



Guideline: Considerations regarding Identifications of Goods and Services in an International Trademark Filing Program

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INTA's International Classification Subcommittee of the Harmonization of Trademark Law and Practice Committee

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I. Scenario and Overview.

You are the General Counsel (or outside business counsel) of Whiz-Bang Enterprises, Inc., a business with a limited portfolio of trademark¹¹ registrations. The Whiz-Bang trademarks are presently registered only in the country in which Whiz-Bang resides. Up to this point, this approach to trademarks has been perfectly adequate, as the business of the company has been focused in its country of residence.

In the past year, the business of the company has grown and, in recognition of the world's great need for Whiz-Bang's products and services, a new "Vice President of International Business Development" has been hired, with a mandate to rapidly launch the company's global business expansion. On her first day, the new VP is shocked to learn that Whiz-Bang has no international trademark registration coverage! You insightfully feel a headache coming on, as you realize that you will be forced to delve into the complex and sometimes arcane world of international trademark filing. There are many aspects to consider when contemplating an international trademark filing program. Where should you file? Should you make use of centralized registries such as European Union Intellectual Property Office (EUIPO) or the African Intellectual Property Office (OAPI), or international treaties such as the Madrid Protocol? Which of your company's marks should you register? Should you register both design marks and word marks? What about marks that are in color -- can you claim colors in your international filings? What goods and services should you identify in your new international filings? How should the goods and services be classified? What is the Nice Classification system? Is the Nice Classification system applicable? If Nice is applicable, should you attempt to cover the Nice class headings in your filings, or just the specific Whiz-Bang goods and services? Don't some countries also use a sub-classification system in conjunction with Nice? Are there special goods/services identification strategies and best practices in certain industries? Are there different goods/services identification strategies depending upon whether Whiz-Bang's global expansion occurs organically versus through franchising with third parties?

This Guideline takes narrow aim at the latter set of questions, namely, the development of a plan for the identifications of goods and services for your international trademark filing

¹ Trademark practitioners are aware that the term "trademark" technically refers to a mark that indicates the source of goods, and that the term "service mark" refers to a mark that indicates the source of services. In this Guideline, we will be considering matters relevant to both trademarks and service marks. The term "trademark," however, is sometimes used as a general term for both trademarks and service marks, as is common in colloquial use.

program. If trademark law and practice were harmonized the world over, this would not be a concern, because the manner of identifying goods and services in each foreign application would be consistent across all international filing systems. In that case, one would simply determine the best identification strategy in one's domestic jurisdiction and replicate the same identification in the subsequent international application filings.

But, alas, trademark law and practice are not (yet) entirely harmonized with respect to identifications of goods and services. Rather, a patchwork quilt of regulations and practices exists around the world, with various issues and inconsistencies regarding identifications in different jurisdictions. This Guideline seeks to provide an overview of the non-harmonized identification landscape, insight into various traps for the unwary, and a glimpse at some of the efforts of the international trademark community as they push toward a hoped-for harmonized future for trademark identifications of goods and services.

The primary objective of this Guideline is to anticipate identification issues in international trademark registration. This should allow practitioners to address potential problems in advance so as to conduct as efficient an international trademark filing program as is possible given the current non-harmonized state of practice in this area. A secondary objective is to illustrate a bit of the absurdity of non-harmonization in this area, and to prompt the global trademark community toward greater harmonization efforts for the betterment of the global economy in improved efficiency, streamlining of process and, ultimately, reduced cost in international trademark registration practice.

II. The Nice Classification System.

Any consideration of identifications of goods and services in trademark applications must begin with a description of the Nice Classification. The Nice Classification, established by the Nice Agreement in 1957, is an international classification of goods and services. It is updated every five years, and is currently in its 11th edition. Under Nice, all goods and services are divided into 45 separate designated classes. Classes 1-34 are the goods classes and classes 35-45 are the services classes. As of 2018, there were 85 contracting parties to the Nice Agreement. A list of Nice Agreement countries is set forth in Appendix 1. In addition, 65 non-member countries, the International Bureau of WIPO, the African Intellectual Property Organization (OAPI), the African Regional Intellectual Property Organization (ARIPO), the

Benelux Organization for Intellectual Property (BOIP) and the European Union Intellectual Property Office (Trade Marks and Designs) (EUIPO), utilize the Nice Classification. A list of these countries and organizations is set forth in Appendix 2.

Because the Nice Classification system is recognized in numerous jurisdictions, applying for trademarks internationally is a far more streamlined process than it otherwise would be. Use of the Nice Classification by the various offices has the advantage that trademark applications are coordinated with reference to a single classification system. Filing is thereby simplified, as the goods and services covered by a given mark will be classified using the same system in all jurisdictions that have adopted Nice. That the Nice Classification exists in several languages also saves applicants time and expense when filing internationally, although this can sometimes lead to inconsistencies, depending upon translations.

In the case of Whiz-Bang, decisions have already been made on the classification of the Whiz-Bang products and services in connection with the existing local trademark registrations (assuming, of course, that the local country is a Nice country). With some exceptions, it is likely that these classifications will continue to apply to the new international filings in other Nice countries.

