

03b Annexure General – Sections 31 and 32 of the Trade Marks Act 2002

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1. Introduction

This Annexure outlines the correct classification of goods and services that are more difficult to classify under the Trade Marks Act 2002 (the Act). The Intellectual Property Office of New Zealand (IPONZ) provides these guidelines to assist trade mark applicants to select the correct class and scope of specifications before making an application.

The contents of this Annexure are drawn primarily from the International Classification of Goods and Services (Nice Classification) (2006, 9th edition)¹. Other points of reference include:

- The UK Patent Office Trade Marks Registry work manual
- The UK Patent Office web site
- The Australian Trade Marks Manual of Practice and Procedure
- United States Patent and Trademark Office Acceptable Identification of Goods and Services Manual (1997)
- The United States Patent and Trademark Office web site

Footnote

¹ Reference updated 5 January 2007

2. Correct classification

This Annexure outlines the correct classification of goods and services that are more difficult to classify under the Act. In providing these general guidelines, the Intellectual Property Office of New Zealand (IPONZ) hopes to assist trade mark applicants to select the correct class and scope of specifications, before making an application. It is important that the goods or services applied for are correctly classified in light of current international classification standards.

The examiner will check the specification and draw any errors to the attention of the applicant. However, as long as the goods or services applied for can fall in the class applied in, the examiner will assume that the applicant has applied in the correct class.

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Animal welfare services

Animal welfare services² are classified in class 44.

Badges

Badges are classified differently, depending on whether they are for wear or not.

Specification	Class
Badges for wear, of precious metal	14
Badges for wear, not of precious metal	26

Badges not for wear are classified according to the material they are made of.

Specification	Class
Badges made of common metal	6
Badges made of leather	18
Badges made of plastic	20
Badges made of textile materials	24

Beverages

Beverages are classified according to their content or purpose.

Specification	Class
Dietetic beverages adapted for medical purposes	5
Medicinal alcohol, medicinal tea	
Medicinal drinks, medicinal infusions	
Milk beverages (milk predominating), milkshakes	29
Coffee, tea, cocoa	30
Beverages based on coffee, tea and cocoa	
Chocolate-based beverages, chocolate beverages with milk	
Beverages for pets or animals	31
Mineral water, aerated water, drinking water, tonic water	32
Soft drinks, isotonic drinks	
Non-alcoholic drinks, such as de-alcoholised wines and cider	
Fruit drinks and fruit juices	
Alcoholic beverages (other than beers)	33
Wines, spirits, liqueurs, ciders	

Bicycle dynamos

Bicycle dynamos³ are classified in class 7.

Bonus schemes

see [Customer Loyalty Schemes and Programmes](#)

Butler services

Butler services⁴ are in the nature of a personal service rendered by others to meet the needs of individuals. They are therefore classified in class 45.

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Cabinet making

Cabinet making⁵ may be classified as follows:

Specification	Class
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Repair of cabinets	37
Custom manufacture of cabinets	40

Civil engineering

– see [Construction Services](#)

Child care services

Child care services may be classified in a number of classes as follows:

Specification	Class
Training in the care of children	41
Design of child care facilities	42
Child care services	
Provision of child care centres	43
Day care services for children	
Day care centres	44

Cleaning machines, apparatus and installations

Cleaning machines, apparatus and installations are classified as follows:

Specification	Class
Electrically operated or mechanically powered cleaning machines, apparatus and installations	7
Hand operated domestic cleaning utensils	21

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Clothing accessories

Clothing accessories fall into a number of classes. For example:

Specification	Class
Jewellery	14
Handbags	18
Shoes, leather belts [clothing]	25
Hair bands and clips, false hair pieces, brooches	26

Construction services

Building construction services are classified in class 37. Class 37 is intended to cover building of structures, roads, bridges and similar civil engineering projects. Shipbuilding is also classified in class 37.

Manufacturing services, that is, the construction of custom manufactured products, are classified in class 40.

Customer loyalty schemes or programmes

Customer loyalty schemes or programmes that allow customers to accumulate points to be used for discounts on future purchases are primarily retail store services, hence are classified in class 35.

Airline frequent flyer programmes are classified in class 39.

Organising and conducting a customer loyalty or bonus scheme for a third party is a promotion or advertising service, and is classified in class 35.

