

## Annexure General

Sections 31 and 32 of the Trade Marks Act 2002

This Annexure outlines the correct classification of some goods and services that are more difficult to classify. This Annexure does not constrain the judgment and discretion of the Commissioner of Trade Marks, and each application will be considered on its own merits.

### 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, 10th edition). 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
- The United States Patent and Trademark Office web site.

### 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.

- Animal welfare services
- Badges
- Beverages
- Bonus schemes
- Cabinet making
- ~~Civil engineering~~
- Child care services
- Cleaning machines, apparatus and installations

- Clothing accessories
- Construction services
- Customer loyalty schemes or programmes
- Dance choreography
- Distribution services
- Doors
- Drinks
- Electricity services, energy services
- Electronic games
- Energy services
- Engineering services
- Event management
- Exhibitions
- Filters and filtering materials
- Franchising services
- Frequent flyer programmes
- ... goods in class X, ... all goods in class X, ... services in class X, ... all services in class X
- Hire purchase finance services
- Loyalty schemes and programmes
- Manufacturing services
- ~~Occupational health and safety~~
- Medicated goods
- Occupational health and safety
- Project management
- Property development services
- Protective clothing and padding
- Protein
- Supplements
- Tableware
- Tourism services, tourist services
- Travel agency services
- Valves
- Wet suits
- Wine and related goods and services

### **Animal welfare services**

Animal welfare services<sup>2</sup> 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
Metal name badges	6
Paper badges	16
Name badges made of plastic	20

### **Beverages**

Beverages are classified according to their content or purpose.

Specification	Class
Dietetic beverages adapted for medical purposes Medicinal alcohol, medicinal tea Medicinal drinks, medicinal infusions	5
Milk beverages (milk predominating), milkshakes	29

Specification	Class
Coffee, tea, cocoa Coffee, tea and cocoa based beverages Chocolate-based beverages, chocolate beverages with milk	30
Beverages for pets or animals	31
Mineral water, aerated water, drinking water, tonic water Soft drinks, isotonic drinks Non-alcoholic drinks, such as de-alcoholised wines and cider Fruit drinks and fruit juices Beer	32
Alcoholic beverages (other than beers) Wines, spirits, liqueurs, ciders	33

### Bonus schemes

See *Customer Loyalty Schemes and Programmes*

### Cabinet making

Cabinet making<sup>5</sup> may be classified as follows:

Specification	Class
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 Nursery schools	41
Providing child care centres Day care services for children	43
Medical clinic day care services for sick children	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

### **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~~ structures. Shipbuilding is also classified in class 37.

~~Manufacturing~~ Custom 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 or for promotional purposes, hence are classified in class 35.

Administration of frequent flyer programmes would be classified in class 35, whereas the travel services which feature a frequent flyer programme such as 'air transportation services featuring a frequent flyer bonus program' 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 choreography<sup>6</sup> services are similar in nature to dance instruction services and classified in class 41.

### 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 services<sup>7</sup>

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	39

Specification	Class
Transmission of electricity	
Transportation and storage of electricity	
Supply of electricity	
Production of electricity	40
Generation of electricity	

### Electronic games

The 11<sup>th</sup> edition<sup>8</sup> of the Nice Classification states:

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

All apparatus that are solely for playing games are classified in class 28.

### Energy services

See *Electricity Services*

### Engineering services

Engineering services are generally classified in class 42. A few specific engineering terms are classified in other classes.

Where the terms 'engineering' or 'engineering services' appear in any service class other than class 42, examiners will object that the term is unclear. The applicant will be asked to describe the services in an alternative way, so they clearly fall within the class applied in.

The following terms are acceptable, for example:

<u>Specification</u>	<u>Class</u>
<u>Business process re-engineering services</u>	<u>35</u>



<u>Specification</u>	<u>Class</u>
<u>Construction and maintenance services relating to civil engineering</u> <u>Demolition of civil engineering structures</u> <u>Marine engineering [construction services]</u> <u>Construction engineering services [construction supervision]</u> <u>Construction engineering services [construction consultancy]</u>	<u>37</u>
<u>Sound engineering services</u>	<u>41</u>
<u>Engineering</u> <u>Engineering services</u> <u>Civil engineering</u>	<u>42</u>

### **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

### 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 Filters for electric coffee machines	11
Coffee filters made of paper	16
Filters for non-electric coffee machines	21
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:

Franchising services are classified in several different classes depending on the precise nature of the services being provided.

Where a specification includes the unqualified terms 'franchising' or 'franchising services', examiners will object that the term is unclear. The applicant will be asked to describe the services in an alternative way, so they clearly fall within the class applied in.

The following terms are acceptable, for example:

Specification	Class
Business consultancy services relating to franchising <u>Business advisory services in relation to the operation of franchises</u> <u>Advertising services relating to franchising</u>	35
<u>Financial advice in the field of franchising</u>	<u>36</u>
<u>Franchising services, namely education and training of franchisees</u>	<u>41</u>

Specification	Class
Legal services relating to franchising <u>Legal consultancy relating to franchising</u>	45 <sup>9</sup>

### Frequent flyer programmes

See *Customer loyalty schemes and programmes*

... goods in class X, ... all goods in class X, ... services in class X, ... all services in class X

Where a specification term refers to goods or services contained in another class using the wording 'goods in class X' or 'services in class X', examiners will object that the term is unclear.

The applicant will be asked to substitute a precise description of the goods or services which 'goods in class X' or 'services in class X' was intended to describe.

For example:

Class	<u>Unacceptable specification term</u>	<u>Acceptable alternative</u>
<u>9</u>	<u>Computer software for goods in class 7</u>	<u>Computer software for operating sewing machines</u>
<u>9</u>	<u>Computer software for services in class 37</u>	<u>Computer software for use in the construction industry</u>
<u>35</u>	<u>Retail services in relation to all goods in class 25</u>	<u>Retail services in relation to clothing, footwear and headwear</u>
<u>37</u>	<u>Installation services in relation to goods in class 11</u>	<u>Installation of heating and air conditioning apparatus</u>
<u>42</u>	<u>Design services in relation to all goods in class 20</u>	<u>Design of furniture</u>

## Hire purchase finance services

Hire-purchase financing services are classified in class 36.