You also learn, though, that new Whiz-Bang products and services will be introduced in conjunction with the international filing program, so you will need to consult the Nice Classification. The U.S. Patent and Trademark Office (USPTO) provides the following “short titles” for the classes (although these short titles are for convenience only and are not formally a part of the Nice Classification):

Class Number	Short Title
GOODS	
1	Chemicals
2	Paints
3	Cosmetics and cleaning preparations
4	Lubricants and fuels
5	Pharmaceuticals
6	Metal goods
7	Machinery
8	Hand tools
9	Electrical and scientific apparatus

10	Medical apparatus
11	Environmental control apparatus
12	Vehicles
13	Firearms
14	Jewelry
15	Musical instruments
16	Paper goods and printed matter
17	Rubber goods
18	Leather goods
19	Non-metallic building materials
20	Furniture and articles not otherwise classified
21	Housewares and glass
22	Cordage and fibers
23	Yarns and threads
24	Fabrics
25	Clothing
26	Fancy goods
27	Floor coverings
28	Toys and sporting goods
29	Meats and processed foods
30	Staple foods
31	Natural agricultural products

32	Light beverages
33	Wines and spirits
34	Smokers' articles
SERVICES	
35	Advertising and business
36	Insurance and financial
37	Building construction and repair
38	Telecommunications
39	Transportation and storage
40	Treatment of materials
41	Education and entertainment
42	Computer and scientific
43	Hotels and restaurants
44	Medical, beauty and agricultural
45	Personal and legal

Once the general classes are identified, the next step is to delve into the “Class Headings” and the “Explanatory Notes” for each class. These are available from WIPO at: <http://web2.wipo.int/classifications/nice/nicepub/en/fr/edition-20160101/classheadings/>. The Nice Classification also provides certain general classification principles to assist practitioners in properly classifying goods and services. The Nice general classification principles are available at: http://web2.wipo.int/classifications/nice/nicepub/en/fr/edition-20160101/general_remarks/.

The class headings of the Nice Classification provide general information about the types of goods and services that belong to each class. It is important to note, though, that the Nice Classification short titles, class headings and explanatory notes are not intended to be exhaustive or exclusive, but rather to serve as a reference to enable applicants to identify the correct classes for their goods and services.

For convenience, Appendix 3 sets forth a listing of the common Nice Classifications applicable to particular industries.

III. How Broad Should my ID be? Isn't It Easier to Apply for an Entire Class if I Can?

The identification of goods and services in a trademark application is important because it defines the scope of trademark protection of the resulting trademark registration. If a trademark registration identifies “perfume,” then that trademark registration typically would be beneficial in a trademark enforcement action against a confusingly similar trademark that is

being used in connection with perfume or some other product that is related to perfume (e.g. cosmetics, body washes, lotions, etc.). A registration identifying “perfume” likely would not be as useful in an enforcement action against the use of a similar trademark in connection with unrelated goods or services (e.g., industrial machines, lawn-care services, telecommunications software, etc.), unless the mark has a reputation and the jurisdiction of enforcement recognizes reputation-based theories of confusion.

Because of the importance of the identification, there is always a tension between breadth and specificity in the preparation of an identification of goods and services. A broad identification covers a large array of goods and services, in order to attempt to gain the greatest scope of protection for the resulting trademark registration. A more specific identification of goods and services can reflect the actual use by the applicant. Unduly broad identifications can also attract unwanted and unnecessary objections from third parties, making registration more difficult and expensive.

Opinions differ on this question, and treatments differ under the trademark laws of the different jurisdictions around the world. In the United States, for example, trademark registrations must be supported by actual use of the mark on the goods and services identified in the registration, and this use must be supported and declared six years after registration and at every ten-year renewal. The principle underlying this approach is the view that a trademark registration is merely a formal recognition of, and provision of national rights with respect to, a trademark right that already exists at common law through usage. While an initial registration may be obtained that includes goods/services which are not currently in use in the United States, for example through reliance on a foreign registration, later use requirements will still need to be met to keep the registration in force. Accordingly, the goods and services covered by the registration cannot exceed the scope of goods and services on which the trademark is actually used by the applicant.

This is not the case in most other jurisdictions around the world. In most other jurisdictions, trademark registrations may be obtained without a demonstration of use, although use may still be relevant, for example if a non-use cancellation action is filed against the registration or if the owner wants to enforce a registration which is outside of its non-use grace period. For this reason, in these jurisdictions there is no procedural limitation on the

identifications of goods and services set forth in the application. There are, however, some practical limitations. In most jurisdictions, the application filing cost increases with the number of classes of goods and services in the application. Further, an applicant typically has little interest in covering goods and services that are far removed from the actual area of the applicant's business and adjacent and related areas, especially if it increases the chances of third party objections. In some jurisdictions there may also be issues of bad faith to consider if the applicant files for an unduly broad range of goods/services which the applicant has no intention to provide. Finally, in most countries, a trademark registration is subject to cancellation within a number of years after the registration -- typically three or five years -- with respect to any goods and services for which the mark has not been used. As such, a trademark registration whose goods and services identification dramatically exceeds the scope of actual use of the trademark soon becomes ineffective as an enforcement tool beyond those goods and services for which the trademark is actually in use.

In some countries, it is possible to cover all goods in an entire Nice Class. While this approach obviously would not work in the United States, the Philippines or other countries that follow a usage-based approach, it can be a useful strategy in certain jurisdictions, such as Argentina, Honduras, Ecuador, and Afghanistan. Notably, the European Union in 2013 discontinued the practice of considering class headings to cover all goods/services in a class, finding instead that a class heading listing would cover only the actual goods and services listed in the class heading. Because the goods and services listed in the class heading are examples only, this finding was a significant blow to applicants who had pursued a class heading filing strategy in the past in their European Union Trademark filings in the hope of covering all goods/services. There was, however, an opportunity for EU trademark owners to add additional items to certain of their class heading registrations, within a specified six-month period.

