



Practical guidance for comparing goods and services

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** This document contains the answers to questions submitted by the audience during the webinar that could not be answered during the live session.*

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Questions and answers – Practical Guidance for comparing goods and services

My layout of the TMview is different. Is this normal?

We did not show TMview during this Webinar but only **TMclass** and **Similarity Tool**.

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When determining whether a mark has been used for a particular product (for instance, in a cancellation action based on non-use), does the Office basically apply the same reasoning it uses in an assessment for confusion, when trying to determine whether the concerned products are identical?

 **Yes**

The scope of protection of a term will be assessed in the same way both when it comes to comparing goods and services and when considering whether the use of a trade mark constitutes use for goods or services for which it is registered.

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Where can I find this tool on the EUIPO website?

Both the Similarity Tool and TMclass can be found on the **EUIPO's website** in the **'Search' section** which leads to the **page on 'Databases'**.

Both of these tools are found in the **sub-section 'European Union Intellectual Property Network (EUIPN) Databases'**.

Here are the **direct links** to these tools:

- **Similarity Tool:** <http://euipo.europa.eu/sim/>
- **TMclass:** <http://tmclass.tmdn.org/ec2/>

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I work primarily with Class 31 - a very specific product within Class 31 - *Rose plants*.

If somebody has an existing trade mark on a similar word mark with a goods description for *live plants*, but their product is a completely different type of plant - one not available in the same sales channels for example - should we still be able to overcome any issues relating to the goods, even though our 'goods' are classed as *live plants* as well?

Rose plants are a specific type of plant and are therefore covered by the scope of protection of the broader category of *live plants*.

The comparison of the goods and services **must be based on the wording indicated in the respective lists of goods/services**.

Any actual or intended use not stipulated in the list of goods/services is not relevant for this comparison since it must be limited to the goods/services on which the opposition is based and those against which it is directed.

However, if proof of use of the earlier mark is validly requested and the submitted evidence is sufficient for only some of the goods/services listed, the earlier mark will be deemed to be registered for only those goods/services and the examination will be restricted to the same ones.

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Tea excluding medicinal tea in Class 30 v medicinal tea in Class 5, are these similar?

 **Yes**

According to current EUIPO practice, **these goods are similar** because they **coincide in their nature, methods of use, distribution channels and relevant public**.

This can be seen from the following pair in the **Similarity Tool**: *herbal teas for medicinal purposes (Class 5) v tea (Class 30)*.

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If you offer a service (such as an airline booking system) via a downloadable software application, would the application be considered a product? A service? Or both?

In principle, **the question to be considered is whether the product or service in question has an independent economic value.** In other words, if it is usually provided in exchange for some form of (monetary) compensation.

If not, this would suggest that the product or service is a mere ancillary activity provided together with, or after, the purchase of the other product or service.

It should **also be considered whether the intention is to create, and later to maintain, an independent outlet for the product in the market or whether, on the other hand, the product would merely serve as a means, or way, of providing the service to consumers.**

This could help to determine whether what is being offered should be protected as a product or a service, or potentially as both depending on the specific circumstances as referred to above.

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About *software* (e.g *game software*) Class 9 are *computer software* of Class 9 concern only downloadable software instead of remote software (e.g 41 *entertainment service via internet platform*)?

Software in Class 9 refers to recorded or downloadable software which is installed on one's own device whereas **remote software**, or **software as a service (SaaS)**, including for gaming, is a service in **Class 42** (see for example the term *software as a service [SaaS] featuring software platforms for electronic gaming* in TMclass). This service refers to providing non-downloadable software over the internet that is hosted on the service providers' servers.

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Why is usually assessed that retail services for certain goods are only similar to a low degree to such goods? Aren't retail services essential to commercialising such goods? i.e. without vendors, there could be no way of purchasing the goods.

The **EUIPO's guidelines on Comparisons of G&S in the [Specific Industries annex](#)**, section [5.6.2.1](#) on retail services, states that **retail services concerning the sale of specific goods are similar to an average degree to these specific goods** (20/03/2018, T-390/16, DONTORO dog friendship (fig.)/TORO et al., EU:T:2018:156, § 33; 07/10/2015, T-365/14, TRECOLORE / FRECCIE TRICOLORI et al., EU:T:2015:763, § 34).

Although the nature, purpose and methods of use of these goods and services are not the same, they display similarities, because they are complementary and the services are generally offered in the same places as those where the goods are offered for sale. Furthermore, they target the same public.

The goods covered by the retail services and the specific goods covered by the other mark have to be identical to find an average degree of similarity between the retail services of those goods and the goods themselves, that is to say, they must either be exactly the same goods or fall under the natural and usual meaning of the category. For other scenarios concerning retail of goods v goods that are not identical, see the relevant section of the EUIPO's guidelines as referred to above.

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I think we have a similar example in the webinar (*Class 30 10 would be tea v Class 5 medical tea*), but it was not clear enough to me. In this regard, I was wondering whether *shoes for medical purposes* in Class 10 would be similar to a low degree to *footwear* in Class 25. In fact, if remember well, there was a case about the similarity of these kind of products.

