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1 INTRODUCTION AND PURPOSE

The purpose of these instructions is to give details on the classification team procedures and to ensure consistent and uniform working procedures are adopted. It sets out the best working practice for the various procedures and duties undertaken.

2 CLASSIFICATION WORKING PROCEDURES: APPLICATIONS

The three essential principles which need to be borne in mind when classifying and editing the specifications of an application are:

- the goods or services should fall within the class(es) shown on the application;
- the descriptions are clear, within the context of the class number specified, and are understandable, in order that a proper search of the register may be carried out;
- the range of goods/services is not outside the practice concerning wide specifications.

The following paragraphs detail the procedures which apply these principles. However, there may be applications with specifications that appear to conflict with the guidelines but which make it perfectly clear what goods or services in which class are covered. Specifications that meet these requirements are acceptable and should not be edited merely to bring them into line with the contents of this manual. This should be borne in mind at all times when considering any changes to a specification.

The examination and editing of specifications is carried out by the Examiner. Classification is an integral part of the examination function and it is the Examiner's responsibility to ensure that the application is correctly classified. Each examiner has an individual responsibility to ensure that the application under examination is correct in all respects - including its classification. It is recognised that on some occasions expert help may be needed when classifying difficult items or activities. To this end in addition to the "International Classification of Goods and Services" list, the Classification Team provides a networked and constantly updated classification database which is available on the website. The Team also provides advice to staff on difficult cases.

The classification and editing of specifications involves a number of checks which are listed in outline below but are dealt with more fully in the section referred to after each item. The guidelines for punctuation and editing indicate the ideal. However it must be emphasised that if specifications are clear and the goods or services are properly classified they should not be changed.

2.1 How to classify goods and services

First, consult the "International Classification of Goods and Services". If the item is not listed then check the Registry's Classification Search database at www.ipo.gov.uk/tm/t-find/t-find-class.htm.

If no reference is found then consult the List of Classes together with the Explanatory Notes in the International Classification for those classes which are thought to be most appropriate. In the event that the item is still not capable of being classified, the following principles are used to determine its classification:

GOODS

(a) A finished product is in principle classified according to its function or purpose. If the function or purpose of a finished product is not mentioned in any class heading, the finished product is classified by analogy with other comparable finished products, indicated in the Alphabetical List of the WIPO International Classification. If none is found, other subsidiary criteria, such as that of the material of which the product is made or its mode of operation, are applied.

(b) A finished product which is a multipurpose composite object (e.g., clocks incorporating radios) may be classified in all classes that correspond to any of its functions or intended purposes. If those functions or purposes are not mentioned in any class heading, other criteria indicated under (a), above, are to be applied.

(c) Raw materials, un-worked or semi-worked, are in principle classified according to the material of which they consist.

(d) Goods intended to form part of another product are in principle classified in the same class as that product only in cases where the same type of goods cannot normally be used for another purpose. In all other cases, the criterion indicated under (a), above, applies.

(e) When a product, whether finished or not, is classified according to the material of which it is made, and it is made of different materials, the product is in principle classified according to the material which predominates.

(f) Cases adapted to the product they are intended to contain are in principle classified in the same class as the product. For example, cases for sunglasses – Class 9; cases for medical tools – Class 10; cases for rifles – Class 13; jewellery cases – Class 14 (not to be confused with trinket boxes – Class 20).

SERVICES

(a) Services are in principle classified according to the branches of activities specified in the headings of the service classes and in their Explanatory Notes or, if not specified, by analogy with other comparable services indicated in the Alphabetical List of the WIPO International Classification.

(b) Rental services are in principle classified in the same classes as the services provided by means of the rented objects (e.g., Rental of telephones, covered by Class 38).

(c) Services that provide advice, information or consultation are in principle classified in the same classes as the services that correspond to the subject matter of the advice, information or consultation, e.g., transportation consultancy (Class. 39), business management consultancy (Class. 35), financial consultancy (Class. 36), beauty consultancy (Class. 44). The rendering of the advice, information or consultancy by electronic means (e.g., telephone, computer) does not affect the classification of these services.

2.2 Goods or services to be grouped together by class number

An application may be made in more than one class. Where an application relates to more than one class the statement of goods and/or services shall specify for each item each separate class for which registration is sought. If there are items proper to more than one class they should be grouped together by reference to their specified class number. In all cases the items or groups of items specified by class number should be listed in consecutive numerical order. Where goods or services do not relate to the class number(s) specified on the application form, the applicant may add an extra class or classes to his application subject to payment of the appropriate additional class fee(s).

If an application is filed without a class number and the goods fall in more than one class, for example, detergents, which can fall in classes 1, 3 and 5, the examiner will advise the applicant of the deficiency in the examination report (under Rule 13) in order to give the applicant the opportunity to amend the application to comply with Rule 8(2)(a) and 8(3) :

(2) Every application shall specify-

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

(3) If the application relates to more than one class in the Nice Classification the specification contained in it shall set out the classes in consecutive numerical order and the specification of the goods or services shall be grouped accordingly.

Note that it is the responsibility of the applicant to insert the class number on an application form and in cases of doubt, pre-filing advice is freely available from the Classification Team.

2.3 Editing vague or incomprehensible specifications or terms within specifications

The first thing to establish about any specification applied for is whether or not the goods or services for which cover is sought is understandable. If most of the specification is too vague and cannot be classified, details of the goods or services should be requested. If necessary, further information should be sought, such as in the form of brochures or pamphlets published by the applicant, which are directly relevant to the application. It puts the onus on the applicant to send this further information to help clarify what the specification is intended to cover and provide suitable wording for this.

If a class has been specified by the applicant this may enable an Examiner to edit a vague item so as to suggest an acceptable term. Such amendments must be brought to the applicant's attention in the examination report. If only a minority of terms are not understood these should be edited to something comprehensible or removed altogether and a note put on the examination report under the edited specification that.....(list items) are too vague and should be further explained if not covered by the edited specification.

For example:

Class 9 Computers; computer programs; tapes and discs, all being magnetic and for use in the recording of data; compusificators.

Offer in the examination report letter:

Class 9 Computers; computer programs; tapes and discs, all being magnetic and for use in the recording of data.

and add a note reading "Compusificators" is not understood and further explanation should be given if it is not covered by the above specification.

Note: if the term "compusificators" is explained and accepted or another term accepted in its place, the application may have to be re-searched by the Examiner.