Because the class heading approach is useful in some jurisdictions, irrelevant in other jurisdictions, and invalid in a final set of jurisdictions, Whiz-Bang must look at each jurisdiction individually to determine if a class heading strategy is worthwhile to pursue. The costs of such an individualized, jurisdiction-by-jurisdiction identification analysis must be carefully weighed against incremental legal benefits to be obtained from obtaining class heading coverage in certain jurisdictions, as compared to the efficiency of pursuing a single, narrower identification that only covers Whiz-Bang's actual and anticipated goods and services but will pass muster in

most or all of the jurisdictions contemplated by the international filing program. It may often be worth including both the class heading and a more specific list of goods/services to keep options available. Such cost-benefit analyses can be challenging, but the size, scope, budget and make-up of constituent jurisdictions in the filing program will typically dictate the best and most cost-effective overall approach.

IV. Which Countries Do Not Use Nice and What Do I do There?

As noted above, the majority of jurisdictions in the world have adopted and use the Nice Classification for trademark registration. Canada is a notable example of a jurisdiction that previously had not adopted the Nice Classification system, but based on newly-enacted legislation, Canada will become a member of the Nice Agreement and implement the Nice Classification system starting in 2019. Bahamas, Venezuela, and Fiji are other examples of countries that do not currently follow Nice Classification. Still other countries, for example, Chile, Saudi Arabia, Thailand and UAE have not officially adopted the Nice Classification System, although it is used as a guideline.

In jurisdictions that are not members of the Nice Agreement and have not otherwise adopted the Nice Classification, it is incumbent upon applicants to select individual goods and services, or categories of goods and services, pursuant to the protocols and procedures of each such individual jurisdiction. While an identification of goods and services under Nice is often easily usable in a non-Nice jurisdiction, this is not always the case as terminology and definitions do not always correspond. Moreover, certain jurisdictions have established their own separate goods and services classification systems which must be consulted in the development of an international filing program that includes such jurisdictions. Seeking the advice of local attorneys before filing is always recommended in such cases.

V. What about Countries that Use a Sub-Classification System?

Adding a further layer of complexity to the Whiz-Bang project, there are many jurisdictions within the Nice community that have adopted a sub-classification system. These are systems in which each individual class of goods and services in Nice has been further subdivided into smaller sub-classes of goods and services within the class.

One important example of a sub-classification system is in China, where the Nice Classification system is supplemented with local sub-classification. The Chinese sub-classification system is set forth in attached [Appendix of Chinese Sub-Classifications](#).

Within the Chinese system, the sub-classes have great importance. Generally speaking, Chinese law, unlike the law of many other jurisdictions that utilize the Nice Classification, considers goods and services residing in different subclasses to be legally unrelated. Thus, when a trademark examiner is considering the registration of one trademark that is identical to another trademark, the later-filed trademark will generally be allowed if the goods and services fall into a different subclass, even if the goods fall within the same Nice class and would normally seem very similar and legally related. This is also true in opposition practice; a trademark opposition will often fail in China, even with respect to identical trademarks on very similar and seemingly legally related goods, if the goods reside in different subclasses within a Nice class. The same issue can also have an impact in infringement proceedings, although the Courts tend to take a less restrictive view than the Chinese office.

An example of this can be seen by reference to Nice International Class 25. Nice International Class 25 covers items of clothing, footwear and headgear, such as shirts, pants, shoes, hats, gloves, socks, etc. In most jurisdictions in the world, a trademark application for the mark “ABC” for “shoes” in class 25 will not be allowed to register if there is already an existing registration for “ABC” for “socks” in class 25, on the theory that shoes and socks are related goods, both falling within class 25, and that a likelihood of confusion as to source in the minds of the public would result if one party registered and used the “ABC” mark for shoes and another party were permitted to register and use the same “ABC” mark for socks.

Not so, however, in China. Under the Chinese sub-classification system, shoes and socks, while both falling within class 25, fall within different subclasses within class 25 (2507 and 2509, respectively). As such, these two registrations of the “ABC” mark, owned by different parties, will typically be allowed to co-exist in China. Moreover, if the owner of the “ABC” registration for shoes sought to oppose the “ABC” registration for socks, on the basis of likelihood of confusion, such opposition would typically be unsuccessful absent evidence of bad faith or some other aggravating circumstances.

Korea, Yemen, Iraq and Japan also determine similarity by sub-classification. As one can imagine, such sub-classification systems can prove problematic when attempting to develop meaningful identifications of goods and services for an international filing program, even with respect to countries such as China, Turkey, Japan and Iraq which all technically follow the Nice Classification system. Like in jurisdictions that allow for class heading filings, and jurisdictions that do not use Nice, countries that utilize sub-classification systems must be analyzed on an individual, jurisdiction-by-jurisdiction basis in the development of an international trademark filing program. Again, seeking local advice early in the filing process is important to ensure that the registration covers all of the appropriate sub-classes, especially if counterfeits are a concern in that country and it is likely that a registration will need to be enforced.

VI. What about Countries that Do Not Recognize Service Classes?

As your dismay over the Whiz-Bang filing program continues to grow, you learn that some jurisdictions do not recognize service marks. As noted above, the Nice Classification system includes classes of both goods and services. In addition, international agreements such as TRIPS, the Trademark Law Treaty (TLT) and the Singapore Treaty on the Law of Trade Marks require the recognition of service marks. Consequently, the number of jurisdictions that do not recognize services is thankfully relatively small and decreasing but there are still some. Of these, many are Commonwealth Nations or British Oversea Territories. For example, Fiji, Gibraltar, Guyana and Zambia do not currently register service marks on a national basis.