According to **current EUIPO practice**, *orthopedic footwear* in Class 10 is **similar to a low degree** to *footwear* in Class 25 because they **coincide** in their nature, methods of use and relevant public.

This can be seen from a pair to this effect in the Similarity Tool.

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Would charging stations for electric vehicles be considered similar to vehicles?

According to **current EUIPO practice**, **electric batteries for vehicles** (also covered by the broader term *apparatus, instruments and cables for electricity*) in **Class 9 are considered similar** to **vehicles** in **Class 12** and there are pairs to this effect in the Similarity Tool.

However, there is no set practice when it comes to other types of apparatus for electricity, such as charging stations for electric vehicles.

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It is also considered as evidence prior decisions of the Opposition Division in which has been already established a similarity?

The EUIPO is not bound by previous decision of the Opposition Division, since each case has to be dealt with separately and with regard to its particularities.

However, even though previous decisions are not binding, **their reasoning and outcome should still be duly considered when deciding upon the case in question.**

Nevertheless, **a coincidence of the goods/services** in question in sufficient Canon criteria and other factors for a finding of similarity between them **should always be assessed independently and irrespectively of any previous decisions of the Opposition Division.**

The comparison of goods and services should also take into account and follow any applicable pairs in the Similarity Tool, either directly or by analogy, since they reflect current EUIPO practice that may change over time.

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If a wine is related to a PGI ,does that influence the comparison with other alcoholic drink?

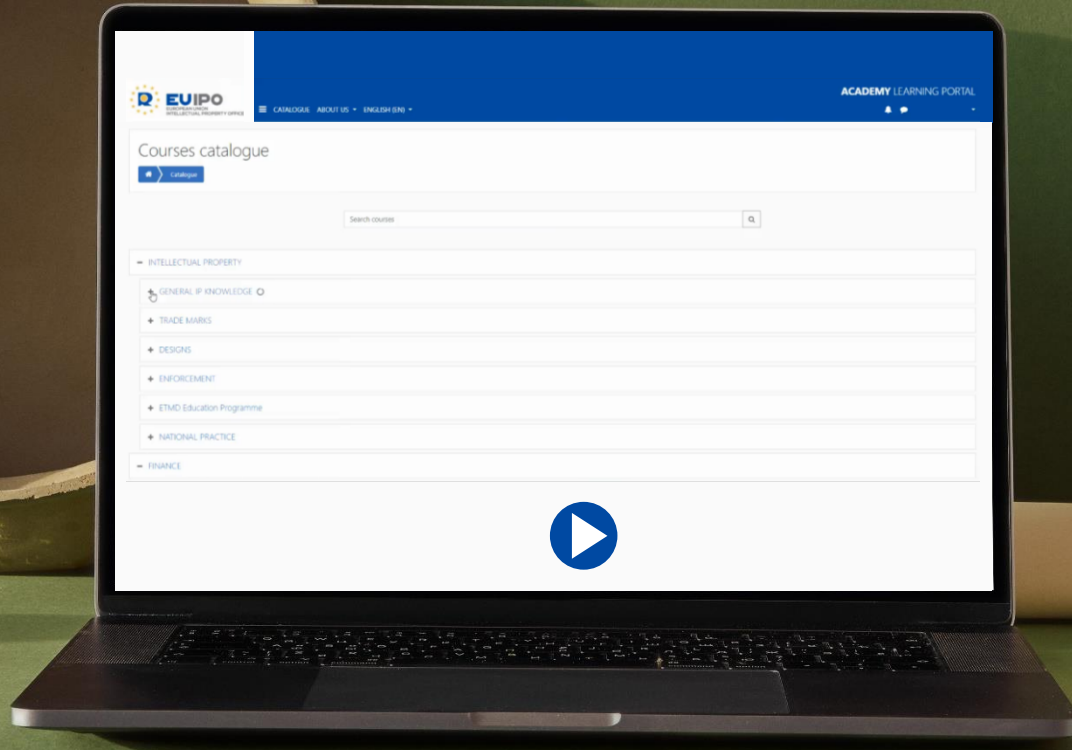
Currently the EUIPO has not set any practice when it comes to comparing wine or other alcoholic beverages of different geographical origin.

However, **the indication of the geographical origin of a wine may constitute a relevant consideration when the product is purchased insofar as it may**, for the consumer, be an indication of the specific qualities inherent in that wine. This could be the case especially when the different geographical origins of the goods in question imply that they concern different types of wine or other alcoholic beverages.

Nevertheless, **according to the EUIPO's guidelines on proof of use, the geographical origin of the goods is not relevant to this extent.**

Even if the geographical origin of wines is an important factor when they are being chosen, such a factor is not so important that wines with different appellations of origin could constitute subcategories of goods that could be viewed autonomously (30/06/2015, T-489/13, VIÑA ALBERDI / VILLA ALBERTI, EU:T:2015:446, § 37).

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