If the specification is preceded by a class number it will be acceptable to allow certain terms which, without the class designation, would prove to be too vague to classify. For example, an application filed for:

Class 35 Information services

This is acceptable since these services can only relate to business, advertising, accounting etc in Class 35, whereas "information services" without any class designation is far too vague, encompassing information in relation to any activity or goods.

Other examples of goods or services that should not be queried are:

Class 3 Detergents (can only relate to detergents in that class);

Class 6 Building materials (only covers metallic goods);

Class 14 Badges (limited to badges of precious metal for wear);

Class 25 Protective clothing (class specified effectively excludes protective clothing in Class 9);

Class 33 Beverages (can only mean alcoholic beverages classified under this class);

Class 38 Rental services (edit to rental of telecommunications apparatus: that is all that is in this class).

However, specifications that are so vague or incomprehensible that it would be pointless to examine the application without clarification should be queried by getting more information from the applicant either using the examination report or, alternatively, it may be quicker and more convenient to speak to the applicant or their agent by telephone.

If the reply is not clear a letter seeking further clarification should be sent.

Examiners should not raise expectations which cannot be fulfilled. On a number of occasions in the past practitioner's have complained that they had provided further details about the goods on an application only to be told that it was not possible in the circumstances to add a class. In situations where Examiners have to raise a specification query they should consider the likely implications of such a request. It should be made clear from the outset whether a

class or classes will be allowed to be added. For example, if an applicant files for “materials for making tiles” under Class 17 there is no point in saying that “it might be possible to add a class” since there are a range of materials in Class 17 for use in making tiles.

2.4 Goods or services incorrectly classified by the applicant

If it is clear from the specification that there are goods or services that are obviously proper to other classes that the application does not cover, the applicant will be informed of the discrepancies in the examination report. For example, an application for:

Class 33 Wines, lager, stout, shandy and beer.

the applicant would be advised that "lager, stout, shandy and beer" are proper to Class 32 and invited to add a class thus extending the application to cover Class 32.

Similarly an application filed for:

Class 39 Arranging of travel; providing car hire; booking of accommodation for travellers.

would prompt the examiner to advise the applicant in the examination report that the service of "booking of accommodation for travellers" is proper to Class 43. Again the applicant has the option of extending the application to cover two classes. In the event of these discrepancies being raised at the examination report stage, the applicant will have an opportunity to add an extra class or classes (by filing a form TM3A) after examination. This applies even if a majority of the goods or services are not covered by the class or classes stated. Alternatively, the goods or services that are not covered by the present class or classes may be deleted.

It is the Examiner's responsibility to check that the classes listed adequately reflect the goods or services shown on the application and if necessary raise the question at the examination stage. This applies even in instances where the majority of the application is covered by the correct number of classes, for instance as in the specification shown in the example above: Class 39 Arranging of travel; providing car hire; travel insurance. In this example, it will be necessary to inform the applicant that "travel insurance" is a service proper to Class 36

In the case of an application filed where the goods or services are correctly classified but could also be proper to other classes **no action will be taken**. For example, "valves" fall in ten classes, the classification being determined by purpose and material. If an application is received for e.g. Class 7 Valves, it will be assumed that the only goods required to be covered are valves in Class 7, i.e. valves being parts of machines and no mention made to valves falling in other classes.

2.5 Amendment of a specification of an application

For various reasons there may be need during an application's progress to amend the statement of goods or services. For example, a specification may have to be restricted in order to overcome an objection or a class added because of incorrect classification. Section 39 of the Act sets out the principles which govern practice in this area:

(1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.

If the application has been published, the withdrawal or restriction shall also be published.

(2) 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 following paragraphs set out in detail the registrar's practice on restrictions, broadening in scope and adding and deleting classes in relation to applications.

2.6 Restriction of the goods or services

Note that once a specification has been restricted it cannot subsequently be changed back to its original scope. Section 39(1) of the Act gives the applicant the right to restrict his specification at any time, but there is no corresponding right to reinstate goods or services that have been previously deleted. Because files are open to public inspection after publication, the applicant's written request for deletion of goods or services must be taken as irrevocable unless the applicant can show that the request to restrict the specification was a mistake. Evidence is required to show that a request was made by mistake, e.g. misunderstanding a client's instructions. A change of heart is not considered to be a mistake even though an error of judgement may have been made in requesting deletion of goods or services.

2.7 Adding a class or classes to an application: the law

The parts of the legislation which govern practice in this area are:

Rule 8(4)

If the specification contained in the application lists items by reference to a class in the Nice Classification in which they do not fall, the applicant may request, by filing Form TM3A, that the application be amended to include the appropriate class for those items, and

upon payment of such class fee as may be appropriate the registrar shall amend the application accordingly.

and

Section 39(2)

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 service covered by the application.

2.8 Adding a class or classes to an application: practice

Put in simple terms, a class may only be added when an application explicitly lists goods or services which are not in the class shown on the application form, with the proviso that the addition of any class is a correction which does not broaden the scope of the specification as filed. You cannot add a class where items **may** be in another class but, at the same time, may also be covered by the specification as filed.

Rule 8 and Section 39(2) of the Act have to be read together. It is clear that these provisions only allow the addition of a class where the specification explicitly lists goods or services which are in a different class and have been included only because of an error of wording or copying or as an obvious mistake.

Therefore, in most cases, an applicant may only be invited to make a specification explicit within the boundary of the class of goods or services which appears on the application form.

For instance, an applicant who filed for “non-alcoholic beverages” in Class 30 could not add Class 32 after filing in order to cover, e.g. “orange juice”, since “tea” and “coffee” are beverages which come within the scope of Class 30. To permit such an addition does not satisfy Rule 8(3) and moreover, would extend the goods (only Class 30 beverages have been applied for) and thus would be contrary to Section 39(2). However, Class 32 could be added if the specification was filed as “non-alcoholic beverages and orange juice”, but only for “orange juice”.

In the case of an application filed in Class 27 for “computer hardware; and all other goods/services in this class”, it would be possible to allow the addition of any class in which “Computer hardware” falls in (since no “computer hardware” is appropriate in Class 27). Concerning the “all other goods in this class”, the applicant would be required to specify which Class 27 goods require protection. With regard to “all other services in this class” this would have to be deleted since there are no services in Class 27 (which is self evidently a goods class).