There are, however, ways to achieve service mark protection in some of these countries. Cayman Islands, Gibraltar, and Sierra Leone, allow extension of a United Kingdom or EUTM registration covering services. Guyana allows extension of a United Kingdom registration covering services. Additionally, Equatorial Guinea does not have its own trademark registration system but is a member of the African Intellectual Property Organization (OAPI), and an OAPI trademark registration (which may cover goods or services) has effect there.

If some of Whiz-Bang's offerings are services, and some of the countries identified above that do not recognize service marks are valuable markets, Whiz-Bang may consider securing trademark protection within the country to the extent possible either through the registration of the mark for related or underlying goods (e.g. goods that are sold, serviced,

designed, distributed, or managed) or by extension of another trademark registration (United Kingdom or EUTM as discussed above).

VII. Must Goods and Services Identifications be Translated into Foreign Languages and Are There Issues with Translations?

Each national or regional trademark office has at least one or more official languages. All correspondence, including the application for registration, which itself includes the identification of goods and services, must be submitted in an official language. While a mark itself may be in another language, many trademark offices will require a statement regarding the meaning or translation of the mark itself in one of its respective official languages.

In general, a translation of the identification of goods and services into an official language will be required. Due to the expenses of translations, there may be an advantage to leveraging a sunk translation cost into trademark application filings in additional national offices with the same official language. In this manner, translation costs can be spread across applications in multiple jurisdictions when budgeting for filing costs.

Descriptions of goods and services in select languages can be leveraged to multiple countries and regional entities. English is an accepted language in Australia, Benelux, Canada, EUIPO, Ireland, New Zealand, Nigeria, OAPI, Singapore, United Kingdom, and United States. Spanish is an accepted language in Spain, Mexico, Philippines, Colombia, Argentina, Peru, Venezuela, and Chile. French is an accepted language in France, Canada, OAPI, Benelux, and Switzerland. EUTM applications can be filed in any of the 23 official languages of the European Union. Madrid Protocol applications may be filed in English, French or Spanish.

Because the Nice Classification system defines class headings and goods and services within those classes, which are agreed upon by representatives of each of the contracting states, if an identification of goods and services is adopted relying solely upon the Nice class headings and the alphabetical listings of goods and services under those headings, then no translation is required for filing in the trademark office of another Nice contracting state.

VII. Toward Harmonization? The TM5 and TMClass Projects.

The global trademark community continues to push toward harmonization in the area of identifications of goods and services in trademark applications. This section describes some of those efforts and initiatives, some of which may assist in the formulation of the Whiz-Bang international filing program.

TM5

In 2001, the trademark offices of Japan, the European Union, and the United States formed a “cooperative framework” called the Trademark Trilateral to exchange information on trademark-related matters, and undertake cooperative activities for their mutual benefit, and for the interests of their respective trademark filers and registrants. One of the efforts undertaken by the Trademark Trilateral was to identify a set of identifications of goods and services that were sufficiently definite and clear to pass muster under the examination guidelines and practices of the respective national trademark offices (the JPO, EUIPO and the USPTO). This effort was successful; on June 3, 2004, the Trademark Trilateral announced agreement among the three offices as to a list of identifications and classifications acceptable in all three trademark offices. The initial list contained over 7,000 approved identifications.

In 2011 and 2012, respectively, the Trademark Trilateral was expanded to include the Korean Intellectual Property Office (KIPO) and State Administration for Industry and Commerce of the People’s Republic of China (SAIC). The collaborative framework was then renamed as the “TM5.” The mission statement of the TM5 is as follows: “Through exchange of information on practices and programs as well as common projects aiming at the harmonization or improvement of trademark procedures, TM5 strives to promote cooperation and collaboration between members and contribute to increasingly user-friendly and, if possible, interoperable trademark systems.” Like the Trademark Trilateral before it, one of the projects of the TM5 is to identify common identifications of goods and services acceptable in all five trademark offices. In January 2015, the TM5 announced the launch of the TM5 ID List Tool, a searchable database of over 14,000 identifications of goods and services -- known as the “unified list” -- that are acceptable in all five trademark offices. The TM5 ID List Tool can be accessed at <http://oami.europa.eu/ec2/tm5>. The preamble to the TM5 ID List Tool sets for the following concise explanation of the utility of the tool:

The TM 5 “ID List Project” is designed to assist trademark right holders who seek trademark protection in multiple jurisdictions.

Right holders who seek trademark registrations from national IP offices must provide those offices with descriptions (“IDs” or “identifications”) of the goods or services that are associated with the trademarks. Right holders prepare these IDs in one of two ways: they either craft the IDs on their own, or they select an ID, or a combination of IDs, from lists of possible IDs that the national offices maintain.

An advantage to utilizing an ID from a pre-written list is that the right holder is assured that the national IP office will not ask the right holder to modify the ID. On the other hand, if the right holder drafts the ID on his own, the national office may find that the ID is inadequate, perhaps because the ID is insufficiently clear. A finding that an ID is inadequate can delay both the processing of the request to register the trademark, and the ultimate issuance of a registration.

Hence, a right holder may benefit substantially by drawing an ID from a pre-published list of IDs. That benefit, however, may be blunted if the right holder wishes to obtain registrations in multiple jurisdictions: no two national offices have identical lists of pre-approved IDs, and a right-holder who seeks registrations in multiple jurisdictions may therefore have to consult multiple lists, and present multiple IDs, all to describe the same goods.

