

***GUIDELINES FOR EXAMINATION OF  
EUROPEAN UNION TRADE MARKS***

***EUROPEAN UNION  
INTELLECTUAL PROPERTY OFFICE  
(EUIPO)***

***PART C***

***OPPOSITION***

***SECTION 2***

***DOUBLE IDENTITY AND  
LIKELIHOOD OF CONFUSION***

***CHAPTER 2***

***COMPARISON OF  
GOODS AND SERVICES***

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## 1 Introduction

### 1.1 Relevance

The comparison of goods and services is primarily of relevance for the assessment of identity according to Article 8(1)(a) EUTMR and likelihood of confusion according to Article 8(1)(b) EUTMR. One of the main conditions for Article 8(1)(a) EUTMR is the identity of goods/services, while Article 8(1)(b) EUTMR requires the identity or similarity of goods/services. Consequently, if all goods/services are found to be dissimilar, one of the conditions contained in Article 8(1) EUTMR is not fulfilled and the opposition must be rejected without addressing the remaining sections of the decision<sup>1</sup>.

The criteria for the assessment of identity or similarity might also play a role when proof of use has been requested and the evidence has to be assessed in order to conclude whether the opponent showed use for the goods/services as registered. In particular, it is important to determine whether the goods and services for which the mark has been used belong to the category of goods and services for which the trade mark was registered. This is because, under Article 42(2) EUTMR, proof of use for a good or service that is merely similar to the good or service registered does not prove use for the registered good or service (see the Guidelines, Part C, Opposition, Section 6, Proof of Use).

Likewise, evidence of use of goods/services might also be relevant when examining a claim to enhanced distinctiveness. In such cases it is often necessary to examine whether the enhanced distinctiveness covers goods/services for which the earlier trade mark enjoys protection and which are relevant for the specific case, that is to say, which have been considered to be identical or similar to the goods/services of the contested EUTM (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark).

Furthermore, the outcome of the comparison of goods/services plays an important role for defining the part of the public for whom likelihood of confusion is analysed because the relevant public is that of the goods/services found to be identical or similar (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 3, Relevant Public and Degree of Attention).

The comparison of goods/services may also be relevant under Article 8(3) EUTMR, which requires the identity or 'close relation or equivalence in commercial terms' of goods/services (see the Guidelines, Part C, Opposition, Section 3, Unauthorised Filing by Agents of the TM Proprietor (Article 8(3) EUTMR)), and under the applicable provisions of national law under Article 8(4) EUTMR, since identity or similarity of the goods/services is often a condition under which the use of a subsequent trade mark may be prohibited (see the Guidelines, Part C, Opposition, Section 4, Rights under Article 8(4) EUTMR). Furthermore, under Article 8(5) EUTMR, the degree of similarity or dissimilarity between the goods or services is a factor that must be taken into account when establishing whether or not the consumer will perceive a link between the marks. For example, the goods or services may be so manifestly dissimilar that use of the later mark on the contested goods or services is unlikely to bring the earlier mark

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<sup>1</sup> Equally, the comparison of goods and services is of relevance in invalidity proceedings, since pursuant to Article 53(1)(a) EUTMR, a registered European Union trade mark is declared invalid where the conditions set out in Article 8(1) EUTMR are fulfilled.

to the mind of the relevant public (see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR)).

## 1.2 Nice Classification: a starting point

Article 28(1) EUTMR requires that the goods/services to be compared are classified according to the Nice Classification. Currently the Nice Classification consists of 34 classes (1-34) to categorise goods and 11 classes (35-45) to categorise services.

### 1.2.1 Its nature as a classification tool

The Nice Classification was set up with the aim of harmonising national classification practices. Its first edition entered into force in 1961. Although it has undergone several revisions, it sometimes lags behind the rapid changes in product developments in the markets. Furthermore, the wording of the headings is sometimes unclear and imprecise.

The Nice Classification serves purely administrative purposes and, as such, does not provide in itself a basis for drawing conclusions as to the similarity of goods and services.

In accordance with Article 28(7) EUTMR, the fact that the respective goods or services are listed in the same class of the Nice Classification is not, in itself, an indication of similarity.

#### Examples

- *Live animals* are dissimilar to *flowers* (Class 31).
- *Advertising* is dissimilar to *office functions* (Class 35).

The fact that two specific goods/services fall under the same general indication of a class heading does not per se make them similar, let alone identical: *cars* and *bicycles* — although both fall under *vehicles* in Class 12 — are considered dissimilar.

Furthermore, goods/services listed in different classes are not necessarily considered dissimilar (judgment of 16/12/2008, T-259/06, Manso de Velasco, EU:T:2008:575, § 30-31).

#### Examples

- *Meat extracts* (Class 29) are similar to *spices* (Class 30).
- *Travel arrangement* (Class 39) is similar to *providing temporary accommodation* (Class 43).

### 1.2.2 Its structure and methodology

Classification may serve as a tool to identify the common characteristics of certain goods/services.

Many classes of the Nice Classification are structured according to factors such as function, composition and/or purpose of use which may be relevant in the comparison of goods/services. For example:

- Class 1 comprises chemical goods primarily based on their chemical properties (nature), rather than on their specific application. In contrast, Class 3 covers all items that are either cleaning preparations or for personal hygiene or beautification. Although they can by their nature also be classified as chemical products, it is their specific purpose that allows a distinction and thus a different classification.
- Equally, it is because of their nature that most items made of leather are classified in Class 18, whereas clothing made of leather falls under Class 25 since it serves a very specific purpose, namely for wear by people and as protection from the elements.

### 1.2.3 Conclusions to be drawn from the structure of the Nice Classification

The structure of the class headings is not uniform and does not follow the same logic. Some classes consist of only one general indication that by its definition already covers nearly all the goods/services included in this class (Class 15 *musical instruments*; Class 38 *telecommunications*). Some others include many general indications, some being very broad and others very specific. For example, the heading of Class 9 includes more than 30 terms, ranging from *scientific apparatus and instruments* to *fire-extinguishing apparatus*.

Exceptionally, there are class headings containing general indications that include another general indication and are thus identical.

Example: *materials for dressing* in Class 5 include *plasters* in Class 5.

Other specific indications in a class heading are only mentioned to clarify that they do not belong to another class.

Example: *adhesives used in industry* are included in *chemicals used in industry* in Class 1. Its reference is mainly thought to distinguish them from *adhesives* classified in Class 16, which are for stationery or household purposes.

To conclude, the Nice Classification gives indications that can be used in the assessment of identity or similarity of goods/services. However, its structure and content is not coherent. Therefore, each heading or specific term has to be analysed according to the specific class under which it is classified. As stated before, the Nice Classification mainly serves to categorise the goods/services for administrative purposes and is not decisive for their comparison.

### 1.2.4 Changes in the classification of goods/services

Normally, with each revision of the Nice Classification there are changes in the classification of goods/services (in particular the transfer of goods/services between various classes) or in the wording of headings. In such cases the list of goods/services of both the earlier and the contested mark must be interpreted according to the edition of the Nice Classification at its moment of filing.

### Example

- *Legal services* were transferred from Class 42 to Class 45 with the eighth edition of the Nice Classification. The nature of these services has not changed.
- *Vending machines* were transferred from Class 9 to Class 7 in the 10th edition of the Nice Classification, since a vending machine is basically a powered machine and as such was considered more appropriately classified in Class 7 with other machinery. However, since the nature of these goods has not changed, *vending machines* classified in different classes due to different filing dates of the respective applications are regarded as identical.

## **1.3 The Similarity Tool (ETMDN) for the comparison of goods/services**

The [Similarity Tool](#) for the comparison of goods and services is a search tool to help and support examiners in assessing the similarity of goods and services. The Similarity Tool serves to harmonise practice on the assessment of similarity of goods and services and to guarantee coherence of opposition decisions. The Similarity Tool must be followed by examiners.

The Similarity Tool is based on the comparison of specific pairs of goods and services. A 'pair' compares two 'terms'. A 'term' consists of a class number from the Nice Classification (1-45) and a textual element, that is to say, a specific good or service (including general categories of goods and services, such as *clothing* or *education*). There are five possible results of the search: identity, high degree of similarity, similarity, low degree of similarity and dissimilarity. For each of the degrees of similarity, the tool indicates which criteria lead to each result.

The Similarity Tool is constantly updated and if necessary revised in order to create a comprehensive and reliable source of reference.