Note that when applicants are invited to file a TM3A to add a class or classes, they should be informed that the mark has not been examined in respect of the goods or services that have been identified as being incorrectly classified. Examination of these items may only take place on receipt of the TM3A.

2.9 Deleting a class or classes from an application

This can be done at any time during the prosecution of an application and under no circumstances should a Form TM12 (Request to divide an application) be requested from the applicant to carry out this action. The restriction of goods or services is permitted under Section 39(1) because this is merely a narrowing of the scope of a specification.

2.10 Amending a class number where all the goods or services have been incorrectly classified

If there is a contradiction between the whole list of goods or services and the class number, the problem can be solved by simply amending the class number (after informing the applicant or agent). This circumstance falls within Section 39(2) (c) of correcting an obvious mistake. A form TM3A is not required to correct this type of error. Therefore, if the goods or services have been correctly stated on the application form, **and the goods or services are clearly not in the class as filed**, this can be allowed.

For example, a single application filed for:

Class 9 Computer programming

would clearly indicate a service and the application should be allowed to transfer to Class 42.

If, however, an application with a specification for "All goods in Class 31" is filed, this cannot subsequently be transferred to Class 29. People searching the pending marks would have no idea that the Class 31 application was intended to cover such goods. If someone applied in Class 36 for "insurance services" and it turned out that they sold computers, a transfer to Class 9 would not be possible.

It will be necessary to update the databases to reflect any change as soon as possible.

2.11 Transfer of goods or services where an application covers more than one class

If on a multi-class application there are goods or services incorrectly classified it is allowable to transfer those goods or services between the classes shown on the application. For example, an application specifies:

Deodorants for personal use; room deodorants; perfumes.	Class 3
Air freshening preparations.	Class 5
Air deodorising apparatus.	Class 11

In this example "room deodorants" are wrongly classified in Class 3 and should be deleted from the Class 3 specification. They are proper to Class 5 and may be transferred and the Class 5 specification edited to "Air freshening preparations; room deodorants".

It may be the case that there are insufficient classes to cover all the goods or services.

For example:

Deodorants for personal use; perfumes.	Class 3
Air freshening preparations; room deodorants.	Class 5
Air deodorising apparatus; deodorising apparatus for personal use.	Class 11

In this example "deodorising apparatus for personal use" falls into Class 21 but the application only covers Classes 3, 5 and 11. This will be brought to the applicant's attention in the examination report and the applicant will be given the opportunity to file a TM3A ("Request for additional classes following examination") and add Class 21. Alternatively, the applicant will have the option to delete the goods from the specification.

2.12 Amendment of a specification of an application after publication

The scope to amend a published application is governed by Section 39 of the Act and Rule 25, the relevant parts of which read:

Section 39:

- (1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.
- (2) In other respects, an application may be amended, at the request of the applicant, only by correcting-
 - (a) The name and 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.

Rule 25-

- (1) Where, pursuant to section 39, a request is made for amendment of an application which has been published in the Journal and the amendment affects...the goods or services covered by the application, the amendment or a statement of the effect of the amendment shall also be published in the Journal.

(2) Any person claiming to be affected by the amendment may, within one month of the date on which the amendment or a statement of the effect of the amendment was published under paragraph (1), give notice to the registrar of objection to the amendment on Form TM7 which shall include a statement of the grounds of objection which shall, in particular, indicate why the amendment would not fall within section 39(2).

Therefore, once the specification of an application has been published and then subsequently amended, the amendment must also be published (but not the whole application).

2.13 Correction of an error in classification before registration

If an error in classification is detected at the publication stage, the applicant should be contacted in order to rectify it before the mark is registered. It is in the interest of the applicant to ensure that his goods or services are in the correct class since such an error would result in his mark being overlooked when later filed applications are examined for potentially conflicting marks.

Moreover, in the event that a subsequent application is made for an international registration which is based on a UK application that includes incorrectly classified items, an irregularity? notice will be issued by WIPO, thus delaying its progress.

2.14 Objections to broad claims: practice

Objections under Rule 8(2) will be raised in **all classes** where a claim is made to "All goods" or "All services" - these descriptions are too broad and too vague and do not constitute a proper list of goods or services. Objection will also be taken in any class against specifications such as: "electric, electrical and/or electronic apparatus, appliances, devices, equipment and/or instruments" (whether listed separately or in combination).

Applications in the service classes which continue to include claims such as "services that cannot be classified in other classes" or "miscellaneous services" will continue to face an objection under Rule 8.

Applications for specifications that are drafted in the form of the headings to the International Classes will not, in the main, be subject to a broad specification check. The exceptions are Classes 7 and 45 (and if a specification in class 9 includes the terms "Electrical and electronic apparatus and instruments").

Class 7

Claims to "machines" without further qualification will be objected to. The following gives examples of descriptions which are acceptable, since in each case the end use of the machine has been identified:

Machines for agricultural purposes;

or Machines for use in manufacturing processes;

or Machines for the woollen industry

or other specific machines, e.g. washing machines.

Class 9

Applications filed in Class 9 which continue to make reference to "electric, electrical and/or electronic apparatus appliances, devices, equipment and instruments" (formerly part of the class 9 heading before 2002) will be objected to - whether listed separately or in combination.

Class 45

The class heading for Class 45 is:

Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals.

The final part of the heading, "personal and social services rendered by others to meet the needs of individuals" is considered too broad in scope and consequently an objection under Rule 8(2) will be raised against applications containing this description. Objections will also be taken against applications where specifications contain either "personal services" or "social services" as individual elements, e.g. "personal services rendered by others to meet the needs of individuals" or the like broad descriptions. The second part of the heading, "security services for the protection of property and individuals" is sufficiently precise and will not attract an objection.

In addition to the above, rule 8(2) objections may also be used to challenge other statements of goods or services that are considered too vague and/or too broad, for example against "retail services" in Class 35.

2.15 At what stage should a Rule 8(2) objection be raised?

The Rule 8(2) objection should only be taken at the examination stage and if the Examiner so determines, the search may be restricted to the named goods. However, if only the named goods are searched, this must be brought to the attention of the applicant in the examination report - who may subsequently broaden the specification to cover more goods (providing the goods are within the ambit of the specification as originally filed).

As always though, each case is a matter of judgement for the Examiner and providing an "all class" search does not result in a waste of resources, the wider search option is available.

