and is used by over 140 countries throughout the world and by organisations such as The Office for Harmonization in the Internal Market (OHIM). Of these countries 78 are party to the Nice Agreement and 68, although not party to it, use the Nice Classification for their classification purposes. The system comprises 45 classes and groups together broadly similar goods or services into categories which assists the registry carrying out efficient searches of the register. Classes 1 – 34 contain goods and classes 35 – 45 contain services. It also allows businesses to check whether there are registered marks that conflict with marks they are using, or propose to use, in respect of particular goods or services. Whilst classification may be seen as an administrative tool its importance to applicants in relation to determining the boundaries of infringement rights cannot be stressed too highly. If the classification of the goods or services on an application is made incorrectly, the validity of any rights stemming from a subsequent registration might be called into question at a later date. This could result in a mark being the subject of proceedings to remove it from the register.

The Classification Team's ability to meet time related targets is dependent upon the detail of information that is provided. If full details are provided about the goods or services to be classified this should result in a faster turn round time.

### **Current Classification contact points:**

Telephone - (01633) 811148 or 811170  
E-mail - [TMClassificationEnquiries@ipo.gov.uk](mailto:TMClassificationEnquiries@ipo.gov.uk)  
Fax - (01633) 811174

### Web site information:

[www.ipo.gov.uk/t-class-guide.htm](http://www.ipo.gov.uk/t-class-guide.htm) - this will provide you with general information and an overview of the 45 classes of goods and services.

[www.ipo.gov.uk/tm/t-find/t-find-class.htm](http://www.ipo.gov.uk/tm/t-find/t-find-class.htm) - this will provide a classification search database, which will help you to correctly classify the goods and services that you intend to use your trade mark on.

## 3. Legal framework and general principles

### 3.1 The classes

Goods and services are divided into 45 classes - 1 to 34 for goods and 35 to 45 for services.

Classification is set out in detail in the "International Classification of Goods and Services" published by WIPO (10<sup>th</sup> edition, published in 2011). As a supplement to the WIPO list, the Registry has prepared its own classification tool called Trade Mark Classification Search which is accessible on the Trade Marks part of the Office's website and can be found at: [www.ipo.gov.uk/tm/t-find/t-find-class.htm](http://www.ipo.gov.uk/tm/t-find/t-find-class.htm) . Compiled from information held on the Register, this searchable database represents the Registrar's view on the classification of goods or services. It contains over seventy five thousand entries (including all the entries found in the current edition of the WIPO list) and is a valuable aid in the classification of goods and services and the framing of specifications.

To access Trade Mark Classification Search Tool, click on to [www.ipo.gov.uk](http://www.ipo.gov.uk) - then the Trade Marks button - then On-line TM Services and finally Classification. Once you reach the Tool, help is given on how to access information from the database.

### 3.2 The International Classification (Nice Classification)

The "International Classification of Goods and Services" list is currently in its Tenth edition, which came into force on 1<sup>st</sup> January 2012, and is divided into two parts. Part 1 consists of two alphabetical lists, one for goods and one for services. Part 2 lists the classes in numerical order and under each class lists goods and services class in alphabetical order.

The legal status for use of the International Classification in the UK is set out in the statute. Section 34(1) of the Trade Marks Act states:

Goods and services shall be classified for purposes of the registration of trade marks according to a prescribed system of classification.

And, under Rule 7 of the Trade Marks Rules 2008:

(1) The prescribed system of classification for the purposes of the registration of trade marks is the Nice Classification.

(2) When a trade mark is registered it shall be classified according to the version of the Nice Classification that had effect on the date of application for registration.

Trade mark registrations may be obtained in the UK from three organisations namely the UK Registry, WIPO (through the Madrid Protocol) and OHIM. All of these organisations classify goods and services in accordance with the International Classification as administered by the WIPO.

### 3.3 The Registrar's decision is final

Section 34(2) of the Act states:

Any question arising as to the class within which any goods or services fall shall be determined by the registrar, whose decision shall be final.

Although the UK registry follows the International Classification, ultimately Section 34(2) of the Act gives the registrar the power to decide any question arising "as to the class within which any goods or services fall". The same principle applies to Community Trade Mark applications before OHIM, an organisation which also makes its own discretion to determine classification issues. The International Classification is not fully comprehensive and in the absence of an item being specified in the list of goods and services, the registrar has to decide the appropriate class. In the GE Trade Mark case (1969 RPC 418) in Graham J. said:

“This section, in my judgment, is dealing with administrative matters and enables the registrar to decide without appeal in which class any particular goods must be registered. It does not oust the jurisdiction of the court to decide, as in the present case, whether any goods as to which there is a dispute properly fall within the specification”.