Dance choreography

Dance choreography⁶ services are similar in nature to dance instruction services and classified in class 41.

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Distribution services

Distribution services are classified in class 39 if in the nature of delivery services, and class 35 if in the nature of retail services.

Doors

Doors are classified as follows:

Specification	Class
Doors made of metal	6
Doors for vehicles	12
Doors not made of metal	19
Doors for furniture	20

Drinks

– [see Beverages](#)

Electricity services, energy services⁷

Class 4 is the correct classification for electricity as a ‘good’. Class 39 is the correct classification for the distribution and transmission of energy.

Class 40 is the correct classification for the production of energy and analogous services.

Specification	Class
(Electricity goods)	4
Fuels, gas, gasoline, petrol, coal	4
Distribution of electricity	
Transmission of electricity	39
Transportation and storage of electricity	
Supply of electricity	
Production of electricity	
Generation of electricity	40

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Electronic calculators

These are classified as a computer service in class 42, unless:

- Class 36: if they are incidental to a banking service, e.g., overseas currency converters and mortgage repayment calculators.
- Class 41 if they are incidental to an education service, e.g., online mathematical calculator's incidental to an education service.

Electronic games

The 9th edition⁸ of the Nice Classification states:

Specification	Class
Games (Apparatus for -) adapted for use with television receivers only Amusement apparatus adapted for use with television receivers only Coin-operated apparatus (Mechanisms for-)	9
Games (Automatic -) other than those adapted for use with television receivers only Games (Apparatus for -) adapted for use with an external display screen or monitor Games other than those adapted for use with television receivers only (Apparatus for electronic -) Amusement machines, automatic and coin operated	28

Class 9 covers:

- Games apparatus that is adapted or intended for use with a television, monitor or some other form of display apparatus that is separate from the games apparatus.

Class 28 covers:

- Games apparatus that is self contained, usually hand-held, and that does not require a separate piece of apparatus such as a television or computer monitor to play the game. These games may have programmes built in or programmes that slot in.
- Electronic games without a display.
- Games apparatus that is coin and/or counter fed or coin and/or counter operated.

All computer games programmes, computer games software and computer games cartridges are classified in class 9 regardless of the type of game.

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Energy services

– see [Electricity Services](#)

Event management

Event management services are classified as follows:

Specification	Class
Administration and business management of events	35
Management of entertainment events	41
Arranging temporary accommodation, food and beverages for events	43

Exhibitions

Organisation of exhibitions is classified according to the purpose of the exhibitions as follows:

Specification	Class
Organisation of exhibitions for commercial and advertising purposes	35
Organisation of exhibitions for cultural, educational, sporting or entertainment purposes	41

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Filters and filtering materials

Filters are usually finished articles and are normally classified according to their use. For example:

Specification	Class
Filters being parts of engines or machines	7
Photographic filters	9
Filters for ultraviolet rays for medical purposes	10
Filters for water supply apparatus	11
Filters for electric coffee machines	16
Coffee filters made of paper	21
Filters for non-electric coffee machines	34
Cigarette filters	34

Filtering materials are classified according to the material they are made of. For example:

Specification	Class
Filtering materials made of unprocessed plastic	1
Filtering materials made of metal	6
Filtering materials made of paper	16
Filtering materials made of semi-processed plastic	17
Filtering materials made of textile	24

Franchising services

Franchising services are classified as follows:

Specification	Class
Business consultancy services relating to franchising	35
Legal services relating to franchising	45 ⁹

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Frequent flyer programmes

– [see Customer loyalty schemes and programmes](#)

Hire purchase finance services

Hire-purchase financing services are classified in class 36.

Loyalty schemes and programmes

– [see Customer loyalty schemes and programmes](#)

Occupational health and safety

Occupational health and safety¹⁰ services are classified according to the services they relate to or field in which they are being offered. For example:

Specification	Class
Education and training services in relation to occupational health and safety	41
Occupational health and safety (ergonomics and design)	42
Consultancy in relation to occupational health and safety	42
Occupational health and safety (therapeutic and rehabilitation services)	43

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Medicated goods₂

Dentifrices, shampoos, soaps and toothpastes are correctly classified in class 3 whether they are medicated or not. However, mouthwashes and rinses are classified as follows:

Goods	Class 3	Class 5
Mouthwash	not for medical purposes	for medical purposes
Dental rinse	non-medicated	medicated
Mouth rinse	not for medical purposes	for medical purposes

Project management

Project management services are generally classified according to the services they relate to or the field in which they are being offered.