The TM5 ID List Project is an attempt to enable such right holders to enjoy some of the benefits that may flow from use of pre-approved IDs. In particular, it is expected that the project may result in a “unified” list that is comprised of IDs that are acceptable not only to the IP offices of each of the five TM5 partners, but to IP offices of other jurisdictions as well. A right holder who seeks to obtain trademark registrations from two or more of the national offices that participate in the project is assured that each of those offices will accept any ID that is included in the “unified list.”

TMClass

While the TM5 seeks to identify common identifications that are accepted in all five of the national trademark offices, the TMClass project seeks to clarify and harmonize the classification of individual goods and services within the Nice Classification.

The problem arises among Nice jurisdictions. While there is agreement on the Nice Classifications themselves, there has often been disagreement among trademark offices as to classification of particular goods and services within the classifications. In one jurisdiction, a particular good would be classified in one way, and in another jurisdiction the same good would be classified differently. This could result in a single-class application in one jurisdiction and a multi-class application in the other jurisdiction, even using the same identification.

In July 2008, a group of European trademark offices agreed to attempt to harmonize classification differences. The goal was to streamline processes, increase efficiency and reduce identification-based rejections in trademark filings by providing a common classification list -- organized according to the "taxonomy" -- applicable to, and agreed upon, by all participant trademark offices. Initially, the United Kingdom Intellectual Property Office (UKIPO) and EUIPO developed a common harmonized database of identification classifications in the English language. The Swedish Patent and Registration Office (PRV) then agreed to take the English harmonized database, translate it into Swedish and adopt it as the official classification list. Other offices in Europe agreed to follow this approach, and now all European trademark offices with English as a working language (the EUIPO, the UKIPO, the Irish Patents Office, and the National IP Office of Malta) have adopted the English harmonized list. As of April 2018, TMClass boasts 67 harmonized offices. In addition, numerous jurisdictions are currently providing data and working to integrate their identification lists with TMClass taxonomy.

Madrid Goods and Services Manager

The International Bureau (IB) offers the Madrid Goods and Services Manager (MGS), a tool available at <https://webaccess.wipo.int/mgs/>, to facilitate assembly of approved identifications for international filing programs conducted through the Madrid Protocol, and avoid Irregularity Notices resulting from problem identifications and/or classifications. As of the date hereof, the MGS is available in 17 languages. According to the IB:

MGS is an on-line tool developed by the International Bureau (IB) and designed to assist trademark applicants and their representatives in compiling the lists of goods and services that they need to submit when filing international applications under the Madrid System.

MGS gives access to thousands of standard terms accepted by the IB under the Madrid System procedures that can be used to identify goods and services in an international trademark application. These terms:

- *have been correctly classified by WIPO according to the latest edition of the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification); and,*
- *are accepted by WIPO under the Madrid system procedures (i.e., will not be subject of an irregularity notice under Rule 12 or Rule 13 of the Common Regulations under the Madrid Agreement and Protocol) .*

MGS enables applicants to browse and search for relevant terms which may then be translated into any of the three working languages of the Madrid System. Additional information on the functioning of MGS is available at "Help".

All of these initiatives, the TM5, TMClass and the MGS demonstrate effort by the global trademark community to increase harmonization efforts for the betterment of global trademark process, and give hope for a brighter future in which unnecessary inefficiencies in global trademark filing are significantly reduced.

Appendix 1: List of Nice Countries

Albania	Greece	Poland
Algeria	Guinea	Portugal
Argentina	Hungary	Republic of Korea
Armenia	Iceland	Republic of Moldova
Australia	Iran	Romania
Austria	Ireland	Russian Federation
Azerbaijan	Israel	Saint Kitts and Nevis
Bahrain	Italy	Saint Lucia
Barbados	Jamaica	Serbia
Belarus	Japan	Singapore
Belgium	Jordan	Slovakia
Benin	Kazakhstan	Slovenia
Bosnia and Herzegovina	Kyrgyzstan	Spain
Bulgaria	Latvia	Suriname
China	Lebanon	Sweden
Croatia	Liechtenstein	Switzerland
Cuba	Lithuania	Syrian Arab Republic
Czech Republic	Luxembourg	Tajikistan
Democratic People's Republic of Korea	Malawi	Macedonia
Denmark	Malaysia	Trinidad and Tobago
Dominica	Mexico	Tunisia
Egypt	Monaco	Turkey
Estonia	Mongolia	Turkmenistan
Finland	Montenegro	Ukraine
France	Morocco	United Kingdom
Georgia	Mozambique	United Republic of Tanzania
Germany	Netherlands	United States of America
	New Zealand	Uruguay
	Norway	Uzbekistan

Appendix 2: List of Non-Agreement Nice Adherents

Angola	Kuwait	Sri Lanka
Antigua and Barbuda	Lesotho	Sudan
Bangladesh	Libya	Swaziland
Bolivia	Madagascar	Thailand
Botswana	Malta	Tonga
Brazil	Mauritius	Uganda
Burundi	Namibia	United Arab Emirates
Cambodia	Nepal	Venezuela
Chile	Netherlands Antilles	Viet Nam
Colombia	Nicaragua	Yemen
Costa Rica	Nigeria	Zambia
Cyprus	Pakistan	Zimbabwe
Democratic Republic of the Congo	Panama	African Intellectual Property Organization (OAPI)
Djibouti	Paraguay	African Regional Intellectual Property Organization (ARIPO)
Ecuador	Peru	Benelux Organisation for Intellectual Property (BOIP)
El Salvador	Philippines	European Intellectual Property Office (EUIPO)
Ethiopia	Qatar	International Bureau of the World Intellectual Property Organization (WIPO)
Ghana	Rwanda	
Guatemala	Saint Vincent and the Grenadines	
Guyana	Samoa	
Haiti	San Marino	
Honduras	Saudi Arabia	
India	Seychelles	
Indonesia	Sierra Leone	
Iraq	Solomon Islands	
Kenya	South Africa	