However, it should be noted that this power does not apply to International Registrations that are designated to the UK. Under the Madrid Protocol, WIPO is responsible for the classification of items which are included in specifications on the International Register.

### 3.4 Changes to the classification

Section 65 of the Act enables the registrar to make rules concerning changes to the classification.

Sub-section (1) says:

Provision may be made by rules empowering the registrar to do such things as he considers necessary to implement any amended or substituted classification of goods or services for the purposes of the registration of trade marks.

From time to time changes to the International Classification are made and these are published on our website. However, each application is classified by reference to the classification which is in force at the time of application and consequently changes are not made retrospectively to existing registrations unless the registrar considers it necessary for existing entries on the register to accord with the new classification (Section 65(2)). Applications made before that date are subject to the old classification. This practice is well established, see the Australian Wine Importers case (6 RPC 311), Cal-U-Test (1967 FSR 39), GE Trade Mark case (1969 RPC 418) and more recently in the Avenet Incorporated v. Isoact Limited case (1998 FSR 16), in which Jacob J. said:

“It is settled, at least at first instance,.....one has to look at the Trade Mark Registry practice to see whether the registrar in practice at the time of registration included the particular service or goods within that class (see GE Trade Mark 1969 RPC 418 at 458).”

In the Cal-U-Test case the classification had changed since the date of registration but the case was decided with reference to the practice at the date of registration. When a new edition of the classification has been published special care must be taken to note items that have changed class. When searching for earlier marks the classification at the date of registration of any conflicting mark is the relevant one. Examiners should familiarise themselves with changes that have taken place and may have to adjust the search accordingly.

Changes to the classification are usually made following meetings at WIPO at which the UK is represented. WIPO now aims to revise the classification every three or five years and to issue a new edition of its list following decisions made by the Preparatory Working Group as confirmed by the Committee of Experts. The 10<sup>th</sup> edition of the International Classification became effective on 1<sup>st</sup> January 2012. The purpose of amending the classification is mainly to remove anomalies and inconsistencies that have been found and to make improvements with new entries. We are always willing to consider suggestions to improve the classification and where fundamental changes are proposed, consultations will take place with the users of the office.

### **3.5 Need for clarity in specifications**

Rule 8(2)(a) and (b) states:

(2) Every application shall specify-

(a) the class in the Nice Classification to which it relates; and

(b) the goods or services which are appropriate to the class and they shall be described in such a way as to indicate clearly the nature of those goods or services and to allow them to be classified in the classes in the Nice Classification.

Following the Postkantoor (C-363/99) decision it is clear that the scope of registered rights must be determined with legal certainty. Clarity and consistency of treatment is the aim when dealing with specifications. This is desirable for all the users of the office. It is unacceptable that searchers should be inconvenienced by specifications which do not make it clear what goods or services are covered. Examiners must satisfy themselves that all the terms of a specification are understandable. The Examiner may require some explanation of the terms used by the applicant, but this does not necessarily mean that the term is inappropriate.

The test to be applied is whether the applicant's descriptions of his goods or services are such that permit an average person engaged in the relevant trade to clearly ascertain the nature of the goods or services for which the applicant seeks to register his trade mark, without the need for further explanation.

Though it is preferable that terms be defined in mainstream dictionaries, it is acceptable to use terms found in specialist dictionaries or other works. Also many terms are used which are common in particular trades and can be accepted in specifications providing they are clearly understood and fall in the class of the application. Even if a particular term does not appear in a specialist dictionary it may be accepted on the basis that it is widely understood, for example when a new term of art is prevalent on the internet.

Examiners should not allow an item in a specification unless they are satisfied the descriptions of goods or services satisfies the test described above and that the goods or services fall in the class or classes designated on the application form.

### **3.6 Meaning of terms contained in specifications**

In *British Sugar PLC-v-James Robertson & Sons Ltd* (1996 RPC 280) (the TREAT decision) Jacob J said:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.”

In the *OFREX* case (1963 RPC 169-171), Pennycuik J. made the following comments concerning the scope of the term “stationery”:

“What is said is that staples do not come within class 39 [refers to the UK classification in force 1876-1938] as an item of stationery.... in order to answer that question, the first step I think is to look at the ordinary meaning of the word “stationery”, which as defined in the Oxford English Dictionary is: “the articles sold by a stationer; writing materials, writing table appurtenances, etc”. I feel no doubt that staples are stationery, according to the ordinary meaning of the word”.

