

Annexure to Computer Services

1. Introduction

This Annexure outlines the correct classification of computer, telecommunication and online goods and services under the Trade Marks Act 2002 (the Act) that are more difficult to classify. 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) (2017, 11th edition) (reference updated 1 January 2017).

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

2. Correct classification

This Annexure outlines the correct classification of computer, telecommunication and online related 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.

Call centre services

Call centre services are classified in class 38 or class 35 according to the nature of the services.

Specification	Class
Call centre services that are in the nature of a “customer service” service.	35

Specification	Class
Call centre services in the nature of providing telecommunications solutions services.	38

Computer security services

Computer security services may be classified in the following classes depending on the nature of the service being provided:

Specification	Class
Consultancy in the field of computer security Computerised communication network security Data security services [firewalls] Computer security services, namely, restricting access to and by computer networks to and of undesired websites, media, individuals and facilities Computer services for the protection of computer software	42
Security services for buildings provided online or via a computer network Monitoring of computerised security systems for security purposes	45

Directory services

Directory goods and services are classified as follows:

Specification	Class
Telephone directory databases	9
Printed directories	16
Provision of business directories, and directories for retail and	35

Specification	Class
wholesale purposes	
Provision of telephone directory information	38

Electronic publications

Downloadable electronic publications are considered to be goods, such as software, and are classified in class 9.

Electronic publishing services are classified as follows:

Specification	Class
Electronic publication of publicity texts	35
Electronic publication of texts [other than publicity texts] Publication of electronic books and journals online Providing online electronic publications (not downloadable)	41

Hyperlinks

The service of providing hyperlinks on a web site to other traders' websites is a telecommunication service and is classified in class 38.

Middleware

Middleware is considered to be software. Therefore the installation, updating and maintaining of middleware is classified in class 42.

Web-casts and web-casting

The terms "webcasts", "webcasting" and similar cover a wide range of services that can be in the nature of a broadcasting service in class 38 or an entertainment service in class 41.

~~For example, if the services involve providing a website from which the user can receive “webcasted” transmissions over the Internet, these services are correctly classified in class 38. For example, if the services involve providing services via a website, from which the user can receive “webcasted” transmissions over the Internet, these services are correctly classified in class 38.~~

However, if these services involve providing a particular online show “webcasted” over the Internet, these services are correctly classified in class 41.

Webcasting services are classified as follows:

Specification	Class
Webcasting a television programme via the Internet	38
Entertainment services, namely a continuing comedy show broadcasted over the Internet Production of entertainment webcasts	41

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.

Computer services

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

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

Computer services are classified as follows:

Specification	Class
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Specification	Class
Installation, maintenance and repair of computer hardware	37
Electronic transmission of data and documents via computer terminals Operation of chat rooms, providing chat room services Electronic bulletin board services (telecommunications services) Electronic mail services	38
Computer training services	41
Computer programming and related services Computer programming for others Computer code conversion for others Recovery of computer data Computer software Installation, maintenance and repair of computer software Updating of computer software Duplication of computer programmes Design services Computer software design Design of computers for others Computer site design and website or webpage design Computer systems analysis	42
Maintaining websites or web pages for others Hosting computer sites (websites) Consultancy in the field of computer hardware and software	42

Computer software

The unqualified terms “computer software”, “non-downloadable computer software”, “computer applications”, “software modules”, “interactive software”, “multimedia software”, “software as a service (SaaS)” and the like are considered too broad and too vague, as they do not precisely indicate the particular software that the applicant provides.

Where a specification includes a broad software term, a concern will be raised under section 32(2) of the Trade Marks Act 2002 and the applicant will be asked to specify the software more precisely.

Software terms that clearly specify the function/purpose of the software will be acceptable, for example:

- Computer game software
- Downloadable anti-virus software
- Geographical information system (GIS) software
- Software for use in cancer diagnosis
- Computer programmes for use in teaching children to read
- Software as a service (SaaS) for appointment scheduling and time management
- Providing temporary use of online non-downloadable software for dental imaging purposes
- Downloadable applications (apps) that enable users to make payments
- CAD software for use in the architecture field
- Spreadsheet software for use by budget advisors
- Accounting software for use in medical practices

Software terms that describe the software's function or purpose in a vague way are not acceptable. The following terms are not acceptable, for example:

- Software for personal use
- Software for general use
- Software for charitable purposes
- Software for household purposes
- Software for use in offices

Software terms that specify only the intended users will be considered on a case by case basis. Examiners will object if the specified users could use a wide variety of software. The following terms would be unacceptable, for example:

- Software for children
- Software for the elderly
- Software for use by businesses

Where a software term specifies use in a particular field, sector or industry, examiners will interpret the term narrowly. "Software for use in the X field/sector/industry" and "software for the X field/sector/industry" will be interpreted to mean "software for use in the provision of X services".