For example:

Specification	Class
Project financing	36
Building project management	37
Architectural project management Project management [design]	42

Class 35 is the correct classification for business project management, that is, project management services to do with the way a business is organised or run. This is so regardless of the nature of the business using the management services.

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Protective clothing and padding

– [see also Wet suits](#)

Clothing, footwear and headgear for normal wear are classified in class 25. Certain specialised items of clothing, footwear and headgear are classified in class 9. These items protect the wearer from injury in accidents, or where there is some known potential for injury. Protective

clothing for medical, surgical or dental purposes is classified in class 10.

Pads to protect the wearer from injury are usually classified in class 9, but can be classified in other classes. Padding for wearing in sport is classified in class 28. Supports worn on limb joints etc are classified in class 28 if worn for sports purposes, and class 10 if worn for medical purposes.

For example:

Specification	Class
Clothing, footwear and headgear Clothing and shoes for protection against accidents, irradiation and fire Protective clothing, footwear and headgear for industrial purposes Protective helmets Protective masks Protective suits for aviators Diving suits and diving masks (protective clothing for use in diving) Pads Knee pads and elbow pads for wear by labourers	9
Protective clothing for medical, surgical or dental purposes Limb supports for medical purposes	10
Clothing, footwear and headgear for normal wear Protective clothing for use in inclement weather conditions	25
Cricket pads Shin pads for wear while playing sport Limb supports for sports purposes	28

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Supplements

Dietetic and food supplements for medical purposes are classified in class 5. Non-medical dietetic and food supplements are classified in classes 29, 30, 31 and 32 according to the base product.

Tableware

Tableware is classified as follows¹²:

Specification	Class
Cutlery, including cutlery of precious metals Knives, forks and spoons	8
Table linen made of paper Table mats made of paper Table napkins made of paper	16
Bowls, cups, dishes, plates and platters Napkin holders/rings Salt and pepper shakers	21
Table linen made of textile Table mats, not of paper Table napkins made of textile	24

Most services provided by a travel agency are classified in class 39; however accommodation reservation services are classified in class 43.

Typesetting

Typesetting¹³ services are classified in class 40.

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Valves

Valves may be classified according to their purpose or to the materials they are made of.

Specification	Class
Valves made of metal, other than parts of machines	6
Valves, being parts of machines	7
Automatic valves	9
Regulative valves	
Solenoid valves	
Thermionic valves	
Feeding bottle valves	10
Valves for medical purposes	
Valves for controlling the level in tanks	11
Thermostatic valves, being parts of heating installations	
Air valves for steam heating installations	
Valves, being plumbing fittings	
Valves for air conditioners	
Valves for vehicle tyres	12
Valves for musical instruments	15
Valves made of rubber or vulcanised fibre	17
Valves made of leather	18
Water pipe valves, not made of metal or plastic	19
Valves not of metal, other than parts of machines	20
Water pipe valves made of plastic	

Wet suits

-see also [Protective clothing and padding](#)

While wet suits may be considered as sports equipment they are correctly classified in class 9 or 25 depending on whether it is for a surface sport or for diving. For example:

Specification	Class
Wet suits for diving	9
All diving equipment	
Wet suits for surfing or waterskiing	25
Wet suits for surface water sports	

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Wine and related goods and services

Wine and related goods and services are classified as follows:

Specification	Class
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Chemicals used in the making of wine	1
Printed publications relating to wine	16
Juices and beverages containing wine (alcohol content of 1.2% or less by volume)	32
Wine (alcohol content of 1.2% or more by volume)	33
Wine sales/ cellar door sales	35
Mail order services relating to wine	39
Delivery of wine	39
Winemaking/ Oenology	40
Wine tasting events, organisation of wine tasting events, entertainment relating to wine tasting	41
Wine bar services	43
Wine bar services	44

Footnote

² Practice Guideline Amendment 2004/05, Information For Clients, Issue 33: 30 September 2004.

