



REPUBLIC OF ESTONIA  
PATENT OFFICE



**EUIPO**  
EUROPEAN UNION  
INTELLECTUAL PROPERTY OFFICE

# CHOOSING GOODS AND SERVICES FOR TRADEMARK PROTECTION



## SELECTING A SUITABLE COVERAGE

There are two key factors to consider while requesting trade mark protection. The trade mark itself (whether you prefer a word mark, figurative mark, both, or another type of trademark in its place), as well as a list of the goods and services for which you want protection with the trade mark.

A trade mark is registered in connection with specific goods and/or services, which **specify the scope of the right granted** to the owner of the trademark; the trademark cannot be applied for so-called universally, covering all fields. Therefore, the list of goods and services is a very important part of the application. Spend time preparing it; ensure that the list's content meets your needs and that the form is created so that you won't have to spend time afterwards communicating with the agency. **The effort spent up front pays off later in terms of time and money won, as well as better-planned strategy! Therefore, keep the following in mind.**

- Think carefully about the goods and services for which you want protection for.
- Consider whether the database's listing for the good or service matches what you want, whether you need to look for another one, or even whether you need to come up with something new.
- Make it clear to yourself whether you need legal protection for the trade mark in terms of services or goods instead. Or both. Sometimes it can be quite a difficult decision point.

- Consider your plans for the future. **The trade mark will receive legal protection for 10 years and its legal protection can be extended every 10 years to indefinitely.** Maybe it is worth to include goods or services that are not yet produced/provided, but there's a possibility in the future?
- Would it be worthwhile to protect the trade mark a little more widely, even if there is no desire to expand? Consider which identical or very similar registered trade marks in relation to your goods or services would be actually harmful to your business. Therefore, would it make sense to register your trade mark for goods and services close to your goods and services and thus keep the „air clean“, or would it make sense to spend money only if there is a real threat and dispute?
- When making the goods and services list, keep in mind the golden rule: **„As much as necessary, as little as possible.“** „The more the merrier“ is not the case here, because the more goods and services are mentioned in the application, the greater the risk that there will be an earlier owner of the trade mark or trade name who has an earlier right to the trade mark for some goods and/or services.

When compiling the list, it is also useful to note that if the trade mark has not been used for 5 years for the goods and/or services, the interested party has the right to request that the trade mark owner's exclusive right for those goods and/or services be revoked.

- It is also important to know that **the list of goods and/or services can be limited at any time, but the initial scope of protection can never be extended for the same application.** If you have prepared the application quickly and want to complete the list even on the next day, it will not be possible. In this case, you will have to file a new application and pay a new state fee.
- **Know that the sale and marketing of your own goods can be protected along with the**

**application for protection.**

- Know that **the state fee depends on the number of classes of goods/services indicated in the application**, and not on the number of goods/services indicated in one class.

## CLASSIFICATION OF GOODS AND SERVICES



Goods and services are categorized according to an international system called the Nice classification to make the list's creation easier. There are 45 classes in total, with classes **1-34 including names of goods and classes 35-45 containing names of services**. Goods are divided into classes mainly by purpose, function or material, services by field of activity or purpose.

Each class has a **class header** that lists the **primary types** of goods or services that fall under that class and helps in identifying the category and class in which your goods and/or services belong. In addition, the Nice classification includes an alphabetical list of goods and services, class headers, and explanations for each class.

# TM|class

We recommend choosing names of goods and services that have previously received approval from all European Union agencies when submitting an application electronically. These names are in the **TMclass** (i.e. names of goods and services in the Nice classification + much more) harmonized database, and they are typically automatically accepted for classification.

From a market perspective, TMclass groups goods and services based on shared qualities, starting with general characteristics and ending with more specific ones. The user's search is made simpler and they have a better understanding of each class's content, which also makes it easier to choose appropriate names. TMclass also assists in searching, translating, and categorizing goods and services when filing trade mark registrations.

(<https://euipo.europa.eu/knowledge/course/view.php?id=3368>).

## ACCELERATED PROCEDURE



When choosing an accelerated procedure, you cannot choose goods with your own wording. The goods must be chosen from the unified database TMclass. The number of permitted goods and services is also limited, a maximum of 60 names of allowed goods and/or services can be listed in the application.


## CLARITY AND ACCURACY OF THE LIST



The goods and/or services listed on the request for trade mark protection must

- worded in a way that allows the relevant organizations and authorities to understand the extent of the requested legal protection;
- categorised in accordance with the Nice classification.

Therefore, it is strongly advised to choose goods and services using the TMClass. It also speeds up the registration process. However, if at all possible, we advise avoiding the phrases listed in the group title while selecting goods and services from the unified database.



The main purpose of the terms in the group title is to inform generally which goods or services belong to the class – it's possible that they aren't precise enough to be included in lists of goods and services.

In order to help the applicant easily determine the name of the good or service that interests them, TMclass also includes substantive repeats of goods and services. Only the word order has been altered or synonyms have been used to identify one good or service. Therefore, we advise that you carefully review the list of goods and services and mark them all off only once.



*Illustration: [www.freepik.com](http://www.freepik.com)*

Keep the above in mind if you have to include your goods and/or services in the application in free form because the databases do not have what you require. More detailed materials are available on our website, [www.epa.ee](http://www.epa.ee). You can also seek advice by contacting 627 7939 / 627 7915 or sending an email to [kaubamark@epa.ee](mailto:kaubamark@epa.ee).