## Loyalty schemes and programmes

See *Customer loyalty schemes and programmes*

## Manufacturing services

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. However, custom manufacturing services are classified in class 40. This means the manufacture of particular goods to customer requirements and/or specifications.

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

## **Occupational health and safety**

Occupational health and safety<sup>10</sup> 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
Ergonomic design services for health and safety purposes	42
Occupational therapy and rehabilitation	44
Consulting in the field of workplace safety	45

## Medicated goods<sup>4410</sup>

Dentifrices, shampoos, soaps, mouthwash, mouth rinse and toothpastes are classified according to whether the goods are for medical use or not:

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
Soap	non-medicated	medicated
Dentifrices	non-medicated	medicated
Shampoo	non-medicated	medicated
Toothpastes	non-medicated	medicated

## Occupational health and safety

Occupational health and safety<sup>11</sup> services are classified according to the services they relate to or field in which they are being offered. For example:

<u>Specification</u>	<u>Class</u>
<u>Education and training services in relation to occupational health and safety</u>	<u>41</u>
<u>Ergonomic design services for health and safety purposes</u>	<u>42</u>

<u>Specification</u>	<u>Class</u>
<u>Occupational therapy and rehabilitation</u>	<u>44</u>
<u>Consulting in the field of workplace safety</u>	<u>45</u>

### **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 regardless of the nature of the business using the management services.

### **Property development services**

Property development services are classified in several different classes depending on the precise nature of the services being provided.

Where a specification includes the unqualified terms ‘property development’ or ‘property development services’, examiners will object that the term is unclear. The applicant will be asked to describe the services in an alternative way, so they clearly fall within the class applied in.

The following terms are acceptable, for example:

<u>Specification</u>	<u>Class</u>
<u>Property development services being property investment services</u> <u>Financing of property development</u> <u>Real estate services in relation to property developments</u> <u>Arranging insurance for property developments</u>	<u>36</u>
<u>Property development services (building and construction services)</u> <u>Property development services, namely maintenance services in relation to property developments</u>	<u>37</u>
<u>Property development services being architectural services</u> <u>Property development services, namely engineering services</u> <u>Property development services, namely design of property developments</u>	<u>42</u>

### **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 and shoes for protection against accidents, irradiation and fire	9
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)	
Knee pads and elbow pads for workers	
Protective clothing for medical, surgical or dental purposes	10
Limb supports for medical purposes	
Clothing, footwear and headgear	25
Clothing, not being protective clothing, incorporating reflective or fluorescent elements or material	
Cricket pads	28
Shin pads for wear while playing sport	
Limb supports for sports purposes	

## Protein

The removal of both 'protein for human consumption' from class 29, and 'protein for animal consumption' from class 31 of the 10<sup>th</sup> edition of the Nice Classification, made it clear that protein was not itself a good that could be correctly classified in either class. Protein products should be classified according to their nature or purpose.

IPONZ examines 'protein' terms to be consistent with the Nice Classification and the way 'protein' terms are treated internationally. Taking this approach benefits New Zealand applicants who file international registrations from New Zealand, as it will help avoid irregularities being raised in relation to 'protein' terms. It also means that trade mark specifications will be clear and easily understood.

### ***Protein goods in class 1***

Class 1 is the correct class for proteins that are raw materials, proteins for use in manufacture, or proteins to be used in the industrial manufacture of food, beverages or dietary/nutritional supplements.

### ***Protein goods in class 5***

Class 5 is the correct class for protein in the form of dietary supplements or nutritional supplements. To fall clearly within the scope of class 5, a protein term must be described as a supplement.

Where an applicant has a class 5 'protein' term that is not described as a supplement, examiners will object that the term is unclear.

### ***Protein goods in classes 29 or 30***

As indicated above, class 1 is the correct class for proteins that are raw materials, proteins for use in manufacture, or proteins to be used in the industrial manufacture of food, beverages or dietary/nutritional supplements. Therefore the Office considers that terms such as the following are unclear in classes 29 or 30:

- Protein(s), protein(s) in this class
- Food protein(s), food protein(s) in this class
- Protein(s) for human consumption, protein(s) for human consumption in this class
- Food protein(s) for human consumption, food protein(s) for human consumption in this class
- Protein preparations, protein preparations for human consumption, protein preparations in this class
- Edible protein(s), edible protein(s) in this class
- Frozen protein(s), frozen edible protein(s)
- Prepared protein(s), prepared edible protein(s)
- Canned protein(s), canned edible protein(s)
- Animal protein(s)
- Milk protein(s)
- Vegetal protein(s)
- Legume protein(s)
- Soy protein(s), soya protein(s), soya bean protein(s)
- Wheat protein(s)

The applicant will be asked to describe the goods in an alternative way so that they clearly fall within the class applied in. Where possible, foodstuffs in classes 29 and 30 should be described avoiding use of the word 'protein'.

For example:

- 'Meat' in class 29 is clear, whereas 'animal protein' in class 29 is unclear.
- 'Tofu' in class 29 is clear, whereas 'soy protein' in class 29 is unclear.
- 'Protein milk' in class 29 is clear, whereas 'milk proteins' in class 29 is unclear.

- ‘Formed textured vegetable protein for use as a meat substitute’ in class 29 is clear, whereas ‘vegetal proteins’ in class 29 is unclear.
- ‘High-protein cereal bars’ in class 30 is clear, whereas ‘cereal proteins’ in class 30 is unclear.

## Supplements

Dietetic and food supplements for medical purposes and non-medical dietetic and food supplements are classified in class 5.

## Tableware

Tableware is classified as follows<sup>12</sup>:

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

Tourism and tourist services are classified in several different classes depending on the precise nature of the services being provided.

