

## Annexure to Computer Services

### 1. Introduction

This Annexure outlines the correct classification of computer, telecommunication and online goods and services under the Trade Marks Act 2002 (the Act) that are more difficult to classify. 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) (~~2011, 10<sup>th</sup> edition~~[2017, 11<sup>th</sup> edition](#)) (reference updated 1 January ~~2012~~[2017](#)).

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 (1997)
- The United States Patent and Trademark Office web site

### 2. Correct classification

This Annexure outlines the correct classification of computer, telecommunication and online related 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.

#### Call centre services

Call centre services are classified in class 38 or class 35 according to the nature of the services.

| Specification  | Class |
|--|-------|
| Call centre services that are in the nature of a “customer service” service. | 35    |

| Specification   | Class |
|---|-------|
| Call centre services in the nature of <del>operating-providing</del> telecommunications <del>aspects of a business—for instance call diversion, messaging ete</del> solutions services. | 38    |

### Computer security services

Computer security services may be classified in the following classes depending on the nature of the service being provided:

| Specification   | Class |
|---|-------|
| Consultancy in the field of computer security<br>Computerised communication network security<br>Data security services [firewalls]<br>Computer security services, namely, restricting access to and by computer networks to and of undesired websites, media, individuals and facilities<br>Computer services for the protection of computer software | 42    |
| <del>Computerised security services for business establishments</del><br>Security services for buildings provided online or via a computer network<br>Monitoring of computerised security systems for security purposes   | 45    |

### Directory services

Directory goods and services are classified as follows:

| Specification                 | Class |
|-------------------------------|-------|
| Telephone directory databases | 9     |
| Printed directories           | 16    |

| Specification  | Class |
|--|-------|
| Provision of business directories, and directories for retail and wholesale purposes | 35    |
| Provision of telephone directory information   | 38    |

### Electronic publications

Downloadable electronic publications are considered to be goods, such as software, and are classified in class 9.

Electronic publishing services are classified as follows:

| Specification  | Class |
|--|-------|
| Electronic publication of publicity texts  | 35    |
| Electronic publication of texts [other than publicity texts]<br>Publication of electronic books and journals online<br>Providing online electronic publications (not downloadable) | 41    |

### Electronic storage of data

Where electronic storage of data is in the nature of a business service, it is classified in class 35. This means if the storage of data is incidental to a business service, it is correctly classified in class 35. Electronic storage of technical information is also classified in class 35.

Where electronic storage of data is primarily a storage service, such as storing electronic data or documents for others, it is classified in class 39.

Library services related to data stored and retrieved by electronic means are correctly classified in class 41.

### Hyperlinks

See also *Links (computer)*.

The service of providing hyperlinks on a web site to other traders' websites is a [telecommunication service](#) which is more in line with hosting of web sites. This is classified in class 42 and is classified in class 38.

### **Internet café services**

Internet café services are correctly classified in accordance with the nature of the underlying service being provided. For example, if the main purpose of the operation is to provide access to the internet then this service is correctly classified in class 38; however if the main service is to provide food and drink, this service is correctly classified in class 43. Moreover, if the main purpose of the business is to lease access to or rent computers, then these services are correctly classified in class 42.

Internet café services are correctly classified as follows:

| Specification  | Class |
|--|-------|
| Internet café services, namely, providing telecommunications connections to the Internet in a café environment | 38    |
| Internet café services [computer rental]   | 42    |
| Internet café services [provision of food and drink]   | 43    |

### **Internet related goods**

Class 9 is the correct classification for Internet related goods, and includes:

- Computer programmes/software downloadable from the Internet.
- Publications in electronic format, including those downloadable from the Internet (Electronic publications not downloadable from the internet are classified as a service in class 41)
- Computer software that enables connection to databases and the Internet.
- Electronic and telecommunications apparatus (including modems) that enable connection to databases and the Internet.
- Computer software enabling the searching of data on the Internet.

### **Links (computer)**

~~The service of providing telecommunications links to the Internet is classified in class 38.~~

~~The service of providing hyperlinks on a web site to other traders' websites is a service which is more in line with hosting of web sites. This is classified in class 42.~~

### **Middleware**

Middleware is considered to be software ~~unless the applicant believes that it is hardware~~. Therefore the installation, updating and maintaining of middleware is classified in class 42.

~~Where the applicant believes that the middleware is hardware, then these services are correctly classified in class 37.~~

### **Web-casts and web-casting**

The terms "webcasts", "webcasting" and similar cover a wide range of services that can be in the nature of a broadcasting service in class 38 or an entertainment service in class 41.

For example, if the services involve providing a website from which the user can receive "webcasted" transmissions over the Internet, these services are correctly classified in class 38. However, if these services involve providing a particular online show "webcasted" over the Internet, these services are correctly classified in class 41.