And in the *MINERVA* case (2000 FSR 734) Jacob J. made the following comments concerning printed matter:

“The specification of goods poses difficulties. “Printed matter” as a pure matter of language, I suppose, covers anything upon which there is printing. In a sense, every trade mark for whatever goods could also therefore be registered for printed matter if one reads “printed matter” perfectly literally. Every packet has printed matter on it. “Printed Matter” cannot in my judgment mean merely that the trade mark is printed on something. For example, if there is a registration for “printed matter” but the only use is on labels for, say, soap or bananas, there has not been use for printed matter. On the other hand, the kind of printed forms and other things produced by these proprietors seem to be perfectly well described as “printed matter”. People buy them for what is printed on them. However, there is a very big difference between that sort of printed matter and printed matter of a literary character.”

### **3.7 Class to be taken into account when interpreting specifications**

Care must be taken concerning the scope of what a particular item covers when viewed in the context of the class in which it is applied or registered. For example, a registration in respect of “articles of clothing” in Class 25 does not include “articles of clothing for protection against accidents” in Class 9. Similarly, an application for “cases” in Class 18 could not include within its scope “violin cases” in Class 15. In the Court of Appeal, Lord Justice Mummery observed in the case of *Altecnic Ltd’s application* (2002 RPC 34) - commonly referred to as the *CAREMIX* decision – at paragraph 45:

“In my judgment, the registrar is entitled to treat the class number in the application as relevant to the interpretation of the scope of the application, for example, in the case of an ambiguity in the list of the specification of goods. The application is a considered statement of the applicant which, on ordinary principles of the construction of documents, has to be read as a whole to determine its meaning and effect. The fact that the internationally agreed Nice Classification System has been devised to “serve exclusively administrative purpose” (see, for example, Rule 2(4) of the Commission Regulation 2868/95EC) does not mean that the selection by the applicant of one or more class numbers in his application has to be totally ignored in deciding, as a matter of construction of the application, what the application is for and whether it can be properly amended. I would reject the submission of Mr Purvis that it is only permissible to take account of the class number when it expressly (or implicitly) referred to in the “specification of goods” column of Form TM3, as in the examples helpfully discussed by Jacob J in *British Sugar PLC -v- James Robertson & Sons Limited* [1996] RPC 280 at p289 (eg consideration of the relevance of the practice of the registrar at the date of registration of adding to the list “All included in this class” and “All included in class X”). That kind of case is no doubt a stronger one for interpretation of the application by reference to the class number, but I fail to see why it should be the only kind of case in which the class number can be taken into account by the registrar or why the registrar should have to ignore the class number which the applicant (or his advisers on his behalf) have inserted in the Form TM3 as part of the required expression of the applicant’s case in relation to the registration of the trade mark.”

### **3.8 Interpreting specifications of services**

In relation to descriptions of services, extra care should be taken when defining the scope of a specification. In the *Avenet Incorporated v. Isoact Limited* case (1998 FSR 16), Jacob J. said:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase”.

### **3.9 Interpreting the WIPO class headings**

The use of WIPO class headings as statements of goods or services may lead to confusion concerning the scope of protection provided. In the context of the Nice International Classification, it is clear that the headings to the classes are intended to convey general indications relating to the fields to which goods or services belong (see General Remarks, Nice Classification 10<sup>th</sup> edition, page 3).

When a class heading is used as a specification, it loses its capacity to function as a class heading and becomes part of an application or registration as a statement of goods or services. It follows that the question of what a class heading includes or does not include is irrelevant and interpretation of the statement of goods or services may only be made by reference to the goods or services included in that statement.

It is a common misunderstanding that a WIPO class heading always includes all the goods or services in a particular class and some applicants may be misled into thinking there is no need to be specific when making an application. For instance, the heading for Class 15 is “Musical instruments”. The goods “stands for musical instruments” are also proper to this class but are not covered by the scope of the heading. Likewise the heading for Class 12, “Vehicles; apparatus for locomotion by land, air or water” makes no reference to “Repair outfits for inner tubes.” In Class 20, the item “sleeping bags for camping” is not covered by “furniture”.

### **3.10 Intention to use the mark on all the goods or services within a claimed specification**

Section 3(6) of the Act states:

A trade mark shall not be registered if or to the extent that the application is made in bad faith.

