

## CHAPTER 4

### CLASSIFICATIONS OF GOODS & SERVICES

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## **CHAPTER 4**

### **CLASSIFICATIONS OF GOODS & SERVICES**

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#### **4.1 Overview**

In Malaysia, a trademark application for registration has to be accompanied by a list of the goods and/or services on which the mark is intended to be used. The list of goods and services is an important aspect of a trade mark application as the scope of the applicant's rights in the mark is defined and limited by the scope of the list also known as the specification.

The goods and services must be classified in accordance with an internationally agreed classification system used by more than 150 countries, known as the International Classification of Goods and Services (ICGS) or the Nice Classification. Also, Madrid Goods and Services as additional reference for trademark specification. The international classification system enables efficient searches for conflicting trademarks to be done worldwide, benefitting not just the Registry staff, but also users who wish to check whether there are marks which have been already applied for or registered that conflict with marks they are using or propose to use. If the classification of the goods or services of an application is made incorrectly, the validity of any rights stemming from a subsequent registration might be called into question at a later date. This could result in a mark being the subject of proceedings to remove it from the Register.

It is therefore important that the list of goods and services in an application for registration be worded in such a way as to (a) indicate clearly the nature of the goods and services, and (b) allow each item to be classified in the correct class of the edition and version of the Nice Classification prevailing at the point of filing of the application for registration of the trade mark.

The purpose of this manual is to describe the Registry's practice concerning classification of goods and services in MyIPO.

## **4.2 Relevant Legislation**

### **Trademark Acts 2019 (Act 815)**

#### **Application of Registration**

**19.** - (1) Goods or services shall be classified for the purpose of the registration of trademarks in accordance with a system of classification as prescribed.

(2) If any question arises as to the class within which any goods or services are comprised, that question shall be decided by the Registrar.

#### **Regulations of Trademarks 2019**

**11.** – (1) Every application for registration of trademark, for each class of goods or services to which the application relates, shall contain the following:

(a) class number as provided in the classification of goods or services as specified in the Third Schedule; and

(b) a specification of those goods or services-

(i) which is appropriate to that class; and

(ii) which is described in such manner-

(A) as to indicate clearly the nature of those goods or services; and

(B) as to allow those goods or services to be classified in accordance with the classification system as specified in the Third Schedule.

(2) For the purposes of paragraph (1)(b), the classification of goods or services as specified in the Third Schedule, which shall include such classification as set out in a pre-approved list made available by the Registrar, from which a specification may be adopted by the applicant.

(3) An application under subregulation (1) may be made in respect of more than one class of goods or services from the classification of goods or services as specified in the Third Schedule, and in such a case, paragraph (1)(b) shall apply for each class of the goods or services to which the application relates.

(4) In the case of an application for registration in respect of all the goods or services included in a particular class in the Third Schedule, or of a large variety of goods or services, the Registrar may refuse the application unless the Registrar is satisfied that the specification is justified by the use of the trademark which the applicant has made, or intends to make if and when the trademark is registered.

(5) When a trademark is registered, the trademark shall be classified according to the version of the system of classification of goods or

services as specified in the Third Schedule which is in force on the date of filing of the application for registration of such trademark.

(6) In this regulation, “specification” means the specification of goods or services in respect of which a trademark is registered or intends to be registered.

## 4.3 The Nice Classification

Goods and services are divided into 45 classes, each class covering a different category of goods or services. Classes 1 to 34 relate to goods, and Classes 35 to 45 relate to services. In total, the Nice Classification contains around 11,000 indications of goods and services.

### 4.3.1 Structure of the Nice Classification

Each class of the Nice Classification contains:

- a) **Class Heading:** The class headings describe in very broad terms the nature of the goods or services contained in each class.
- b) **Explanatory Note:** The explanatory note of a given class describes in greater detail the types of goods or services included in that class
- c) **Alphabetical List:** The most detailed level of the Classification is the alphabetical list which shows the individual goods or services appropriate to a class.

The Nice Classification further contain General Remarks which prescribe that the indications of goods and services appearing in the class headings are general indications relating to the fields to which, in principle, the goods or services belong. The Alphabetical List should therefore be consulted in order to ascertain the exact classification of each individual good or service.

