



INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

Trade Marks Training Workshop for Trade Mark Prosecutors

14 & 16 November 2016

Brought to you by the Registry of Trade Marks, IPOS



INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

International Classification of Goods and Services

Common Issues

Kok Chi Suan (Registry of Trade Marks)

14 & 16 November 2016



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Common Issues

ICGS – Common Issues

Class Heading

- Class heading of the prevailing edition and version of the Nice Classification is acceptable (except “personal and social services rendered by others to meet the needs of individuals” in Class 45)
- Class heading of previous edition and version of the Nice Classification may not be acceptable.
- Class heading does not equate to a claim for all the goods or services that may be in that class

ICGS – Common Issues

Referencing to other classes

- Cross referencing to the goods and services in the other classes of the same multi-class application is acceptable
- ; all relating to goods in Classes XX and YY of this application

Use of registered Trade Marks (TM)

- Whether belonging to the applicant or otherwise, registered trade marks are not acceptable in specifications of goods and services
- Amend to generic descriptions of the goods and services
- Example: Bluetooth, Pilates, Vaseline

Use of Geographical Indications (GI)

- Should not be used in the specification unless it is clear that the reference is indeed to the GI and not the generic category of goods
- Amend to:
 - generic description of the product ("sparkling white wine" for "Champagne" or "brandy" for "Cognac")
 - clarify that it is indeed the GI that is being referred to (Wines with the geographical indication "Champagne" or Spirits with the geographical indication "Cognac")

ICGS – Common Issues

Alternative expressions for GI

- Appellations of origin
 - Example: Spirits protected by the appellation of origin "Tequila"
- Protected designations of origin (PDO)
 - Example: Wine with protected designations of origin "Champagne"
- Appellation d'origine contrôlée (AOC)
 - Example: Brandy with AOC "Cognac"

ICGS – Common Issues

Rule 19(4)

- All goods/services in this class
- All goods/services included in this class
- Multi-class application consisting of unrealistically broad range of goods/services when viewed in a commercial context such that it is unlikely that the applicant would trade in that entire range of goods/services



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Common Issues (Madrid Application)

ICGS – Common Issues (Madrid Application)

Transfer of goods and/or services

- Not applicable for international registration (IR) designating SG
- Form MM21 to request for correction of the IR



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Common Errors Regarding Specific Terms/Descriptions

ICGS – Specific Terms/Descriptions

Mail order services (Pre-2004 Circulars)

- “mail order services” per se is not acceptable
- Reword to (example):
 - The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order
 - Mail order retail services

Desserts (Pre-2004 Circulars)

- “desserts” per se is not acceptable
- Clarify the nature of the “desserts”
- Example:
 - Desserts [Ice cream] (30)
 - Milk-based desserts (29)

ICGS – Specific Terms/Descriptions

Sale of [goods of interest] (Circular No. 17/2014)

- “sale of [goods of interest]” is not acceptable
- Reword to (example):
 - Retail services relating to the sale of [goods of interest]
 - Retail sale of [goods of interest]
 - Online retail sale of [goods of interest]

Retailing of services (Circular No. 2/2004)

- “retailing of services” is not acceptable
- “the bringing together, for the benefit of others, of a variety of services (excluding the transport thereof), enabling customers to conveniently view and purchase those services” is also not acceptable

ICGS – Specific Terms/Descriptions

Distribution services (Circular No. 12/2014)

- “distribution services” per se is not acceptable in Class 35, 39 & 41
- “distribution services (other than transportation)” is not acceptable in Class 35
- Reword to (example):
 - Distribution of samples (35)
 - Distribution of goods (transportation) (39)
 - Distribution (other than transportation) of films (41)

Manufacturing of goods (Circular No. 12/2004)

- “manufacturing of goods” per se is not acceptable
- Reword to (example):
 - Custom manufacturing of goods [for others]

ICGS – Specific Terms/Descriptions

Provision of news (Circular No. 19/2004)

- “provision of news” per se is not acceptable
- Indicate the subject matter of the news provided or the purpose
- Reword to (example):
 - Provision of financial news (36)
 - Provision of news [telecommunication services] (38)
 - Provision of news for entertainment purposes (41)

Prepared meals (Circular No. 6/2005)

- “prepared meals” per se is not acceptable
- Clarify the predominant ingredient
- Reword to (example):
 - Prepared meals consisting of meat (29)
 - Prepared meals containing principally of rice (30)

ICGS – Specific Terms/Descriptions

Computerised communication network security and other security services (Circular No. 5/2005)

- Class 45 covers services for the protection and security of individuals and property in general and such services being offered online or via a computer network
- Class 42 will cover security services if they pertain to security of computer networks or the internet
- Some security services in Class 39 (E.g. “Guarded transport of valuables”, “escorting of travelers”)

Providing access to databases, Rental of access time to the internet, Providing of user access to the internet, Rental of access time to databases (Circular No. 33/2007)

- Accept in Class 38 only

ICGS – Specific Terms/Descriptions

Technical consultancy services, Technical support services (Circular No. 25/2006)

- “technical consultancy services”, “technical support services” per se is not acceptable
- Clarify the subject matter
- **Note* Technical VS Technological**

Concierge services, Association services (Circular No. 6/2009) Computer services (Circular No. 3/2010)

- “concierge services”, “association services”, “computer services” per se is not acceptable
- Specify the exact nature of the services intended

“Ancillary Services” / “Related Services” (Circular No. 11/2009)

- Not acceptable regardless of whether they are preceded or followed by a specific term
- Specify the exact services intended

ICGS – Specific Terms/Descriptions

Providing a website (Circular No. 7/2016)