During the passage of the Trade Marks Bill, Parliament was informed that a circumstance where bad faith might be found included instances where the applicant has no bona fide intention to use the mark, or intends to use it, in relation to the whole range of goods and services listed in an application.

In the Mercury Communications case (1995 FSR 850) Laddie J, said:

“In my view it is thoroughly undesirable that a trader who is in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those far removed from his own area of interest. If he does he runs the risk of his registration being attacked on the grounds of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act.”

These comments were quoted with some approval by Walker J. in the Roadrunner case (1996 FSR 818) in relation to Section 3(6) of the Act. He said:

“Counsel have not been able to refer me to any material which shows the legislative purpose behind the Directive’s reference to bad faith. The recitals of the Directive make clear that it is intended to achieve partial (not total) harmonisation of trade mark law within the European Union. The recitals refer to it being essential to require ‘that the conditions for obtaining and continuing to hold a registered trade mark are, in general, identical to all Member States’ and the need to ‘require that registered trade marks must actually be used or, if not used, be subject to revocation’.”

“I find it impossible to get any clear guidance from these general recitals. They do however provide some support for Laddie J.’s observations in Mercury, which I have already cited, that unduly wide specifications may not be possible under the 1994 Act.”

In line with Section 32(3) of the Act, the application form TM3 requires the applicant to state that:

...the trade mark is being used, by the applicant or with his or her consent, in relation to those goods or services, or that he has a **bona fide** intention that it should be so used.

In relation to what is meant by intention, in the case of DUCKER'S trade mark (45 RPC page 402), the Master of the Rolls, Lord Hanworth, quoting the BATT'S trade mark case said:

"a man must have an intention to deal, and meaning by the intention to deal some definite and present intention to deal in certain goods or descriptions of goods; I agree that the goods need not be in being at the moment, and that there is futurity indicated in the definition; but the mark is to be a mark which is to be definitely used or in respect of which there is a resolve to use it in the immediate future upon or in connection with goods. I think that the words "proposed to be used" mean a real intention to use, not a mere problematical intention, not an uncertain or indeterminate possibility, but it means a resolve or settled purpose which has been reached at the time when the mark is to be registered."

He went on to ask what is the meaning of "bona fide"? and said:

"I think that must mean a real intention in the sense which I have already explained and if it is not found that there was a real resolve, intention and purpose, then it is shown that originally the mark was put upon the Register at a time when it ought not to have been put on, because there was not a sincere purpose to make use of the mark in connection with goods".

Accordingly, applications will normally be accepted even if they cover goods or services in many classes. However, in extreme cases, or where vague and wide terminology is used, the registrar will raise an objection under Rule 8(2) of the Act on the basis that the statement on the application form appears to have been made in bad faith.

See Classification Desk Instruction at 2.15 which gives detailed guidance on the criteria and procedures for raising objections under Rule 8(2).

### **3.11 Widening of a specification after filing not allowed**

Section 39(2) states:

In other respects, an application may be amended, at the request of the applicant, only by correcting-

- (a) the name or address of the applicant,
- (b) errors of wording or of copying, or
- (c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

The widening of a specification after filing an application could disadvantage other applicants who have searched the pending marks index and is therefore not permitted. See Classification Desk Instruction at 2.3 to 2.13 which sets out practice in relation to changes to specifications of applications and paragraph 3.1 which deals with amendment of specifications of registrations.

### **3.12 Case law: Retail, wholesale and shopping centre services**

In [Case C-418/02](#) (Praktiker), reference for a preliminary ruling under Article 234 EC from the Bundespatentgericht (Germany), was made to the European Court of Justice in relation to an application from Praktiker Bau- und Heimwerkermärkte AG, concerning the registration of a trade mark in respect of services provided in connection with retail trade.

In reply to the questions asked of it, the Court ruled in its judgment issued on 7 July 2005 that:

- "1. The concept of 'services' referred to by First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, in particular in Article 2, covers services provided in connection with retail trade in goods.
2. For the purpose 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 in connection with regard to the goods or types of goods to which those services relate."

#### **Scope and effect of the Praktiker decision**

The services provided by retailers are recognised by the Court as being "all activity carried out by the trader for the purpose of encouraging the conclusion of a transaction. That activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the above mentioned transaction with the trader in question rather than with a competitor".

Accordingly, these are the services covered by a "retail services" type registration.