## **4.4 Classification Tools**

### **4.4.1 Pre-approved Goods and Services**

MyIPO has a database of pre-approved list of goods and services. The list was adopted from Madrid Goods & Services 12<sup>th</sup> Edition 2023. The list comprises of 113,471 terms of goods and services. The list will be updated from time to time accordingly.

Applicants can be assured that every term found in the pre-approved list of goods and services at the point of filing will be accepted by the Registrar for classification purposes. This will shorten the examination time as there is no need to verify whether the goods and/or services can be accepted in the class proposed by the applicant and ultimately the application would be accepted for publication earlier if no other objections are encountered. Applicants can also enjoy a lower fee for each class that fully conforms to the pre-approved list. The Registry's database of the pre-approved list of goods and services has also been incorporated into the electronic form for applying to register a trade mark.

It can be accessed by the link at-

[http://onlineapps.myipo.gov.my:8500/tmclass/search\\_class.cfm](http://onlineapps.myipo.gov.my:8500/tmclass/search_class.cfm)



#### **4.4.2 Madrid Goods & Services**

Madrid Goods and Services (MGS) is database for classification of goods and services developed by World Intellectual Property (WIPO). The MGS list comprises of list goods and services which include(s)-

- (i) Nice Classification
- (ii) List of goods and services from designated Contracting Party (dCP)

The MGS list can be accepted by Registrar as of December 2023 since some of the listings are imported for MyIPO pre-approved list. The examination process also will be shortened since the MGS list is also considered as accurate to the respective classification. If the MGS list being selected for application of trademark, applicant need to aware that the fee will be charge as TMA2B without adopting pre-approved.

The link for MGS listing is at- <https://webaccess.wipo.int/mgs/>

## **4.5 General Classification Principles**

There are some general classification principles that goods and services specification must adhere to. In order to comply with formality goods and services requirement, there some of these rules and principles need to be verified.

### **4.5.1 Clear indication of specifications**

In accordance to Rule 11(b) of the Trademark Regulations 2019 provides that to indicate clearly the nature of those goods or services. The specification of goods and services must clearly define their nature and be described in a way that enables them to be categorized within the appropriate classes of the Nice Classification. The terms used should therefore be sourced from standard dictionaries, specialized dictionaries, or be commonly found on the internet.

If a term of goods or services is unclear, Registrar may issue Provisional Refusal (Formality) for the applicant explanation or an amendment of the term if needed. Some case may differ from each other.

### 4.5.2 Vague specifications

If the specifications of goods and services is vague, Registrar may issue Provisional Refusal under this provision. Here are some examples: -

(a)

35	<b>Business of design, printing on uniform and premium gift, and wholesale and retail sales.</b>
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Exhibit 1

- Specifications above is unclear respective to class 35. The applicant needs to explain on the goods or services. Since class 35 consist of 'Business administration', 'Business management', the specification claim by applicant does not comply in a manner of class 35.

(b)

**To provide, advisory, consultancy and execution of Marketing Communication Services (Advertising, PR, sales promotions, personal selling, KOL, events, activations and online media, consumer & industrial research and data analytics); Consultancy on marketing, AI and effectiveness study; Business consultancy; Trading of all types of media space and inventory via cash and contra; All items classified in Class 35.**

Exhibit 2

- Specifications above display some of the goods or services is unclear and vague. The item 'To provide, advisory, consultancy and execution of Marketing Communication Services (Advertising, PR, sales promotions, personal selling, KOL, events, activations and online media, consumer & industrial research and data analytics)' and 'Trading of all types of media space and inventory via cash and contra' is considered vague to Registrar. Explanation needed for both of the item to fit in class 35.

#### **4.5.3 Broad specifications**

Specification of goods or services in trademark registration need to be specific to the claim by the applicant. If the applicant tends to apply with a broad specification goods or services, Registrar shall issue a provisional refusal for the trademark application. Applicant need to explain on the goods or services or amendment needed for the response.

Example of case as below: -

(a)

35 Business management of sports people; Promotion of goods and services through sponsorship of sports events; Shop Window dressing; Public relations services; **Retail store services**; Business management of wholesale outlets.

### Exhibit 3

- The specification 'Retail store services' is broad in class 35. Applicant need to specify and narrow the services. Since retail services have a wide variety of product in the market, applicant need be specific on the products so that the trademark will not monopoly on retail services.
- Registrar will suggest the applicant to amend the services to 'Retail store services relating to cosmetic and beauty preparation'.