Where a specification includes the unqualified terms 'tourism', 'tourism services' or 'tourist services', examiners will object that the term is unclear. The applicant will be asked to describe the services in an alternative way, so they clearly fall within the class applied in.

The following terms are acceptable, for example:

<u>Specification</u>	<u>Class</u>
<u>Tourism advertising</u>	<u>35</u>
<u>Tourism services, namely, organisation and booking of travel</u> <u>Tourism services, namely arranging of transport services for sightseeing tours</u> <u>Providing tourist travel information</u> <u>Booking of travel through tourist offices</u>	<u>39</u>
<u>Tourism services, namely conducting guided tours for cultural or educational purposes</u> <u>Tourism services, being the provision of information relating to recreational activities</u>	<u>41</u>
<u>Tourism services, namely booking of accommodation for travellers</u> <u>Tourism services, namely tourist hostel services</u> <u>Tourism services, being the provision of holiday accommodation information</u>	<u>43</u>
<u>Medical tourism services in the nature of dental care, medical and surgical services</u>	<u>44</u>

### **Travel agency services**

Most services provided by a travel agency are classified in class 39; however tours (for example, wine tours) are classified in class 41, and accommodation reservation services are classified in class 43.

## 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

Specification	Class
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 Water pipe valves made of plastic	20

### 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 scuba diving	9
Wet suits for surfing or waterskiing Wet suits for surface water sports	25

### Wine and related goods and services

Wine and related goods and services are classified as follows:

Specification	Class
Chemicals used in the making of wine	1

Specification	Class
Printed publications relating to wine	16
De-alcoholized wines	32
Low alcohol wine	33
Low alcohol wine containing not more than 1.15% by volume of alcohol	
Wine sales/ cellar door sales	35
Mail order services relating to wine	
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
Viticulture	44

### 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
- All goods or services in this class
- Association services
- Business services, Business to Business, B2B, B2C
- Club services
- Charitable services
- Components
- Consultancy and advisory services
- Emergency assistance services
- Foodstuffs
- Hire services
- Household appliances
- Humanitarian services
- Information and advisory services
- Kits
- Leasing services
- Management services
- ~~Manufacturing services~~
- Outsourcing services
- Parts and fittings
- Peripherals
- Rental services, leasing services, hire services
- Retail, wholesale and distribution services
- Retailing of services
- Substitutes
- Supply of
- Systems
- Well-being services

## 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*

### All goods or services in this class<sup>14</sup>

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.

## 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:

Specification	Class
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 services, Business to Business, B2B, B2C**

The terms “business services”, “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 service being provided as it could potentially encompass several different services.

### **Charitable services**

The unqualified term “charitable services”, and the like are unacceptably vague. These services may fall in a number of classes. For example:

Specification	Class
Charitable fundraising services	36
Providing radio and cellular communication services for charitable purposes	38
Charitable services in the nature of providing transport for the elderly or disabled persons	39
Organisation of sporting events for charitable purposes	41
Providing food to needy persons [charitable services]	43

### **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:

Specification	Class
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:

Specification	Class
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.

Specification	Class
Consultancy services in relation to the client's personnel management and business administration	35
Consultancy in the field of air transportation	39
Consultancy in the field of energy protection	40
Training consultancy	41

Specification	Class
Advisory services relating to regulations concerning food Quality assurance consultancy	42
Consultancy services relating to food	43

### Emergency assistance services

The term “emergency assistance” does not identify the type of services being provided to a person in distress. The applicant will be asked to amend the specification to clarify what type of assistance is being provided. For example:

Specification	Class
Emergency roadside repair of vehicles	37
Emergency automobile towing services	39
Providing emergency shelter services in the nature of temporary housing	43
Emergency medical assistance	44

### Foodstuffs

As foodstuffs can be classified in multiple classes and refer to wide range of goods and services, the Office considers that unqualified entries such as the following are not sufficiently clear for classification purposes:

- Functional foods and beverages; ~~nutraceuticals~~
- Processed food; processed food products; prepared food
- Foodstuffs
- Fillings for food
- Snack foods
- Prepared meals

- Food ingredients
- Frozen or canned food

The applicant will be asked to further describe the type of goods for which protection is sought, such as ‘cereal based snack foods’ in class 30, or ‘canned fruit’ in class 29.

### Hire services

See *Rental services*

### Household appliances

Appliances are classified according to the purpose of the product, and as such can be classified in a variety of classes. The phrase “household appliances” is too vague, and 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.

Specification	Class
Household appliances, namely ovens, refrigerators and microwaves	11

### Humanitarian services

See *charitable 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:

Specification	Class
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:

Specification	Class
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*

### **Management services**

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

For example:

Specification	Class
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



Specification	Class
Copyright management	45 <sup>16</sup>

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**

~~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. However, custom manufacturing services are classified in class 40. This includes the manufacture of particular goods to customer requirements and/or specifications.~~

~~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 services<sup>17</sup>**

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.

## 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:

Specification	Class
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	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	39

Specification	Class
Rental of parking spaces	
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	41
Rental of gaming machines or computer game programmes	
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

Specification	Class
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 these terms, 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.

#### **Retail, wholesale and distribution services**

The unqualified terms “retail, wholesale and distribution services”, “retail services”, “wholesale services”, “retail and wholesale services”, “distribution services” or the like are considered too broad and too vague in class 35 as they do not clearly and precisely indicate the nature of the services being provided. Where the specification includes these terms a concern will be raised under section 32(2) of the Trade Marks Act 2002 and the applicant will be asked to state clearly and precisely the goods to which the services relate.