³ Practice Guideline Amendment 2004/05, Information For Clients, Issue 33: 30 September 2004.

⁴ Practice Guideline Amendment 2004/05, Information For Clients, Issue 33: 30 September 2004.

⁵ Practice Guideline Amendment 2004/05, Information For Clients, Issue 33: 30 September 2004.

⁶ Practice Guideline Amendment 2004/05, Information For Clients, Issue 33: 30 September 2004.

⁷ Practice Guideline Amendment 2003/5, Information For Clients, Issue 29: 30 December 2003.

⁸ Reference updated 5 January 2007

⁹ Reference updated 5 January 2007

¹⁰ Practice Guideline Amendment 2004/05, Information For Clients, Issue 33: 30 September 2004.

¹¹ Practice Guideline Amendment 2007/02, IPONZ Newsletter, March 2007.

¹² Table updated 5 January 2007

¹³ Practice Guideline Amendment 2004/05, Information For Clients, Issue 33: 30 September 2004.

3. Broad specifications

When examining a specification of goods or services, an examiner considers whether the applicant has applied for an unrealistically broad range of goods or services. A concern will be raised under section 32(2) of the Act where the examiner considers the specification applied for is too broad or that it is commercially unrealistic that the applicant would use the mark in relation to that broad range of goods or services.

The following are considered unrealistically broad or vague in a specification and will result in a concern being raised under section 32(2) of the Act.

[Accessories](#)

[Advisory services](#)

[And the like](#)

[All goods or services in this class](#)

[Ancillary goods/services](#)

[Association services](#)

[Business to Business, B2B, B2C](#)

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Accessories

– see also [Clothing accessories](#)

The unqualified term “accessories” in a specification is unacceptably vague. Where a specification includes the unqualified term “accessories”, a concern will be raised under section 32(2) of the Act. The applicant will be asked to qualify this term by linking the term to specific goods such as computer accessories.

Accessories may be linked to the entire preceding specification. For example, the phrase “accessories in relation to all the aforementioned goods” would be acceptable.

Advisory services

- see [Consultancy and advisory services](#) and [Information and advisory services](#)

And the like

- see [Like services](#)

All goods or services in this class¹⁴

The wording “all goods in this class” or “all services in this class” or similar is never acceptable in a specification. When classification schedules change, some classes may also change. It then becomes difficult to tell which goods or services are included in the registration without referring to previous schedules of the 1953 Act.

This is so, even for the classes where the entire class heading is acceptable, such as class 25. For example, “clothing, footwear, headgear” is acceptable in class 25, but “all goods in this class” is not.

Concerns will be raised under section 32(2) of the Act for all applications where the specification comprises or includes “all goods or services in this class”. The applicant will be asked to substitute a precise description of the goods or services in respect of which registration is desired.

Ancillary goods/services

The phrase “...and ancillary goods/services” is too vague. The applicant should be asked to amend the specification by substituting more precise language that clearly indicates the goods or services in respect of which registration is desired.

Association services

The unqualified terms “association services”, “services (not included in other classes) rendered by an association to its own members” and the like are unacceptably vague. These services may fall in a number of classes. For example:

Information services, as provided by an association, in the nature of ...	Depends on the field
Advice relating to the business management of associations Promotion of association services	35
Sponsorship of associations	36
Education and training services as provided by an association	41

Where a specification includes the unqualified terms “association services”, “services (not included in other classes) rendered by an association to its own members” or the like, a concern will be raised under section 32(2) of the Act. The applicant will be asked to qualify those terms by specifying the exact service or services in respect of which registration is desired.

Business to Business, B2B, B2C

The terms “business to business services”, “B2B services” and the like, are considered too vague and too broad for specification purposes. Where a specification includes these unqualified terms or the like, a concern will be raised under section 32(2) of the Act. The applicant will be asked to qualify those terms by specifying the exact nature of the business-to-business service as it could potentially encompass several different services.

Club services

The unqualified terms “club services”, “services (not included in other classes) rendered by a club to its members” and the like, are unacceptably vague. These services may fall into a number of classes. For example:

Information services, as provided by a club, in the nature of ...	Depends on the field
Advice relating to the business management of clubs Promotion of club services	35

Sponsorship of clubs	36
Education and training services as provided by a club Entertainment services provided by a club to its members	41

Where a specification includes the unqualified terms “club services”, “services (not included in other classes) rendered by a club to its members” or the like, a concern will be raised under section 32(2) of the Act. The applicant will be asked to qualify those terms by specifying the exact club service or services in respect of which registration is desired.