- “providing a website” acceptable in Class 42 only
- Reword by specifying the services which are provided via the website (example):
 - Providing non-downloadable games via a website (41)
 - Providing financial information via a website (36)

Kits (Circular No. 7/2016)

- “kits” per se is not acceptable
- Specify the purpose of the kits (E.g. “Cosmetic kits” in Class 3)
- Specify the composition of the kits
 - **All goods** are proper to the class
 - Repair kits comprising screwdrivers, pliers and hammers” in Class 8 ✓
 - **Not all goods** are proper to the class
 - Repair kits comprising screwdrivers, pliers, hammers, metal screws ✗
and bolts in Class 8
 - Repair kits comprising screwdrivers, pliers and hammers sold together with metal screws and bolts in Class 8 ✓

ICGS – Specific Terms/Descriptions

Electronic machines (Circular No. 8/2016)

- “electronic machines ” per se is not acceptable in Class 9
- Specify purpose of the machines
- Example:
 - Automated teller machines [ATM]
 - Calculating machines
 - Weighing machines

Business services

- “business services” per se is not acceptable in Class 35
- Specify the exact nature of the services intended
- Example:
 - Business management
 - Business consultancy

ICGS – Specific Terms/Descriptions

Dim Sum

- “dim sum” per se is not acceptable
- Specify the exact dim sum dish
- Example:
 - Braised chicken feet (29)
 - Baozi [stuffed buns] (30)
 - Jiaozi [stuffed dumplings] (30)

Lanyards or Neck straps

- Lanyards for handphone (09)
- Lanyards for camera (09)
- Lanyards for spectacles (09)
- Lanyards for keys (14)
- Keycords (14)
- Lanyards [cords] for wear (26)



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Overcoming Objections

ICGS – Overcoming objections

Specification objections

- Specification that is deemed vague and clarification on the nature of the goods/services requested
 - Do clarify and propose amendments that are proper to the Class

Example: “business services” in Class 35

Proposal: “business services, namely, business organization and consultancy services”.

ICGS – Overcoming objections

Specification objections

- Specification that is deemed vague and clarification on the nature of the goods/services requested
 - Do not clarify and propose amendments that are not proper to the Class

Example: “prepared meals” in Class 30

Proposal: “prepared meals consisting predominantly of noodles” in Class 30 and add “prepared meals consisting predominantly of meat” in Class 29.

ICGS – Overcoming objections

Circumstances when it is not allowed

The transfer of the item would not be allowed if the mistake is not obvious on the face of the application, in the sense that an alteration in the item previously claimed is required or would widen the scope of the specification originally sought.

Example 1:

Original filing: Class 1: Developing materials
 Class 3: Detergents for household purposes

Proposed transfer: “Detergents for household purposes” from Class 3 to “detergents for use in manufacturing processes” in Class 1

Decision: Not allowed as the transfer would widen the scope of the specification originally sought.

Example 2:

Original filing: Class 30: Non-alcoholic beverages
 Class 32: Beer

Proposed transfer: “Orange juice” from Class 30 to Class 32

Decision: Not allowed as it is not obvious that “orange juice” was intended to be claimed as it would be assumed that the “non-alcoholic beverages” claimed in Class 30 are only those which fall in Class 30.

ICGS – Overcoming objections

Expanding the list of precedents for specification claims

(Circular No. 3/2014, dated 7 February 2014)

Currently, the Registry is prepared to rely on precedents from Singapore, United Kingdom, Australia and Hong Kong registrations in relation to specifications of goods or services. To view the relevant circular, please click [here](#).

In order to further harmonize our practice with other developed jurisdictions and to better serve our customers, the Registry will now extend this practice to precedents from New Zealand and the United States of America.

With this extension, agents and applicants are welcome to submit precedents from the following jurisdictions in support of their specification of goods or services:

- Singapore
- United Kingdom
- Australia
- Hong Kong
- New Zealand
- United States of America

However, please note that the Registrar will not consider precedents which:

- Had clearly been accepted in the wrong class;
- Are no longer accurate in light of the relevant edition/version of the International Classification of Goods and Services;
- Are inconsistent with our current practice or that of the relevant foreign IP office.

ICGS – Overcoming objections

Formalizing of amendments to specification of goods or services

(Circular No. 11/2015, dated 22 Dec 2015)

The Registry wishes to remind applicants to exercise care when formalizing amendments to the specification of goods or services covered by their trade mark applications.

Once the specification covered by an application has been restricted, it cannot subsequently be expanded. This is in compliance with Section 14(3) of the Trade Marks Act, which states that amendment requests to an application shall not extend the goods or services covered.

This applies to national applications, where specification amendments are formalized by submitting the amendment form (Form TM27), as well as to international registrations designating Singapore, where amendments are formalized by submitting a written response to consent to the Registry's proposal to effect these amendments to the objected specification items.

Prior to the submission of requests to amend the specification, applicants are advised to ensure that their requested amendments accurately reflect their intended goods and services, even if the amendments are proposed by the Registry. The Registry would not be able to accede to requests to expand the specification after restriction amendments have been approved.



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Filing of specification in Form TM4

ICGS – Filing of specification in Form TM4

Incentive in filing fees coming your way...

- Specification of goods and services filed using the pre-approved list of goods and services (full green list) will enjoy discounted filing fees
 - Encourage the use of the pre-approved list of goods and services
 - Pass on the savings on examination resources required to the Applicants
- More information available in Q1 2017
- Filing of specification of goods and services not found in the pre-approved list of goods and services (red items) will not be affected

THANK YOU