Since the tool gives, or will give, answers to specific comparisons, the Guidelines concentrate on defining the general principles and their application in practice.

## **1.4 Definition of goods and services (terminology)**

### **1.4.1 Goods**

The EUTMR does not give a definition of goods and services. Although the Nice Classification gives some general explanations to this effect in its introductory remarks, it refrains from clearly setting criteria for the distinction between goods and services.

In principle, the word 'goods' refers to any kind of item that may be traded. Goods comprise raw materials (unprocessed plastics in Class 1), semi-finished products (plastics in extruded form for use in manufacture in Class 17) and finished products (plastic household containers in Class 21). They include natural and manufactured goods, such as agricultural products in Class 31 and machines and machine tools in Class 7.

However, sometimes it is not clear whether goods only comprise tangible physical products as opposed to services, which are intangible. The definition and thus the scope of protection are particularly relevant when it comes to ‘goods’ such as *electricity*, which are intangible. This question is already answered during the examination on classification and will usually not cause any problems in the comparison of goods and services.

#### 1.4.2 Services

A service is any activity or benefit that one party can offer to another that is intangible and does not result in the transfer of ownership of any physical object. In contrast to goods, a service is **always** intangible.

Importantly, services comprise economic activities provided to **third parties**.

- Advertising one’s own goods is not a service but running an advertisement agency (designing advertisement campaigns for third parties) is. Similarly *shop window dressing* is only a service when provided for third parties, not when done in one’s own shop.
- Selling or distributing one’s own goods is not a service. Retail services are meant to cover the services around the actual sale of goods, such as providing the customer with an opportunity to conveniently see, compare or test the goods. For more detailed information, see Annex II, paragraph 7, Retail services.

One indication for an activity to be considered a service under trade mark law is its independent economic value, that is to say, that it is usually provided in exchange for some form of (monetary) compensation. Otherwise, it could be a mere ancillary activity provided together with or after the purchase of a specific good.

#### Example

- Delivery, including the transport of furniture that has previously been purchased (either in a physical establishment or online), is not an independent service falling under *transport services* in Class 39.

However, the intention to make profit is not necessarily a criterion for defining whether an activity can qualify as a ‘service’ (judgment of 09/12/2008, C-442/07, Radetzky, EU:C:2008:696, § 16-18). It is more a question of whether the service has an independent market area and targeted public rather than the way or form in which compensation is made.

#### 1.4.3 Products

In common parlance the term ‘products’ is used for both goods and services, e.g. ‘financial products’ instead of financial services. Whether terms in common parlance are described as ‘products’ is immaterial for them being classified as goods or services.

## 1.5 Determining the goods/services

### 1.5.1 The correct wording

As a preliminary matter, the correct wording of the lists of goods/services under consideration must be identified.

#### 1.5.1.1 European Union trade marks

An application for an EUTM will be published in all the official languages of the Union (Article 120(1) EUTMR). Likewise, all entries in the Register of European Union trade marks (the Register) will be in all these languages (Article 120(2) EUTMR). Both applications and entries in the Register are published in the EUTM Bulletin (Rule 85(1) and (2) EUTMIR).

In practice, occasional discrepancies may be found between:

- the translation of the wording of the list of goods and/or services of an EUTM (application or registration) published in the EUTM Bulletin, and
- the original wording as filed.

In cases of such a discrepancy, the definitive version of the list of goods and services is:

- the text in the first language if the first language is one of the five languages of the Office.
- the text in the second language indicated by the applicant (see Article 120(3) EUTMR) if the first language of the application is not one of the five languages of the Office.

This applies regardless of whether the EUTM (or EUTM application) is the earlier right or the contested application.

#### 1.5.1.2 Earlier national marks and international registrations

The list of goods and services of the earlier marks on which the opposition is based must be submitted in the language of the opposition proceedings (Rule 19(3) EUTMIR). The Office does not require any certified translation and accepts simple translations, drawn up by the opponent or its representative. The Office normally does not make use of its faculty under Rule 98(1) EUTMIR, second sentence, to require the translation to be certified by a sworn or official translator. Where the representative adds a declaration that the translation is true to the original, the Office will in principle not question this. The other party may, however, question the correctness of the translation during the adversarial part of the proceedings. (See the Guidelines, Part C, Opposition, Section 1, Procedural Matters).

For international registrations under the Madrid Agreement or Protocol, the language in which the international registration was registered is definitive (French, English or Spanish). However, where the language of the opposition procedure is not the

language of the international registration, a translation must be supplied as for earlier national marks.

### 1.5.2 The relevant scope

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 the comparison since this comparison is part of the assessment of likelihood of confusion in relation to the goods/services on which the opposition is based and directed against; it is not an assessment of actual confusion or infringement (judgment of 16/06/2010, T-487/08, Kremezin, EU:T:2010:237, § 71).

However, if proof of use of the earlier mark is validly requested and the submitted evidence is sufficient only for part of the goods/services listed, the earlier mark is deemed to be registered for only those goods/services (Article 42(2) EUTMR), and consequently the examination is restricted to those goods/services (see the Guidelines, Part C, Opposition, Section 6, Proof of Use).

Moreover, in the case of the earlier mark, only the goods and services on which the opposition is validly based are pertinent. Hence, no account will be taken of the goods/services:

- that cannot be taken into account for reasons of admissibility,
- that have not been properly substantiated (e.g. only a partial translation of the list of goods/services was filed), or
- on which the opposition is not, or is no longer, based.

Similarly, only those goods and services of the contested application against which the opposition is directed are taken into consideration. Consequently, restrictions during the proceedings of either the list of goods/services of the application, or the goods/services on which the opposition is based, or of both, will limit the goods and services to be compared.

Furthermore, an analysis of the wording of the list of goods/services might be required to determine the scope of protection of those goods and services. This is especially true where terms such as **in particular**, **namely**, or equivalents are used in order to show the relationship of an individual product with a broader category.

The term **in particular** (or **for example**, **such as**, **including** or other equivalent) indicates that the specific goods/services are only examples of items included in the category, and that protection is not restricted to them. In other words, it introduces a non-exhaustive list of examples (on the use of **in particular** see the reference in judgment of 09/04/2003, T-224/01, Nu-tride, EU:T:2003:107).

On the other hand, the term **namely** (or **exclusively** or other equivalent) is exclusive and restricts the scope of the registration only to the specifically listed goods.

For example, in the case of *chemicals used in industry, namely raw materials for plastics* only the *raw materials for plastics* need to be compared with the goods of the other mark.

It should be recalled that the use of commas in the list of goods/services serves to separate items within the same or a similar category. The use of a semicolon means a separation between terms. The separation of terms by different punctuation can lead to changes in their meaning and may lead to a different assessment when comparing the goods/services. For more information on punctuation in lists of goods and services, see the Guidelines, Part B, Examination, Section 3, Classification.

For example, in *computer software for use with industrial machines; fire extinguishers* in Class 9, the inclusion of a semicolon means that the term '*fire extinguishers*' must be considered as an independent category of goods, regardless of whether the intention was to protect computer software to be used in the field of industrial machines and fire extinguishers.

### 1.5.3 The meaning of goods/services

Once the wording of the goods and services to be considered has been identified, their meaning must be determined.

In some cases the exact meaning is immediately obvious from the list of goods and/or services of the marks where a more or less detailed description of the goods and services will often be given. For example, the wording *belts, being articles of clothing* excludes by definition safety or industrial belts.

In cases of doubt about the exact meaning of the terms used in the list of goods and/or services, these terms have to be interpreted both in the light of the Nice Classification and from a commercial perspective.

Therefore, *belts* in Class 25 are due to their classification *articles of clothing*.

Where the meaning of terms in a semantic context, a commercial context and/or under the Nice Classification are ambiguous or leave some doubts, the meaning they have under the Nice Classification prevails.

*Clothing*, for instance, refers to 'clothes collectively' (see e.g. *Oxford English Dictionary*) and thus to items worn to cover the body, such as shirts, dresses, pants, etc. Although the definition found in standard dictionaries does not explicitly exclude *footwear*, the fact that it appears in the Nice Classification as a separate item in the same Class 25 leads to the conclusion that *clothing* and *footwear* are not identical but similar (confirmed by judgment of 13/07/2004, T-115/02, 'a' in a black ellipse, EU:T:2004:234, § 26).

