

COMMON COMMUNICATION
ON THE ACCEPTABILITY OF
CLASSIFICATION TERMS AND THE
GENERAL INDICATIONS OF THE NICE
CLASS HEADINGS

MARCH 2022

*Common Practice on the Acceptability of Classification Terms,
originally published 20 February 2014*

*Common Practice on the General Indications of the Nice Class
Headings, 2nd version, originally published 28 October 2015*

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1 Introduction

As a result of the transposition of Directive No 2015/2436 (hereinafter ‘TMD’) into national laws and the implementation of Regulation No 2017/1001 (hereinafter ‘EUTMR’), and to improve user friendliness and accessibility, this Common Communication aims to consolidate the existing Common Practices related to the acceptability of classification terms and the general indications of the Nice class headings, which remain relevant and applicable in light of the TMD/EUTMR.

2 Background

On 19 June 2012, the Court of Justice delivered its ruling in [Case C-307/10 ‘IP Translator’](#), which provided answers to questions related to the use of the general indications of the class headings of the Nice Classification. In particular, two of the three questions asked to the Court and the answers provided were:

1. In the context of [Directive 2008/95], is it necessary for the various goods or services covered by a trade mark application to be identified with any, and if so what particular, degree of clarity and precision?

“Directive 2008/95 must be interpreted as meaning that it requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark.”

2. In the context of [Directive 2008/95], is it permissible to use the general words of the class headings of the [Nice Classification] for the purpose of identifying the various goods or services covered by a trade mark application?

“Directive 2008/95 must be interpreted as meaning that it does not preclude the use of the general indications of the class headings of the Nice Classification to identify the goods and services for which the protection of the trade mark is sought, provided that such identification is sufficiently clear and precise.”

Given the impact of the judgment on European classification practice at the time, it was clear that a harmonised interpretation of the judgment by Member State Intellectual Property Offices, the Benelux Office for Intellectual Property and the European Union Intellectual Property Office (hereinafter collectively ‘IPOs’) would bring greater transparency, predictability, and legal certainty for both competent authorities and economic operators. The IPOs and User Associations (hereinafter ‘UAs’) expressed their willingness to collaborate on such an initiative and carried out a series of meetings and fruitful discussions covering the different areas of the judgment.

The extensive effort invested by IPOs and UAs resulted in the following:

- **Common Practice on the Acceptability of Classification Terms v1.0**, a Common Practice containing a set of guidelines to help identify when a classification term is sufficiently clear and precise. It provides guidance on the answer to the judgment’s first question [above](#).

Tools such as [TMclass](#) are available to assist in searching for and identifying acceptable terms. A classification term that is applied for will be added to the harmonised database on the condition that it meets the criteria set in the guidelines. Subsequently remaining terms comprised in the harmonised database will be made subject to revision in order to determine if they are in compliance with the guidelines. The guidelines can also be of assistance to reason the acceptance or rejection of these applied-for terms.

- **Common Practice on the General Indications of the Nice Class Headings v1.2**, utilising the Acceptability of Classification Terms guidelines, this Common Practice includes a list of non-acceptable general indications and the reasoning for non-acceptability. It provides guidance on the answer to the judgment's second question [above](#).

Pursuant to Article 39(3) TMD / Article 33(3) EUTMR,

"...the general indications included in the class headings of the Nice Classification or other general terms may be used, provided that they comply with the requisite standards of clarity and precision set out in this Article."

and Article 39(4) TMD / Article 33(4) EUTMR,

"The office shall reject an application in respect of indications or terms which are unclear or imprecise, where the applicant does not suggest an acceptable wording within a period set by the office to that effect."

In light of the changes in the TMD and the EUTMR, an assessment of the relevance of the CP1 Common Practices was conducted. It was concluded that the TMD and the EUTMR are aligned with the 'IP Translator' judgment and consequently, the guidelines on the acceptability of classification terms are still relevant and beneficial in light of Article 39(3) TMD / Article 33(3) EUTMR. Similarly, the list of non-acceptable general indications of the Nice class headings remains valid in light of Article 39(4) TMD / Article 33(4) EUTMR.