(b)

25 **Aprons**; Bandanas; Baseball caps; **Baseball caps and hats**; **Bottoms as clothing**; Cap visors; Caps being headwear; **Children's dress-up costumes in the nature of depictions of animals and animal-like characters and creatures**; **Clothing jackets**; **Clothing jerseys**; Cosplay costumes; Costumes for use in children's dress up play; Costumes for use in role-playing games; **Costumes for use in the amusement industry**; Dresses; Footwear; Halloween costumes; Hats; **Headbands**; Headwear; Long-sleeved shirts; Neckties; Pajamas; Rainwear; Scarves; Shirts; Shoes; Short-sleeved shirts; Shorts; Sleepwear; Slippers; Socks; Sweaters; Sweatpants; Sweatshirts; Swimwear; T-shirts; Tank tops; **Ties as clothing**; **Tops as clothing**; Underwear; Vests.

### Exhibit 4

- The specification above shows claims in class 25. The item 'Aprons' is broad because the goods can be found in various classes. The applicant needs to determine and specify the goods in the respective class.
- Registrar suggest to amend the item to 'Aprons [clothing]'. The specification is more accurate to the respective class.

#### **4.5.4 Class heading**

Class headings of the Nice Classification are general indications of the goods and services that are included in a particular class. The details of class heading can be referred in MyIPO website, on goods or services section.

Claims for class headings or parts of class headings of the Nice Classification as in for some classes are generally acceptable, unless in class 5, 7, 9, 12 and 35. The class heading in these classes are indicated as in table below.

Class	Specification of class heading
5	Pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for human beings and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.
7	Machines, machine tools, power-operated tools; motors and engines, except for land vehicles; machine coupling and transmission components, except for land vehicles; agricultural implements, other than hand-operated hand tools; incubators for eggs; automatic vending machines.
9	Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media, computer software, blank digital or analogue recording and storage media; mechanisms for coin-operated apparatus; cash registers, calculating

	devices; computers and computer peripheral devices; diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming; fire-extinguishing apparatus.
12	Vehicles; apparatus for locomotion by land, air or water.
35	Advertising; business management; business administration; office functions. / Advertising; business management, organization and administration; office functions.

#### 4.5.4.1 Accepted descriptions for class heading

There are certain descriptions of class heading can be accepted. It is only applicable for specifications in class 5,9 and 35. For these classes, the claim for the whole descriptions class heading is prohibited. If applicant only claim for some of the class heading, it is acceptable.

**Example 1:** Claim whole item for class 5 is not acceptable. But if the claim only for items “Pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies”, it is acceptable. In consideration that applicant did not apply edible goods and poison goods in the same class.



**Example 2:** “Advertising; business management; business administration; office functions” is prohibited for the claim in class 35. If the claim is “Advertising; business management; business administration”, then it is acceptable. As long as the specifications claim is not as a whole, then it is permissible.

#### **4.5.4.2 Goods mixed with food and poison**

Specifications in class 5 are mixed with food and poison. In MyIPO practice, if the claim item consists of foods, therefore it is prohibited to claim poison goods on the same class and vice versa. It based on Section 23(5) of the Act.

**Example 1:** “Pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for human beings and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides” in class 5 contains food item and poison. The specifications are not acceptable for claim. Examiner must remark at File Note and pending the application to Substantive and Examination stage. Provisional refusal will be issued during this stage.

#### **4.5.5 Terms of specifications to use or avoid**

Regulation 11(1)(b)(ii) Regulations of Trademarks 2019 indicates that specifications of goods or services must be described in such manner according to the respective class. There are some terms or spelling that can be accepted and there are some need to avoid.

##### **4.5.5.1 Use of acronyms and abbreviations in specifications**

In view of the need for clarity in the specification, only acronyms and abbreviations which are commonly known in the particular industry of the goods and/or services claimed, such as “CDROM”, “MP3”, “VCD”, “AM”, “FM”, “TV”, “UV”, “USB”, “HD”, are acceptable.

If the acronym or abbreviation is not widely recognized in the industry or is vague in its meaning, the Registrar will request that it be amend to its full form.

##### **4.5.5.2 Use of Bahasa Melayu**

Specifications of goods or services in MyIPO are comply to Nice Classification requirement. The official language used for list goods or services is in English. Most IP office and countries are using English for determining goods or services. There are some countries, such as Japan, Indonesia, Thailand are using its national language for local registration.