Examples of acceptable terms:

- Retail, wholesale and distribution of furniture
- Retail, wholesale and distribution of sporting goods
- Retail, wholesale and distribution of food and beverages
- Retail, wholesale and distribution of personal goods
- Retail, wholesale and distribution of household goods
- Retail, wholesale and distribution services provided by variety stores
- Retail, wholesale and distribution services provided by hypermarkets
- Retail, wholesale and distribution services provided by department stores
- Retail, wholesale and distribution services provided by convenience stores
- Retail, wholesale and distribution services provided by supermarkets
- Retail, wholesale and distribution services in relation to [indicate goods or types of goods, category or field]
- Retail, wholesale and distribution services in the field of [indicate goods or types of goods, category such as consumer electronics, clothing, food, houseware, candles, cosmetics]
- Retail, wholesale and distribution services in the field of [indicate field such as educational apparatus and instruments, medical goods, hospitality apparatus and equipment]

- Retail, wholesale and distribution in relation to consumer goods and general consumer merchandise namely [indicate goods or type of goods, category or field]
- Retail and wholesale store services in relation to [indicate goods or types of goods, category or field]
- Online retail and wholesale services in relation to [indicate goods or types of goods, category or field]
- ~~Retail and wholesale services featuring green and eco-friendly products in the nature of [indicate goods]~~
- The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in relation to [indicate goods or types of goods, category or field]
- Mail order retail services in relation to [indicate goods or types of goods, category or field]
- Mail order retail services in the field of [indicate goods or types of goods, category or field]

Examples of unacceptable terms:

- Retail, wholesale and distribution services
- The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods
- Retail, wholesale and distribution of discount goods
- Retail, wholesale and distribution of products
- Retail, wholesale and distribution of a wide variety of consumer goods
- Retail wholesale and distribution services in relation to consumer goods
- Retail, wholesale and distribution services in relation to consumer merchandise
- Retail, wholesale and distribution services in relation to merchandise
- Retail, wholesale and distribution services in relation to processed goods
- Retail, wholesale and distribution service featuring [indication of goods] [the term “featuring” is considered to be a non-limiting term by the [officeOffice](#)]
- Mail order services
- Mail order retail services
- Catalogue shopping services
- Television shopping services
- Electronic shopping services
- Internet shopping services
- Online shopping services
- Online retail, wholesale and distribution services
- E-tailing services

### **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).

### **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.

### **Well-being services**

The unqualified term "well-being services" or the like in a specification is unacceptably vague. Where a specification includes the unqualified term, 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 wellbeing services being provided such as massage services (class 44), counselling in the field of mental health and wellness (class 44), spiritual counselling services (class 45)

#### 4. Limiting or non-limiting terms

Some terms are always non-limiting when they appear in goods and services specifications. For other terms, whether the term is limiting or non-limiting will depend on context.

Please refer to the particular term in the list below for further guidance.

- Ancillary goods / Ancillary services
- Ancillary services
- ...and related goods / ...and related services
- ...and related services
- And the like
- Being
- Comprising
- Consisting of
- Containing
- Derived from
- Enabling
- Especially
- Etc
- Exclusively / Solely
- Featuring
- For example / Such as
- Goods associated with / Services associated with
- Goods in relation to
- Goods in the nature of
- Including
- In particular / Particularly
- In relation to
- In the field of
- Like goods / Like services
- Like services
- Made from / Made of
- Made of
- Mainly
- Mostly
- Namely
- Particularly
- Predominantly
- Principally
- Services associated with
- Services for / Services in / Services of
- Services in

- Services in the nature of / Services in relation to
- Services in relation to
- Services of
- Solely
- Specifically
- Such as

### **Ancillary goods / Ancillary services**

“Ancillary” can mean “supplementary” or “in addition to something else, but not as important”.

Examiners will object if “ancillary goods” or “ancillary services” appear in a specification, as these terms are unclear.

The applicant will be asked to amend the specification by substituting more precise language that clearly indicates the exact nature of the goods or services.

### **Ancillary services**

See *Ancillary goods / Ancillary services*

### **...and related goods / ...and related services**

The terms “... and related goods” and “... and related services” are too vague.

The applicant will be asked to amend the specification by substituting more precise language that clearly indicates the exact nature of the goods or services.

### **...and related services**

See *...and related goods / ...and related services*

### **And the like**

“And the like” is always non-limiting.

Examiners will object if “and the like” appears in a specification, as “and the like” is unclear.

The applicant will be asked to amend the specification by substituting more precise language that clearly indicates the exact nature of the goods or services.



## **Being**

“Being” can be used similarly to “namely”.

When used similarly to “namely”, “being” always limits the term that it qualifies.

“Being” will sometimes clarify the nature of the goods or services in an acceptable way.

*Examples of acceptable terms that include “being”:*

- “Water heaters being parts of machines” in class 7
- “Bean bags being playthings” in class 28
- “Club services being online dating club services” in class 45

However examiners will object if a phrase beginning with “being” qualifies a broad or unclear good or service, and the term that follows “being” is also broad or unclear.

*Examples of unacceptable terms that include “being”:*

- “Fillings being foodstuffs” in class 29 or class 30
- “Kits being for children” in class 16
- “Humanitarian services being charitable services” in any service class

## **Comprising**

“Comprising” means the same as “consisting of”, ie “made up or composed of”.

“Comprised of” is often used, and has the same meaning.

“Comprising” will sometimes clarify the nature of the goods or services in an acceptable way.

*Examples of acceptable terms that include “comprising”:*

- “Dietary supplements comprising vitamins and minerals” in class 5
- “Dental care kits comprising toothbrushes and dental floss” in class 21
- “Information services comprising travel information” in class 39

However examiners will object if a phrase beginning with “comprising” qualifies a broad or unclear good or service, but the specification term remains broad or unclear.

*Examples of unacceptable terms that include “comprising”:*

- “Prepared meals comprising food ingredients in this class” in class 29 or class 30
- “Internet services comprising computer services” in class 42

## Consisting of

“Consisting of” means “made up or composed of”.

“Consisting of” will sometimes clarify the nature of the goods or services in an acceptable way.

*Examples of acceptable terms that include “consisting of”:*

- “Drawing kits consisting of pencils, sketchbooks and erasers” in class 16
- “Logistics services consisting of the storage, transport and delivery of goods” in class 39

However examiners will object if a phrase beginning with “consisting of” qualifies a broad or unclear good or service, but the specification term remains broad or unclear.