The Court stated that it is not necessary to specify in detail the retail services for which registration is sought. Rather general wording may be used. In that connection the Court cited with approval the wording in the explanatory note to Class 35 of the International Classification, namely, "the bringing together of a variety of goods, enabling customers to conveniently view and purchase those goods."

Having recognised that there is no barrier to the registration of services connected with the retail trade in goods, the Court did not draw any distinction between the various forms of retail services (for example, supermarkets, department stores, specialist retail outlets, mail order, electronic shopping etc). Whereas in the past it was a requirement in the UK to specify the precise nature of the retail services being provided, the Court makes it clear that this is not required and that the emphasis is to be placed on the nature of the goods supplied in connection with the services.

Consequently, it is necessary to specify the goods or types of goods in **all** cases. The mark Praktiker was filed for registration in relation to, inter alia, retail services in connection with the “building, home improvement and gardening goods for the do-it-yourself sector”. The Court approved this as being sufficient to identify the types of goods connected with the services applied for.

Consequently, an indication of the types of goods concerned with the services will be sufficient, although applicants may list the associated goods in more detail if they so wish. Note that a registration for retail services does not cover the sale of goods themselves and therefore if applicants require protection for their marks to include the transaction that occurs between the customer and the retailer at the point of sale, it will be advisable to file in the appropriate goods classes in respect of those items that are being sold under the trade mark.

### **What is acceptable**

The following paragraphs provide guidance on what is (and what is not) acceptable and the effect of the revised practice on pending applications and existing registrations.

#### **Acceptable**

The bringing together, for the benefit of others, of a variety of [indicate goods or types of goods], enabling customers to conveniently view and purchase those goods; The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase [indicate goods or types of goods];

Retail services connected with [indicate goods or types of goods];

Retail services connected with the sale of [indicate goods or types of goods];

Retail store services in the field of [indicate goods or types of goods];

Department store retail services connected with [indicate goods or types of goods] as in, for example:

Department store services connected with the sale of beauty products, toiletries, machines for household use, hand tools, optical goods, cameras, domestic electrical and electronic equipment, including white goods, jewellery, clocks, watches, stationery, publications, leather goods, luggage, furniture, household containers and utensils, furnishings, textiles, clothing, footwear, headwear, haberdashery, toys and games, sports equipment, foodstuffs, drinks and tobacco products;

Shop retail services connected with [indicate goods or types of goods];

Mail order retail services connected with [indicate goods or types of goods];

Electronic shopping retail services connected with [indicate goods or types of goods];

Retail clothing shop services;

Stationery shop retail services connected with the sale of stationery, printed matter, computer equipment and peripherals and home entertainment products;

The bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods from a clothing and clothing accessories catalogue by mail order or by means of telecommunications.

### **Not acceptable**

Sale of electrical and electronic goods for industrial use [the sale of goods is not a service];

Trade in building products [trading in goods is not a service];

Retailing [retailing goods is not a service per se];

Retailing of cars [retailing of goods is not a service];

Retail services for the sale of foods [sale of goods is not a service];

Retail off licences specialising in the sale of alcoholic beverages [sales are not a service];

Online marketplace for the sale of goods [not a service per se];

Online marketplace connected with the sale of goods [not a service per se];

Resale of goods [not a service per se];

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods specialising in [indicate goods or types of goods]

Shops [not a service per se];

Factory shops [not a service per se];

Shopkeeping [not a service per se];

Merchandising [not a service per se];

Distributorship [not a service per se];

Sales services [not a service per se];

Direct selling [not a service per se];

Mail order [not a service per se];

Television shopping [not a service per se];

Electronic shopping [not a service per se];

Computer shopping [not a service per se];

E-commerce [not a service per se] ;

Retail services [unqualified] ;

Retail store services [unqualified];

Department store services [unqualified];

Mail order catalogue services [unqualified];

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those [unqualified] goods; The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store [“department store” does not identify the types of goods];

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise internet web site [“general merchandise” does not identify the types of goods];

Retail services connected with the sale of electrical and electronic goods [the terms “Electrical” and/or “Electronic” are too vague without further indication to define types of goods];

Retail services connected with stationery products and the like goods [“and the like goods” fails to identify the goods or types of goods];

### **Wholesale services**

The Court’s judgment did not include any observations concerning the acceptability of services provided by wholesalers. However, the same practice will apply as for retail services and it will be necessary to specify the goods or types of goods, as in, for example:

Wholesale services connected with the sale of [indicate goods or types of goods]

### **Where the specification is deficient**

For descriptions which identify retail services but which do not clearly indicate the goods or types of goods connected with the services, an objection will be raised under section 1(1) and/or rule 8(2)(b) (because such claims do not clearly identify “services” within the meaning of section 1(1) of the Act). Similarly, specifications which include descriptions that adequately identify the goods, but fail to define the retail services, (for example, “sale of clothing”) will face similar objections.

