



WIPO | MADRID

The International
Trademark System

Classification guidelines and tools

Regional Meeting of Intellectual Property Office Officials Responsible
for the Madrid System

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Legal Division
Madrid Registry

Tokyo, December 2016

Agenda

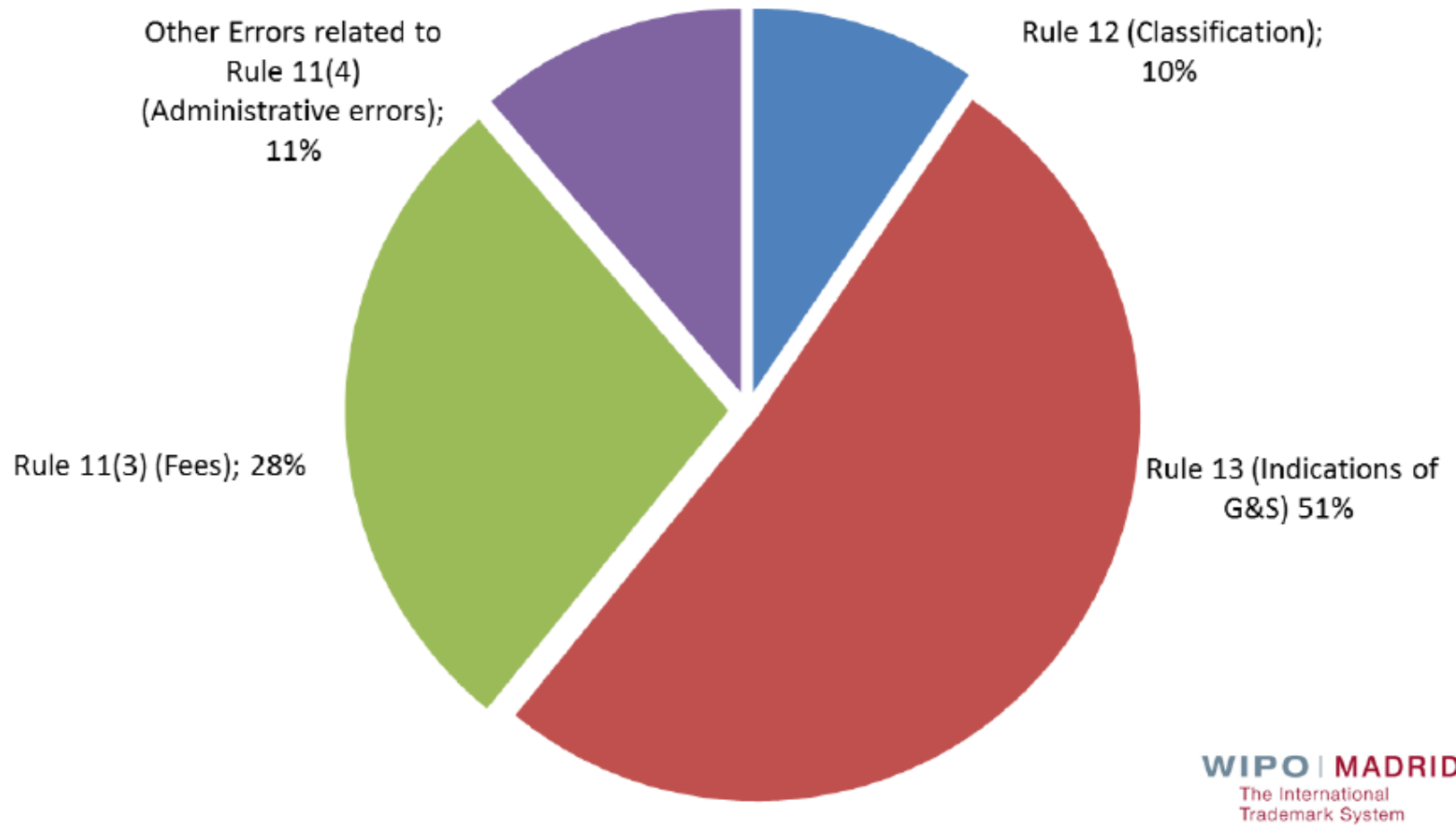
- Introduction
- Legal basis
- Classification tools used by the International Bureau
- The Classification Guidelines
- Madrid Goods and Services Manager
- WIPO's internal classification database

Introduction

Irregular international applications



Types of irregularities



Legal basis

Control of the classification

■ Article 3(2):

“The indication of classes given by the applicant shall be subject to control by the International Bureau, which shall exercise the said control in association with the Office of origin. In the event of disagreement between the said Office and the International Bureau, the opinion of the latter shall prevail.”