2.16 Dealing with replies to broad claim objections

In dealing with replies to Rule 8(2) objections, examiners must consider the arguments submitted by applicants about each application on their merits. In some instances, applicants will rely on previous acceptances in order to justify a broad specification on a fresh application. This is not acceptable. The applicant should be reminded that each application has to be looked at on its own merits and that the question that needs to be addressed is "is this mark being used (or is there a definite intention to use) in relation to all the goods and/or services of this application"? There is normally no justification in accepting very wide specifications merely because the applicant states that the cover provided by its "house" mark

is very wide. Again, each mark has to be looked at individually in relation to the goods and/or services claimed.

In the absence of any evidence showing use of the mark it may prove necessary to seek a witness statement or statutory declaration from the applicant which might satisfy us that the applicant has a bona fide intention to use the mark in relation to all the goods or services claimed. However, this should only be sought if the Examiner thinks that it is unlikely that the mark applied for would be used in trade or business in connection with **all** the goods or services claimed.

Rule 62(1) (a) of the Trade Marks Rules 2008 gives the Registrar authority to seek information:

“Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of any proceedings as the registrar thinks fit, and in particular may-

- (a) Require a document, information or evidence to be filed within such period as the registrar may specify;

Any evidence submitted should be adequately identified, e.g. relevant passages underlined or similarly marked to show wide use of the mark or that the applicant's business is extensive in range.

2.17 All goods in Class: the Trademark Law Treaty and Regulations

The Trademark Law Treaty, (which can be viewed on the WIPO web site at www.wipo.int/treaties/en/ip/tlt/trtdocs_wo027.html - sets out international administration practice and procedure. In particular Article 9(1), Classification of Goods and/or Services states:

"Each registration and any publication effected by an Office which concerns an application or registration and which indicates goods and/or services **shall indicate the goods and/or services by their names**, grouped according to the classes of the Nice Classification, and each group shall be preceded by the number of the class of that Classification to which that group of goods or services belongs and shall be presented in the order of the classes of the said Classification".

The following sets out practice in relation to specifications that refer to "all goods" or "all services":

Where a claim to "all goods" or "all services" is made on an application, a Rule 8(2) objection will be raised. However, the Examiner should (with the exception of Classes 7 and 45 and for specific goods in Class 9) edit the specification to that of the appropriate class heading shown in the International Classification (but should not include any qualifications contained in parentheses). The applicant may decide to list specific goods or services as an alternative or in addition to the class heading. In relation to Classes 7 and 45, no proposals should be made and the applicant should be asked (in the examination report) to provide a statement of the goods or services.

For instance, a specification reading "All goods in Class 10" should be changed to reflect the class heading, namely:

Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials.

The applicant must be given a reason for the change in the specification. The Examiner should state that the specification as filed is not allowable because the goods are not named but if the proposal in the report is not acceptable any counter proposals will be considered. This offer can be made because a class heading only serves to indicate in broad terms what a particular class includes and if there is doubt that the proposed specification does not cover all the goods intended to be used in connection with the mark, items may be added which fall in the class of the application. For instance in the above it would be possible to add e.g. "parts and fittings for all the aforesaid goods" since the class heading does not list these goods.

Note that applications filed with specifications such as:

Class 25: Articles of outer clothing and all other goods in this class

will continue to be edited in the normal way, i.e. to "Articles of outer clothing". It will be assumed that the scope of cover is not intended to embrace all goods in the class but the applicant may later wish to broaden the specification to include e.g. "underwear" which is allowed. Any broadening of a specification, subsequent to its editing, but which is still within the ambit of the specification originally filed, may necessitate a re-search.

Some specifications include "all goods" followed by a qualifying statement, e.g.:

Class 1: All goods in Class 1 for use in agriculture, horticulture and forestry

Class 5: All goods in Class 5 for destroying vermin.

These specifications will not be acceptable since although the goods' purposes are stated, the goods are not named. The two examples shown above should be edited to:

Class 1: Chemical products for use in agriculture, horticulture and forestry

Class 5: Preparations for destroying vermin

The applicant should be informed that "All goods" is not an acceptable statement of the goods and the above is proposed as an alternative. The registrar will be prepared to consider the addition of the other goods falling in these classes that can be used in agriculture, horticulture and forestry or for destroying vermin (and which are included in the original description)..

2.18 Punctuation, qualifications and use of "all for" as a qualifier

Precise punctuation is important to ensure clarity in a specification. Providing punctuation is clear it need not be changed and should not be changed merely to fit in with an examiner's particular style (e.g. there is no need to delete a comma before the word "and").

Please note that we also allow capital letters to be used in specifications for the separation of terms and we allow specifications which consist wholly of capital letters.

The following guidelines are intended to help examiners assess whether the punctuation is clear and offers advice on improving punctuation if necessary.

In specifications which list a number of goods or services without uses or other qualifications, either commas or semi-colons may be used between the goods/services e.g.:

"Coffee, tea, rice, bread, salt." or "Coffee; tea; rice; bread; salt."

or combinations of the two e.g.:

"Coffee, tea, rice; bread; salt." or "Coffee; tea; rice, bread and salt".

In the above examples the meaning would not be altered if any or all of the commas were replaced by semi-colons. In many other situations the correct use of commas and semi-colons is of great importance e.g.:

"Ingredients for food; hydrocarbon preparations and resins, all for use in the manufacture of paints; plastics and fertilizers".

Any alteration to the punctuation of the above specification would result in a change in the way the specification could be interpreted. The "all for use in the manufacture of paints" is only intended to apply to "hydrocarbon preparations and resins" and the semi-colons around this item and the comma before "all for use in the manufacture etc." achieve this.

The use of the term "all for" should also be noted in the above example.

"Hydrocarbon preparations and resins for use in the manufacture of paints"

This is not clear since it is uncertain whether the "hydrocarbon preparations" are for use in manufacture or not.

Qualifications which follow a comma only refer to those goods or services which follow the previous semi-colon e.g.:

"Pharmaceutical preparations; plasters and bandages, all for surgical use"

The qualification "all for surgical use", refers only to plasters and bandages;

And in:

"Meat; fish, poultry and game; jams; fruit and vegetables, all being preserved"

The qualification "all being preserved" refers only to "fruit and vegetables" because these are the only goods which follow the previous semi-colon.

Qualifications which follow a semi-colon refer to all the preceding goods or services, e.g. in a specification reading:

"Bleaching preparations, detergents and fabric softeners; all for laundry use".

The qualification "all for laundry use" applies to all the preceding goods.