### **Effect on pending applications**

In order to comply with the Courts judgement, pending applications that do not conform with the revised practice will require amendment (except those applications that have already been fully accepted and which include specifications agreed under the previous practice).

Examiners will write to applicants or their representatives and allow sufficient time in which to make proposals to amend their specifications.

### **Effect on registrations**

Owners of registered marks may request a restriction of their specifications (in order to comply with the revised practice). For example, a registration in Class 35 for: “The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store” could be amended by requesting part surrender of the specification (using Form TM23) as in, for example:

“Surrendered in respect of all services except the bringing together, for the benefit of others, of a variety of [ state goods or types of goods ] , enabling customers to conveniently view and purchase those goods in a department store”;

### **Absolute Grounds for refusal**

Retail stores are commonly named after their geographical location. Retail services will therefore be classified as a local service and applications to register geographical place names as trade marks for such services will normally be objected to.

### **Shopping Centre Services**

In the judgement of the High Court in *Land Securities plc (and others)* (CH2008 APP 0278/0279/0281) it was recognised that the services provided by the operator of a shopping centre are those which "make the shopping centre as a whole an attractive place for the consumer to come and spend money. In that manner the operator generates a goodwill associated with the name or mark under which the shopping centre trades. To that extent, the shopping centre operator is providing services".

In reaching its decision, the Court focused on the following terms which made up the opening section of the specification in question:

"The bringing together for the benefit of others, of a variety of retail outlets, entertainment, restaurant and other services, enabling customers to conveniently view and purchase goods and services and make use of such facilities in a shopping centre or mall;"

Having decided that the operator of a shopping centre or mall does provide a service within the meaning of the Trade Marks Act 1994, the Court then went on to consider whether the terms applied for are sufficiently clear for the purposes of satisfying rule 8(2)(b) of the Trade Marks Rules. Ultimately, the Court found that the majority of those terms did satisfy the relevant criteria, although objections were upheld against the references to "and other services" and "such facilities" on the basis that they are broad, non-specific and unclear (paragraphs 50-51 of the decision refer).

Based on guidance set out in this decision, the Registrar **will accept** the following specifications:

The bringing together for the benefit of others, of a variety of retail outlets, entertainment, restaurant and [other clearly defined *related* services], enabling customers to conveniently view and purchase goods and make use of and purchase such services in a shopping centre or mall.

The bringing together for the benefit of others, via the internet, of a variety of retailers and [other clearly defined *related* services] through a virtual shopping mall, enabling customers to conveniently view and purchase goods and make use of and purchase such services by means of telecommunications.

In the above examples, the reference to "other clearly defined *related* services" refers to those services which are conventionally offered within a shopping centre to complement the primary activity of providing retail outlets. To illustrate this point, the Court acknowledged facilities as child care, language assistance, car cleaning, restaurants and cinemas as being services typically provided within a retail environment (paragraphs 13 and 28 of CH2008 APP 0278/0279/0281 refer). It is important to emphasise that any reference to such services included as part of a wider shopping centre-type specification will not equate to a claim to the provision of those services *per se*. To illustrate this point, the Registrar will not consider a class 35 claim to "the provision of restaurant facilities" (where it is made as part of a wider claim covering the services of a shopping centre operator) to be the same as a claim to "restaurant services" which are proper to class 43.

It should also be noted that the specifications presented above **do not** exhaustively list the specific goods which are likely to be provided by outlets situated within the shopping centre or mall. Notwithstanding the fact that the listing of goods remains a requirement of more conventional retail claims, the Registrar does not consider it to be a necessary requirement in relation to claims for the operation of shopping centres and malls.

By contrast, applicants should note that the following example specification **would not be accepted**:

The bringing together for the benefit of others, of a variety of retail outlets and other services enabling customers to conveniently view and purchase goods and services and make use of such facilities in a shopping centre or mall. It is important to stress that the judgement in Land Securities did not focus on "the bringing together of services" *per se*, but only "the bringing together of services within a shopping centre or mall" (including the virtual type). As a consequence, specifications which involve the bringing together of services in some other manner will be judged on a case by case basis and referred to classification section where necessary.

