



EXPLAINER: CLASSIFICATION

MIND YOUR WORDS!

The importance of
making the right choices in the
classification of goods and services

*Includes: examples,
tips & tricks!*



THE ARTICLE THAT IS CENTRAL IN CLASSIFICATION

Art 2.5bis (2) BCIP

"The goods and services for which protection is sought shall be identified by the applicant with **sufficient clarity and precision** to enable the competent authorities and economic operators, on that sole basis, to determine the **extent of the protection** sought."

WHAT IS INSUFFICIENT?

An example of **insufficient clarity and precision**:

- CI 18 Goods made of leather and imitation leather.
- CI 7 Machines.

These should be made **more clear and precise**, for example:

- CI 18 Leather backpacks; imitation leather handbags.
- CI 7 Sewing machines for textiles and leather.

3 EASY TIPS

1. When selecting the relevant goods and services, be ambitious but also **realistic**. Keep in mind that extending your scope of protection equally increases the likelihood of conflicts with other trademarks.
2. It is important to realize that you do need to **'genuinely' use** your trademark for the goods and services chosen.
3. **Limiting** your list of goods and services is always allowed, whereas **expanding is not possible**. Adding new goods or services will require a new trademark application.

EXTRA TIP!

Be aware of the **correct use of terms** such as:

- namely
- to know
- inter alia
- including
- excluding
- all aforementioned goods or services only in relation to (specification)
- all aforementioned goods and services also in relation to
- all aforementioned goods and services not in relation to (disclaimer)

3 examples



EXAMPLE 1

For instance:

- CI 25 Clothing, **including** socks, hoodies and T-shirts; or
- CI 25 Clothing, **in particular** socks, hoodies and T-shirts.

What does this actually mean?

- This is not a limitation nor an exception, but merely a message to the market **without any legal implications**

EXAMPLE 2

- CI 25 Clothing, **namely** socks, hoodies and T-shirts.

What does this actually mean?

- The list is limited to socks, hoodies and T-shirts. This is clearly a **limitation**, where the term "clothing" could also have simply been omitted.

EXAMPLE 3

- Suppose the word Tuxedo being filed as a trademark for:
- CI 25 Clothing, excluding smoking jackets.

What does this actually mean?

- It excludes the goods for which it is descriptive, but this is a so-called '**Postkantoor**' restriction (i.e. disclaimer) which is not permissible.
- An acceptable restriction would be, for example:
- CI 25 Swimsuits; socks; hoodies.

RECOMMENDED!

- Preferably use approved classification terms.



- Use the Harmonised Database

TMclass

Classification Tools • Classification Resources • Translation Tools

Search term

Language: English (en) Search term: Search term (E.g. Milk) Nice Class: 1-40

Harmonised Database

Office Databases:

<input type="checkbox"/> WIPO	<input type="checkbox"/> Antigua and Barbuda (ASIPCO)	<input type="checkbox"/> ARIPO	<input type="checkbox"/> Australia (IPA)	<input type="checkbox"/> Belize (BISIPCO)
<input type="checkbox"/> Canada (CIPCO - CPIC)	<input type="checkbox"/> Ghana (GHIPCO)	<input type="checkbox"/> Iceland (ISIPCO)	<input type="checkbox"/> India (CISIPCO)	<input type="checkbox"/> Israel (IIPCO)
<input type="checkbox"/> Malaysia (MYIPCO)	<input type="checkbox"/> Namibia (NIPCO)	<input type="checkbox"/> New Zealand (ZPNCZ)	<input type="checkbox"/> OAPI	<input type="checkbox"/> Philippines (PPIPCL)
<input type="checkbox"/> Saint Vincent and the Grenadines (CIPCO - VC)	<input type="checkbox"/> Tanzania (TANIPCO)	<input type="checkbox"/> The Gambia (GIPCO)	<input type="checkbox"/> Trinidad and Tobago (TTIPCO)	<input type="checkbox"/> Uganda (USIPCO)

Welcome to TMclass

TMclass helps you to search for and classify Goods and Services (terms) needed to apply for trade mark protection. You can also translate a list of Goods and Services and verify if they



PUNCTUATION MATTERS

Use “;” and “,” to distinguish terms

- CI 25 Clothing; shoes; headgear, excluding socks”

Is this correct? Or should it read as follows?

- CI 25 Clothing, excluding socks; shoes; headgear.

The second one is correct, because headgear are not socks and vice versa



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