Where goods or services are to be qualified by a number of items or uses, the qualifications should be separated by commas and the last item worded so as to relate all the items in the qualification to the goods or services being qualified.

When specifications are framed as in the following example:

"Banking, life insurance and consultancy and advisory services relating to the aforesaid services".

There is no need to edit this to:

"Banking, life insurance and consultancy and advisory services, all relating to the aforesaid services"

Since it is obvious that both the consultancy and advisory services relate to banking and life insurance.

Similarly there is no need to edit:

"Telecommunications apparatus and instruments for maritime use"

to

"Telecommunications apparatus and instruments, all for maritime use"

In these examples it is clear that the qualifications are meant to apply to all the services or goods (i.e. the items "read through" to the qualification) and to edit such specifications to conform to the ideal is not sensible.

Full stops are allowed within the body of a specification, e.g.

"Soaps and bleaching preparations. Cleansing preparations and conditioners; all for laundry use."

In this instance if the full stop is changed to a semi-colon, the limitation would then apply to the whole specification (which is obviously not intended).

2.19 All included in Class

Under previous Trade Marks Acts it was necessary to qualify goods or services which without qualifications could be proper to other classes.

Under the 1994 Act there is no need to add any qualifications since goods or services have to be read in conjunction with the class or classes indicated on the application form. This applies to all specifications including those with parts and fittings in the goods classes and with information, advisory and consultancy services in the service classes. Therefore, the following and similar specifications should be accepted without amendment:

Class 12 Cars, buses and trucks and parts and fittings for the aforesaid goods.

Class 45 Legal services; arbitration and conciliation services; information, advisory and consultancy services for the aforesaid services.

In these two examples the class designation which precedes the goods or services serves to qualify the goods and services.

It may be that some applicants will prefer to qualify goods or services using "old" qualifications. This is not wrong and these versions may continue to be accepted, e.g.:

Class 30 Biscuits, all being in Class 30

Class 39 Travel agency services included in Class 39.

Although in both these examples the qualifiers are redundant, they should be left in the specification if the applicant wishes to retain them.

2.20 Exclusions

Exclusions are the opposite of positive limits in that they define what the goods or services are **not**, starting with the wording "but not including..." Following the judgment of the ECJ in the *Postkantoor* case, C-363/99, there is reduced scope for overcoming section 3(1) objections using exclusions. Previously known as the "penguin practice", because of its inception as a result of Penguin Book's trade mark application, it was the registrar's practice to allow exclusions in respect of marks which are descriptive of goods in the specification having certain characteristics, but acceptable for the same goods without that characteristic.

However, *Postkantoor* makes it clear that the Trade Mark Directive, from which the UK Act is derived, "prevents a trade mark registration authority from registering a mark for certain goods or services on condition that they do not possess a particular characteristic". In other words, excluding the particular characteristic that the mark describes is not an option. The reasoning that the Court gave for this ruling is underpinned by the legitimate interest of other traders; an exclusion in relation to particular characteristics might cause other traders to refrain from using that sign in trade, because it would be unclear that the mark's protection did not actually extend to those goods or services for which it was descriptive. They would not know, as a general rule, about the exclusion and there might be legal uncertainty, which is what the Directive is intended to prevent.

Characteristics versus sub-categories

However, there is still a place for exclusions provided they are in respect of categories or sub-categories of goods or services and **not** in respect merely of their characteristics. A characteristic is a specific quality, attribute or trait, whilst a category is a group or sub-group of the item. The term “characteristic” includes not only obvious descriptions, such as “pink” for shirts, but also covers when, where, why and how the goods or service may be supplied and their intended purpose. It would not therefore be acceptable to exclude, for the mark “Post Office”, postage stamps provided they are not connected with a post office.

When considering employing exclusions, regard must be had to whether the exclusion will render the mark deceptive or whether it is likely that the applicant intends to use the mark on goods or services for which it is not descriptive (otherwise, it may be open to a bad faith objection (section 3(6)).

The following are examples of acceptable and unacceptable exclusions:

Acceptable:

Mark: **TUTANKHAMUN**

Specification: “Printed matter; but not including educational, archaeological or historical printed matter.

This is acceptable because printed matter can be sub-categorised; books on history etc would be a sub-category rather than a characteristic. An exclusion merely in relation to books about Tutankhamun would be too narrow as the applicant would then have cover for similar goods (such as books about Egyptology).

Mark: **VELVET BUNNY**

Specification: “Toys, games and playthings; but not including soft toys”.

This is acceptable because soft toys can be regarded as a subcategory of toys and the mark would not be descriptive of other types of toys.

Mark: **FISH**

Specification: “Cleaning preparations; cosmetics; preparations for the hair; but not including soaps.”

This overcomes the problem with novelty soaps, novelty soaps being a sub-category in this class. It would be insufficient simply to exclude soaps in the form of fish.

Unacceptable:

Mark: **ROSE**

Specification: “Cosmetics, perfumes, toiletries; but not including any such goods scented to smell like roses.”

This exclusion does not overcome the descriptiveness objection because the exclusion relates simply to goods bearing the characteristic described by the mark.

This objection cannot be overcome for this type of goods.

Mark: **DAFFODIL**

Specification: “Chinaware; glassware; ornaments, statuettes and figurines; but not including any such goods in the form of or decorated with flowers”.

This would not overcome the descriptiveness objection because the mark describes a characteristic of the goods; and it is common in the trade for goods of this type to be decorated florally.

Mark: **FROG**

Specification: “Footwear; but not including footwear in the form of frogs”.

This exclusion does not overcome the descriptiveness objection. The exclusion covers only a specific characteristic of the goods rather than a sub-category. The objection could be overcome by excluding “novelty footwear.”

Mark: **BROADBAND GLOBAL**

Specification: “Telecommunications; provision of telecommunications information; transmission of messages and images; broadcasting services; but not including any such services provided by or about the internet.”

The exclusion does not overcome the descriptiveness objection. “Broadband” is a characteristic of telecommunications services, usually, although not exclusively, associated with internet use. Internet services are not a sub-category of a broadband telecommunications service. The mark describes a specific characteristic of a telecommunications service, i.e. a broadband telecom service providing global access.

The descriptiveness objection cannot be overcome. Broadband services are a subcategory of telecommunications services, but it is implausible that the applicant would apply for a mark like this in respect of non-broadband services. Consequently, a proposal to exclude “broadband telecommunication services” would give rise to further objections under section 3(3) (b) - because other use would be deceptive - and Rule 8(2) because there is no real intention to use other than for broadband services.