*Examples of unacceptable terms that include “consisting of”:*

- “Snack foods consisting of grains and nuts” in class 29 or class 30. “Grains” are class 30 goods and “nuts” are class 29 goods, hence this specification term is unclear in either class.
- “Online services consisting of services in this class” in any service class

In cases where the primary or predominant ingredients of the goods must be specified, additional qualifiers may need to be used, for example:

- Principally consisting of
- Primarily consisting of
- Mainly consisting of
- Consisting of ... (X predominating)

*Examples of acceptable terms that include “consisting of” using further qualifiers:*

- “Prepared meals primarily consisting of meat and ~~vegetables~~ vegetables, also featuring rice or pasta” in class 29
- “Kits mainly consisting of razors and razor blades” in class 8
- “Snack foods consisting of grains and nuts (nuts predominating)” in class 29
- “Snack foods consisting of grains and nuts (grains predominating)” in class 30

## Containing

“Containing” can have a similar meaning to “including”.

“Containing” will sometimes clarify the nature of the goods or services in an acceptable way.

*Examples of acceptable terms that include “containing”:*

- “Cosmetic foundations containing sunscreen” in class 3
- “Watches containing an electronic game function” in class 14

However examiners will object if a phrase beginning with “containing” qualifies a broad or unclear good or service, but the specification term remains broad or unclear.

*Examples of unacceptable terms that include “containing”:*

- “Computer software containing computer code” in class 9. All computer software contains computer code.
- “Snack bars containing cereals, chocolate, dried fruit and nuts” in class 29 or class 30. “Cereals” and “chocolate” are in class 30, and “dried fruit” and “nuts” are in class 29. Only specifying the predominant ingredients will make this term clear in either class.

In cases where the primary or predominant ingredients of the goods need to be specified, additional qualifiers may need to be used, for example:

- Principally containing
- Primarily containing
- Mainly containing
- Containing ... (X predominating)

*Examples of acceptable terms that include “containing” using further qualifiers:*

- “Canned food principally containing poultry and cooked vegetables” in class 29
- “Kits for carpet installation and removal mainly containing carpet knives and carpet staple removers” in class 8
- “Snack bars containing cereals, chocolate, dried fruit and nuts (nuts predominating)” in class 29
- “Snack bars containing cereals, chocolate, dried fruit and nuts (cereals and chocolate predominating)” in class 30

### **Derived from**

“Derived from” indicates that something comes from a particular source. “Derived from” will sometimes clarify the nature of goods in an acceptable way.

Examples of acceptable terms that include “derived from”:

- “Fuels derived from crude oil” in class 4
- “Edible oils derived from fish” in class 29
- “Snack bars derived from cereals” in class 30. Examiners will interpret this term as “snack bars made from cereals”.

However, examiners will object if a phrase beginning with “derived from” qualifies a broad or unclear good, and the specification term remains broad or unclear.

Examples of unacceptable terms that include “derived from”:

- “Kits derived from goods in this class” in class 16. “Derived from goods in this class” is too broad and vague. “Stationery kits” would be acceptable in class 16.
- “Snack bars derived from cereals, dried fruit and nuts” in class 29 or class 30. “Cereals” are in class 30, and “dried fruit” and “nuts” are in class 29. Only specifying the predominant ingredient(s) will make this term clear in either class.

## Enabling

“Enabling” means “that enables”.

“Enabling” will sometimes clarify the nature of the goods or services in an acceptable way.

*Examples of acceptable terms that include “enabling”:*

- “Computer programs enabling users to access to the internet” in class 9
- “Providing online non-downloadable software enabling the creation of websites” in class 42

However examiners will object if a phrase beginning with “enabling” qualifies a broad or unclear good or service, but the specification term remains broad or unclear.

*Examples of unacceptable terms that include “enabling”:*

- “Prepared meals enabling healthy living” in classes 29 or 30
- “Customer services enabling efficiency” in any service class

## Epecially

The meaning of “especially” depends on the context in which it appears.

“Especially” can mean “in an especial manner”. “Especially” can also mean “principally, chiefly”.

Examiners will object if a phrase beginning with “especially” qualifies a broad or unclear good or service, and the specification term is broad or unclear.

*Examples of acceptable terms that include “especially”:*

- “Furniture especially made for laboratories” is acceptable in class 9. In this context, “made especially for laboratories” clarifies how the furniture fits within the scope of the class.
- “Bags especially designed for skis” is acceptable in class 28. In this context, “especially designed for skis” clarifies how the bags fit within the scope of the class.

*Examples of unacceptable terms that include “especially”:*

- “Snack foods, especially snack foods based on nuts” is unacceptable in class 29. This term claims broad “snack foods”. Only “snack foods based on nuts” falls clearly within the class and is sufficiently precise.
- “Information services especially travel information” is unacceptable in class 39. This term claims broad “information services”. Only “travel information” falls clearly within the class and is sufficiently precise.

**Etc**

“Etc” is used at the end of a list to indicate that further items are included.

“Etc” is always non-limiting.

Examiners will object if “etc” appears in a specification, as “etc” is too broad and unclear.

The applicant will be asked to amend the specification by substituting more precise language that clearly indicates the exact nature of the goods or services.

### **Exclusively / Solely**

“Exclusively” means “so as to exclude all except some particular object, subject, etc; solely”.

“Solely” means “only, exclusively”.

“Exclusively” and “solely” will sometimes clarify the nature of the goods or services in an acceptable way.

*Examples of acceptable terms that include “exclusively” or “solely”:*

- “Pharmaceuticals solely for the treatment of cancer” in class 5
- “Printed matter exclusively for advertising travel services” in class 16

However examiners will object if a phrase beginning with “exclusively” or “solely” qualifies a broad or unclear good or service, but the specification term remains broad or unclear.