However, that does not mean that two general indications of one class heading can never be considered identical. As mentioned above, the structure of the class headings is not uniform. Some general indications included in the class headings may encompass others.

#### Example

- *Meat* and *poultry* are identical (Class 29).

## 1.6 Objective approach

The comparison of the goods/services in question must be made **without** taking into account the degree of similarity of the conflicting signs or the distinctiveness of the earlier mark. It is only in the overall assessment of a decision that the examiners will take into account all the relevant factors.

The classification of the goods or services is not conclusive, because similar goods/services may be classified in different classes, whereas dissimilar goods/services may fall within the same class.

Identity or similarity of the goods/services in question must be determined on an objective basis.

It is necessary to base the findings on the realities of the marketplace, such as established customs in the relevant field of industry or commerce. These customs, especially trade practices, are dynamic and constantly changing. For instance, mobile phones nowadays combine many functions such as being communication tools as well as photographic apparatus.

The degree of similarity of the goods and services is a matter of law, which must be assessed *ex officio* by the Office even if the parties do not comment on it<sup>2</sup>. However, the Office's *ex officio* examination is restricted to well-known facts, that is to say, 'facts that are already well known or which may be learned from generally accessible sources', which excludes facts of a highly technical nature (judgment of 03/07/2013, T-106/12, Alpharen, EU:T:2013:340, § 51). Consequently, what does not follow from the evidence/arguments submitted by the parties or is not commonly known should not be speculated on or extensively investigated *ex officio* (judgment of 09/02/2011, T-222/09, Alpharen, EU:T:2011:36, § 31-32). This follows from Article 76(1) EUTMR, according to which, in opposition proceedings, the Office is restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought. (See also the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 1, General Principles).

## 1.7 Statement of reasons

The examiner is required to reason the outcome of the comparison (identity, similarity or dissimilarity) for each of the individual goods and services specified in the application for registration. However, the examiner may use only general reasoning for groups of the goods or services concerned as long as the goods or services present analogous characteristics (see by analogy order of 18/03/2010, C-282/09 P, P@yweb card/Payweb card, EU:C:2010:153, § 37-38, judgments of 12/04/2011, T-28/10, Euro automatic payment, EU:T:2011:158, § 54; 17/10/2013, C-597/12 P, Zebexir, EU:C:2013:672, § 26-27).

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<sup>2</sup> Judgment of 16/01/2007, T-53/05, Calvo, EU:T:2007:7, § 59.

## 2 Identity

### 2.1 General principles

Identity is generally defined as ‘the quality or condition of being the same in substance, composition, nature, properties, or in particular qualities under consideration’ (*Oxford English Dictionary*).

Identity exists not only when the goods and services completely coincide (the same terms or synonyms are used), but also when and insofar as the contested mark’s goods/services fall within the broader category of the earlier mark, or when and insofar as — conversely — a broader term of the contested mark includes the more specific goods/services of the earlier mark. There might also be identity when two broad categories under comparison coincide partially (‘overlap’). Hence a distinction can be made between cases of ‘full identity’ and ‘partial identity’.

Identity should not be established on the basis of similarity factors (see paragraph 3.1.1 below).

### 2.2 Identical terms or synonyms

Identity between the goods/services in dispute must be established on the basis of the wording of the relevant parts of the lists of goods and/or services of the two marks that have been identified in accordance with the principles set out above. Identity is obvious where the goods/services to be compared are listed in exactly the same terms.

#### Example

- *Vehicles* are identical to *vehicles*.

Where this is not the case, the terms of the respective lists of goods and/or services must be interpreted in order to show that they are in fact synonyms; that their meaning is the same. The interpretation can be made based on dictionary definitions, expressions from the Nice Classification and in particular taking into account the commercial perspective.

#### Examples

- *Bicycle* is a synonym for *bike*. The goods are identical.
- The meaning of the words *smokers’ articles* in Class 34 refers to individual objects that are used in close connection with tobacco or tobacco products. In former editions of the Nice Classification these products were called *smokers’ requisites*. Therefore, despite a different term used in the current heading, these goods are identical.
- From a commercial perspective, *health spa services* and *wellness services* are the same and are therefore identical.

However, if an identical wording is used but the goods are classified in different classes, this generally means that these goods are not identical.

### Examples

- *Drills* (machine tools) in Class 7 are not identical to *drills* (hand tools) in Class 8.
- *Lasers* (not for medical treatment) in Class 9 are not identical to *lasers* (for curative purposes) in Class 10.

Even though they might be similar, the classification in different classes indicates that they have a different nature, purpose or method of use, etc.

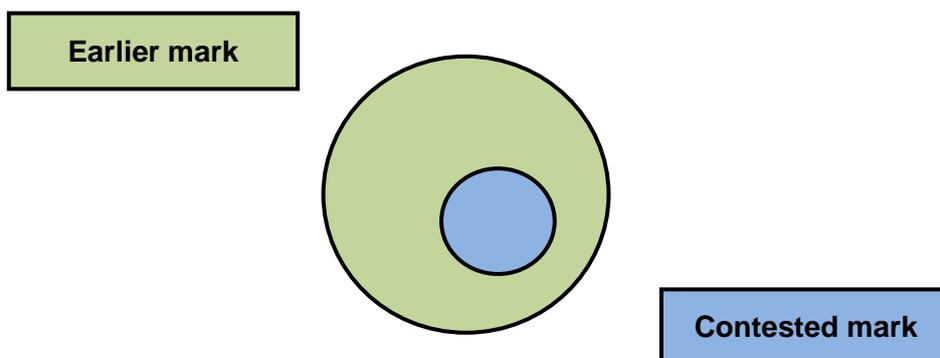
The same reasoning does not apply if the different classification is only due to a revision of the Nice Classification or where it is clear that the goods/services are wrongly 'classified' due to an obvious mistake.

### Examples

- *Playing cards* (Class 16 — 7th edition) are identical to *playing cards* (Class 28 — 10th edition).
- *Pharmaceutical preparations* (Class 15, obvious typing error) are identical to *pharmaceutical preparations* (Class 5).

## **2.3 Terms included in general indication or broad category**

### 2.3.1 The earlier mark includes the goods/services of the contested mark



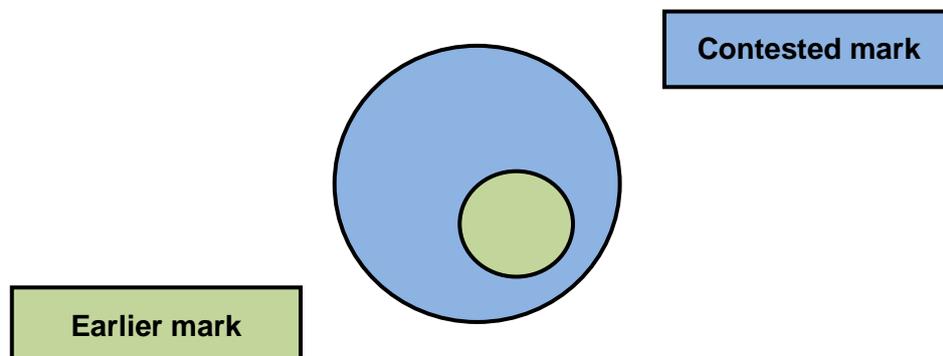
Where the list of goods/services of the earlier right includes a general indication or a broad category that covers the goods/services of the contested mark in their entirety, the goods/services will be identical (judgment of 17/01/2012, T-522/10, Hell, EU:T:2012:9, § 36).

### Examples

- *Temporary accommodation* (earlier right, Class 43) includes *youth hostel services* (contested mark, Class 43). Therefore, the services are identical.

- *Pasta* (earlier right, Class 30) includes *spaghetti* (contested mark, Class 30). The conflicting goods are considered identical.

### 2.3.2 The contested mark includes the goods/services of the earlier mark



If the goods/services designated in the earlier mark are covered by a general indication or broad category used in the contested mark, these goods/services must be considered identical since the Office cannot dissect *ex officio* the broad category of the applicant's/holder's goods/services (judgment of 07/09/2006, T-133/05, Pam-Pim's Baby-Prop, EU:T:2006:247, § 29).

#### Examples

- The earlier mark's *jeans* (Class 25) are included in *articles of clothing* (contested mark, Class 25). The goods are considered identical.
- The earlier mark's *bicycles* (Class 12) are included in *vehicles* (contested mark, Class 12). The goods are considered identical.