Components

The unqualified term “components” or the like in a specification is unacceptably vague. Where a specification includes the unqualified term “components”, a concern will be raised under section 32(2) of the Act. The applicant will be asked to qualify this term by linking the term to specific goods such as computer components.

Components may be linked to the entire preceding specification. For example, the phrase “components in relation to all the aforementioned goods” would be acceptable.

Consultancy and advisory services

Consultancy and advisory services are generally classified according to the services they relate to or the field in which they are being offered. For example:

Financial consultancy	36
Building construction consultancy	37
Telecommunications consultancy	38
Travel consultancy	39
Dress making consultancy	40
Training consultation services	41
Computer programming consultancy	42

Class 35 is the correct classification for consultancy services in relation to business management or business administration, that is, consultancy services to do with the way a business is organised or run. This is so regardless of the nature of the business using the consultancy or advisory service.

However, consultancy services on technical matters may fall into a number of classes.

Consultancy services in relation to the client’s personnel management and business administration	35
Food delivery services	39
Processing and treatment of cooked food	40
Training of personnel in food technology	41
Advisory services relating to regulations concerning food Quality control relating to the hygiene of food	42
Consultancy services relating to food Hospitality services [food and drink]	43

Etc

The use of “etc” in a specification is unacceptably vague and broad, necessitating concerns raised under both section 31 and section 32(2). The applicant will be asked to amend the specification by substituting more precise language that clearly indicates the goods or services in respect of which registration is desired.

Goods

The unqualified term “goods” is not acceptable, but is acceptable when used in conjunction with a description that adequately describes the type of goods for which protection is sought. For example, “leather goods” and “goods for the care of the skin” are acceptable.

Goods in the nature of¹⁵

The phrase “goods in the nature of” will generally be acceptable in a specification. The examiner will interpret such a phrase as relating to the specific goods. For example, “goods in the nature of clothing” will be interpreted as “clothing”.

Goods in relation to

The phrase “goods in relation to...” is too vague. The applicant should be asked to amend the specification by substituting more precise language that clearly indicates the goods or services in respect of which registration is desired.

Hire services

- see [Rental services](#)

Information and advisory services

Information and advisory services are classified according to the subject content of the information being provided. This is so regardless of the means by which the information is provided. Information provided by electronic means or over the Internet is thus also classified according to the subject or content of the information rather than by the means of delivery.

For example:

Business information, including business information provided over the Internet	35
Insurance and real estate information provided over the telephone and in printed form	36
Transport information provided over the Internet	39
Weather information provided by electronic means	42

The service of “providing information in a wide variety of fields” is considered to be too broad and must be limited by the subject matter of the information being supplied.

The gathering together of information, such as market research or opinion polling, is classified in class 35 regardless of the subject matter of the information being gathered.

Kits

The applicant must specify either the purpose of the kit (if it has a single purpose) or the goods the kit contains.

If the kit is for the purpose of making a single object, it is classified according to the item it is intended to make. For example:

Kits for making desks	20
Kits for making bird cages	21

If the kit is described as a “hobby craft kit”, it is classified in class 28 as a kind of toy or amusement product.

If the kit is a combination of items around a theme, the kit is classified according to the class that would include the majority of the individual items in the kit. For example, a first aid kit that comprises primarily bandages, antiseptic and aspirin would be classified in class 5 even though it also included tweezers (class 8) and an instruction manual (class 16).

If the kit does not appear to have a predominant class, the applicant must choose which class or classes they wish to apply in.

Leasing services

- see [Rental services](#)

Like goods or services

The phrase “...and the like” is too vague. The applicant should be asked to amend the specification by substituting more precise language that clearly indicates the goods or services in respect of which registration is desired.

Management services

Management services are generally classified according to the services they relate to or field in which they are being offered.