Examples

- "Software for use in the travel industry" will be interpreted as "software for use in the provision of travel services", and is acceptable.
- "Software for the financial services sector" will be interpreted as "software for use in the provision of financial services", and is acceptable.
- "Software for use in the medical field" will be interpreted as "software for use in the provision of medical services", and is acceptable.
- "Software for use in the retail industry" will be interpreted as "software for use in the provision of retail services", and is acceptable.

Terms that specify only the apparatus the software will be used on are not acceptable, because a wide range of software can be used on most apparatus. The following terms are unacceptable, for example:

- Software for use on tablet computers
- Software applications for mobile phones
- Apps for use with televisions

Databases

~~The provision of database services including the term “providing databases” is considered to be too broad and too vague as the exact nature of the services included within this description is unclear. Database services are classified in more than one class according to the nature of the services being provided.~~

~~Moreover, where the provision of database services relates to the provision of information by means of a computer database, then this service is classified according to the subject matter of the information being provided.~~

~~Where a specification includes the term “providing databases”, “providing database services” or similar and the applicant has not specified the exact nature of these services, 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.~~

Database services are classified in more than one class according to the nature of the services being provided. The provision of database services including the term “providing databases” is considered to be too broad and too vague as the exact nature of the services included within this description is unclear, and 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.

If the Applicant is providing a service by means of a computer database, the applicant should apply in the appropriate service class for those services. The term should be reworded using this format:

- Providing [insert X service] by means of a computer database.

If the applicant is providing non-downloadable software by means of a computer database, the term should be reworded as follows, and is correctly classified in class 42:

- Providing non-downloadable software [insert wording that describes the function or purpose of the software] by means of a computer database.

IPONZ classifies the provision of database services as follows:

Specification	Class
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Specification	Class
Computerised database management Compilation of information into computer databases Systemisation of information into computer databases <u>Provision of marketing services by means of a computer database</u>	35
<u>Provision of financial services via computer databases</u>	<u>36</u>
Leasing access time to a computer database	38
Physical storage services for servers and databases	39
<u>Provision of entertainment and educational services by means of a computer database</u>	<u>41</u>
Development of computer databases Consultancy relating to computer database programmes Design of computer databases Designing database programmes for others Hosting computer databases <u>Providing non-downloadable software for business purposes, via a computer database</u>	42

The service of providing information by means of a computer database is classified according to the subject matter of the information being provided. The description of service should resemble ~~these~~ the following formats:

- ~~• providing a database in the field of [indicate specific service-related field]”, or~~
- ~~• providing an online computer database in the field of [indicate specific service-related field].~~
- Providing [X information] by means of a computer database.
- Providing information from a database in the field of [indicate X field].

For example, the following specifications would be acceptable:

Specification	Class
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Specification	Class
Provision of commercial business information by means of a computer database	35
Providing a database on financial information by means of a global computer network <u>Providing information from a database in the field of financial information</u>	36
Providing an interactive computer database in the field of travel via a global computer network <u>Provision of travel information by means of a computer database</u>	39
Providing a database in the field of entertainment <u>Providing information from an online database in the field of entertainment</u>	41

Electronic business services or E-business services

See also [Electronic commerce services or E-commerce services](#)

The term “e-business” covers a wide range of services including electronic commerce services. The term e-business is commonly used to refer to business that is conducted via electronic means, including over the Internet, as well as other computer networks or wireless communications and can also encompass all forms of electronic trading. However, the term “e-business” and similar do not indicate the nature of the service that is being provided and as such could be classified in several classes.

Therefore, the unqualified term “electronic business” or “e-business” is not considered sufficient to describe the relevant services in a specification. Where a specification includes the unqualified term “electronic business” or “e-business”, 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.

Electronic commerce services or E-commerce services

Electronic commerce is a broad term encompassing services that can be classified in several classes.

The unqualified term “electronic commerce” or “e-commerce” is not sufficient to describe the relevant services in a specification. Where a specification includes the unqualified term “electronic commerce” or “e-commerce”, 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.

Electronic commerce can be classified as follows:

Specification	Class
Retail and wholesale of goods over the Internet in relation to [indicate goods, or types of goods, category or field] Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes	35
Electronic commerce payment services	36
Electronic data interchange Transfer of information, data, messages and images via computer networks and the Internet Providing telecommunication services for e-commerce platforms on the Internet and other electronic media	38
Designing, creating, maintaining and hosting online retail and electronic commerce websites for others Providing user authentication services using biometric hardware and software technology for e-commerce transactions	42

Internet and online services

The provision of Internet or online services including the terms “providing Internet services”, “providing online services” or similar, is considered to be too broad and too vague as the exact nature of the services included within these descriptions is unclear. Internet or online services can be classified in more than one class according to the nature of the services.