The applicant/holder may however restrict the list of goods/services in a way that excludes identity, but could still lead to similarity (judgment of 24/05/2011, T-161/10, E-Plex, EU:T:2011:244, § 22).

- The earlier mark's *jeans* (Class 25) are included in *articles of clothing* (Class 25). The applicant/holder restricts the specification to *articles of clothing, excluding jeans*. The goods are no longer identical but remain similar.
- The earlier mark's *bicycles* (Class 12) are included in *vehicles* (contested mark, Class 12). The applicant/holder restricts the specification to *vehicles, namely automobiles*. The goods are no longer identical or similar.

If the applicant/holder does not restrict the list of goods/services, or does so in an insufficient way, the Office will treat the contested mark's general indication or broad term/category as a single unit and find identity.

If the contested mark covers a general indication or a broad term/category as well as specific items that fall under that general indication or broad term/category, all of these will need to be compared with the specific earlier goods/services. The result of identity

found with the general indication or broad term/category does not automatically extend to the specific items.

#### Example

- The contested mark covers *vehicles* (general indication) as well as *bicycles*, *aircraft*, *trains* (included in vehicles). Where the earlier mark is protected for *bicycles*, identity will be found with respect to *vehicles* and to *bicycles* but not for *aircraft or trains*.

However, if the contested mark covers a general indication or broad term/category and specific terms that are not listed independently but only as examples, the comparison differs insofar as only the general indication or broad term/category has to be compared.

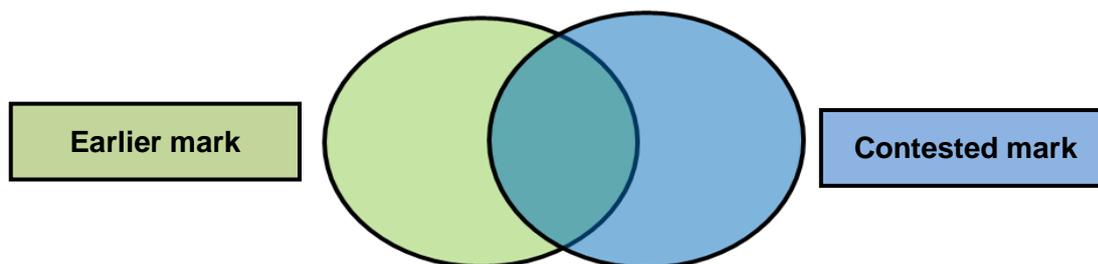
#### Example

- The contested mark covers *vehicles*, ***in particular bicycles***, *aircraft*, *trains*. The earlier mark is protected for *bicycles*. The goods in conflict are considered identical.

The applicant/holder can avoid this result by deleting the general indication *vehicles*, the expression *in particular*, and the specific category *bicycles*.

Where the list of goods and/or services of the contested mark reads: *vehicles*, ***namely bicycles***, *aircraft*, *trains*, the comparison differs insofar as only the specific items have to be compared. In this case only the contested *bicycles* are identical to the earlier goods.

## 2.4 Overlap



If two categories of goods/services coincide partially ('overlap') there might be identity if:

- a. they are classified in the same class;
- b. it is impossible to clearly separate the two goods/services.

Examples

Earlier goods	Contested goods	Coinciding part
<i>Outdoor clothing for women.</i>	<i>Clothing made of leather</i>	Outdoor clothing for women made of leather
<i>Components and spare parts for land vehicles</i>	<i>Vehicle seats</i> <sup>3</sup>	Seats for land vehicles
<i>Bread</i>	<i>Long-life bakery products.</i>	Long-life bread
<i>Electric kitchen utensils</i>	<i>Thermometers</i> <sup>4</sup>	Electric kitchen thermometers
<i>Soap</i>	<i>Cleaning preparations</i>	Soaps for cleaning purposes
<i>Scientific instruments</i>	<i>Optical instruments</i>	Scientific optical instruments, e.g. microscopes
<i>Online banking services</i>	<i>Commercial banking services</i>	Online commercial banking services

In such cases, it is impossible for the Office to filter these goods from the abovementioned categories. Since the Office cannot dissect *ex officio* the broad category of the applicant's/holder's goods, they are considered to be identical.

In the fifth example given above, the outcome changes of course if *soap* is limited to *soaps for personal use*. In this case the goods are no longer included in the heading *cleaning preparations* in Class 3 since the latter is only for household use.

## 2.5 Practice on the use of general indications of the class headings

In accordance with Article 28(3) EUTMR the Office does not object to the use of any of the general indications of the class headings provided that this identification is sufficiently clear and precise<sup>5</sup>.

In accordance with Article 28(5) EUTMR, the use of general terms or general indications of the class headings will be interpreted as including all the goods or services clearly covered by the literal meaning of the indication or term. The use of such terms will not be interpreted as comprising a claim to goods or services that cannot be so understood.

Under Article 28(8) EUTMR, during the six-month period after the entry into force of the Amending Regulation, proprietors of EU trade marks filed before 22/06/2012 and registered for the entire heading of a Nice class have the opportunity to declare that their intention at the time of filing was to cover goods and services beyond the literal meaning of that class heading, provided that the goods or services declared are included in the alphabetical list for the class of the edition of the Nice Classification in force on the date of filing.

<sup>3</sup> Judgment of 09/09/2008, T-363/06, Magic seat, EU:T:2008:319, § 22.

<sup>4</sup> Judgment of 19/01/2011, T-336/09, Topcom, EU:T:2011:10, § 34.

<sup>5</sup> See the 'Common Communication on the Common practice on the General Indications of the Nice Class headings'.

During that six-month period, President's Communication No 2/12 of 20/06/2012 remains in force and therefore trade marks filed before 22/06/2012 and registered for an entire class heading are considered to cover the literal meaning of the general indications, as well as the goods and services of the alphabetical list of that class in the edition of the Nice Classification in force at the time of filing.

In accordance with Article 28(8) EUTMR, last sentence, from the expiry of the six-month period following the entry into force of the Amending Regulation, all EU trade marks registered in respect of the entire heading of a Nice class for which no declaration has been filed, will be deemed to extend only to goods or services clearly covered by the literal meaning of the indications included in the heading of the relevant class.

Declarations for EU trade marks filed within the relevant period will take effect from the moment of their entry in the Register.

Where the declaration is accepted and the Register is amended, Article 28(9) EUTMR will apply.

In accordance with Article 28(9) EUTMR, the amendment of a list of goods or services, recorded in the Register following a declaration under Article 28(8) EUTMR made during the six-month period after the entry into force of the Regulation, cannot give the proprietor of an EU trade mark the right to oppose or to apply for a declaration of invalidity of a later mark where and to the extent that (i) that later trade mark was in use, or an application had been made to register the later trade mark, for goods or services before the register was amended for the earlier mark and (ii) the use in relation to those goods or services did not infringe, or would not have infringed, the proprietor's rights based on the literal meaning of the goods or services recorded in the register at that time.

In practice, this means that where the earlier mark is an EU trade mark and the contested mark was filed, or was in use, before the register was amended under Article 28(8) EUTMR in relation to the earlier EU trade mark, the goods and services identified as going beyond the literal meaning of the class heading will not be taken into account in oppositions or declarations of invalidity filed after the entry into force of the Amending Regulation.

As regards the scope of protection of national marks, the Office and all national trade mark offices of the European Union issued a Common Communication on the implementation of the 'IP Translator' judgment (in the 'Common Communication on the implementation of IP Translator'). According to that Communication, the Office interprets the scope of protection of national marks containing class headings as follows:

- **Earlier national trade marks filed before the 'IP Translator' judgment:** In principle, the Office accepts the filing practice of all national trade mark offices in the European Union. National trade marks filed before the 'IP Translator' judgment have the scope of protection awarded by the national office(s). The majority of the national offices interpret the class headings of their marks literally. For those marks, the Office also interprets the class headings on the basis of the natural and usual meaning of each general indication.
- Only **eight** national trade mark offices do **not** interpret the class headings of their own marks filed before the 'IP Translator' judgment on the basis of their natural

and usual meaning: **Bulgaria, Finland, Greece, Hungary, Italy, Lithuania, Malta and Romania** (see Table 1 of the Common Communication). The Office interprets those national marks as covering the class headings plus the alphabetical list of the Nice edition at the time of filing (even if the national office interprets the class heading to cover all goods and services in the class).