Note that the use of exclusions to overcome objections is covered in the Trade Marks Examination Guide.

2.21 Territorial and other limitations

The purpose of a specification is to provide a statement of the goods and services. (Section 32(2) (c)). Under the 1994 Act provision is made under Section 13 for specified territorial or other limitations. Geographical limitations have in the past been incorrectly included in lists of goods and services rather than expressly identified as limitations. Therefore, in instances where there are geographical limitations which appear in the statement of goods/services, applicants will be required to delete these and insert them in Box 9 on the form TM3. Section 13, which governs the practice on limitations reads:

Registration subject to disclaimer or limitation 13(1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may-

- (a) disclaim any right to the exclusive use of any specified element of the trade mark, or
- (b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation;

and where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 9 (rights conferred by registered trade mark) are restricted accordingly.

There is a need to distinguish between territorial limitations, which are properly the subject of a voluntary limitation of rights under Section 13 of the Act, and restrictions of the type or kind of products or services included in the statements of goods/services. In the first category are territorial limitations such as:

Pharmaceutical preparations and substances, none being for export, other than to the Republic of Ireland;

Cosmetics and soaps, all for sale in Northern Ireland and Scotland;

Manufactured tobacco, for export from the United Kingdom to Zambia, the Republic of South Africa and Tanzania;

Nightclub services provided in London;

All of the limitations which appear under this category must not be included in statement of goods or services and should be entered in Box 9 of the form TM3 and recorded under the limitations field on the Registry database as, for example:

Registration of this mark is subject to the following limitation: The rights conferred are limited to goods which are not for export, other than to the Republic of Ireland;

Registration of this mark is subject to the following limitation: The rights conferred are limited to goods for sale only in Northern Ireland and Scotland;

Registration of this mark is subject to the following limitation: The rights conferred are limited to services provided only in London.

Registration of this mark is subject to the following limitation: The rights conferred are limited to goods solely for export from the United Kingdom to Zambia, the Republic of South Africa and Tanzania.

Secondly, there are restrictions which particularise the type of goods or services, their purpose, method of sale or geographical origin, or otherwise qualify the goods or services so as to more accurately describe them. For example:

Fertilizers for use in the care of house plants;

Pharmaceutical substances for use in treatment of cardiovascular diseases;

Gardening magazines;

Alcoholic beverages, but in so far as whisky and whisky based liqueurs are concerned only Scotch whisky and Scotch whisky based liqueurs produced in Scotland;

Transportation of goods by rail;

Pharmaceutical preparations for supply only on prescription of a registered medical practitioner;

Lubricants, for sale in containers of not less than 20 litres;

Milk and cheese, the produce of Northern Ireland;

Cleaning preparations; preparations for the hair; but not including soaps;

Financial services, but not including banking;

Building materials (not of metal).

All of the above types of limitations may continue to be accepted in specifications of goods or services.

For the purposes of examination on relative grounds, the registrar will treat registrations which contain a restriction of the type exemplified above as a voluntary restriction of rights under section 13 of the Act.

The revised practice came into force on 26th July 2004. An application filed on or after this date with a territorial limitation contained in the body of the specification will face objection at the time of issue of the examination report. A pending application filed before this date which includes such a limitation within its specification (or if the Registrar has already agreed to a revised specification including a territorial limitation) will not be amended unless the applicant makes an appropriate request. In respect of registrations and other pending applications filed before the implementation date, the revised practice will also apply to requests (or requirements) to enter territorial limitations made on or after 26th July 2004.

2.22 Use of registered trade marks in specifications

Trade Marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade are not registrable in the *prima facie*. However, the Trade Marks Act recognises that such signs or indications are capable of being registered if they have acquired a distinctive character through use as a trade mark. For instance the word DIGITAL is registered in Class 38 but is also used in trade as a description, as in, for example, “digital television broadcasting”. Moreover, Section 11 of the Act makes it clear that a registered trade mark is not infringed by the use of indications concerning characteristics of goods or services or indications of their intended purpose, provided the use is in accordance with honest practices. Therefore, it is acceptable to include in specifications ordinary dictionary words (or words common to the trade) which in the context of a statement of goods or services function as descriptions but which may at the same time be registered trade marks. It is also acceptable in a specification to use a registered trade mark as a description provided that use is not in the same context as the goods or services for which the mark is registered. For example, POLO is registered in many classes but is also descriptive of a type of shirt in Class 25. Therefore in Class 25 specifications, the term “polo shirts” is acceptable as a description.

This practice **does not** apply to surnames or coined or invented words as registered trade marks. For instance, JACUZZI would not be acceptable in any specification: it is registered for "whirlpool baths". YO-YO is a registered trade mark and applicants are asked to substitute it with "spools incorporating coiled string which rewind and return to the hand when thrown". The word TELECOPIER is registered in Class 9 and must not be used in place of facsimile machines or services (in Class 38). The surname HOOVER is a well known registered brand of vacuum cleaner and as a registered trade mark cannot be used to describe such equipment or the service of vacuuming.

NB: An expanded list of registered trade marks and acceptable alternative terms which may be used in specifications follows:

REGISTERED MARK	CLASS/ES	ACCEPTABLE ALTERNATIVE
ALLEN	08	Hexagonal wrenches; hexagonal spanners
ARTEX	02	Distemper
BABYGRO	25	All-in-one stretch garments for babies
BAND-AID	05	Adhesive dressings/materials
BLUETOOTH	09	Telecommunication equipment
BIRO	16	Ball point pen
CATSEYE	09	Reflecting road studs
BLUE-RAY DISC	09	Optical and magneto-optical discs
BOOGIE	28	Body boards
BOTOX	05	Botulinum toxin
DICTAPHONE	09	Instrument for recording and reproducing dictation
DISCMAN	09	Portable compact disc player
ELASTOPLAST	05	Elasticised dressings
FRISBEE	28	Toy flying saucer