Appendix 3: Common Nice Classifications for Industries

(a) Energy

Typical classes include classes 1 (chemicals used in drilling, fissionable material for nuclear energy), 4 (industrial oils and lubricants, gas and fuels), 6 (offshore drilling platforms), 7 (drilling machines and rigs, wind turbines), 9 (solar panels), 37 (oil and gas drilling), 39 (transport and storage), and 40 (treatment of materials with specific reference to production of energy)

(b) Capital Goods and Industrial Machinery

Typical classes include classes 6 (metal parts, pipes and fittings), 7 (industrial and agricultural machinery, household appliances), 9 (computers and software), and 12 (cars and trucks)

(c) Professional Services

Typical classes including classes 35 (business consulting, management and advertising services), 36 (financial, banking and insurance services), 37 (architecture services, building and construction, computer installation and repair services), 42 (software design and development, scientific research, engineering services), 44 (medical, dental and veterinary services), and 45 (legal, security, personal and social services)

(d) Transportation Services

Typical classes include classes 11 (climate controlled transport containers), 12 (land, air and water transportation vehicles), 36 (insurance and letters of credit), 37 (maintenance and repair of vehicles), and 39 (transportation services, rental vehicles, transportation logistics)

(e) Automotive

Typical classes include classes 9 (batteries and chargers), 12 (cars and parts), 36 (financing services), 37 (repair services), 39 (transportation and storage of vehicles), 40 (custom manufacture of vehicles), and possibly 28 (toys, etc.)

(f) Apparel and Footwear

Typical classes include classes 9 (glasses and sunglasses), 14 (jewelry), 18 (bags), 24 (fabrics and textiles), 25 (clothing, footwear, headgear), 28 (toys and sporting goods), and 35 (retail services)

(g) Entertainment

Typical classes include classes, 9 (DVDs, media, software, video games), 16 (books and magazines), 25 (clothing and footwear), 28 (games, toys and sporting goods), 38 (broadcasting services of all types), 41 (entertainment services, television, radio, movies, sporting events), and 42 (online media, software and video games)

(h) Hospitality

Typical classes include classes 25 (clothing), 28 (games, toys and sporting goods), 29 (preserved foods), 30 (condiments), 32 (beers and non-alcoholic beverages), 33 (wine and alcoholic beverages), and 43 (hotels, retirement homes, restaurants, bars)

(i) Media & Advertising

Typical classes include classes 16 (printed publications), 35 (advertising, public relations, business management, business administration, office functions), 38 (broadcasting services of all types), and 41 (entertainment services)

(j) Retailers

Typical classes include classes 35 (physical and online retail services)

(k) Agricultural, Food and Beverage

Typical classes include classes 1 (chemicals used in agriculture, horticulture, and forestry), 5 (preparations for destroying vermin, fungicides, herbicides), 7 (agricultural machinery), 8 (hand operated agricultural implements), 10 (veterinary apparatus and instruments), 12 (vehicles), 18 (leather, animal skins and hides), 29 (various food items), 30 (various food and beverage items), 31 (agricultural, horticultural, and forestry products, live animals, fresh fruits and vegetables, seeds, plants, and flowers), 32 (Beers, non-alcoholic drinks, beverage syrups), 33 (Alcoholic beverages (except beers)), 34 (tobacco), 43 (services for providing food and drink), and 44 (veterinary services, care for animals, agriculture, horticulture, and forestry services)

(l) Household and Personal Products

Typical Classes include Class 3 (household cleaners, cosmetics, soaps and personal care products), Class 5 (nutritional supplements), Class 20 (household and office furniture)], Class 21 (dishes, drinkware, kitchenware) and Class 24 (textiles, floor coverings, wall coverings)

(m) Healthcare Services

Typical Classes include classes 16 (printed matter), 36 (insurance), 41 (education), and 44 (medical services)

(n) Healthcare Equipment

Typical Classes include classes 5 (sanitary preparations and dressings), 9 (computer software), 10 (surgical, medical, dental, veterinary apparatus and instruments), and 44 (medical services)

(o) Pharmaceuticals and Biotech

Typical Classes include classes 5 (pharmaceutical preparations), 42 (scientific research and testing), and 44 (medical services)

(p) Insurance and Financial

Typical classes include classes 9 (computer software), 16 (printed matter) and 36 (insurance and financial services)

(q) Real Estate

Typical classes include classes 35 (real estate auctioneering, organization of real estate displays and exhibitions for promotion and advertising purposes, compiling real estate brokerage listings), 36 (real estate services), 37 (real estate development, building and construction services), 42 (real estate planning, designing and surveys), and 45 (guarding of real estate)

(r) Information Technology & Software

Typical Classes include classes 9 (downloadable software), 16 (printed manuals), 35 (business consulting services, business conferences), 38 (telecommunications, online chat rooms, instant messaging), 39 (electronic storage services), 41 (interactive computer games, education and training services, blogs), 42 (non-downloadable software, ASP/SaaS/cloud services, hosting services, software support services, development services), and 45 (online social networking services)

(s) Technology Hardware and Equipment

Typical Classes include classes 9 (hardware, software, etc.), 16 (printed manuals), 35 (business consulting services, business conferences), 36 (financing services), 38 (telecommunications, online chat rooms, instant messaging), 39 (electronic storage services), 41 (education and training services, blogs), and 42 (computer technical support, computer consulting, network design, etc.)