*Examples of unacceptable terms that include “exclusively” or “solely”:*

- “Computer software exclusively for children” in class 9
- “Foodstuffs solely for expectant mothers” in class 30
- “Information exclusively for managers” in any service class

### **Featuring**

For National Trade Marks filed on or after 1 February 2019 and International Registrations with a designation date on or after 1 February 2019, specification terms that include the word “featuring” may not be acceptable. The Office will treat the term “featuring” as being a non-limiting term having the same meaning as “including”.

A phrase beginning with “featuring” will only be acceptable if it qualifies a good or service that is sufficiently precise and clear all by itself.

*Examples of acceptable terms that include “featuring”:*

- “Compact discs featuring music” in class 9
- “Clothing featuring dresses” in class 25

Examiners will object if a phrase beginning with “featuring” qualifies a broad or unclear good or service.

*Examples of unacceptable terms that include “featuring”:*

- “Computer software featuring games” in class 9
- “Snack foods featuring peanuts” in class 29
- “Retail services featuring clothing” in class 35
- “Providing non-downloadable software featuring games via a website” in class 42

### **For example / Such as**

“For example” means “by way of illustration; as an example or instance”. “Such as” has the same meaning as “for example”.

“For example” and “such as” are always non-limiting.

Examiners will object if a phrase beginning with “for example” or “such as” qualifies a broad or unclear good or service.

*Examples of unacceptable terms that include “for example” or “such as”:*

- “Computer software, for example software for business management purposes” in class 9. This term claims broad “computer software”. In this term, only “software for business management purposes” is sufficiently precise.
- “Snack foods, such as Chinese steamed dumplings” in class 30. This term claims broad “snack foods”. In this term, only “Chinese steamed dumplings” falls clearly within the class and is sufficiently precise.
- “Customer services, for example administration of customer loyalty programmes” in class 35. This term claims broad “customer services”. In this term, only “administration of customer loyalty programmes” falls clearly within the class and is sufficiently precise.

Punctuation may affect the meaning of a specification term that includes “for example” or “such as”, and should always be taken into account.

*Examples showing the impact of punctuation:*

“Retail services, such as online retail, of furniture”:

Acceptable.

All the services are limited to furniture.

“Retail services, such as online retail of furniture”:

Unacceptable.

This term claims broad retail services. Only *online* retail is limited to furniture.

### **Goods associated with / Services associated with**

The terms “goods associated with” and “services associated with” are too vague.

The applicant will be asked to amend the specification by substituting more precise language that clearly indicates the exact nature of the goods or services.

### **Goods in relation to**

The phrase “goods in relation to...”, “products in relation to...” and the like are too vague. The applicant will be asked to amend the specification by substituting more precise language that clearly indicates the exact nature of the goods.

*Examples of unacceptable terms that include “goods in relation to”:*

- “Goods in relation to printed matter and stationery” in class 16
- “Retail of goods in relation to printed matter and stationery” in class 35. “Goods in relation to printed matter and stationery” is insufficiently precise, hence the scope of these retail services is unclear.

### **Goods in the nature of**

The term “goods in the nature of” and the like may be acceptable in a specification. Examiners will interpret the term that follows as a description of the specific good.

*Examples of acceptable terms that include “goods in the nature of”:*

- “Goods in the nature of clothing” in class 25. This will be interpreted as “clothing”.
- “Foodstuffs in the nature of soup” in class 29. This will be interpreted as “soup”.

However examiners will object if the term that follows “goods in the nature of” is too broad or unclear.

*Examples of unacceptable terms that include “goods in the nature of”:*

- “Goods in the nature of household appliances” in classes 7, 9 or 11. This will be interpreted as “household appliances”, however “household appliances” is too broad and unclear.
- “Goods in the nature of systems” in any goods class. This will be interpreted as “systems”, however “systems” is too broad and unclear.
- “Goods in the nature of foodstuffs” in classes 29 or 30. This will be interpreted as “foodstuffs”, however “foodstuffs” is too broad and unclear.

## Including

“Including” means “containing as part of a whole being considered”.

The following terms are treated the same as “including”:

- Including but not limited to
- Including (without limitation)
- Including in relation to

“Including” is always non-limiting.

Examiners will object if a phrase beginning with “including” qualifies a broad or unclear good or service.

*Examples of unacceptable terms that include “including”:*

- “Software including anti-virus software” in class 9
- “Charitable services including fundraising for needy children” in class 36
- “Providing information via a website including financial and insurance information” in class 36

Punctuation may affect the meaning of a specification term that includes the word “including”, and should always be taken into account.

*Examples showing the impact of punctuation:*

“Retail services, including online retail services, of clothing”:	Acceptable.  All the services are limited to clothing.
“Retail services, including online retail services of clothing”:	Unacceptable.



This term claims broad retail services. Only *online* retail is limited to clothing.

### **In particular / Particularly**

“In particular” and “particularly” are used to single out a subject to which a statement is especially applicable.

“In particular” and “particularly” are treated as non-limiting terms.

Examiners will object if a phrase beginning with “in particular” or “particularly” qualifies a broad or unclear good or service.

*Examples of unacceptable terms that include “in particular” or “particularly”:*

- “Software, in particular virtual reality entertainment software” in class 9. This term claims broad “software”. In this term, only “virtual reality entertainment software” is sufficiently precise.
- “Snack bars, particularly cereal-based snack bars” in class 30. This term claims broad “snack bars”. In this term, only “cereal-based snack bars” falls clearly within the class and is sufficiently precise.
- “Retail services, in particular in relation to motor vehicles and their parts” in class 35. This term claims broad “retail services”. In this term, only “retail in relation to motor vehicles and their parts” is sufficiently precise.
- “Providing information via a website particularly health information” in class 44. This term claims broad “providing information via a website”. In this term, only the provision of “health information” falls clearly within the class and is sufficiently precise.

### **In relation to**

“In relation to” means “with regard to, in respect of”.

“In relation to” limits the term which it qualifies.

*Examples of acceptable terms that include “in relation to”:*

- “Software applications in relation to image processing” in class 9
- “Mail order retail services in relation to cosmetics and toiletries” in class 35
- “Rental services in relation to bulldozers” in class 37

However examiners will object if a phrase beginning with “in relation to” qualifies a broad or unclear good or service, and the term that follows “in relation to” is likewise broad or unclear.