[List of implementing offices](#)

Chapter 1: Common Practice on the acceptability of classification terms

Objective of this Common Practice

This Common Practice contains a set of guidelines that will help to identify when any classification term is sufficiently clear and precise.

These guidelines will be of assistance to the harmonised workflow, through which new classification terms are assessed in order to be added to the harmonised database. The guidelines can also be of help to reason the acceptance or rejection of any classification term that is applied for.

Explanatory notes

The Nice Classification is a system of classifying the goods and services that can be found in the global marketplace into “classes”. The Nice Classification is based on the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, which is administered by WIPO. It consists of a list of classes, explanatory notes and an alphabetical list of goods and services. The list of classes of Nice Classification, guidelines, explanatory notes, and general remarks on classification practice published by WIPO is the primary source of interpretation of the acceptability of any classification term.

There are 34 classes of goods and 11 classes of services. The class headings are general indications relating to the fields to which, in principle, the goods and services belong. The general indications of the Nice class headings are the expressions that appear in the class headings between semicolons, for example, Class 13 is made up of 4 general indications: “Firearms;”, “ammunition and projectiles;”, “explosives;” and “fireworks”. The class number may give further clarification but is not a decisive factor.

Tools such as [TMclass](#) are available to assist in searching for and identifying acceptable terms.

Summary of guidelines

A set of 3 guidelines that describes criteria to determine the clarity and precision (or lack of such) of a term has been established.

The set of guidelines is the following:

- I. Explanation when a description of goods and services is sufficiently clear and precise
- II. Examples of factors that can add sufficient clarity and precision
- III. Specification of terms in a number of classes

Guidelines

I. A description of goods and services is sufficiently clear and precise when its scope of protection can be understood from its natural and usual meaning.

II. If this scope of protection cannot be understood, sufficient clarity and precision may be achieved by identifying factors such as characteristics, purpose and/or identifiable market sector ⁽¹⁾. Elements that could help to identify the market sector may be, but are not limited to, the following

- consumers and/or sales channels
- skills and know-how to be used/produced
- technical capabilities to be used/produced.

Examples

<u>Not clear and precise term</u>	<u>Proposals / possible solutions: (examples from harmonised database)</u>
Goods of common metal not included in other classes (cl 6)	Construction elements of metal (cl 6)
	Building materials of metal (cl 6)
Machines (cl 7)	Agricultural machines (cl 7)
	Machines for processing plastics (cl 7)
	Milking machines (cl 7)
Goods in precious metals or coated therewith (cl 14)	Works of art of precious metal (cl 14)
Goods made from paper and cardboard (cl 16)	Filtering materials of paper (cl 16)
Goods made from rubber, gutta-percha, gum, asbestos and mica (cl 17)	Rings of rubber (cl 17)
Goods made of these materials [leather and imitations of leather] (cl 18)	Briefcases [leather goods] (cl 18)

⁽¹⁾ Market sector describes a set of businesses that are buying and selling such similar goods and services that they are in direct competition with each other.

Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics (cl 20)	Door fittings, made of plastics (cl 20)
	Figurines of wood (cl 20)
Repair (cl 37)	Shoe repair (cl 37)
	Repair of computer hardware (cl 37)
Installation services (cl 37)	Installation of doors and windows (cl 37)
	Installation of burglar alarms (cl 37)
Treatment of materials (cl 40)	Treatment of toxic waste (cl 40)
	Air purification (cl 40)
Personal and social services rendered by others to meet the needs of individuals (cl 45)	Personal background investigations (cl 45)
	Personal shopping for others (cl 45)
	Adoption agency services (cl 45)

III. A term may be part of the description of goods and services in a number of classes; it may be clear and precise in a particular class without further specification. For example [Furniture](#) (cl 20), [Clothing](#) (cl 25).