(t) Telecommunications

Typical Classes include classes 9 (routers, modems, computerized switching equipment, cell phones, telephones), and 38 (telecommunications services)

(u) Utilities

Typical Classes include classes 1 (gas mixtures, chemicals for use in treatment of water), 4 (electrical energy, natural gas, fuel), 6 (metal water tanks), 7 (water distribution machines, water filtration machines), 9 (apparatus for electricity supply), 11 (gas purifying apparatus, gas installations, apparatus for purifying water, apparatus for distributing water), 19 (non-metallic conduits for water distribution), 37 (electrical installation services), 39 (supply and storage of electricity, distribution of gas), 40 (production of electricity, processing or purifying of gas), 42 (gas prospecting)

Appendix 4: Reference Table

COUNTRY	NICE CLASSIFICATION ADOPTED?	SUB CLASSIFICATION REQUIRED?	SERVICE CLASSIFICATIONS PERMITTED?	MEMBER OF TM5	MEMBER OF TMCLASSES
African Intellectual Property Organization (OAPI)	ADHERENT	NO	YES		YES
African Regional Intellectual Property Organization (ARIPO)	ADHERENT	NO	YES		YES
Albania	SIGNATORY	NO	YES		YES
Algeria	SIGNATORY	NO	YES		

Angola	ADHERENT	NO	YES		
Anguilla	ADHERENT	NO	YES		
Antigua and Barbuda	ADHERENT	NO	YES		
Argentina	SIGNATORY	NO	YES		
Armenia	SIGNATORY	NO	YES		
Australia	SIGNATORY	NO	YES		
Austria	SIGNATORY	NO	YES		YES
Azerbaijan	SIGNATORY	NO	YES		
Bahamas	NO	NO	YES		
Bahrain	SIGNATORY	NO	YES		
Bangladesh	ADHERENT	NO	YES		
Barbados	SIGNATORY	NO	YES		
Belarus	SIGNATORY	NO	YES		
Belgium	SIGNATORY	NO	YES		
Belize	ADHERENT	NO	YES		
Benelux (BOIP)	ADHERENT	NO	YES		YES
Benin	SIGNATORY	NO	YES		
Bolivia	ADHERENT	NO	YES		
Bosnia and Herzegovina	SIGNATORY	NO	YES		YES
Botswana	ADHERENT	NO	YES		
Brazil	ADHERENT	NO	YES		YES
Brunei Darussalam	ADHERENT	NO	YES		YES
Bulgaria	SIGNATORY	NO	YES		YES
Burundi	ADHERENT	NO	YES		
Cambodia	ADHERENT	NO	YES		YES
Canada	NO	NO	YES		
Cayman Islands	ADHERENT	NO	YES		
Chile	ADHERENT	NO	YES		
China	SIGNATORY	YES	YES	YES	YES
Colombia	ADHERENT	NO	YES		YES
Costa Rica	ADHERENT	NO	YES		YES
Croatia	SIGNATORY	NO	YES		YES
Cuba	SIGNATORY	NO	YES		YES
Cyprus	ADHERENT	NO	YES		YES
Czech Republic	SIGNATORY	NO	YES		YES

Democratic People's Republic of Korea	SIGNATORY	NO	YES		
Democratic Republic of the Congo	ADHERENT	NO	YES		
Denmark	SIGNATORY	NO	YES		YES
Djibouti	ADHERENT	NO	YES		
Dominica	SIGNATORY	NO	YES		
Dominican Republic	ADHERENT	NO	YES		
Ecuador	ADHERENT	NO	YES		
Egypt	SIGNATORY	NO	YES		
El Salvador	ADHERENT	NO	YES		YES
Equatorial Guinea	REGISTRATION UNDER AUSPICES OF OAPI	REGISTRATION UNDER AUSPICES OF OAPI	REGISTRATION UNDER AUSPICES OF OAPI		
Estonia	SIGNATORY	NO	YES		YES
Ethiopia	ADHERENT	NO	YES		
European Union Intellectual Property Office (EUIPO)	ADHERENT	NO	YES	YES	YES
Fiji	NO	NO	NO		
Finland	SIGNATORY	NO	YES		YES
France	SIGNATORY	NO	YES		YES
Georgia	SIGNATORY	NO	YES		
Germany	SIGNATORY	NO	YES		YES
Ghana	ADHERENT	NO	YES		
Gibraltar	REGISTRATION UNDER AUSPICES OF UK-IPO OR EUIPO	REGISTRATION UNDER AUSPICES OF UK-IPO OR EUIPO	REGISTRATION UNDER AUSPICES OF UK-IPO OR EUIPO		
Greece	SIGNATORY	NO	YES		YES
Guatemala	ADHERENT	NO	YES		
Guinea	SIGNATORY	NO	YES		