For example:

Financial management Estate management Investment management	36
Construction management services	37
Management of aircraft operations	39
Waste management services	40
Management of cinemas Management services for performing artists	41
Restaurant management	43
Copyright management	45 ¹⁶

Class 35 is the correct classification for management services in relation to business management or business administration, that is, management services to do with the way a business is organised or run. This is so regardless of the nature of the business using the management services.

Manufacturing services

Custom manufacturing services are classified in class 40. This includes the manufacture of particular goods to customer requirements and/or specifications. However, the manufacture of goods is not considered to be a service offered to others and is incidental to the creation of a product. Applicants should apply in the goods class appropriate to the products on which they are using or intend to use their mark.

Building construction services are classified in class 37. Class 37 is intended to cover building of structures, roads, bridges and similar civil engineering projects. Class 37 is also the correct classification for shipbuilding.

Outsourcing services¹⁷

The term “outsourcing services” is considered to be too broad and vague as the exact nature of the services included within this description is unclear. In addition, outsourcing services are classified in more than one class according to the nature of the goods or services being outsourced.

Where a specification includes the term “outsourcing services”, a concern will be raised under section 32(2) of the Act if the applicant has not specified the exact nature of these services.

Parts and fittings

The unqualified term “parts and fittings” or the like in a specification is unacceptably vague. Where a specification includes the unqualified term “parts and fittings”, a concern will be raised under section 32(2) of the Act. The applicant will be asked to qualify this term by linking the term to specific goods such as computer parts and fittings.

Parts and fittings may be linked to the entire preceding specification; for example, “parts and fittings in relation to all the aforementioned goods” would be acceptable.

Peripherals

The unqualified term “peripherals” or the like in a specification is unacceptably vague. Where a specification includes the unqualified term “peripherals”, a concern will be raised under section 32(2) of the Act. The applicant will be asked to qualify this term by linking the term to specific goods such as computer peripherals.

Peripherals may be linked to the entire preceding specification; for example, “peripherals in relation to all the aforementioned goods” would be acceptable.

Related goods

The phrase “...and related goods” is too vague. The applicant should be asked to amend the specification by substituting more precise language that clearly indicates the goods in respect of which registration is desired.

Related services

The phrase “...and related services” is too vague. The applicant should be asked to amend the specification by substituting more precise language that clearly indicates the services in respect of which registration is desired.

Rental services, leasing services, hire services

Rental services, leasing services and hire services are classified in the same classes as the services provided by means of the rented objects. See the General Remarks section of the Nice Classification (page 3). For example:

Rental of publicity material or advertising space	35
Rental of photocopying machines or office machinery and equipment	35
Rental of food vending machines	35
Rental of real estate, apartments or office space not warehouses or parking spaces (39), stadium facilities (41) or holiday or temporary accommodation (43)	36
Rental of construction equipment, bulldozers, cranes, or excavators	37

Rental of cleaning equipment or road sweeping machines	37
Rental of telecommunications equipment including telephones, modems, facsimile apparatus	38
Car hire services, rental of vehicles, boats or wheelchairs Rental of parking spaces	39
Rental of storage containers or warehouses	39
Rental of mailboxes	39
Rental of sewing machines	40
Rental of sound recordings, films, videos, videotapes, radio sets, television sets, audio equipment, video cameras and VCRs, tape recording equipment, movie projectors and accessories, stage scenery and show scenery, lighting apparatus for theatre sets or TV studios, or musical instruments Rental of gaming machines or computer game programmes	41
Rental of sports equipment, stadium facilities, tennis courts or sports fields	41
Rental of computers and computer hardware and computer software not computer game programmes (41)	42
Rental of photographic equipment	42
Rental of temporary accommodation, rooms, tents, furniture, tables, chairs, table linen or glassware	43
Rental of medical equipment, sanitation facilities, protective clothing and equipment	44
Rental of agricultural and farming equipment	44
Rental of clothing, clothing hire, costume hire, uniform hire	45

The unqualified terms “rental services”, “leasing services”, “hire services” or the like are considered too broad and too vague as they do not clearly and precisely indicate the nature of the services being provided. Where a specification includes the unqualified terms “rental services”, “leasing services”, “hire services” or the like, a concern will be raised under section 32(2) of the Trade Marks Act 2002 and the applicant will be asked to state the goods to which the services relate.