GATEWAY	37	Telecommunication access services
HOOVER	07	Vacuum cleaners
HULA HOOP	29	Circular tubed plaything
IPOD	09	Portable digital music device
JACUZZI	11	Whirl pool baths
JEEP	12	All terrain vehicles
MEMORY STICK	09	Data storage media device
PERSPEX	17	Synthetic resin sold in the form of sheets
PORTAKABIN	06 & 19	Portable buildings
ROLLER BLADE	28	In-line skates
STRIMMER	07	Grass cutting machines
SELLOTAPE	16	Adhesive tape
SIMWARE	09	Computer programs and software
SLUSH PUPPY	30	Frozen confectionery
TELETEXT	38	Television screen based information broadcasting and retrieval services
THERMOS	21	Insulated flasks
TUPPERWARE	21	Plastic food containers
VASELINE	05	Petroleum jelly
VELCRO	26	Hook and eye fasteners
VELUX	06 & 19	Roof windows
WALKMAN	09	Portable audio equipment
YO YO	28	Spools incorporating coiled string which rewind and return to the hand when trown

2.23 Use of standard specifications

Whilst the use of standard specifications is to be encouraged, their function is for the sole purpose of initial examination only. Individual applications may require further modification to take account of any other objections under the Act or Rules, e.g. under Section 3(3)(b) if the mark is deceptive or Section 3(6) if the goods, when read in conjunction with the mark, seem to be too broad.

2.24 Communicating changes in specifications to customers

If a change is made to a specification it must be brought to the applicant's attention by:-

- underlining or typed in bold in the case of lengthy specifications **and**
- in all cases pointing out the specific changes made and reasons for them.

In relation to all specifications:

Changes **must** be underlined or typed in bold **and reasons** given. If only deletions are made the reasons **must** be stated. Where substantial changes are made involving a large degree of re-editing these **must** be explained. Also, deletion of any wording **must** always be explained.

Furthermore, a reason **must always** be given for any substantial amendment which affects the protection sought For example:

"the punctuation has been amended to ensure that the qualification applies to all the goods" or "the goods "potato crisps" have been deleted because they are proper to Class 29".

2.25 Updating the OPTICS database

On some applications there is scope to allow the updating of the OPTICS database before the ready for advert (RFA) stage is reached. There are instances where applicants may file wide specifications which attract objections under Rule 8(2) but subsequently agree to restrict the range of goods or services. In these cases there is a clear benefit in updating OPTICS as soon as possible in order that the true position of an application is correctly reflected on the database. When an applicant agrees to restrict a wide specification following the raising of an objection under Rule 8(2), OPTICS should be updated immediately. If there is no agreement from the applicant to limit the goods or services, OPTICS must not be updated. Some applicants anticipate an objection under Rule 8(2) by writing soon after the application has been filed in order to request a restriction of the specification. For example some agents file for "articles of outer clothing and all goods in the class" and shortly afterwards send a letter which limits the goods to "articles of outer clothing" thus avoiding an objection under Rule 8(2). In these instances OPTICS should also be updated as soon as notification of the limitation is received but not before.

In any other circumstances (e.g. following an objection under section 3(1) or more likely to avoid notification on relative grounds OPTICS **must not** be changed until the mark is ready for publication. OPTICS would not be updated before the application is ready for publication if, for example, in the case of an application filed in respect of "motor vehicles" which is limited to "agricultural tractors".

3 CLASSIFICATION WORKING PROCEDURES: REGISTERED MARKS

3.1 Amendment of a specification of a registration

Under Rule 33, the specification of a registration may be restricted at any time. It may also be possible in certain circumstances to correct a classification error using Rule 74. Changes which affect the classification of items in specifications (usually following changes to the International Classification) can be carried out by reclassification (under Section 65 and Rule 54). The following sections deal with these procedures.

3.2 Partial surrender of a specification for a registered mark

The relevant part of Rule 33 states:

(1) Subject to paragraph (2), the proprietor may surrender a registered trade mark, by sending notice to the registrar-

(b) on Form TM23, in respect only of those goods or services specified by the proprietor in the notice.

(3) The registrar shall, upon the surrender taking effect, make the appropriate entry in the register and publish the date of surrender on the Office website.

For this a purpose a form TM23 (“Notice of a partial surrender of the specification of goods or services for which the mark is registered”) is used. This form contains a heading "Goods or services to be surrendered" and any goods or services that require to be deleted from a registration should be entered here. If the goods or services relate to a registration covering more than one class they should be listed in class order. Upon the surrender taking effect, an entry will be made in the register and it will be published in the Trade Marks Journal.

It is a responsibility of the Classification Team to scrutinise forms TM23 and any enquiries concerning amendments to a specification of a registration should be directed to them.

However, it is the responsibility of the registered proprietor to state the goods or services that are to be surrendered. It is not acceptable to merely list the goods or services which are intended to remain after surrender but this additional information is helpful (in order to provide a clear statement of what the registration is ultimately intended to cover).

3.3 Reclassification of specifications

From time to time, changes are made to the International Classification and the law allows the updating of existing entries if the goods or services on a registration have changed class.

On January 1st 2002, there was a significantly restructuring of Class 42 by restricting the scope of the class and, at the same time, adding three new additional classes. Reclassification of registrations from Class 42 to the new classes will not be mandatory but will be encouraged.

The primary legislation defining the scope of the registrar's duties in relation to reclassification is found under Section 65 of the Act and is as follows:

- (1) 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.
- (2) Provision may in particular be made for the amendment of existing entries on the register so as to accord with the new classification.
- (3) Any such power of amendment shall not be exercised so as to extend the rights conferred by the registration, except where it appears to the registrar that any extension would involve undue complexity and than any extension would not be substantial and would not adversely affect the rights of any person.
- (4) The rules may empower the registrar-
 - (a) to require the proprietor of a registered trade mark, within such time as may be prescribed, to file a proposal for amendment of the register, and
 - (b) to cancel or refuse to renew the registration of the trade mark in the event of his failing to do so.
- (5) Any such proposal shall be advertised, and may be opposed, in such manner as may be prescribed.

3.4 Rules governing reclassification:

The following rules provide detail concerning working procedures:

54 (1) The Registrar may at any time amend an entry in the register which relates to the classification of a registered trade mark so that it accords with the version of the Nice Classification that has effect at that time.

(2) Before making any amendment to the register under paragraph (1) the registrar shall give the proprietor of the mark written notice of the proposed amendments and shall at the same time advise the proprietor that-

(a) the proprietor may make written objections to the proposals, within two months of the date of the notice, stating the grounds of those objections, and

(b) if no written objections are received within the period specified the registrar will publish the proposals and the proprietor shall not be entitled to make any objections to the proposals upon such publication.