*Examples of unacceptable terms that include “in relation to”:*

- “Rental services in relation to machines” in any service class. “Machines” is too vague. “Rental services in relation to machines” could fall within many service classes.
- “Charitable services in relation to helping others” in any service class
- “Club services in relation to children” in any service class

See also Goods in relation to, Services in the nature of

### **In the field of**

“Field” can mean “an area or sphere of action, enquiry, or interest; a theme, a subject”.

“In the field of” will sometimes clarify the nature of the goods or services in an acceptable way.

*Examples of acceptable terms that include “in the field of”:*

- “Magazines in the field of dance” in class 16
- “Information and booking services in the field of tourist travel” in class 39
- “Providing online non-downloadable software in the field of healthcare” in class 42
- “Consultancy in the field of viticulture” in class 44

However examiners will object if a phrase beginning with “in the field of” qualifies a broad or unclear good or service, and the specification term remains broad or unclear.

*Examples of unacceptable terms that include “in the field of”:*

- “Kits in the field of construction” in class 6 or class 19. This description is insufficiently precise. Neither the precise purpose of the kits nor the main goods within the kits have been specified.
- “Information in the field of general human interest” in any service class

In some situations the good or service preceding “in the field of” must be replaced by a more specific term.

*Examples where the preceding term must be described more precisely:*

- “Computer services in the field of entertainment” in any service class. The exact nature of the services must be specified, eg “rental of computer software in the field of entertainment” in class 42.
- “Database services in the field of hospitality” in any service class. The exact nature of the services must be specified, eg “design of computer databases in the field of hospitality” in class 42.

- “E-commerce services in the field of restaurants” in any service class. The exact nature of the services must be specified, eg “e-commerce services, namely electronic payment services in the field of restaurants” in class 36.

### **Like goods / Like services**

“Like” can mean “similar to”. “Like goods” means “similar goods”, and “like services” means “similar services”.

Examiners will object if “like goods” or “like services” appears in a specification, as these terms are unclear.

The applicant will be asked to amend the specification by substituting more precise language that clearly indicates the exact nature of the goods or services.

### **Like services**

See *Like goods / Like services*

### **Made from / Made of**

“Made from” and “made of” will sometimes clarify the nature of goods in an acceptable way.

*Examples of acceptable terms that include “made from” or “made of”:*

- “Building materials made of metal” in class 6
- “Dental implants made from artificial materials” in class 10
- “Beverages made from yoghurt” in class 29

However examiners will object if a phrase beginning with “made from” or “made of” qualifies a broad or unclear good, and the specification term remains broad or unclear.

*Examples of unacceptable terms that include “made from” or “made of”:*

- “Building materials made of metallic and non-metallic materials” in class 6 or class 19. Metallic building materials are in class 6 and non-metallic building materials are in class 19, hence this specification term is unclear in either class.
- “Snack foods made from dried fruits and cereals” in class 29 or class 30. “Dried fruits” are in class 29 and “cereals” are in class 30, hence this specification term is unclear in either class.

In cases where the primary or predominant ingredients of the goods must be specified, additional qualifiers may need to be used, for example:

- Principally made from/of
- Primarily made from/of

- Mainly made from/of
- Made from/of ... (X predominating)

*Examples of acceptable terms that include “made from/of” using further qualifiers:*

- “Entrees principally made of meat, ~~poultry and seafood~~ containing rice or pasta” in class 29
- “Prepared meals primarily made from soba noodles and savoury sauces, containing vegetables and/or tofu” in class 30
- “Snack foods made of dried fruits and cereals (dried fruits predominating)” in class 29
- “Snack foods made from dried fruits and cereals (cereals predominating)” in class 30

## **Made of**

See *Made from / Made of*

## **Mainly**

“Mainly” means “for the most part”.

“Mainly” will sometimes clarify the nature of the goods or services in an acceptable way.

*Examples of acceptable terms that include “mainly”:*

- “Desserts made mainly from milk products” is acceptable in class 29. In this context, “made mainly from milk products” clarifies how the desserts fit within the scope of the class.

However examiners will object if a phrase beginning with “mainly” qualifies a broad or unclear good or service, and the specification term remains broad or unclear.

*Examples of unacceptable terms that include “mainly”:*

- “Retail mainly of food and beverages” is unacceptable in class 35. This term claims broad “retail”. The retail services could be in relation to other goods, not only food and beverages.
- “Rental services, mainly of televisions” is unacceptable in class 41. This term claims broad “rental services”. The rental services could be in relation to other goods, not only TVs.

## **Mostly**

“Mostly” means “for the greatest part”, and has a similar meaning to “mainly”.

“Mostly” will sometimes clarify the nature of the goods or services in an acceptable way.

*Examples of acceptable terms that include “mostly”:*

- “Frozen meals made mostly from poultry” is acceptable in class 29. In this context, “made mostly from poultry” clarifies how the frozen meals fit within the scope of the class.

However examiners will object if a phrase beginning with “mostly” qualifies a broad or unclear good or service, and the specification term remains broad or unclear.

*Examples of unacceptable terms that include “mostly”:*

- “Parts and accessories, mostly for computers” is unacceptable in class 9. This term claims broad “parts and accessories”. The parts and accessories could be for other goods, not only computers.

## **Namely**

“Namely” means “that is to say, to be specific”.

“Namely” always limits the term that it qualifies.

*Examples of acceptable terms that include “namely”:*

- “Household appliances, namely televisions, stereos and DVD players” in class 9
- “Accessories in this class, namely bags, purses and wallets” in class 18
- “Wellbeing services, namely dental services” in class 44

However examiners will object if a phrase beginning with “namely” qualifies a broad or unclear good or service, and the term that follows “namely” is likewise broad or unclear.