Webcasting services are classified as follows:

| Specification   | Class |
|---|-------|
| Webcasting a television programme via the Internet  | 38    |
| Entertainment services, namely a continuing comedy show broadcasted over the Internet<br>Production of <a href="#">entertainment</a> webcasts | 41    |

### **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.

### Computer services

The provision of computer services including the term “computer services” is considered to be too broad and too vague as the exact nature of the services included within this description is unclear. In addition, computer services are classified in more than one class according to the nature of the goods or services.

Where a specification includes the term “computer services” and the applicant has not specified the exact nature of these services, a concern will be raised under section 32(2) of the Act.

Computer services are classified as follows:

| Specification   | Class |
|---|-------|
| Installation, maintenance and repair of computer hardware   | 37    |
| Electronic transmission of data and documents via computer terminals<br>Operation of chat rooms, providing chat room services<br>Electronic bulletin board services (telecommunications services)<br>Electronic mail services   | 38    |
| Computer training services  | 41    |
| Computer programming and related services<br>Computer programming for others<br>Computer code conversion for others<br>Recovery of computer data<br>Computer software<br>Installation, maintenance and repair of computer software<br>Updating of computer software<br>Duplication of computer programmes<br>Design services<br>Computer software design<br>Design of computers for others<br>Computer site design and website or webpage design<br>Computer systems analysis | 42    |

| Specification   | Class |
|---|-------|
| Maintaining websites or web pages for others<br>Hosting computer sites (websites)<br>Consultancy in the field of computer hardware and software | 42    |

### Computer software

The unqualified terms “computer software”, “non-downloadable computer software”, “software as a service (SaaS)” and the like are considered too broad and too vague, as they do not precisely indicate the type of software that the applicant provides.

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 specify the type of computer software provided.

For example:

- Computer game software
- Software for accounting purposes
- Software as a service (SaaS) for business management purposes

### **Databases**

The provision of database services including the term “providing databases” is considered to be too broad and too vague as the exact nature of the services included within this description is unclear. Database services are classified in more than one class according to the nature of the services being provided.

Moreover, where the provision of database services relates to the provision of information by means of a computer database, then this service is classified according to the subject matter of the information being provided.

Where a specification includes the term “providing databases”, “providing database services” or similar and the applicant has not specified the exact nature of these services, 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.

IPONZ classifies the provision of database services as follows:

| Specification | Class |
|---------------|-------|
|---------------|-------|

| Specification  | Class |
|--|-------|
| Computerised database management<br>Compilation of information into computer databases<br>Systemisation of information into computer databases   | 35    |
| Leasing access time to a computer database   | 38    |
| <a href="#">Storage-Physical storage services for archiving databases, images and other electronic data servers and databases</a>  | 39    |
| <a href="#">Database development services</a> Development of computer databases<br><a href="#">Computer database consultancy services</a> Consultancy relating to computer database programmes<br>Design of computer databases<br>Designing <a href="#">and implementing databases</a> database programmes for others<br><a href="#">Hosting databases</a><br>Creating and maintaining databases for others <a href="#">Hosting computer databases</a> | 42    |

[Provision of information by means of computer databases:](#)

The service of providing information by means of a computer database is classified according to the subject matter of the information being provided. The description of service should resemble these formats:

- providing a database in the field of [indicate specific service-related field]”, or
- providing an online computer database in the field of [indicate specific service-related field].

For example, the following specifications would be acceptable:

| Specification  | Class |
|--|-------|
| Provision of commercial business information by means of a computer database | 35    |

| Specification   | Class |
|---|-------|
| Providing a database on financial information by means of a global computer network             | 36    |
| Providing an interactive computer database in the field of travel via a global computer network | 39    |
| Providing a database in the field of entertainment  | 41    |

### Electronic business services or E-business services

See also [Electronic commerce services or E-commerce services](#)

The term “e-business” covers a wide range of services including electronic commerce services. The term e-business is commonly used to refer to business that is conducted via electronic means, including over the Internet, as well as other computer networks or wireless communications and can also encompass all forms of electronic trading. However, the term “e-business” and similar do not indicate the nature of the service that is being provided and as such could be classified in several classes.

Therefore, the unqualified term “electronic business” or “e-business” is not considered sufficient to describe the relevant services in a specification. Where a specification includes the unqualified term “electronic business” or “e-business”, 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.

### Electronic commerce services or E-commerce services

Electronic commerce is a broad term encompassing services that can be classified in several classes.

According to [www.whatis.com](http://www.whatis.com), the term e-commerce covers the following areas:

~~E-tailing, “virtual storefronts” and the “virtual mall”.~~

~~The gathering and use of demographic data through Web contacts.~~

~~Electronic Data Interchange (EDI), the business-to-business exchange of data.~~

~~E-mail and fax, and their use as media for reaching prospective and established customers.~~

~~Business-to-business buying and selling.~~

### The security of business transactions.

The unqualified term “electronic commerce” or “e-commerce” is not sufficient to describe the relevant services in a specification. Where a specification includes the unqualified term “electronic commerce” or “e-commerce”, 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.