## 4 The History of Classification

**The purpose of this information is to provide a breakdown on the history of the Classification system and the amendments made to the system throughout the years.**

### 4.1 The classification used from 1876 to 1938

When the registration of trade marks started in the UK in 1876 a system of 50 classes was used as a basis for the registration process. The classes used are shown in the Rules adopted at the time of the first Trade Marks Act. This system was in use until 1938 when the new Trade Marks Act and Rules of that year became law. The class headings as they were in 1938 are shown in Schedule 2 of the Rules 2000 (unamended version).

Each edition of the Rules from 1876 to 1938 shows the classification in force at a particular date. The 50 class system remained essentially the same during that period. In 1938 the registry published a "Guide to the Classification of Goods under the Trade Marks Acts 1905-1919". This shows the class headings and gives an alphabetical list of goods together with their class numbers. This is the best published guide to the classification during this early period and is available for consultation at the registry.

### 4.2 The International Classification (from 1938 to present)

At the International Conference under the auspices of the United International Bureau for the Protection of Intellectual Property (BIRPI), a predecessor of WIPO, a new classification for international purposes was drawn up. The UK adopted this classification in 1938. The class headings were published as Schedule IV to the Trade Mark Rules of 1938 and came into force for applications made on or after 27th July 1938. At the same time the 1938 Trade Marks Act came into force.

This classification was set out in more detail in two publications, namely, "The Alphabetical Index to the Substituted Classification of Goods" and "The List of Goods in each of the Classes of the Substituted Classification of Goods". The 1938 classification was added to and amended from time to time and the following are the Trade Mark Journals in which amendments appear:

First list:	J3197, 5th July 1939
Second list:	J3223, 3rd January 1940
Third list:	J3249, 3rd July 1940
Fourth list:	J3275, 1st January 1941
Fifth list:	J3301, 2nd July 1941
Sixth list:	J3328, 7th January 1942

Seventh list: J3353, 1st July 1942  
Eighth list: J3380, 6th January 1943

Ninth list: J3406, 7th July 1943  
Tenth list: J3432, 5th January 1944

Eleventh list: J3458, 5th July 1944

Twelfth list: J3484, 3rd January 1945

Materials made of plastics which are used for substantially the same purpose as textile materials: J3600, 9th April 1947

Thirteenth list: J3647, 3rd March 1948

Fourteenth list: J3717, 6th July 1949

In 1950 a new index was published incorporating the above amendments. The following are the Trade Mark Journals in which amendments to this appear:

First list: J3769, 5th July 1950

Second list: J3789, 10th January 1951

Third list: J3919, 8th July 1953

An errata concerning tomato juice was published in J4026, 27th July 1955.

Fourth list J4100, 6th February 1957

Amendments about clock and watch cases and travelling rugs were published in J4180, 20th August 1958.

This classification remained in force until 1965 when a further revised consolidated version of the classification was published following signature of the Nice Agreement.

### **4.3 The Nice Agreement and amendments to the classification**

The International Classification became the subject of the Nice Agreement in 1957 when a number of countries, including the UK which was already using it, agreed to adopt it for the registration of marks. The UK formally ratified the original Nice Agreement in April 1963 and ratified a revised "Stockholm" text (Cmnd 4437, 1970) in March 1970. The agreement in its latest form is reproduced in the WIPO publication "International Classification of Goods and Services for the purposes of the Registration of Marks". WIPO was set up 1970.

The following editions of the International Classification have been published since the Nice Agreement:

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First edition	1963
Second edition	1971
Third edition	1981
Fourth edition	1983
Fifth edition	1987
Sixth edition	1992
Seventh edition	1997
Eighth edition	2002
Ninth edition	2007
Tenth edition	2012

The first and second editions were only published in French as the official text.

An official English translation was published separately in 1965. This was updated by amendments published in the following editions of the Trade Marks Journal:

J4655,	15th November 1967
J4777,	18th March 1970
J4827,	3rd March 1971 (amended to be consistent with the 2nd edition of the International Classification)
J4987,	27th March 1974
J5015.	9th October 1974

The third edition of the International Classification was published in both English and French with both languages being authentic texts. This became effective on 1st February 1981. No changes of goods or services from one class to another were involved.

The changes introduced in the fourth edition became effective on 1st June 1983 and are set out in Trade Marks Journal 5464, 1st June 1983.