*Examples of unacceptable terms that include “namely”:*

- “Foodstuffs in this class, namely frozen food” in class 29 or class 30
- “Software, namely software for mobile phones” in class 9
- “Information services, namely information for members of the public” in any service class

## **Particularly**

See *In particular / Particularly*

## **Predominantly**

“Predominantly” means “mainly; for the most part”.

“Predominantly” will sometimes clarify the nature of the goods or services in an acceptable way.

*Examples of acceptable terms that include “predominantly”:*

- “Prepared meals predominantly made of vegetables” is acceptable in class 29. In this context, “predominantly made of vegetables” clarifies how the meals fit within the scope of the class.
- “Pipes being predominantly of metal” is acceptable in class 6. In this context, “being predominantly of metal” clarifies how the pipes fit within the scope of the class.

However examiners will object if a phrase beginning with “predominantly” qualifies a broad or unclear good or service, and the specification term remains broad or unclear.

*Examples of unacceptable terms that include “predominantly”:*

- “Retail predominantly of bicycles” is unacceptable in class 35. This term claims broad “retail”. The retail services could be in relation to other goods, not only bicycles.
- “Providing information predominantly in relation to preschool education” is unacceptable in class 41. This term claims broad “providing information”. The information could be in relation to other subject areas, not only preschool education.

## **Principally**

“Principally” means “for the most part; chiefly”.

“Principally” will sometimes clarify the nature of the goods or services in an acceptable way.

*Examples of acceptable terms that include “principally”:*

- “Kits consisting principally of cosmetic foundations, mascaras and lipsticks” is acceptable in class 3. In this context, “consisting principally of cosmetic foundations, mascaras and lipsticks” clarifies how the kits fit within the scope of the class.
- “Beverages consisting principally of milk” is acceptable in class 29. In this context, “consisting principally of milk” clarifies how the beverages fit within the scope of the class.

However examiners will object if a phrase incorporating “principally” qualifies a broad or unclear good or service, and the specification term remains broad or unclear.

*Examples of unacceptable terms that include “principally”:*

- “Mail order retail services principally of clothing” is unacceptable in class 35. This term claims broad “mail order retail services”. These services could be in relation to other goods, not only clothing.
- “Consultancy services principally in relation to software development” is unacceptable in class 42. This term claims broad “consultancy services”. The consultancy could be in relation to other subject areas, not only software development.

## **Services associated with**

See *Goods associated with / Services associated with*

### **Services for / Services in / Services of**

The terms “services for”, “services in”, “services of” and the like may be acceptable in a specification. Examiners will interpret the term that follows as a description of the specific service.

*Examples of acceptable terms that include “services for/in/of”:*

- “Services for transport”, “services in transport” or “services of transport” in class 39. These will be interpreted as “transport services”.
- “Services for dentistry”, “services in dentistry” or “services of dentistry” in class 44. These will be interpreted as “dentistry services”.

However examiners will object if the term that follows “services for/in/of” is too broad or unclear.

*Examples of unacceptable terms that include “services for/in/of”:*

- “Services for clubs” in any service class. This will be interpreted as “club services”, however “club services” is unclear.
- “Services in emergency assistance” in any service class. This will be interpreted as “emergency assistance services”, however “emergency assistance services” is unclear.
- “Services of consultancy” in any service class. This will be interpreted as “consultancy services”, however “consultancy services” is too broad and unclear.

### **Services in**

See *Services for / Services in / Services of*

### **Services in the nature of / Services in relation to**

The phrases “services in the nature of”, “services in relation to” and the like may be acceptable in a specification. Examiners will interpret what follows as the specific service.

*Examples of acceptable terms that include “services in the nature of” or “services in relation to”:*

- “Services in the nature of transport” in class 39. This will be interpreted as “transport services”.
- “Services in relation to telecommunications” in class 38. This will be interpreted as “telecommunication services”.
- “Services in the nature of restaurants” in class 43. This will be interpreted as “restaurant services”.

However examiners will object if the term that follows “services in the nature of” or “services in relation to” is too broad or unclear.

*Examples of unacceptable terms that include “services in the nature of” or “services in relation to”:*

- “Services in the nature of clubs” in any service class. While this will be interpreted as “club services”, the exact nature of the club services must be specified.
- “Services in relation to information” in any service class. While this will be interpreted as “information services”, the subject matter of the information must be specified.
- “Services in the nature of consultancy” in any service class. While this will be interpreted as “consultancy services”, the subject area(s) of the consultancy must be specified.
- “Services in relation to the internet” in any service class. While this will be interpreted as “internet services”, the exact nature of the services must be specified.

### **Services in relation to**

See *Services in the nature of / Services in relation to*

### **Services of**

See *Services for / Services in / Services of*

### **Solely**

See *Exclusively / Solely*

### **Specifically**

“Specifically” is “used to indicate the exact identity, purpose, or use of something”.

“Specifically” always limits the term that it qualifies.

*Examples of acceptable terms that include “specifically”:*

- “Glassware specifically adapted for laboratory use” in class 9
- “Bags specifically adapted for sleeping bags” in class 24

However examiners will object if a phrase beginning with “specifically” qualifies a broad or unclear good or service, and the term that follows “specifically” is likewise broad or unclear.

*Examples of unacceptable terms that include “specifically”:*

- “Fittings specifically for goods in this class” in class 9. This term claims “fittings” for every good in class 9, so is too broad.



- “Consultancy services, specifically internet consultancy services” in any service class
- “Providing a database, specifically providing a database via a website” in any service class

### Such as

See *For example / Such as*

### Footnotes

2 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 6 December 2017

~~9 Reference updated 5 January 2007~~

~~10 Practice Guideline Amendment 2004/05, Information For Clients, Issue 33: 30 September 2004. Practice Guideline Amendment 2007/02, IPONZ Newsletter, March 2007.~~

~~11 Practice Guideline Amendment 2007/02, IPONZ Newsletter, March 2007. Practice Guideline Amendment 2004/05, Information For Clients, Issue 33: 30 September 2004.~~

12 Table updated 5 January 2007

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

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