Rule 9(4)(a)(xiii)

- ... the names of the goods and services ...
- ... grouped in the appropriate classes ...
-each group preceded by the number of the class ...
- ... presented in the order of the classes ...
- ... indicated in precise terms ...
- ... preferably using the words appearing in the Alphabetical List

Grounds for irregularities

■ Rule 12:

“If the International Bureau considers that the requirements of Rule 9(4)(a)(xiii) are not complied with ...”

■ Rule 13:

“If the International Bureau considers that any of the goods and services is indicated in the international application by a term that is too vague for the purposes of classification or is incomprehensible or is linguistically incorrect ...”

Classification tools used by the International Bureau

Classification tools used by the International Bureau

- The internal classification database : MGS (Nice plus), acceptable terms and non-acceptable terms
- Explanatory Notes relating to each class heading
- General Remarks of the Nice Classification
- The Classification Guidelines

The Classification Guidelines

Background

- Requested by the Working Group Roundtable in November 2015
- Draft presented in June, available for comments until December 2016
- New draft to be presented in June 2017
- Purpose
 - inform users of the practice
 - serve as a resource for users
 - increase predictability of examination outcome

Guidelines for products

- Products that can be classified in more than one class according to their :
 - purpose only (e.g. “sea water” in 5 -medicinal- and 30 -cooking-);
 - material only (e.g. “gift bags” in 16 -paper- and 22 -textile-);
 - function only (e.g. “mobiles” in 20 -decoration- and 28 -toys-);
 - mode of operation only (e.g. “door opener” in class 6 -non-electric- or 7 -electric-); or
 - nature only (e.g. “berries” in class 29 -processed- and 31 -fresh-)are acceptable in any of those classes

- Products that can be classified in more than one class according to more than one of the five criteria above require further specification (e.g. doors in classes 6, 11, 12 19 and 20)

Guidelines for services

Accept indications of services provided they have sufficient meaning in the context of the given class (e.g. “booking of seats” in 39 (travel) or 41 (shows))

Acceptable and non-acceptable indications

Acceptable

- class headings and general indications therefrom
- namely, in particular, i.e.
- “installation services in relation to the goods mentioned above in class 11” (class 37)
- “custom manufacturing of goods for others” (class 40)
- “wholesale” and “retail sale” in class 35
- trademarks and geographical indications
- acronyms, when unequivocal

Non-acceptable

- general terms outside their natural class without further specification (e.g. clothing outside 25)
- such as, and the like, etc.
- “all goods (services) in class X”
- “vegetables other than those listed in class 31”
- “manufacturing of goods”
- “parts and fittings” or “parts and accessories” without further specification

Recurring issues

- “Game software” and “game programs” fall under class 9, while all “electronic games apparatus” fall under class 28
- “Alcoholic beverages” fall under class 33, irrespective of the level of alcohol
- “Filters” are classified according to their purpose or function, while “filtering materials” according to the material
- “Valves” are classified according to their function or purpose; when that is not possible, according to their material
- “Services provided by an association to its members” are classified according to the nature of the service
- “Kits” are classified according to their purpose or by their composition, provided all goods comprised in the kit fall under the same class

Format

- Proper punctuation is recommended; however, the International Bureau will not amend the list by:
 - adding, removing or changing punctuation marks;
 - changing indications from singular to plural; or,
 - adding or removing brackets

- The International Bureau will format the list from upper case to lower case characters, keeping upper case for:
 - first word per class
 - acronyms

Madrid Goods and Services Manager

Madrid Goods and Services Manager

- Online tool to compile lists of goods and services according to the Nice Classification
- Available since December 2010
- Contains the alphabetical list of the Nice Classification; frequently used terms extracted from the International Register; and, terms from other databases (TM5, USPTO, etc.)
- Near 100 thousand terms in English
- Available in 18 languages
- Shows similar group codes used by JPO and KIPO
- Displays acceptance by 27 Offices