The changes introduced in the fifth edition became effective on 1st January 1987 and are set-out in Trade Marks Journal 5639, 8th October 1986.

The changes introduced in the sixth edition became effective on 1st January 1992 and are set out in a supplement to Trade Marks Journal 5897, 30th October 1991.

The changes introduced in the seventh edition became effective on 1st January 1997 and are set out in Trade Mark Journals 6152, 20<sup>th</sup> November 1996, 6153, 27<sup>th</sup> November 1996 and 6154, 4<sup>th</sup> December 1996.

The changes introduced in the eighth edition became effective on 1st January 2002 and are set out in a supplement to Trade Marks Journal 6407, 28<sup>th</sup> November 2001.

**Other changes or announcements concerning classification and date of publication are:**

Low alcohol drinks - classified from 27<sup>th</sup> April 1987 by reference 1.2% instead of 2% (by volume) alcoholic content, Trade Marks Journal 5669, 6<sup>th</sup> May 1987.

Introduction of the practice known as "All included in class", Trade Marks Journals 5669 and 5770, 6<sup>th</sup> May and 13<sup>th</sup> May 1987 .

Babies' napkins of cellulose or those predominantly of cellulose - transferred to class 16, Trade Marks Journal 5674, 10<sup>th</sup> June 1987.

Publication of the first edition of the Guide to Classification of Service Marks in the United Kingdom, Trade Marks Journal 5772, 10<sup>th</sup> May 1989.

Rule 21 objections in relation to class 9 and class 16 goods, Trade Marks Journal 5844, 10<sup>th</sup> October 1990.

Safes, computer programs and welding apparatus, Trade Marks Journal 5853, 12<sup>th</sup> December 1990.

Changes in class involving various goods and services, Trade Marks Journal 5902, 4<sup>th</sup> December 1991.

Rule 21 objections in relation to class 9 and 16 goods, Trade Marks Journal 5937, 19<sup>th</sup> August 1992.

Classification of diagnostic apparatus and instruments, paper hats and protective pads, Trade Marks Journal 5965, 10<sup>th</sup> March 1993.

Classification of shower cubicles, shower stalls, shower trays/bases, bath screens, partitions and parts and fittings for showers, Trade Marks Journal 5973, 5<sup>th</sup> May 1993.

Publication of the second edition of the Guide to Classification of Service Marks, Trade Marks Journal 5997, 13<sup>th</sup> October 1993.

Conversion for registrations classified under Schedule 3 to Schedule 4 of the Trade Marks Rules 1986, Trade Marks Journal 6007, 12<sup>th</sup> January 1994.

Practice in relation to the classification of computer games apparatus, video games apparatus, computer games software, programmes and cartridges, Trade Marks Journal 6011, 9<sup>th</sup> February 1994.

Classification of on-line and internet services and associated goods: UK practice at May 1996, Trade Marks Journal 6128, 5<sup>th</sup> June 1996.

Classification of on-line and internet services and associated goods: UK practice at July 1999, Trade Marks Journal 6282, 23<sup>rd</sup> June 1999.

Classification of on-line and internet services and associated goods: UK practice at July 1999 - Supplementary Notice, Trade Marks Journal 6291, 25<sup>th</sup> August 1999.

Practice Amendment Circular 02/99 Adding a class or classes to an application.\*

Practice Amendment Circular 04/00 Classification of on-line and internet services and associated goods: UK practice at February 2000, Trade Marks Journal 6319, 15<sup>th</sup> March 2000.\*

Practice Amendment Circular 10/00 Examination of wide specifications and objections under Section 3(6) of the Act, Trade Marks Journal 6334, 28<sup>th</sup> June 2000.\*

Practice Amendment Circular 13/00 Retail Services, Trade Marks Journal 6350, 18<sup>th</sup> October 2000.\*

WIPO Committee of Experts of the Nice Union, Classification of Goods and Services - Restructuring of Class 42 and Classification of Beer, Trade Marks Journal 6356, 29<sup>th</sup> November 2000.\*

Practice Amendment Notice 08/02 Examination of wide specifications and objections under Section 3(6) of the Act (published on website only)

Practice Amendment Notice 06/04 Territorial and other limitations (published on website only)

Practice Amendment Notice 06/05 Retail services

Practice Amendment Notice 05/06 Wide and vague specifications

Practice Amendment Notice 07/06 Retail services: search of the register

Practice Amendment Notice 01/09 Shopping centre services

\* also published on the Office's website.