

TRADE MARKS PRACTICE GUIDELINE AMENDMENT – CROSS CLASS SEARCHING

Issue

Further to the introduction of the presumption of registrability in the Trade Marks Act 2002, a number of recent changes to the NICE classification of goods and services, and similar reviews by other intellectual property offices, IPONZ has reviewed its cross class search list.

Proposal

As a result, IPONZ proposes to add the following to the Practice Guidelines on *Relative Grounds: Identical or Similar Marks*:

2. RAISING OF CITATIONS

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2.3 Cross Class Search List

The monopoly granted in a trade mark is limited to the specified goods or services for which the mark is intended to be used. These goods or services are separated into 45 different classes using the NICE classification system.¹

When Examiners are doing searches for the purposes of section 25 of the Act, where possible all 45 classes of the system will be searched, however, in some cases searches will be limited to the specific application's nominated class and any related classes. There are a number of reasons why searches extend beyond the particular class or classes in which an application is made, including:

- The fact that changes have occurred to the NICE classification system since it introduced in New Zealand. For example “legal services” were classified in class 42 before 1 January 2007 and are now classified in class 45.
- Goods or services of one class may be similar to those of another class. For example, hand-held computer games may fall in class 9 if they interact with electronic equipment or class 28 if they are stand alone.

A cross-class search list is set out in the Appendix to this guideline to show the classes where the Office considers that it is probable such changes or overlaps may arise.

It should be noted, however, that the mere fact that the same or similar mark exists in a class identified in this table does not mean that the goods or services will be similar. For example, although “fertilisers” in class 1 are considered similar to “mulches” in class 31, other goods in class 1 such as “soldering preparations” are unlikely to be considered similar to class 31 goods.

¹ This system is primarily an administrative tool which simplifies searching for trade marks. For more information see the Office Practice Guidelines on *Classification and Specification*.

APPENDIX 1 - CROSS CLASS SEARCH LIST 2007

<i>Class</i>	<i>Cross Class</i>
1	01 31
2	02
3	03 05 21
4	04 39
5	03 05 10 30 31 32
6	06 17 19 20 22
7	07 08 11 12 21
8	07 08 21
9	09 10 11 16 28 38 42 45
10	05 09 10
11	07 09 11 17 19 21 37
12	07 12 35 37 42
13	13 37
14	14 21 35 37 40 42
15	15
16	09 16 41 42
17	06 11 17 19 37
18	18 35 42
19	06 11 17 19 37
20	06 20 21 24
21	03 07 08 11 14 20 21
22	06 22
23	23 26
24	20 24 27 40
25	25 35 40 42
26	23 26
27	24 27 37
28	09 28
29	29 30 31 32
30	05 29 30 31
31	01 05 29 30 31
32	05 29 32 33
33	32 33 40 41 44
34	34
35	12 14 18 25 35 36 40 42 43
36	35 36 41 42 43
37	9 11 12 13 14 17 19 27 37 38 42 44
38	09 37 38 41 42
39	04 39 42 43
40	14 24 25 33 40 42
41	09 16 33 35 38 41 42 43
42	09 12 14 16 18 25 35 37 38 40 42 43
43	35 36 39 41 42 43
44	33 37 42 44 45
45	09 42 44 45