Functions

■ **BROWSE** per class to select goods and services from a “pick-list” of terms pre-accepted by WIPO



■ **SEARCH** acceptable terms using keywords

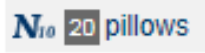
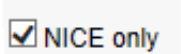



■ **CHECK ACCEPTANCE** of terms:

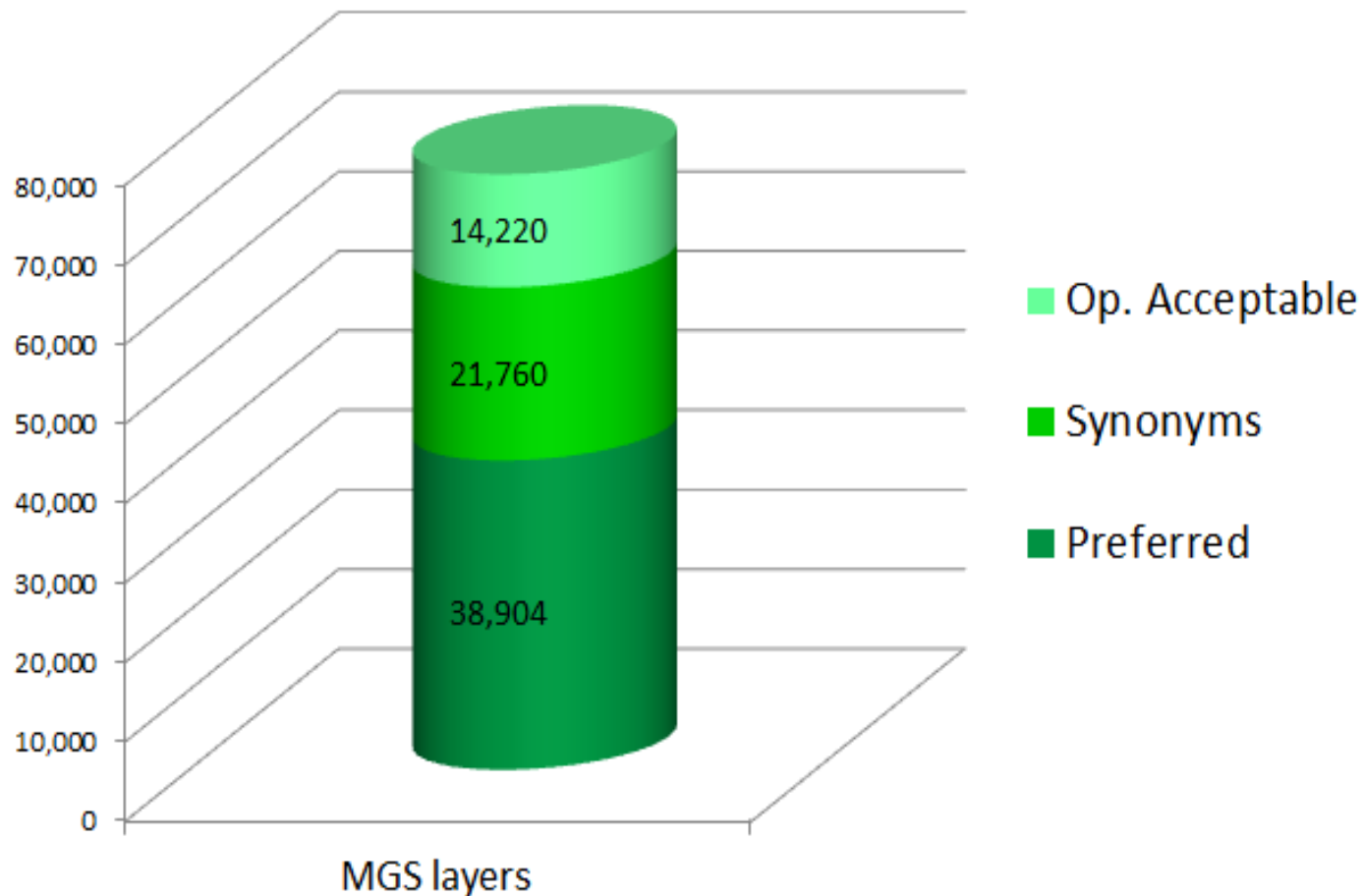
- by WIPO (free-text)
- by a designated Contracting Party (dCP)



