

## Fact Sheet

# A Guide To Trade Mark Specifications

### What is a trade mark specification?

- Goods & services: A trade mark specification is a list of the goods and/or services which are relevant to your trade mark.
- Use classes: Goods and services are split into 45 classes (34 goods and 11 services classes). A general guide to which goods and services are contained in each class can be found on the WIPO website:

<http://www.wipo.int/classifications/fulltext/nice8/enmain.htm>.

### Why is getting the trade mark specification right important?

- Scope of protection: If a third party uses a trade mark which is similar to yours but which is used in relation to goods or services which are not similar to those listed in your specification, there is a greater risk that you won't be able to enforce your registered trade mark against them.

### Will a general description do?

- Generic descriptions: On occasion, it is appropriate to include both broad generic types of goods or services in a specification in addition to the more specific goods and services falling within such generic descriptions: a balance should be struck between the potential benefits and risks.

A broad specification provides:

- A wider scope of protection for your trade mark.
- Increased risks of challenge (both by the Registry and by other trade mark users).

Your trade mark specification should be comprehensive but should not include goods or services completely irrelevant to your intended trade mark use.

### Can I include goods/services which I don't offer?

- Genuine intention: It is acceptable to include goods or services in the specification which you do not presently offer, as long as there is a bona fide intention that the mark will be used in relation to these goods or services in the future.
- Non-use: If your mark is not used in relation to one or more of the goods or services in your specification for a continuous period of five years, there is a risk that a third party may lodge an application to have your registration revoked on grounds of non-use. If such an application were to succeed, the unused goods and services may be deleted from your specification.

### What are the cost implications?

- Multiple goods/services: Application charges are calculated on the basis of the number of different use classes, not the number of goods/service specified within these classes. (So, for example, ten services listed in class 45 costs the same as one service listed in class 45.)
- Multiple classes: A trade mark application can include multiple use classes. Generally speaking, the more use classes in an application, the more expensive the application & renewal costs. That said, it is cheaper to apply for a trade mark which covers two use classes using one application than using a separate applications for each use class.
- European trade marks: If you want to apply for a Community Trade Mark (known as a "CTM") then it is worthwhile noting that the basic application fee includes three use classes. (So, for example, an application containing three use classes will have the same application/renewal fee as an application in only one use class.)

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For questions about your situation, please get in touch with your solicitor at Morton Fraser, who will be happy to discuss how we can help you.

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