If protection is sought for a specialised category of goods and services or a specialised market sector belonging to a different class, further specification of the term may be necessary. For example [Furniture especially made for medical purposes](#) (cl 10), [Furniture especially made for laboratories](#) (cl 9), [Protective clothing](#) (cl 9), [Clothing especially for operating rooms](#) (cl 10), [Clothing for pets](#) (cl 18).

Tools such as [TMclass](#) are available to determine whether the particular category of goods and services needs this further specification or not.

Chapter 2: Common Practice on the general indications of the Nice class headings

The general indications are the expressions that appear in the class headings between semicolons; for example, Class 13 is made up of 4 general indications: “Firearms;”, “ammunition and projectiles;”, “explosives;” and “fireworks”.

The general indications of the Nice class headings were examined with respect to the requisites of clarity and precision. Of these, 5 were considered to lack the clarity and precision to specify the scope of protection that they would give, and consequently cannot be accepted without further specification ⁽²⁾. These are set out below, highlighted in bold.

- Cl. 7 – **Machines** and machine tools
- Cl. 37 – **Repair**
- Cl. 37 – **Installation services**
- Cl. 40 – **Treatment of materials**
- Cl. 45 – **Personal and social services rendered by others to meet the needs of individuals**

In some cases, a part of a general indication may be considered to be sufficiently clear and precise if used on its own, for example, in the general indication “Machines and machine tools”, the description ‘machine tools’ on its own would be acceptable because it describes a specific type of goods. Where this applies, the part of the general indication is shown in grey.

The reasons why each of the five general indications of the Nice class headings are not clear and precise are expressed below.

- Cl. 7 – **Machines** and machine tools - In light of the need for clarity and precision, the term “machines” does not provide a clear indication of what machines are covered. Machines can have different characteristics or different purposes, they may require very different levels of technical capabilities and know-how to be produced and/or used, could be targeting different consumers, be sold through different sales channels, and therefore relate to different market sectors.
- Cl. 37 – **Repair** - In light of the need for clarity and precision, this term does not provide a clear indication of the services being provided, as it simply states that these are repair services, and not what is to be repaired. As the goods to be repaired may have different characteristics, the repair services will be carried out by service providers with different levels of technical capabilities and know-how, and may relate to different market sectors.
- Cl. 37 – **Installation services** - In light of the need for clarity and precision, this term does not provide a clear indication of the services being provided, as it simply states that these are installation services, and not what is to be installed. As the goods to be installed may have different

⁽²⁾ The original list of 11 general indications has since been updated to five after an update in Nice Class version (2016 version of the Nice 10th Edition). The following six general indications were removed from the Common Practice as a result of the update: *Goods of common metal not included in other classes (cl 6)*, *Goods in precious metals or coated therewith (cl 14)*, *Goods made from paper and cardboard (cl 16)*, *Goods made from rubber, gutta-percha, gum, asbestos and mica (cl 17)*, *Goods made of these materials [leather and imitations of leather] (cl 18)*, *Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics (cl 20)*. These six general indications remain unacceptable in view of their lack of clarity and precision.

characteristics, the installation services will be carried out by service providers with different levels of technical capabilities and know-how, and may relate to different market sectors.

- Cl. 40 – **Treatment of materials** - In light of the need for clarity and precision, this term does not give a clear indication of the services being provided. The nature of the treatment is unclear, as are the materials to be treated. These services cover a wide range of activities performed by different service providers on materials of different characteristics requiring very different levels of technical capabilities and know-how, and may relate to different market sectors.
- Cl. 45 – **Personal and social services rendered by others to meet the needs of individuals** - In light of the need for clarity and precision, this term does not give a clear indication of the services being provided. These services cover a wide range of activities performed by different service providers requiring very different levels of skill and know-how, and may relate to different market sectors.