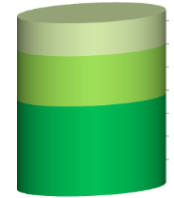
Features

- NICE indications are clearly identified 
- One-click limitation of results to NICE indications 
- Clear identification of all classes containing results 
- One-click restriction of results to a selected class
- No cumbersome paging to move through the results
- User list always visible
- Free-text terms can be typed with or without segmentation by semicolons
- One-click access to translation
- Print or translate lists in a format directly usable for filing

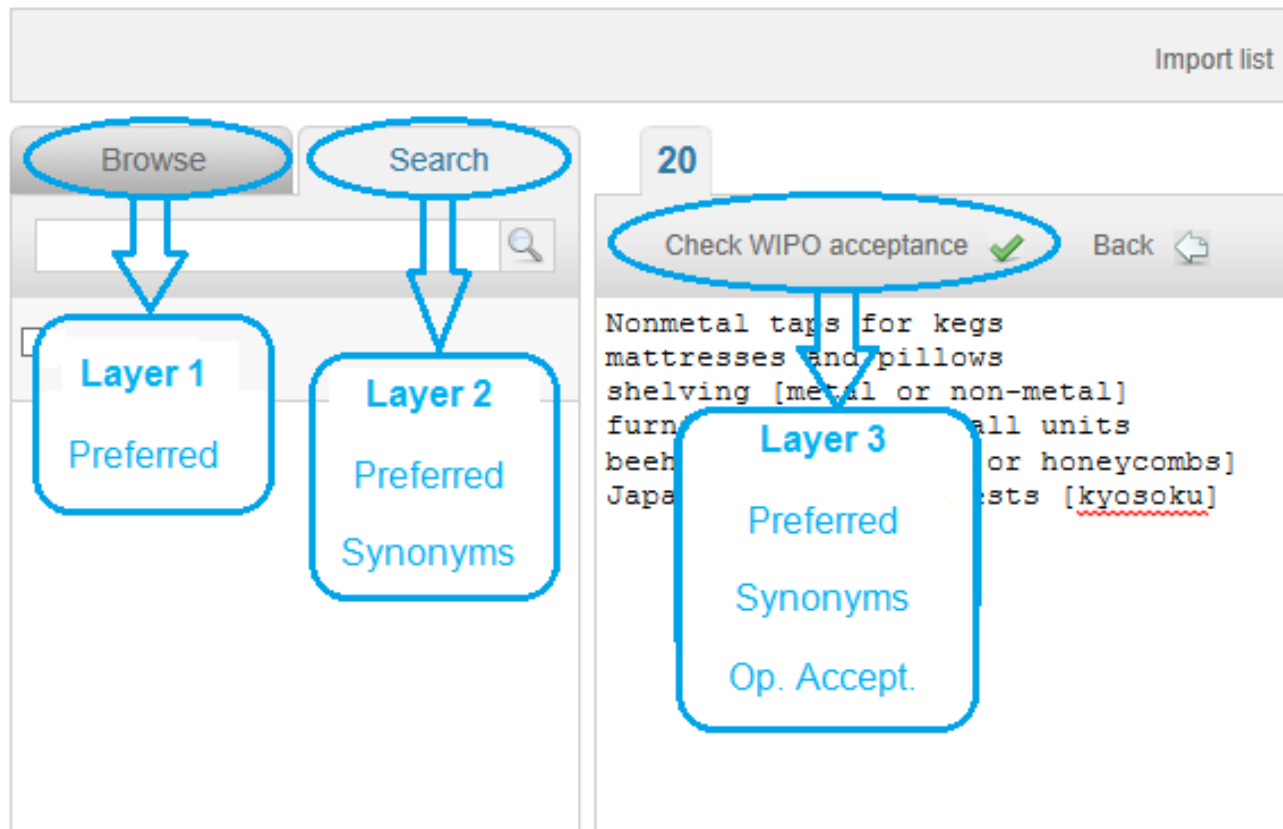
A three-layer data structure (1)



