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TRADEMARK CLASSIFICATION DATABASES AND TOOLS

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CARIFORUM

EUIPO EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE

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TRADEMARK CLASSIFICATION

- The principle of specificity in trademark law – goods & services
- In order to facilitate searches –> TM classifications systems
- Need to standardize systems –> International Classification

THE NICE CLASSIFICATION 1/2

Nice Agreement 1957 (rev. 1967, 1977)

- International Classification of Goods and Services
- a special agreement under the Paris Convention
- 88 Member States (including 9 Caribbean countries)
- obliged to apply the classification and to include class numbers in their trademark publications

Nice Classification (NCL)

- 45 classes + explanatory notes + alphabetical list of goods and services
- currently applied by some 150 national TM Offices, plus 4 regional TM Offices (ARIPO, OAPI, BOIP, EUIPO) and by WIPO IB (Madrid System procedures)

NCL languages

- English / French authentic versions published online by WIPO (NicePub)
- Spanish official version also available online

NCL updating procedure (revision)

- Committee of Experts (all Member States)
- New editions (“amendments”) once every five years (11th edition of 2016)
- New versions (“changes”) once a year since 2013 (today NCL11-2020)

APPLYING THE NICE CLASSIFICATION BY TM OFFICES

Applying the NCL – obligatory for Member States

- 45 classes: 34 classes of goods + 11 classes of services
- indicating class numbers in publications

NCL alphabetical list (Alpha List) – some 10,000 terms of goods and services

- acceptance of terms in the Alpha List is non obligatory
  – some TM offices refuse certain terms that they do not consider as “common names” for goods or services or as “sufficiently specific” to identify them

- non exhaustive
  – other terms may be accepted and are in fact accepted by most TM offices

GOODS AND SERVICES TERMS – ACCEPTANCE TOOLS 1/2

National lists – terms accepted by individual TM offices

- USPTO TM ID manual
- G&S classification tools later on developed in several other TM Offices (e.g., EUIPO, Australia, Japan, Switzerland, Chile, Mexico, etc.)

Common lists – terms accepted by several TM offices

- TM5 ID List – US, EM, JP, KR, CN – English – some 20,000 terms
- EU Harmonised Database – 27 Offices – 23 languages – some 85,000 terms in E
- Pacific Alliance typical terms – CL, CO, MX, PE – Spanish – some 1,000 terms

MGS – terms accepted by WIPO for international registrations (Madrid)

- Madrid Goods and Services (MGS) – E, F, S – some 66,000 terms in E

GOODS AND SERVICES TERMS – ACCEPTANCE TOOLS 2/2

Advantages of G&S acceptance tools

- For IP Offices – can be integrated within their information systems
  - examination consistency – improved work standards
  - work reduction – reduced number of examiners
- For TM applicants – can be integrated with e-filing systems
  - help avoiding irregularities in the identification of goods and services
  - reduced filing costs offered by some TM offices

TRADEMARK CLASSIFICATION PORTALS

TMclass – http://euipo.europa.eu/ec2/ - search, browse & pick, classify, translate

Access to the G&S acceptance lists of 71 TM Offices (national, regional, international) from around the world

ASEAN TMclass – http://www.asean-tmclass.org/ec2/

Access to G&S acceptance lists of 10 AMS TM Offices

MGS – https://webaccess.wipo.int/mgs/

Access to the G&S acceptance list of WIPO (Madrid system) and possibility to heck whether those terms are also accepted by 36 Madrid Union Offices

PROSUR - http://prosur.org/tramitacion/clasificador-de-productos-y-servicios/

Access to G&S acceptance lists of 14 TM Offices from Latin America

TOWARDS A CARIFORUM TRADEMARK CLASSIFICATION TOOL

A publicly available online tool

- offering access to a database of G&S terms accepted by the CARIFORUM TM Offices

- Accessible through the CARIFORUM IP Portal and TMclass
  - incorporating multiple functionalities: search, browse & pick, classify, translate

- Linked to WIPO MGS for Madrid Union Members

- Eventually integrated into
  - the information systems of CARIFORUM TM Offices
  - national TM e-filing tools of CARIFORUM TM Offices

- Possibly integrated into a Madrid e-Filing application

CONTENT OF THE CARIFORUM DATABASE OF GOODS AND SERVICES

Terms accepted (validated) by each of the CARIFORUM TM Offices

Possible initial content proposed for validation:

- Nice Alphabetical List (NCL11-2020) - some 10,000 terms
- Additional terms that are common to both WIPO MGS and the EU Harmonised Database (some 26,000)
- List of typical Caribbean terms (national or regional) – to be built upon proposal by interested CARIFORUM TM offices

INITIAL STEPS TOWARDS BUILDING THE CARIFORUM TM CLASSIFICATION TOOL

CarIPI shall be available to collaborate with the CARIFORUM TM Offices in:

- Organizing the term-validation process to build the CARIFORUM G&S database
- Making available a G&S search tool, with multiple functionalities, offering access to the CARIFORUM G&S database
- Developing the online interface of the CARIFORUM G&S database

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THANK YOU

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