Guyana	ADHERENT	NO	NO, BUT PERMITTED VIA EXTENSION OF UK REGISTRATION		
Haiti	ADHERENT	NO	YES		
Honduras	ADHERENT	NO	YES		YES
Hong Kong	ADHERENT	NO	NO		
Hungary	SIGNATORY	NO	YES		YES
Iceland	SIGNATORY	NO	YES		YES
India	ADHERENT	NO	YES		YES
Indonesia	ADHERENT	NO	YES		
Iran (Islamic Republic of)	ADHERENT	NO	YES		
Iraq	ADHERENT	NO	YES		
Ireland	SIGNATORY	NO	YES		YES
Israel	SIGNATORY	NO	YES		YES
Italy	SIGNATORY	NO	YES		YES
Jamaica	SIGNATORY	NO	YES		
Japan	SIGNATORY	YES	YES	YES	YES
Jersey	REGISTRATION UNDER AUSPICES OF UK-IPO OR EUIPO	REGISTRATION UNDER AUSPICES OF UK-IPO OR EUIPO	REGISTRATION UNDER AUSPICES OF UK-IPO OR EUIPO		
Jordan	SIGNATORY	NO	YES		YES
Kazakhstan	SIGNATORY	NO	YES		
Kenya	ADHERENT	NO	YES		
Kosovo	?	?	?		
Kuwait	ADHERENT	NO	YES		
Kyrgyzstan	SIGNATORY	NO	YES		
Latvia	SIGNATORY	NO	YES		YES
Lebanon	SIGNATORY	NO	YES		
Lesotho	ADHERENT	NO	YES		
Libya	ADHERENT	NO	YES		
Liechtenstein	SIGNATORY	NO	YES		
Lithuania	SIGNATORY	NO	YES		YES
Luxembourg	SIGNATORY	NO	YES		

Madagascar	ADHERENT	NO	YES		
Malawi	SIGNATORY	NO	YES		
Malaysia	SIGNATORY	NO	YES		YES
Malta	ADHERENT	NO	YES		YES
Mauritius	ADHERENT	NO	YES		
Mexico	SIGNATORY	NO	YES		YES
Monaco	SIGNATORY	NO	YES		
Mongolia	SIGNATORY	NO	YES		
Montenegro	SIGNATORY	NO	YES		YES
Morocco	SIGNATORY	NO	YES		YES
Mozambique	SIGNATORY	NO	YES		
Namibia	ADHERENT	NO	YES		
Nepal	ADHERENT	NO	YES		
Netherlands	SIGNATORY	NO	YES		
Netherlands Antilles	ADHERENT	NO	YES		
New Zealand	SIGNATORY	NO	YES		
Nicaragua	ADHERENT	NO	YES		
Nigeria	ADHERENT	NO	YES		
Norway	SIGNATORY	NO	YES		YES
Oman	ADHERENT	NO	YES		
Pakistan	ADHERENT	NO	YES		
Panama	ADHERENT	NO	YES		
Papua New Guinea	?	?	?		
Paraguay	ADHERENT	NO	YES		
Peru	ADHERENT	NO	YES		YES
Philippines	ADHERENT	NO	YES		YES
Poland	SIGNATORY	NO	YES		YES
Portugal	SIGNATORY	NO	YES		YES
Qatar	ADHERENT	NO	YES		
Republic of Korea	SIGNATORY	YES	YES		YES
Former Yugoslav Republic of Macedonia	SIGNATORY	YES	YES		
Republic of Moldova	SIGNATORY	NO	YES		YES

Romania	SIGNATORY	NO	YES		YES
Russian Federation	SIGNATORY	NO	YES		YES
Rwanda	ADHERENT	NO	YES		
Saint Kitts and Nevis	SIGNATORY	NO	YES		
Saint Lucia	SIGNATORY	NO	YES		
Saint Vincent and the Grenadines	ADHERENT	NO	YES		
Samoa	ADHERENT	NO	YES		
San Marino	ADHERENT	NO	YES		YES
Saudi Arabia	ADHERENT	NO	YES		
Serbia	SIGNATORY	NO	YES		YES
Seychelles	ADHERENT	NO	YES		
Sierra Leone	ADHERENT	NO	NO, BUT PERMITTED VIA EXTENSION OF EU OR UK REGISTRATION		
Singapore	SIGNATORY	NO	YES		
Slovakia	SIGNATORY	NO	YES		YES
Slovenia	SIGNATORY	NO	YES		YES
Solomon Islands	ADHERENT	NO	YES		
South Africa	ADHERENT	NO	YES		
Spain	SIGNATORY	NO	YES		YES
Sri Lanka	ADHERENT	NO	YES		
Sudan	ADHERENT	NO	YES		
Suriname	SIGNATORY	NO	YES		
Swaziland	ADHERENT	NO	YES		
Sweden	SIGNATORY	NO	YES		YES
Switzerland	SIGNATORY	NO	YES		YES
Syrian Arab Republic	SIGNATORY	NO	YES		
Taiwan	ADHERENT	?	YES		
Tajikistan	SIGNATORY	NO	YES		
Thailand	ADHERENT	NO	YES		
Tonga	ADHERENT	NO	YES		

Trinidad and Tobago	SIGNATORY	NO	YES		
Tunisia	SIGNATORY	NO	YES		YES
Turkey	SIGNATORY	NO	YES		YES
Turkmenistan	SIGNATORY	NO	YES		
Uganda	ADHERENT	NO	YES		
Ukraine	SIGNATORY	NO	YES		
United Arab Emirates	ADHERENT	NO	YES		
United Kingdom	SIGNATORY	NO	YES		YES
United Republic of Tanzania	SIGNATORY	NO	YES		
United States of America	SIGNATORY	NO	YES	YES	YES
Uruguay	SIGNATORY	NO	YES		YES
Uzbekistan	SIGNATORY	NO	YES		
Venezuela	ADHERENT	NO	YES		
Vietnam	ADHERENT	NO	YES		
Yemen	ADHERENT	YES	YES		
Zambia	ADHERENT	NO	NO		
Zimbabwe	ADHERENT	NO	YES		