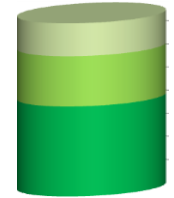
A three-layer data structure (2)



MGS • Madrid Goods & Services Manager



Operationally acceptable terms



Browse Search

mattresses OR pillows x 🔍

NICE only

40 / 71 results in class(es)

3 10 17 20 24 43

N₁₀ 20 pillows

N₁₀ 20 mattresses*

20 accent pillows

20 bath pillows

20





Search related terms 🔍 Edit term ✎ Remove

mattresses and pillows

20 Furniture, mirrors, picture frames; goods (not included in class 20) of meerschaum and substitutes for all these materials, or

- nonmetal taps for kegs
- mattresses and pillows**
- shelving [metal or non-metal]
- furniture, namely, wall units
- beehives [hive boxes or honeycombs]
- Japanese style arm rests [kyosoku]

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Import list Export list Print list Delete list Display preferences 

Translate into... ▼

Browse

Search

Add... ▼

 NICE only







To compile a list of goods and services,
select a language
from the drop-down menu at the upper right corner of this screen
and then use
BROWSE to select validated terms in a given class, or
SEARCH to enter key words and find related validated terms.

For more information,
click on the **HELP** link or watch the **TUTORIAL**.

Updated: 2016.01.28

NCL10-2016

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Import list  Export list  Print list  Delete list  Display preferences  Translate into... 

Browse Search

Add... 

Class 1

Class...  NICE only

1701 results






- acesulfame potassium
- acetal
- acetaldehyde [ethanal]
- acetanilide
- N**o acetate of cellulose, unprocessed
- N**o acetates [chemicals]*
- acetic acid
- acetic acid esters
- N**o acetic anhydride
- N**o acetone
- acetonedicarboxylic acid
- acetone for industrial purposes
- acetophenone
- N**o acetylene
- acetylene for industrial purposes
- N**o acetylene tetrachloride
- N**o acid proof chemical compositions

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[Import list](#) 
[Export list](#) 
[Print list](#) 
[Delete list](#) 
[Display preferences](#) 
[Translate into...](#) ▼

Browse

Search

Add... ▼

 
 NICE only

1 results in class(es)

25

25 Capri pants





To compile a list of goods and services,
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Updated: 2016.01.28

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Import list Export list Print list Delete list Display preferences 




Translate into... ▼

Browse

Search

25

Add... ▼

capri AND pants 
[Edit class](#)  [Clear class](#)  [Check acceptance by designated Contracting Party \(dCP\)](#) 
 NICE only


1 results in class(es)

25







25 Capri pants

25 Clothing, footwear, headgear.

Capri pants


 Terms: 1 - Words: 2

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Import list Export list Print list Delete list Display preferences Translate into... 

Browse

Search




capri AND pants  NICE only

1 results in class(es)

25






25 Capri pants

25

Add... Check WIPO acceptance  Back 

Capri pants
 Capris
 Capri trousers
 Pedal pushers
 clam diggers|


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Import list Export list Print list Delete list Display preferences 

Translate into... ▼

Browse

Search

capri AND pants  NICE only




1 results in class(es)

25

25 Capri pants

25

Add... ▼

[Edit class](#)  [Clear class](#)  [Check acceptance by designated Contracting Party \(dCP\)](#) 
25 Clothing, footwear, headgear.


Capri pants

Capris

Capri trousers

Pedal pushers

clam diggers

 Terms: 5 - Words: 9

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Import list Export list Print list Delete list Display preferences Spanish

Browse Search capri AND pants NICE only 1 results in class(es) 25 Capri pants






25 Edit class Clear class Add... g Party (dCP) ✓

Synonym terms detected: Capri pants Capris Capri trousers Pedal pushers clam diggers Choose OK to keep only "Capri pants" OK Cancel

- 25 Clothing, footwear, headgear: Capri pants Capris Capri trousers Pedal pushers clam diggers


Terms: 5 - Words: 9

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[Import list](#) 
[Export list](#) 
[Print list](#) 
[Delete list](#) 
[Display preferences](#) 
[Translate into...](#) ▼

Browse

Search

 
 NICE only




1 results in class(es)

25

25 Capri pants

25

Add... ▼







[Edit class](#) 
[Clear class](#) 
[Check acceptance by designated Contracting Party \(dCP\)](#) 

25 Clothing, footwear, headgear.

Capri pants
 Capris
 Capri trousers
 Pedal pushers
 clam diggers
 Corn flour
 Corn meal
 Maize flour
 Maize meal

 Terms: 9 - Words: 17

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Import list  Export list  Print list  Delete list  Display preferences  Translate into... 