- **Earlier national marks filed after the ‘IP Translator’ judgment:** the Office interprets all goods and services covered by the national marks on the basis of their natural and usual meaning (see Table 5 of the Common Communication).

In order to determine the scope of protection the abovementioned principles have to be applied. Only those goods or services deemed to be covered following these principles will be considered when making the comparison between the goods/services.

## 3 Similarity of Goods and Services

### 3.1 General principles

#### 3.1.1 Similarity factors

Generally speaking, two items are defined as being similar when they have some characteristics in common. The similarity of goods and services does not depend on any specific number of criteria that could be determined in advance and applied in all cases.

The similarity of goods and services has been addressed in the case-law of the Court of Justice in Canon (judgment of 29/09/1998, C-39/97, Canon, EU:C:1998:442). The Court of Justice held that in assessing the similarity of goods **all** the relevant factors relating to those goods themselves should be taken into account. Those factors include, inter alia, their nature, their end users [**should read ‘intended purpose’**], their method of use and whether they are in competition with each other or are complementary (para. 23).

The term **inter alia** shows that the enumeration of the above factors by the Court is only indicative. There may be other factors in addition to or instead of those mentioned by the Court that may be pertinent for the particular case.

This leads to the conclusion that the following factors should be taken into account:

#### Canon factors

- nature
- intended purpose
- method of use
- complementarity
- in competition.

#### Additional factors

- distribution channels

- relevant public
- the usual origin of the goods/services.

These factors will be further explained below (see ‘The specific similarity factors’); they are also used in the Office’s database on the comparison of goods and services. It should be noted, however, that even though the database is restricted to these eight factors, there might be specific cases where other criteria are relevant.

### 3.1.2 Defining relevant factors

The comparison should focus on identifying the relevant factors that specifically characterise the goods/services that are to be compared. Therefore, the relevance of a particular factor depends on the respective goods/services to be compared.

#### Example

- When comparing *skis* and *ski-boots* it is evident that they do not coincide in their nature or method of use and they are not in competition. Therefore, the comparison should focus on their purpose, their complementary character, their distribution channels, their usual origin and/or the relevant public.

Therefore, the relevant factors and features characterising a product or a service may be different depending on the goods and services they have to be compared with.

It is not necessary to list all possible factors. What does matter, however, is whether the connections between the relevant factors are sufficiently close to find similarity.

The following questions could be asked:

- How will the goods/services be used?
- What is their purpose?
- How likely is it that they coincide in producer?
- Are they usually found in the same outlet, department store or in the same section of a supermarket?

If the factors cannot already be defined from the wording of the goods/services, information may be derived from dictionary entries. However, dictionary entries have to be analysed against commercial realities and in particular taking into account the Nice Classification.

#### Example

- According to the dictionary, *ice* is the singular of *ices* and means inter alia ‘(an) ice cream’ or ‘water ice’ (*The Oxford English Dictionary, online edition*). If the comparison of *ices* and *ice* in Class 30 was done on the basis of the definition from the dictionary alone, it would lead to an erroneous conclusion that *ice* is identical to *ices*. However, since both *ices* and *ice* are mentioned in the list of goods in Class 30, *ices* are to be understood as ‘edible ices’, whereas *ice* is to be understood as ‘cooling ice’. Although they coincide in the composition to the extent that both consist (partly) of frozen water, their commercial nature is different: while one is a foodstuff the other is an auxiliary good for preserving

and/or cooling foodstuffs. It shows that the Nice Classification together with the commercial perspective prevail over the dictionary definition.

Once the relevant factors have been identified, the examiner must determine the relation between and the weight attributed to the relevant factors (see 'Relation between different factors' below).

## 3.2 The specific similarity factors

The following paragraphs define and illustrate the various factors for similarity of goods and services.

### 3.2.1 Nature

Nature of a product/service can be defined as the essential qualities or characteristics by which this product/service is recognised. Nature often corresponds to a particular type or sort of product/service or a specific category to which this product/service belongs and which is usually used to define it. In other words, it is the answer to the question 'What is it?'

#### Examples

- *Yoghurt* is a milk product;
- *Car* is a vehicle;
- *Body lotion* is a cosmetic product.

#### 3.2.1.1 Indicative value of class headings and categories

The fact that the goods/services to be compared fall under the same general indication of a class heading or broad category does not automatically mean that they have the same nature. An example of such a broad category is *foodstuffs for human consumption*.

#### Examples

- *Fresh fruit* (Class 31) on the one hand and *coffee, flour, and bread* (Class 30) on the other hand have a different nature despite being foodstuffs.
- *Meat, fish, poultry and game* (Class 29) are foodstuffs of animal origin. *Fruits and vegetables* (Class 31) are foodstuffs of plant origin. This slight connection, namely all being foodstuffs, does not preclude that their nature is different.

The fact that the goods/services to be compared fall under a sufficiently narrow general indication of a class heading favours an identical or similar nature.

### Example

- *Condensed milk* and *cheese* (both in Class 29) share the same nature because they belong to the same product category, namely milk products, which are a subcategory of foodstuffs (judgment of 4/11/2003, T-85/02, Castillo, EU:T:2003:288, § 33).

#### 3.2.1.2 Features of the goods defining their nature

A variety of features of the goods in question may be useful for defining their nature. These include the following:

**Composition:** e.g. ingredients, materials of which the goods are made.

### Example

- *Yoghurt* (Class 29) is a milk product (the nature of yoghurt may be defined by its basic ingredient).

Composition may be the most relevant criterion for defining nature. However, an identical or similar composition of the goods is not per se an indicator of the same nature.

### Example

- A *chair* (Class 20) and a *doll* (Class 28) can both be made of plastic, but they do not have the same nature since one is a piece of furniture and the other is a toy. They belong to different categories.

**Functioning principle:** e.g. mechanical functioning, with or without engine/motor, optical, electrical, biological, or chemical functioning.

### Example

- *Telescope* (Class 9) is an optical device (the nature of a telescope may be defined by its functioning principle, which is optical).

Although the functioning principle may help to define the nature of some goods, it is not always conclusive. There are cases where goods, in particular technology-related ones, with the same functioning principle have a different nature.

### Example

- A *blender* and an *electric toothbrush* have the same functioning principle of rotation, but they do not have the same nature.

In contrast, there are goods with different functioning principles but the same nature.

### Example

- The functioning principle of *washing machines using washing powder* is chemical, which is not the same as the functioning principle of *washing machines using magnetic waves*. However, these goods have the same nature as they are both washing machines.

**Physical condition:** for example, liquid/solid, hard/soft, flexible/rigid

The physical condition is another feature of the goods that may be used to define nature but, like the functioning principle, it is not conclusive.

### Examples

- All drinks are liquid. Their nature is different from the nature of solid foodstuffs. However, when comparing two different drinks, their physical condition should not be conclusive: *milk* (Class 29) does not have the same nature as an *alcoholic beverage* (Class 33).
- *Yoghurt* is marketed both in solid and liquid form. However, the nature of this good is not defined by its physical condition, but — as mentioned above — by its basic ingredient (milk). In both cases, the nature of a solid yogurt and of a liquid yogurt is the same (a milk product).

#### 3.2.1.3 Nature of services

When defining the nature of services, the features (composition, functioning principle, physical condition) cannot be used since services are intangible.

The nature of services can be defined, in particular, by the kind of activity provided to third parties. In most cases, it is the category under which the service falls that defines its nature.

### Example

- *Taxi services* (Class 39) have the same nature as *bus services* (Class 39) as they are both transport services.

#### 3.2.1.4 Nature of goods versus nature of services

By their *nature*, goods are generally dissimilar to services. This is because goods are articles of trade, wares or merchandise. Their sale usually entails the transfer in title of something physical. Services, on the other hand, consist of the provision of intangible activities.

#### 3.2.2 Intended purpose

Purpose is generally defined as the reason for which something is done or created or for which something exists (*Oxford Dictionary Online*).

As a Canon factor, purpose means the intended use of the goods or services and not any other possible use.

#### Example

- A *plastic bag* can be used as protection against the rain. However, its intended purpose is to carry items.

The purpose is defined by the function of the goods/services. In other words, it answers the questions: What need do these goods/services satisfy? What problem do they solve?

It is sometimes difficult to determine the proper level of abstraction for determining the purpose. As in the case of defining the nature, the purpose must be defined in a sufficiently narrow way.