Electronic commerce can be classified as follows:

| Specification   | Class |
|---|-------|
| Retail and wholesale of goods and services over the Internet<br><a href="#">Gathering demographic data, demographic consultancy</a><br><a href="#">Market research services</a> | 35    |
| Electronic data interchange<br>Computer-aided transmission of data, messages and images<br><a href="#">Electronic mail services, facsimile services</a>                         | 38    |
| <a href="#">Data encryption services</a><br><a href="#">Computer security services</a><br><a href="#">Consultancy services in relation to computer security</a>                 | 42    |

### **Internet and online services**

The provision of Internet or online services including the terms “providing Internet services”, “providing online services” or similar, is considered to be too broad and too vague as the exact nature of the services included within these descriptions is unclear. Internet or online services can be classified in more than one class according to the nature of the services.

Moreover, where the provision of the Internet or online service relates to the provision of information or to the provision of the service itself, then this service is classified according to the subject matter of the information being provided.

Where a specification does not specify the exact nature of the Internet or online service, a concern will be raised under section 32(2) of the Act.

IPONZ classifies the provision of Internet and online services as follows:

| Specification | Class |
|---------------|-------|
|---------------|-------|

| Specification  | Class |
|--|-------|
| Operation of chat rooms<br>Providing chat room services<br>Providing search engines for obtaining data on the Internet<br>Electronic transmission of data and documents via computer terminals<br>Electronic bulletin board services (telecommunications services) | 38    |
| Design and development of search engines<br>Development, maintenance and updating of a telecommunication network search engine   | 42    |

#### A. Service providers

Services provided by means of the Internet or online are classified according to the underlying service. Entities providing services over the Internet or online are considered service providers.

The description of the services should resemble these formats:

| Specification   | Class |
|---|-------|
| <del>Advertising and promotion services provided over the Internet</del><br><del>Online retailing services (Practice Guideline Amendment 2007/08, IPONZ Newsletter, November 2007)</del><br><del>Online ordering services in the field of...[specify goods]</del> | 35    |
| <del>Banking and financial services provided over the Internet</del>  | 36    |
| <del>Travel reservation services provided over the Internet</del>   | 39    |
| <del>Electronic games services provided over the Internet</del>   | 41    |

#### B. Content providers

The service of providing information by means of the Internet or online is classified according to the information subject. Entities that provide information over the Internet or online are considered

content providers, that is, they provide the substantive content for a website or web page. The description should not be phrased in terms of “providing access”.

The description of the service should resemble these formats:

- providing information in the field of [indicate specific service-related field]; or
- providing a website in the field of [indicate specific service-related field].

For example:

| Specification   | Class |
|---|-------|
| Providing financial information by means of a global computer network | 36    |
| Providing telecommunications information over the internet            | 38    |
| Providing a website in the field of entertainment                     | 41    |
| Providing a website on women’s health                                 | 44    |

### C. Telecommunication providers

The service of providing telecommunications connections to a global computer network is classified in **class 38**. Entities that provide this service provide the telecommunications connections by which one computer can communicate with another.

The **telecommunications provider** does not provide the computer hardware that stores and processes the data, or the information itself. The telecommunications provider provides only the means by which the data or information is transferred. This service connects the user to the access provider or the website itself. The telecommunications provider charges the access provider or the user for cost of the telephone connections.

### D. Access providers

The service of “providing user access to a global computer network (service providers)” is classified in **class 38**. This service is that of the **access provider**, that is, entities that provide the computer service that enables computer users to access databases and home pages of others.

The **access provider** provides the computer/server connection required for computer users to access a content provider. Internet access providers make an initial charge to the user for the computer connection to the Internet, and then charge the user for any time spent connected to the Internet.

The word “access” should only be used to describe the services of access providers. It should not be used to describe the services of a content provider.

### **Media**

The unqualified term “media” is not considered sufficient to describe the relevant goods in a specification but is acceptable when used in conjunction with a description that adequately describes the type of media. For example, recording media and optical data media are acceptable.

Where a specification of goods includes the unqualified term “media”, a concern will be raised under section 32(2) of the Act. The applicant will be asked to qualify this term by specifying the exact goods in respect of which registration is desired.

### **Networks**

The unqualified term “networks” or “network services” is not considered sufficient to describe the relevant services in a specification but is acceptable when used in conjunction with a description that adequately describes the type of network. For example, the term “communications network” is acceptable.

Where a specification of goods includes the unqualified term “networks”, a concern will be raised under section 32(2) of the Act. The applicant will be asked to qualify this term by specifying the exact goods in respect of which registration is desired.

### **Online services**

See *Internet services*.