Browse Search

capri AND pants 

NICE only

1 results in class(es)

25


25 Capri pants

25

Add... 

Search related terms  Edit term  Remove term  Back 

Corn flour

Move term to class 30 

25 Clothing, footwear, headgear.

- Capri pants
- Capris
- Capri trousers
- Pedal pushers
- clam diggers
- Corn flour**
- Corn meal
- Maize flour
- Maize meal

 Terms: 9 - Words: 17

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[Import list](#)
[Export list](#)
[Print list](#)
[Delete list](#)
[Display preferences](#)
[Translate into...](#)

Browse

Search

25

30

Add...

capri AND pants

 NICE only

1 results in class(es)

25

25 Capri pants

[Edit class](#)
[Clear class](#)
[Check acceptance by designated Contracting Party \(dCP\)](#)

30

Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces [condiments]; spices; ice.

300059 [Corn flour](#)300059 [Corn meal](#)300059 [Maize flour](#)300059 [Maize meal](#)

MGS – Display of Acceptance / Rejection

Check acceptance by designated Contracting Party (dCP)

[Select all](#)
[Remove all](#)

<input type="checkbox"/> AT - Austria	<input checked="" type="checkbox"/> JP - Japan
<input type="checkbox"/> BX - Benelux	<input checked="" type="checkbox"/> KR - Republic of Korea
<input type="checkbox"/> BY - Belarus	<input type="checkbox"/> MX - Mexico
<input checked="" type="checkbox"/> CH - Switzerland	<input type="checkbox"/> NO - Norway
<input type="checkbox"/> CN - China	<input type="checkbox"/> PT - Portugal
<input type="checkbox"/> CO - Colombia	<input type="checkbox"/> RS - Republic of Serbia
<input checked="" type="checkbox"/> DE - Germany	<input checked="" type="checkbox"/> RU - Russian Federation
<input type="checkbox"/> EE - Estonia	<input type="checkbox"/> SG - Singapore
<input checked="" type="checkbox"/> EM - European Union	<input type="checkbox"/> TR - Turkey
<input type="checkbox"/> FI - Finland	<input type="checkbox"/> UA - Ukraine
<input type="checkbox"/> IL - Israel	<input checked="" type="checkbox"/> US - United States of America
<input type="checkbox"/> IT - Italy	

Under USPTO policy, square brackets should not be used in the identifications of goods or services. If square brackets are used in a listing of basic goods/services or a limitation thereof, a provisional refusal will be issued by USPTO examining attorneys.

For terms shown as rejected by the USA in MGS, please consult the USPTO ID Manual (<https://tmidm.uspto.gov>) for acceptable wording.