(3) If the proprietor makes no written objections within the period specified in paragraph (2)(a) above or at any time before the expiration of that period decides not to make any objections and gives the registrar written notice to this effect, the registrar shall as soon as

practicable after the expiration of that period or upon receipt of the notice publish the proposals in the Journal.

(4) Where the proprietor makes written objections within the period specified in paragraph (2)(a), the registrar shall, as soon as practicable after having considered the objections, publish the proposals in the Journal or, where the registrar has amended the proposals, publish the proposals as amended in the Journal, and the registrar's decision shall be final and not subject to appeal.

55 (1)

Any person may, within two months of the date on which the proposals were published under rule 54, give notice to the registrar of opposition to the proposals on Form TM 7 which shall include a statement of the grounds of opposition which shall, in particular, indicate why the proposed amendments would be contrary to section 65(3)

(2) If no notice of opposition under paragraph (1) above is filed within the time specified, or where any opposition has been determined, the registrar shall make the amendments as proposed and shall enter in the register the date when they were made; and his decision shall be final and not subject to appeal."

3.5 Procedures for reclassification

Reclassification of existing registrations is not presently mandatory but will be carried out upon request of the proprietor. Reclassification of a registration is conducted without a fee or the need to complete a form. There have also been numerous changes to the International Classification over the years and if reclassification is required to update existing registrations, the same procedure will be adopted as in relation to the restructuring of Class 42. It will not be necessary to reclassify a registration which comprises services which fall wholly under both the present and revised Class 42.

Note should be taken that at the time of the next renewal, if classes have been added to the registration as part of the reclassification, additional fees will be required to cover the cost of renewal in any extra classes.

3.6 Letter to proprietor proposing reclassification

The letter notifying the proprietor of the registrar's proposals for reclassification will take into account the scope of the specification and the number of registrations for reclassification owned by that proprietor. Part cancellations or exclusion clauses will be retained in the proposal unless the specification on reclassification clearly does not contain the goods or services that have been cancelled or excluded. If there is any doubt the phrases will be retained. A period of two months will be allowed for reply (Rule 46(2)(a)).

3.7 Proprietor accepts proposals

If the proprietor accepts the proposals it will be helpful if confirmation is provided. This will speed up the reclassification process.

3.8 Proprietor objects to proposals

Where a proposal is not acceptable the examiner will try to resolve the matter through informal correspondence. However, in the event of there being no agreement and an impasse is reached, a hearing may be appointed to finally resolve the issues.

3.9 Proprietor does not respond

Until reclassification is made mandatory, no further action will be taken. If the reclassification is mandatory and no response (either accepting or objecting) has been received, the proposals will be published (Rule 46(3)). The proprietor will not be able to make any objections to the proposals upon publication (Rule 46(2)(b)).

3.10 Notification of publication

A letter will be sent to the proprietor/agent telling them about publication of the proposals. This will be sent whether or not the publication is by agreement. The letter will give the Journal number in which the reclassification proposal is to be published and will include a reminder that the registered proprietor will not be able to oppose if he has not commented earlier. The letter will also contain a statement that a period of two months is allowed for any person to file opposition to the reclassification and we will only contact them again in the event of an opposition being filed. The OPTICS database will be updated after the opposition period has passed and only if no opposition is filed.

3.11 Merger of Registrations

Note that it is not possible to simultaneously reclassify two (or more) registrations and merge them into one multi-class registration. For instance it might be the case that two registrations with identical marks bearing the same date require to be reclassified. Initially both will be reclassified independently after which the proprietor will have the option of merging the two registrations into one. In all cases therefore it will be necessary to complete the reclassification procedure before utilising this provision.

3.12 Single registrations reclassified to more than one class

In the event of a single registration being reclassified into two or more classes, the resulting registration will retain its original number but will become a multi-class registration.

3.13 Correction of errors to specifications of registered marks

Under limited circumstances, it may be possible to correct an error in a specification after a mark has been registered. In the Trade Mark Rules 2008, under *Correction of irregularities of procedure*, Rule 74 states:

(1) Subject to rule 77, the registrar may authorise the rectification of any irregularity in procedure (including the rectification of any document filed) connected with any proceeding or other matter before the registrar or the Office.

(2) Any rectification made under paragraph (1) shall be made-

- (a) after giving the parties such notice; and
- (b) subject to such conditions,

as the registrar may direct.

For instance, we may be told that an application that has proceeded to registration has been incorrectly classified. For example, a specification reading “providing access to the internet” may have wrongly been accepted in Class 42 (instead of Class 38), then subsequently published and registered in that class. If an application is made to correct this type of error, reclassification of the registration will be considered (using Rule 74 and the reclassification procedures set out above).

It may also be possible to add a class to a registration in cases where we made a mistake in classifying the application. For example, if an application is incorrectly registered in Class 33 for “wines, spirits and beers” (beers are in Class 32), a subsequent request to correctly classify “beers” would be permitted resulting in an additional class being created. However, it would not be possible to correct an error that results in a broadening of the scope of a registration. For example, an application accepted and registered in Class 32 for “alcoholic beverages” could not subsequently be amended to read Class 33 since Class 32 includes beer as an alcoholic beverage. To substitute Class 33 for Class 32 would in effect create a registration which had no application as its foundation.

3.14 Goods or services deleted in error

In the Andreas Stihl & Co’s Trade Mark Application (2001 RPC 215), when the mark was published for opposition purposes certain goods were omitted in error from the specification and the mark was subsequently registered minus those goods. The applicant applied to the registrar to rectify the register by reinstating the missing goods. This was rejected on the ground that the scope of the registration would be extended by inclusion of these goods that had been previously omitted when the mark was published. The applicant appealed to the Appointed Person, Geoffrey Hobbs QC. Mr Hobbs commented:

“I think it is open to the registrar in the context of the Act and the rules as a whole to rectify procedurally irregular acts of registration and procedurally irregular refusals of registration as and when they occur.”

and

“...I would be minded to direct that the applicant be given a period of time within which to apply (irrevocably and in writing) to the registrar for withdrawal of the registration of trade mark no 2013437 in the exercise of the discretionary power and to direct that the registration should, in that event, be withdrawn and the revised application for registration advertised afresh (with the previously agreed specification of goods) for purposes of opposition. It

would be for the applicant to decide whether it wished to accept the risk of opposition in relation to the advertised application as a whole”.

The mark was re-advertised with the specification including the deleted goods and proceeded to be correctly registered.