#### Example

- In the case of *vinegar*, the intended purpose should not be defined as ‘human consumption’, which is the general purpose that all foodstuffs share, but as ‘everyday seasoning’.

### 3.2.3 Method of use

The method of use determines the way in which the goods/services are used to achieve their purpose.

The question to be asked is: How are these goods/services used?

Method of use often follows directly from the nature and/or intended purpose of the goods/services and therefore has no or little significance of its own in the similarity analysis.

#### Example

- The method of use of newspapers and books is the same in the sense that they are both read. However, similarity can already be concluded from the facts that they are both printed matter (same nature) and that they both serve to entertain or to inform (same purpose).

Notwithstanding the explanation above, the method of use may be important, independent of nature and purpose, where it characterises the goods:

#### Example

- *Pharmaceutical preparations for treating skin diseases* in Class 5 can take the form of creams. They have the same method of use as *cosmetic creams* in Class 3.

However, even where the method of use characterises the goods under comparison and where it is identical for both goods, this fact alone will not be sufficient to establish similarity.

#### Example

- *Chewing gum* (Class 30) and *chewing tobacco* (Class 34) have an identical method of use. However, this fact alone does not render them similar.

#### 3.2.4 Complementarity

Goods (or services) are complementary if there is a close connection between them, in the sense that one is indispensable (essential) or important (significant) for the use of the other in such a way that consumers may think that responsibility for the production of those goods or provision of those services lies with the same undertaking (see, to that effect, judgments of 11/05/2011, T-74/10, Flaco, EU:T:2011:207, § 40; 21/11/2012, T-558/11, Artis, EU:T:2012:615, § 25; 04/02/2013, T-504/11, Dignitude, EU:T:2013:57, § 44).

The complementary relation between the goods/services can be, for example, functional.

#### Example

- *Internet site hosting services* in Class 42 cannot exist without *computer programming services* in Class 42. There is a functional complementarity between those services, which, by their nature, belong to the field of information technology. Moreover, these services are aimed at the same public and use the same distribution channels. They are therefore similar (judgment of 29/09/2011, T-150/10, Loopia, EU:T:2011:552, § 36 and 43).

By definition, goods intended for different publics cannot be complementary (judgments of 22/06/2011, T-76/09, Farma Mundi Farmaceuticos Mundi, EU:T:2011:298, § 30; 12/07/2012, T-361/11, Dolphin, EU:T:2012:377, § 48). See also paragraph 3.3.1, Interrelation between factors.

#### Example

- *Textile products* in Class 24 (aimed at the public at large) and *treatment services relating to textile products* in Class 40 (aimed at professionals) cannot be complementary (judgment of 16/05/2013, T-80/11, Ridge Wood, EU:T:2013:251, § 28-32). These goods and services are not similar.

Complementarity is not conclusive on its own for finding a similarity between goods and/or services. Although a degree of complementarity may exist, goods and/or services may be dissimilar.

#### Example

- There is a degree of complementarity between *wine* (Class 33) and *wineglasses* (Class 21) insofar as wineglasses are intended to be used for drinking wine.

However, that complementarity is not sufficiently pronounced to conclude that these goods are similar. Furthermore, these goods do not have the same nature or usual origin nor do they usually share distribution channels (judgment of 12/07/2007, T-105/05, Waterford Stellenbosch, EU:T:2007:170, § 34, confirmed by judgment of 07/05/2009, C-398/07 P, Waterford Stellenbosch, EU:C:2009:288, § 45).

However, when the complementarity between goods/services has been identified in combination with other factors, such as 'usual origin' and/or 'distribution channel', similarity may be found:

### Examples

- *Skis* (Class 28) and *ski boots* (Class 25) are complementary because the use of one is indispensable for the use of the other. The relevant public may think that the production of these goods lies with the same undertaking. In addition, they share the same public and distribution channels. These goods are consequently considered similar.
- *Teaching material* in Class 16 (such as, printed matter, pre-recorded data carriers and audio/video cassettes) is essential and thus complementary to *educational courses* in Class 41. Generally the material is issued by the same undertaking; they share the same public and distribution channels. These goods are similar to the services in question (for example judgment of 23/10/2002, T-388/00, ELS, EU:T:2002:260).
- *Services of an architect (designing of buildings)* (Class 42) are indispensable for *building construction* (Class 37). These services are often offered together through the same distribution channels, by the same providers and to the same public. Consequently, these services are complementary and similar (judgment of 09/04/2014, T-144/12, Comsa, EU:T:2014:197, § 65-67).

#### 3.2.4.1 Use in combination: not complementary

Complementarity has to be clearly distinguished from use in combination where goods/services are merely used together whether by choice or convenience (e.g. bread and butter). This means that they are not essential for each other (decision of 16/12/2013, R 0634/2013-4, ST LAB, § 20). In such cases similarity can only be found on the basis of other factors, but not on complementarity.

### Example

- Even if the functioning of *transmission belts* in Class 12 can be measured with the help of a *device for motor-vehicle testing* in Class 9, this does not mean that the goods are complementary. It can be convenient in certain cases to measure the performance of one or the other parameter but simple convenience is not sufficient to conclude that one product is indispensable for the other (decision of 03/10/2013, R 1011/2012-4, SUN, § 39).

Certain goods that are often coordinated with each other but do not fall within the scope of other similarity factors, were determined by the Court to have 'aesthetic

complementarity' (judgments of 01/03/2005, T-169/03, Sissi Rossi, EU:T:2005:72, § 62; 11/07/2007, T-150/04, Tosca Blu, EU:T:2007:214, § 35-39; 11/07/2007, T-443/05, Pirañam, EU:T:2007:219, § 49-50; 20/10/2011, T-214/09, Cor II, EU:T:2011:612, § 32-37). This relationship between the goods falls outside the existing definition of complementarity.

#### Example

- *Handbags* (Class 18) and *clothing* (Class 25) are closely connected but not complementary, since one is not essential for the use of the other. They are merely often used in combination. They are, however, similar because of the fact that they may well be distributed by the same or linked manufacturers, bought by the same public and can be found in the same sales outlets.

#### 3.2.4.2 Ancillary goods/services: not complementary

When certain goods and/or services only support or supplement another product or service, they are not considered to be complementary within the meaning of the case-law. Ancillary goods are typically those used for packaging (e.g. bottles, boxes, cans, etc.) or for promotion (e.g. leaflets, posters, price lists, etc.). Equally, goods/services offered for free in the course of a merchandising campaign are usually not similar to the primary product or service.

#### Examples

- *Organisation and conducting of exhibitions* is not similar to *printed matter, including event notes* (Class 16), since these goods merely serve to promote and announce the specific event. These goods and services are not complementary.
- *Herbal nutritional supplements* in Class 5 are not indispensable or important for the use of *beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages* in Class 32. Any combined consumption of those products is merely ancillary. Therefore, these goods are not complementary. Furthermore, since their purpose, distribution channels and usual producers are different, and they are not in competition, these goods are not similar (judgment of 23/01/2014, T-221/12, Sun fresh, EU:T:2014:25, § 84).

#### 3.2.4.3 Raw materials, parts, components and fittings: not complementary

Lastly, where the goods concern raw materials the criterion complementarity is not applicable in the analysis of similarity.

Raw materials as a significantly important basic component of an end product may be found similar to that product, but not on the basis of complementarity. Similar considerations apply to parts, components and fittings (see also Annex I, paragraphs 1 and 2, and Annex II, paragraphs 5.1 and 5.2).

### Example

- *Plastic or synthetic products used as raw or semi finished material* (in Classes 1 and 17) cannot be regarded as complementary to *finished products* (made from these materials in Classes 9 and 12) on the ground that the raw materials are intended to be turned into the finished products (see, to that effect, judgment of 09/04/2014, T 288/12, Zytel, EU:T:2014:196, § 39).

### 3.2.5 In competition

Goods/services are in competition with each other when one can substitute the other. That means that they serve the same or similar purpose and are offered to the same actual and potential customers. In such a case, the goods/services are also defined as 'interchangeable' (judgment of 04/02/2013, T-504/11, DIGNITUDE, EU:T:2013:57, § 42).

### Examples

- *Wallpaper* (Class 27) and *paints* (Class 2) are in competition because both cover or decorate walls.
- *Rental of movies* (Class 41) and *services of a cinema* (Class 41) are in competition because they both allow you to watch a movie.
- *Electric shavers* and *razor blades* (both in Class 8) are in competition because they serve the same purpose.