OK

Display Acceptance or Rejection

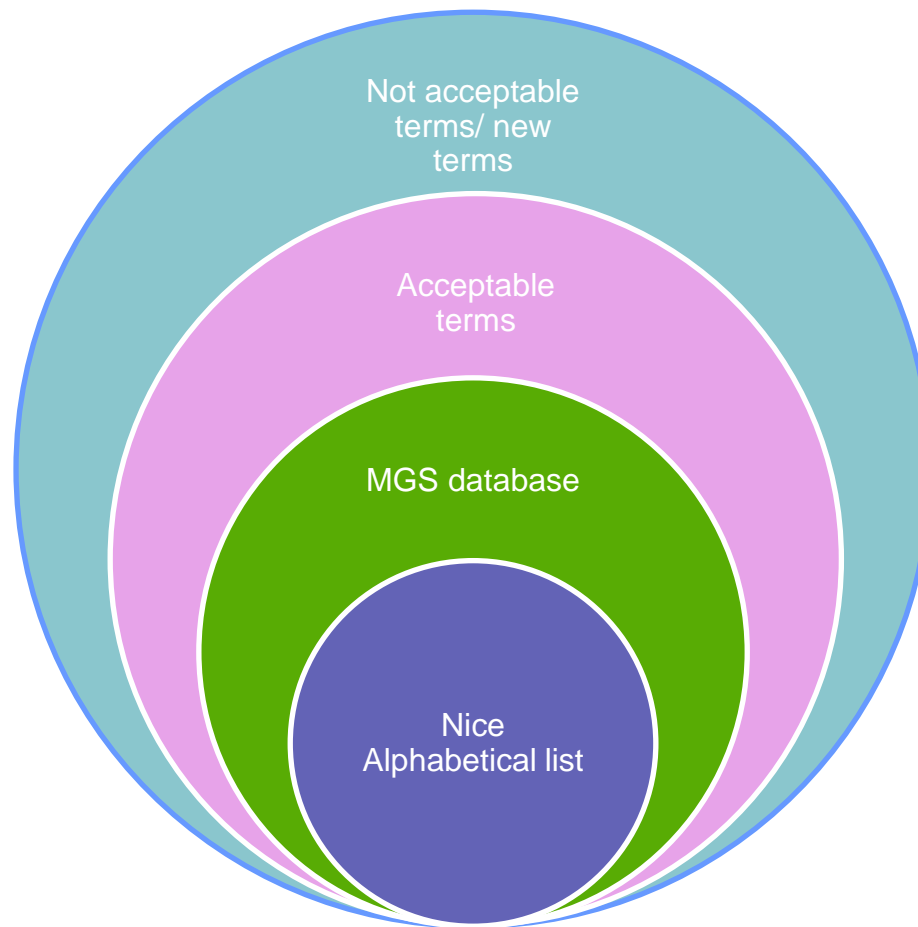
7 Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); implements other than hand-operated; incubators for eggs; automatic vending machines.

dCP Accepted by dCP dCP Rejected by dCP dCP Status unknown

CH	CN	DE	EM	JP	KR	RU	US	070080	knives [parts of machines]
CH	CN	DE	EM	JP	KR	RU	US	070226	saw blades [parts of machines]
CH	CN	DE	EM	JP	KR	RU	US	070133	sifting installations
CH	CN	DE	EM	JP	KR	RU	US	070153	disintegrators
CH	CN	DE	EM	JP	KR	RU	US	070026	mixing machines
CH	CN	DE	EM	JP	KR	RU	US		machines and machine tools
CH	CN	DE	EM	JP	KR	RU	US	070450	heat exchangers [parts of machines]
CH	CN	DE	EM	JP	KR	RU	US	070480	rotary steam presses, portable, for fabrics

WIPO's internal classification database

Internal database



Examination of classification in international applications (1)

WIPO MADRID
The International Trademark System

WORLD INTELLECTUAL PROPERTY ORGANIZATION

Navigation

M1020M01

Request : 1016752401

IRN : 1320070

Classes : 33

Goods and Services in English : Alcoholic beverages; whisky; vodka; aperitifs; pre-mixed alcoholic beverages; mead; cider; rice alcohol

Summary

History

Applicant/Rep

Basic

Priority

Seniority

Mark

Good & Service

Designation

Vienna

Prior IRNs

Miscellaneous

Fees

Limit'n designation

Limit'n G & S

Irregularities

Letters

Basic List:

33 alcoholic beverages, except beer;
aperitifs;
arrack [arak];
baijiu [chinese distilled alcoholic beverage];
brandy;
wine;
piquette;
whisky;
vodka;
anissette [liqueur];
kirsch;
gin;
digesters [liqueurs and spirits];
cocktails;
curacao;
anise [liqueur];
liqueurs;
pre-mixed alcoholic beverages, other than beer-based;
alcoholic beverages containing fruit;
distilled beverages;
spirits [beverages];
mead [hydromel];
peppermint liqueurs;
bitters;
nira [sugarcane-based alcoholic beverage];
rum;
sake;
perry;
cider;
rice alcohol;
alcoholic extracts;
fruit extracts, alcoholic;
alcoholic essences.