But for the international filing, the specifications need to be translated into English so that it will comply to WIPO and Nice Classification standard.

There are some terms in Bahasa Malaysia that can be used for claiming goods or services. For example, the word “Batik”. The word is acceptable since the term can be found in MGS. The word itself had been recognised as term for both and English and Bahasa Malaysia.

#### **4.5.5.3 All included in class term**

Vague terms are not acceptable in specifications and must be remove or deleted. The term is “all included in class XX”. Usually, the term can be found at last sentence of goods or services.

Registrar can delete or remove the term without issuing any notification letter.

**Example:** “Cosmetics; Face powder; all included in class 3”. The word and phrase “all included in class 3” should be deleted and the specification to be remained as “Cosmetics; Face powder”.

#### **4.5.5.4 Accessories term**

The term “accessories” need to be avoided on claim for goods or services. The term is considered vague or broad depending on the class interpretation.

**Example 1:** “Phone accessories” in class 9 is considered vague because the term did not specify to the goods. The term may refer to the ornaments of leather for phone in class 18 since it is also tended to be as phone accessories. In this case, objection will be raised for amendment and to restrict the goods.

The term can be used only as explanatory to the main goods or services, or to express a group of products on the respective class.

**Example 2:** “Retail services relating to car accessories” in class 35 indicate the business selling car accessories product. The main claim is retail services with an explanation of the specific product. Therefore, the term is acceptable.

#### 4.5.6 The use of punctuation in specifications

The use of correct punctuation is very important in a list of goods and services. Applicants are advised to take note of the following guidelines when using punctuation within a specification:

- a) Use semicolons (;) to separate the different categories of goods or services as segments within a class. For example, “Clothing; footwear; headgear” in Class 25 are separated by semi-colons as they are three different categories of goods.
- b) Use commas (,) to separate different items within the same category of goods or services where they are related to each other. For example, “Retail services in relation to clothing, footwear, headgear” in Class 35, “clothing, footwear, headgear” are separated by commas as they form part of the item “retail services in relation to...”.
- c) Avoid the use of colons (:).

The separation of terms by incorrect punctuation can lead to changes in meaning and possible incorrect classification. This may affect on the specification to be at false.

**Example 1:** “Computer programs for use with filling machines; packaging machines” in Class 9. Due to the use of the semi-colon, “packaging machines” would be regarded as an independent category of goods and not regarded as “computer programs for use with packaging machines”.

In this case, an objection will be raised against “packaging machines” as it is proper to Class 7.

**Example 2:** “Meat; fruits; vegetables, all being frozen” in Class 29 means that the qualifier “all being frozen” only applies to “vegetables” as the use of semi-colons before “vegetables” had separated each item as an independent category of goods. If the intention was to protect “frozen meat, frozen fruits and frozen vegetables”, the specification should read as “Meat; fruits; vegetables; all being frozen”.

#### **4.5.7 Use of transitional expressions in specifications**

If a description is restricted to the goods or services listed after an expression, it may be determined by the use of transitional expressions in specifications. Such use may also lead to specifications that include other, unidentified products or services. The Registrar's interpretation of the use of transitional expressions in specifications is outlined below.

##### **4.5.7.1 Restrictive transitional expressions**

Restrictive expressions such as “namely”, “exclusively”, “being”, “in the nature of”, “consisting of” and “comprising” effectively restricts a specification of goods or services. This means that what would otherwise be considered a vague description may be made acceptable through the use of such expressions and the listing of acceptable goods or services after them.

Specification	Effects of use of restrictive expression
Class 5: “Pharmaceutical products <b>exclusively</b> for dermatological use”	The use of “exclusively” would limit the goods to only pharmaceutical products for dermatological use, and exclude pharmaceutical products for all other uses.
Class 21: “Oral care kits <b>comprising</b> toothbrushes and dental floss”	The use of “comprising” renders the specification of goods acceptable as the vague description “oral care kits” has been restricted to encompass only toothbrushes and dental floss.
Class 30: “Desserts, <b>namely</b> ice cream”	The use of “namely” renders the specification of goods acceptable as the vague term “desserts” has been limited to only ice cream.