In some cases the price of goods/services in competition may differ significantly, but this fact alone does not affect the analysis of whether they are in competition with each other or not.

### Example

- *Jewellery made of gold* and *fashion jewellery*<sup>6</sup> (both in Class 14) are in competition even though their price (and value) may greatly differ.

### 3.2.6 Distribution channel

Although 'distribution channel' is not explicitly mentioned in the Canon judgment, it is widely used internationally and nationally in the assessment of whether two goods/services are similar. As an additional factor it has been taken into account in several judgments of the European Courts (see amongst others judgment of 21/04/2005, T-164/03, monBeBé, EU:T:2005:140, § 53). The reasoning for this is as follows.

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<sup>6</sup> Fashion/costume jewellery is understood to be jewellery made from inexpensive metals and imitation gems or semiprecious stones, worn for decorative purposes.

If the goods/services are made available through the same distribution channels, the consumer may be more likely to assume that the goods or services are in the same market sector and are possibly manufactured by the same entity and vice versa.

The term 'distribution channel' does not refer so much to the way of selling or promoting a company's product but rather to the place of distribution. For the analysis of the similarity of goods/services, the distribution system — whether direct or indirect — is not decisive. The question to be asked is rather:

Do the goods/services have the same points of sale, or are they usually provided or offered at the same or similar places?

However, not too much emphasis should be placed on this factor as modern supermarkets, drugstores and department stores sell goods of all kinds. The relevant public is aware that the goods sold in these places come from a multitude of independent undertakings. Therefore, the point of sale is less decisive when deciding whether the relevant public considers that goods share a common origin merely because they are sold at the same outlet.

Only where the goods in question are offered in the same **section** of such shops, where homogeneous goods are sold together, will this favour similarity. In such cases it must be possible to identify the section by its territorial and functional separation from other sections (e.g. dairy section of a supermarket, the cosmetic section of a department store).

Similarly, the factor may be valid in cases in which goods are sold exclusively or commonly in specialised shops. In that event, consumers may tend to believe the origin of the goods to be the same if they are both sold in the same specialised shops and may tend to deny that mutual origin if they are not usually sold in the same shops.

Conversely, different sales outlets may weigh against the similarity of goods.

### Example

- *Wheelchairs versus bicycles*

Although both fall under *vehicles* in *Class 12*, they will not be found at the same sales points. Bicycles are usually sold either in specialist bicycle stores or in a retail store where sporting equipment is available. In contrast, the distribution channels of *wheelchairs* are specialised distributors of medical equipment and devices supplying hospitals and specialised shops where devices for disabled or physically handicapped people are sold.

### 3.2.7 Relevant public

The relevant public, such as the actual and potential customers of the goods and services in dispute, constitutes another factor to be dealt with in the analysis of their similarity (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 3, Relevant Public and Degree of Attention).

The relevant public can be composed of:

- the general public (public at large) or

- professional public (business customers or specialised public).

The relevant public does not necessarily mean the end user; for instance, the end users of food for animals in Class 31 are animals, not the relevant public. The relevant public in this case would be the general consumer.

The mere fact that the potential customers coincide does not automatically constitute an indication of similarity. The same group of customers may be in need of goods or services of the most divergent origin and nature. The fact that, for example, television sets, cars and books are bought by the same relevant public, namely the public at large, has no impact on the similarity analysis. In many cases, either one or both lists of goods/services under comparison target the public at large, but the purpose (customers' needs covered) in each case is different. Such circumstances weigh against similarity.

While a coincidence in the relevant public is not necessarily an indication of similarity, largely diverging publics weigh heavily against similarity.

Diverging customers can be found in the following cases where:

- (a) the goods/services of both lists are directed at the public at large, which can however be clearly categorised by their different (personal) needs, ages, etc.
  - Example: *wheelchairs* versus *bicycles* (Class 12).
- (b) the goods/services of both lists target business customers, however acting in a very different market sector.
  - Example: *chemicals used in forestry* versus *solvents for the lacquer industry* (Class 1).
- (c) one relevant public consists of general consumers and the other of business customers.
  - Example: *containers for contact lenses* (in Class 9) versus *surgical apparatus and instruments* (in Class 10).

### 3.2.8 Usual origin (producer/provider)

Although the Court of Justice did not explicitly mention this factor in its Canon judgment, it follows from the general concept of likelihood of confusion that the usual origin of the goods and services is of particular importance for the analysis of similarity. As the Court has stated, it is 'the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, [that] constitutes a likelihood of confusion' (*Canon*, para. 29). Hence, there is a strong indication of similarity when, in the mind of the relevant public, the goods/services have the same usual origin.

However, this should not be misinterpreted as turning the examination of likelihood of confusion and similarity of goods/services upside down: the finding of a likelihood of confusion depends on many other factors (such as the similarity of signs, the distinctiveness of the earlier mark) and is not exclusively determined by the usual

origin, which as such is only one factor in the analysis of the similarity of goods/services.

A finding that consumers will not be confused about the origin of the goods/services is not an argument appropriate to the comparison of goods/services. This finding should be mentioned in the overall assessment of likelihood of confusion. Origin, in this context, relates mainly to the manufacturing sector (industry) or kind of undertaking producing the goods or offering the services in question rather than to the identity of the producer.

The 'origin' is not merely defined by the actual place of production/provision (e.g. factory, workshop, institute or laboratory) but primarily by taking into consideration who manages and/or controls the production/provision of the goods/services. In other words, the question to be asked is: who is responsible for manufacturing the product or providing the service?

The geographical origin (e.g. China) is not relevant for the finding of similarity of goods/services.

In the ELS judgment the Court held that even goods and services can have the same origin if it is common that the same type of company is responsible for the production/provision of both. *Educational textbooks* (Class 16) were considered to have the same origin as *provision of correspondence courses* (Class 41) since 'undertakings offering any kind of course often hand out those products to pupils as support learning materials' (judgment of 23/10/2002, T-388/00, ELS, EU:T:2002:260, § 55).

The criterion 'usual origin' has to be applied in a restrictive way in order not to dilute it. If all kinds of goods/services deriving from one big (multinational) company or holding were found to have the same origin, this factor would lose its significance.

#### Example

- *Cosmetics* (Class 3) and *foodstuffs* (Classes 29 to 31) might be produced under the umbrella of one company but this does not reflect common trade custom, according to which these types of goods have different producers, each belonging to a specific industry.

#### 3.2.8.1 Features defining a common origin

When determining the usual origin of a product/service the following features might be relevant.

#### **Manufacturing sites**

##### Example

- *Varnishes, lacquers colorants and mordants* (Class 2) are typically produced in the same production enterprises, normally by specialised chemical companies.

The place of production can be a strong indicator that the goods/services in question come from the same source. However, while the same manufacturing sites suggest a common usual origin, different manufacturing sites do not exclude that the goods come

from the same or economically linked undertakings. For instance, *books* (Class 16) and *electronic media* (Class 9) (goods in competition, e-media substituting books) are both goods of a publishing house.

### **Methods of manufacture**

#### Example

- *Leather belts* (Class 25) and *leather handbags* (Class 18) are not only manufactured in the same sites, for example, leather workshops, but also use the same tools and machines for the treatment of leather.

### **(Technical) know-how**

#### Example

- *Computer virus protection services* (Class 42) and *software design* (Class 42) involve similar technical know-how in the field of information technology.

### **Established trade custom known to the public**

An established trade custom, such as when manufacturers expand their businesses to adjacent markets, is of particular importance for concluding that goods/services of different nature have the same origin. In such situations it is necessary to determine whether such expansion is common in the industry or, conversely, whether it may occur in exceptional cases only.

#### Example where extension has become customary

- *Shoes* (Class 25) and *handbags* (Class 18): It is customary on the market that the producers of shoes are also involved in the manufacture of handbags.

#### Example where extension is not (yet) common

- *Clothing* (Class 25) and *perfumes* (Class 3): Even though some couturiers that make fashion clothes nowadays also sell perfumes under their marks, this is not the rule in the clothing industry, and rather applies to (economically) successful designers.

## **3.3 Relation between different factors**

The Canon criteria were enumerated in the relative judgment without any hierarchy (weight) between them and without indicating any relation between them. They were considered one by one. However, they cannot be considered independently since some criteria are interrelated and some criteria are more important than others, regardless of whether goods are being compared with goods, services with services or goods with services. As a result of weighing all these factors in accordance with their respective importance in relation to the goods/services at issue, similarity may be found to various degrees: low, average or high (see paragraph 3.3.4 below).