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Documents History R-Pad Macro

Delta (ctrl+E)

Segment (ctrl+G)

Duplicate terms (alt+D)

Mark (ctrl+M)

Xmas tree (alt+W)

Ocr (ctrl+T)

Romarin (ctrl+R)

Special Char (alt+S)

alcoholic beverage]; brandy; wine; curacao; anise [liqueur]; liqueur; fruit; distilled beverages; alcoholic beverage]; rum; sake;

Examination of classification in international applications (2)

WIPO MADRID
The International Trademark System

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

Navigation [Print](#) [Related Documents](#) [History](#) [R-Pad](#) [Macro](#)

M1020M01

Request : 1017995301 Application (Common)

IRN : as at 29/11/2016 **Actual**

Classes : 09 [11](#) [14](#) [16](#) [18](#) [21](#) [28](#) [35](#)

Goods and Services in English : Photographic apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; cameras including video cameras and digital cameras; magnetic data carriers, recording disks; recording media; computer disks, audio tapes, vcr tapes, disks, cassettes, cds including computer cds and memory sticks; calculators; batteries; cables; electronic and electrical products in this class; televisions, teledvds, digital set top boxes, overhead projectors, stereos, videos including video players and video recorders, radios including clock radios, dvd players, dvd recorders, camcorders, cd players including portable cd players, cd recorders, headphones, home theatre systems, speakers, sound systems; facsimile machines, answering machines, photocopiers, electric personal organisers, electric notetakers, mp3 players, electric typewriters; telephones including mobile telephones; computers including computer hardware and software, computer peripherals including monitors, printers, scanners, mice, keyboards, modems, upgrade hardware, computer joy sticks, computer steering wheels and computer speakers; scales; mobile phone cases; mobile phone covers; phone covers (specifically adapted); shaped covers, cases and protector sleeves for electrical apparatus, including computers, digital audio and video players, portable game machines, portable or personal digital assistants; video games (software); computer games and electronic games (software); games for use with television receivers (software); electronic publications; spectacles including sunglasses, eyeglass frames and protective eyewear; parts and accessories for all of the foregoing being goods in class 9.

Summary
History
Applicant/Rep
Basic
Priority
Seniority
Mark
Good & Service
Designation
Vienna
Prior IRNs
Miscellaneous
Fees
Limit'n designation
Limit'n G & S
Irregularities
Letters

Examination of classification in international applications (3)

Basic List:

09 photographic apparatus and instruments;

apparatus for recording, transmission or reproduction of sound or images;

cameras including video cameras and digital cameras;

magnetic data carriers, recording disks;

recording media;

computer disks, audio tapes, vcr tapes, disks, cassettes, cds including computer cds and memory sticks;

calculators;

batteries;

cables;

electronic and electrical products in this class;

televisions, televideos, teledvds, digital set top boxes, overhead projectors, stereos, videos including video players and video recorders, radios including clock radios, dvd players, dvd recorders, camcorders, cd players including portable cd players, cd recorders, headphones, home theatre systems, speakers, sound systems;

facsimile machines, answering machines, photocopiers, electric personal organisers, electric notetakers, mp3 players, electric typewriters;

telephones including mobile telephones;

computers including computer hardware and software, computer peripherals including monitors, printers, scanners, mice, keyboards, modems, upgrade hardware,

computer joy sticks, computer steering wheels and computer speakers;

scales;

mobile phone cases;

mobile phone covers;

phone covers (specifically adapted);

shaped covers, cases and protector sleeves for electrical apparatus, including computers, digital audio and video players, portable game machines, portable or personal digital assistants;

video games (software);

computer games and electronic games (software);

games for use with television receivers (software);

electronic publications;

spectacles including sunglasses, eyeglass frames and protective eyewear;

parts and accessories for all of the foregoing being goods in class 9.

Examination of classification in international applications (4)

electric typewriters;

English French Spanish Only WIPO approved terms All terms

Submit

Classes: All 16

ID	Term	Class	Notes No	Source	Accepted	Rejected	Reviewed
949788	electric or non-electric typewriters	16			WO		YES
935332	electric typewriters	16		TMClass AUdb	WO		YES
889290	typewriters electric and non-electric	16			WO		
949788	typewriters, electric or non-electric	16		160132	WO		YES

Thank you
for your attention

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