Where an applicant qualifies its rental, leasing or hire services by specifying the nature of the rental, leasing or hire services, IPONZ will continue to raise a concern under section 32(2) of the Act unless the nature of the rental, leasing or hire services is sufficiently precise.

Retailing of services

From time to time IPONZ receives applications with specifications that include "wholesale and/or retail of XYZ services". It is not clear what is meant by the retail and/or wholesale of a service, as opposed to the retail and/or wholesale of particular goods. If the applicant desires registration in respect of the provision of a service, the application should be made in respect of that service, rather than the retail or wholesale of that service.

Therefore, IPONZ will no longer accept trade mark specifications that contain "retail and/or wholesale of XYZ services" (or similar). When IPONZ receives an application that includes such a specification, concern will be raised under section 31 of the Act. The applicant will be asked to delete the reference to retail and/or wholesale, and to substitute instead a precise description of the services in respect of which registration is desired. If necessary the applicant will also need to request a change of class or transfer the services to the appropriate class(es).

Services associated with¹⁸

The phrase “services associated with...” is too vague. The applicant should be asked to amend the specification by substituting more precise language that clearly indicates the services or goods in respect of which registration is desired.

Services in, for, of¹⁹

The phrases “services for...”, “services of...”, “services in...” and the like will generally be acceptable in a specification. The examiner will interpret such phrases as relating to the specific services. For example, “services for transport”, “services of transport” or “services in transport” will be interpreted as “transport services”.

However, where the specification is unclear the applicant should be asked to substitute more precise language that clearly indicates the services or goods in respect of which registration is desired. For example, “services for clubs” is unclear as the unqualified term “club services” is unacceptably vague.

Services in the nature of, in relation to²⁰

The phrases “services in the nature of...”, “services in relation to...” and the like will generally be acceptable in a specification. The examiner will interpret such a phrase as relating to the specific services. For example, “services in the nature of transport” will be interpreted as “transport services”.

However, where the specification is unclear the applicant should be asked to substitute more precise language that clearly indicates the services or goods in respect of which registration is desired. For example, “services in relation to club services” is unclear as the unqualified term “club services” is unacceptably vague.

Services that cannot be placed in other classes

Under the 7th Edition of the Nice Classification of Goods and Services (Classification System number 4), the class 42 heading included “services that cannot be classified in other classes”. This wording is not in the 8th or 9th Edition of the Nice Classification²¹. Therefore, there is no longer a “miscellaneous services” category.

The terms “services that cannot be placed in other classes” is considered to be too vague and too broad to be acceptable in a specification of services. Where a specification includes this unqualified term, a concern will be raised under section 31 and/or section 32(2) of the Act. The actual services for which protection is sought should be specified.

Substitutes

The unqualified term “substitutes” or the like in a specification is unacceptably vague. Where a specification includes the unqualified term “substitutes”, a concern will be raised under section 32(2) of the Act. The applicant will be asked to qualify this term with a description that adequately defines the type of substitute such as coffee substitutes and cream substitutes.

Supply of

The phrase “supply of...” is too ambiguous as it may refer to retail and wholesale services, import/export services, distribution and delivery services, or rental services.

Where a specification includes the unqualified phrase, a concern will be raised under section 32(2) of the Act. The applicant will be asked to amend the specification by substituting a more precise description of the services.

Exception: Water supply services are classified in class 39.

Systems

The unqualified term “systems” or the like in a specification is unacceptably vague. Where a specification includes the unqualified term “systems”, a concern will be raised under section 32(2) of the Act. The applicant will be asked to qualify this term with a description that adequately defines the type of system such as exhaust systems and alarm systems.

Footnotes

¹⁴ Practice Guideline Amendment 2005/01, IPONZ Newsletter, May 2005

¹⁵ Practice Guideline Amendment 2007/01, IPONZ Newsletter, March 2007

¹⁶ Reference updated 5 January 2007

¹⁷ Practice Guideline Amendment 2004/05, Information For Clients, Issue 33: 30 September 2004.

¹⁸ Practice Guideline Amendment 2007/01, IPONZ Newsletter, March 2007

¹⁹ Practice Guideline Amendment 2007/01, IPONZ Newsletter, March 2007

²⁰ Practice Guideline Amendment 2007/01, IPONZ Newsletter, March 2007

²¹ Reference updated 5 January 2007