Moreover, where the provision of the Internet or online service relates to the provision of information or to the provision of the service itself, then this service is classified according to the subject matter of the information being provided.

Where a specification does not specify the exact nature of the Internet or online service, a concern will be raised under section 32(2) of the Act.

IPONZ classifies the provision of Internet and online services as follows:

Specification	Class
Operation of chat rooms Providing chat room services Providing search engines for obtaining data on the Internet Electronic transmission of data and documents via computer terminals Electronic bulletin board services (telecommunications services)	38
Design and development of search engines Development, maintenance and updating of a telecommunication network search engine	42

A. Service providers

Services provided by means of the Internet or online are classified according to the underlying service. Entities providing services over the Internet or online are considered service providers.

B. Content providers

The service of providing information by means of the Internet or online is classified according to the information subject. Entities that provide information over the Internet or online are considered content providers, that is, they provide the substantive content for a website or web page. The description should not be phrased in terms of “providing access”.

The description of the service should resemble these formats:

- providing information in the field of [indicate specific service-related field]; or
- providing a website in the field of [indicate specific service-related field]. providing [indicate specific service relate field] information via a website.

C. Telecommunication providers

The service of providing telecommunications connections to a global computer network is classified in **class 38**. Entities that provide this service provide the telecommunications connections by which one computer can communicate with another.

The **telecommunications provider** does not provide the computer hardware that stores and processes the data, or the information itself. The telecommunications provider provides only the

means by which the data or information is transferred. This service connects the user to the access provider or the website itself. The telecommunications provider charges the access provider or the user for cost of the telephone connections.

D. Access providers

The service of “providing user access to a global computer network (service providers)” is classified in **class 38**. This service is that of the **access provider**, that is, entities that provide the computer service that enables computer users to access databases and home pages of others.

The **access provider** provides the computer/server connection required for computer users to access a content provider. Internet access providers make an initial charge to the user for the computer connection to the Internet, and then charge the user for any time spent connected to the Internet.

The word “access” should only be used to describe the services of access providers. It should not be used to describe the services of a content provider.

Media

The unqualified term “media” is not considered sufficient to describe the relevant goods in a specification but is acceptable when used in conjunction with a description that adequately describes the type of media. For example, recording media and optical data media are acceptable.

Where a specification of goods includes the unqualified term “media”, a concern will be raised under section 32(2) of the Act. The applicant will be asked to qualify this term by specifying the exact goods in respect of which registration is desired.

Networks

The unqualified term “networks” or “network services” is not considered sufficient to describe the relevant services in a specification but is acceptable when used in conjunction with a description that adequately describes the type of network. For example, the term “communications network” is acceptable.

Where a specification of goods includes the unqualified term “networks”, a concern will be raised under section 32(2) of the Act. The applicant will be asked to qualify this term by specifying the exact goods in respect of which registration is desired.

Online services

See *Internet services*.

Providing a website

IPONZ examines “providing a website” terms to be consistent with the NICE classification and the way these terms are treated internationally. Taking this approach benefits New Zealand applicants who file international registrations as it will help avoid irregularities being raised in relation to “providing a website” terms. It also means that trade mark specifications will be clear and easily understood.

IPONZ examines “providing a website” terms as unclear in any service class. Terms beginning with “providing a website featuring” are considered both unclear and unduly broad. Where these terms appear in a specification 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.

If the applicant is providing a service via a website, the applicant should apply in the appropriate service class for those services. The term should be worded using the following format:

- Providing [insert X service] via a website.

If the applicant is providing online non-downloadable software via a website, the term is correctly classified in class 42, and should be worded using the following format:

- Providing on-line non-downloadable software [insert wording that describes the function or purpose of the software] via a website.

If the applicant is providing information via its website, the service should be worded as an information service. Information services are classified according to the subject matter of the information being provided. The applicant should apply in the correct service class, and the term should be worded using the following format:

- Providing [insert X information] via a website.
- Providing information via a website in the field of [indicate specific field].

Examples of acceptable wording:

<u>Specification</u>	<u>Class</u>
<u>Providing information relating to marketing via a website</u> <u>Providing business administration and business management services via a website</u>	<u>35</u>
<u>Provision of financial and insurance services via a website</u>	<u>36</u>

<u>Specification</u>	<u>Class</u>
<u>Providing broadcasting services via a website</u>	<u>38</u>
<u>Provision of educational services and educational information via a website</u>	<u>41</u>
<u>Provision of online non-downloadable software in relation to [specify the function or purpose of the software] via a website</u>	<u>42</u>

Examples of unacceptable wording:

<u>Specification</u>	<u>Class</u>
<u>Providing a website relating to marketing and promotional strategies</u>	<u>35</u>
<u>Providing a website relating to financial information and financial services</u>	<u>36</u>
<u>Providing a website in relation to educational services</u>	<u>41</u>