#### 4.5.7.2 Elaborative transitional expressions

On the other hand, the use of expressions like “such as”, “in particular”, “particularly”, “including”, “especially”, “specifically” and “containing” merely serves to elaborate the preceding description and does not effectively restrict a specification of goods or services. This means that the specification is not limited to specific goods or services, and may also include unnamed goods or services that falls within the scope of the preceding description.

Specification	Effects of use of elaborative expression
Class 15: “Musical instruments, <b>including</b> piano”	The use of “including” does not restrict the scope of the specification. Essentially, the applicant is claiming all types of musical instruments, with piano as an example.
Class 25: “Clothing, <b>in particular</b> T-shirts”	The use of “in particular” does not restrict the scope of the specification. The applicant is claiming all types of clothing, with T-shirts as an example.

Consequently, the use of such elaborative transitional expressions after a vague description will not help to clarify the ambiguity of the preceding description or render the description acceptable as a whole.



For example:

Specification	Effects of use of elaborative expression
Class 3: "Gift sets <b>containing</b> skin and hair care preparations"	As the preceding description "gift sets" is vague, the use of "containing" merely informs that skin and hair care preparations are included in the gift sets, among other products. Such an expression does not help to clarify the vagueness of the preceding description.
Class 30: "Foodstuff <b>especially</b> biscuits"	As the preceding description "foodstuff" is vague, the use of "especially" merely informs that the applicant is claiming other types of foodstuffs apart from "biscuits". Such an expression does not help to render the whole specification acceptable.
Class 45: "Personal services, <b>such as</b> babysitting"	As the preceding description "personal services" is vague, the use of "such as" merely informs that "babysitting" is one of the personal services provided by

	the applicant, and does not help to clarify the ambiguity of the preceding description.
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### 4.5.8 Use of symbols

The use of symbols in specifications claim are allowed. If the use of the symbols causing the specifications to be vague, then it is prohibited and an amendment is required if necessary.

#### 4.5.8.1 Use of slash ( / )

The use of slash symbol is acceptable in specifications claim. The slash indicates the term 'or'. Sometimes applicant tend to use the slash to claim goods that are the same but maybe different on the spelling or pronunciation.

**Example:** The specifications 'Vehicle tire / Tyre vehicle' in class 12 is acceptable. Since the difference between the two items is the spelling, it did not much effect on the claim. The goods are of the same item. So, the claim is accepted as one (1) item.

#### **4.5.8.2 Use of asterisk ( \* )**

Use of asterisk is not acceptable in goods or services claim. If applicant fill goods or services with asterisk, Registrar need to delete the asterisk from the application claim.

**Example:** 'Tea\*; Coffee\*' in class 30 is not acceptable. Registrar must remove the asterisk from the item. The correct claim should read as 'Tea; Coffee'.

## **4.6 Vague Descriptions**

Vague descriptions are not acceptable in specifications and should be amended for the purpose of clarity.

### **4.6.1 Parts and fittings**

“Parts and fittings (or components)” per se are vague and does not specify clearly the goods of interest. Therefore, it should not be accepted unless it relates to specific goods or is being further qualified. Thus, a specification of goods which reads “parts and fittings” should be objected. There are some cases that the term can accepted, such as when the specification reads as “Computer; parts and fitting all of aforesaid”.

**Example:** “Parts and fittings” in class 9 is objected. Unless the descriptions serve as explanatory to the previous goods, it is acceptable. “Computer, parts and fittings for all aforesaid” is acceptable.

### **4.6.2 Vague descriptions relating to food**

A specification consisting of “prepared meals” per se, without further qualification, is vague and may fall within several classes. Applicants are required to specify the predominant ingredient of the prepared meals, and examples of acceptable descriptions are “prepared meals consisting of

meat” in Class 29 or “prepared meals containing principally of rice” in Class 30.

#### **4.6.3 Articles**

The word “articles” is used in the Class Heading of Class 21 (“articles for cleaning purposes”), Class 28 (“gymnastic and sporting articles not included in other classes”), and Class 34 (“smokers' articles”).

As long as the specification containing the word “articles” is clearly described, the Registry will not object to it. Description such as “articles of wood” in Class 19 is not acceptable and will need to be further qualified to “articles of wood for building purposes” in order to clearly indicate the goods intended.

Other examples of acceptable descriptions are “jewellery articles” in Class 14 and “thermal insulating articles” in Class 17.