### 3.3.1 Interrelation of factors

In many cases there will be relationships between the factors in the sense that where one is shared another one might coincide as well.

#### Examples

- Based on the purpose, it is also possible to determine who the actual and potential customers (i.e. the relevant public) are.
- The purpose, together with the relevant public, may also reveal whether goods/services are in competition.
- The same distribution channel goes hand in hand with the same public. In other words, where the distribution channels are different, the public may be different as well.
- Goods/services intended for different publics cannot be complementary (judgments of 11/05/2011, T-74/10, Flaco, EU:T:2011:207, § 40, 22/06/2011; T-76/09, Farma Mundi Farmaceuticos Mundi, EU:T:2011:298, § 30).
- The method of use usually depends on the nature and purpose of the goods.

There are cases in which a distinction between various factors will be difficult to draw. This is particularly true as far as 'nature', 'purpose' and 'method of use' are concerned. Where the examiner encounters such difficulties, it is sufficient to treat these factors jointly.

#### Example

- An *engine* is a machine for converting any of various forms of energy into mechanical force and motion. In such a case, it is difficult to distinguish the nature from the purpose of the product. Therefore, a distinction between what — in this case — is nature and what is purpose is not necessary.

### 3.3.2 Importance of each factor

In assessing the similarity of goods and services, **all** relevant factors characterising the relationship between them should be taken into account. However, depending on the kind of goods and services a particular criterion may be more or less important. In other words, the various criteria do not have a standard value, but rather their specific importance should be determined in the context of each individual case.

In general, the weight of each factor will depend on the impact it has on a possible confusion of the origin. Criteria clearly suggesting that the goods/services come or do not come from the same undertaking or economically linked undertakings should take precedence.

### Generally strong factors

- Usual origin (because it has a strong impact on likelihood of confusion which relates to common commercial origin).
- Purpose (because it is decisive for the choice of the customer buying or selecting goods/services).
- Nature (because it defines the essential qualities and characteristics of the goods/services).
- Complementarity (because the close connection between the use of the goods/services makes the public believe that they share the same source).
- In competition (usually goods/services that are in competition have the same purpose and target the same public).

### Less important factors

- Method of use (even dissimilar goods can be used in the same manner, e.g. *baby carriages* and *shopping trolleys*).
- Distribution channels (even dissimilar goods can be sold in the same section of stores depending on different display practices, e.g. *chewing gum* (Class 30) and *cigarettes* (Class 34)).
- Relevant public (especially when goods/services target the general public).

### 3.3.3 Different types of comparisons: goods versus goods, services versus services and goods versus services

In principle, the same factors for comparing goods with goods are relevant for the comparison of services with services. However, in applying these factors, the basic difference between goods and services (tangible v intangible) must be considered.

Furthermore, the same principles that apply for the comparison between goods and goods and between services and services apply in cases where goods are compared with services.

By their nature goods are generally dissimilar to services. They can, however, be complementary. Services can also have the same purpose and thus be in competition with goods. It follows that under certain circumstances similarity between goods and services can be found.

### 3.3.4 Degree of similarity

Goods and/or services can be found similar to different degrees (low, average, high) depending on how many factors they share and the weight given to each of them. The degree of similarity found between the goods and services is of relevance when finally deciding on the likelihood of confusion.

Generally, one factor on its own is not sufficient to find a low degree of similarity between the goods/services, even if it is a strong factor.

#### Examples of dissimilarity

- *Cars* and *bicycles* (both in Class 12) share the same purpose (taking oneself from A to B), but this does not render them similar.
- Although *window glass* (Class 19) and *glasses for spectacles* (Class 9) have the same nature, they are not similar, since they do not coincide in other relevant factors, such as purpose, producers, distribution channels and relevant public.

It is the combination of various factors and their weight that allows the final conclusion on similarity. The combination of two strong factors, such as nature and producer, or the combination of one strong and two weak factors will often lead to similarity. In contrast, the combination of two weak factors, such as distribution channel and relevant public are, in principle, not conclusive for a finding of similarity between the goods and services.

#### Examples of similarity

- *Milk* and *cheese* (both in Class 29) have a different purpose and method of use; they are not in competition or complementary. However, the fact that they share the same nature (dairy goods) and usual origin (dairy company) is decisive for a finding of similarity.
- Although *pharmaceuticals* and *plasters* (both in Class 5) have a different nature, they share a similar purpose; the cure of diseases, disabilities or injuries. Furthermore, they have the same distribution channels and relevant public. Therefore, they are similar.

The amount of coinciding factors found together with their importance/weight establishes the degree of similarity. Generally speaking, the higher the number of common factors the higher the degree of similarity. A similarity found on the basis of only two factors would normally not be high, contrary to cases where the goods/services coincide in four or more relevant factors.

However, no mathematical analysis is possible since it always depends on the specific circumstances of each case.

## Annex I

### Specific Questions as to the Similarity of Goods and Services

This part does not establish new criteria for finding a similarity between goods and services. It merely helps to clarify how to compare specific groups of goods and services where, apart from the Canon criteria, some general rules and exceptions apply.

#### 1 Parts, Components and Fittings

The mere fact that a certain product can be composed of several components does not establish automatic similarity between the finished product and its parts (judgment of 27/10/2005, T-336/03, Mobilix, EU:T:2005:379, § 61).

##### Examples of dissimilarity

- *Fan blades* (Class 7) and *hair dryer* (Class 11)
- *Electric cable* (Class 9) and *lamp* (Class 11)
- *Buttons* (Class 26) and *clothing* (Class 25).

Similarity will only be found in exceptional cases and requires that at least some of the main factors for a finding of similarity, such as producer, public and/or complementarity are fulfilled.

Such an exception is based on the fact that parts and fittings are often produced and/or sold by the same undertaking that manufactures the end product and target the same purchasing public, as in the case of spare or replacement parts. Depending on the product concerned, the public may also expect the component to be produced by, or under the control of, the 'original' manufacturer, which is a factor that suggests that the goods are similar.

In general, a variety of factors may be significant in each particular case. For instance, if the component is also sold independently, or if it is particularly important for the functioning of the machine, this will favour similarity.

##### Examples of similarity

- *Electric toothbrush* (Class 21) and *replacement brush heads* (Class 21)
- *Printer* (Class 9) and *ink jet cartridges* (Class 2)
- *Sewing machines* (Class 7) and *walking feet for sewing machines* (Class 7).

#### 2 Raw Materials and Semi-Processed Goods

A similar approach is also followed in relation to raw materials and semi-processed goods on the one hand and finished goods on the other.

In most cases, the mere fact that one product is used for the manufacture of another will not be sufficient in itself to show that the goods are similar, as their nature,

purpose, relevant public and distribution channels may be quite distinct (judgment of 13/04/2011, T-98/09, T Tumesa Tubos del Mediterráneo S.A., EU:T:2011:167, § 49-51). According to case-law, the raw materials subject to a transformation process are essentially different from the finished products that incorporate, or are covered by, those raw materials, in terms of nature, aim and intended purpose (see, to that effect, judgment of 03/05/2012, T-270/10, Karra, EU:T:2012:212, § 53). Furthermore, they are not complementary since one is manufactured with the other, and raw material is in general intended for use in industry rather than for direct purchase by the final consumer (judgment of 09/04/2014, T-288/12, Zytel, EU:T:2014:196, § 39-43).

#### Examples of dissimilarity

- *Leather, animal skins* (Class 18) and *clothing* (Class 25)
- *Precious metals* (Class 14) and *jewellery* (Class 14).

However, the final conclusion may depend on the specific circumstances of the case, such as the degree of transformation of the raw material or whether it is the basic component of the end product. The greater the significance of the raw material for the end product, the more likely the goods will be similar. Consequently, similarity might be established when the raw material or the semi-finished product can be decisive for the form, character, quality or value of the end product. In these cases, the raw material can often be obtained separately from the end product through the same distribution channels.

#### Example of similarity

- *Precious stones* (Class 14) and *jewellery* (Class 14). Contrary to *precious metals*, *precious stones* can be obtained in jewellery shops independently of the end product.

A subcategory of raw materials is *ingredients used for the preparation of foodstuffs* (see *ingredients* below).

### **3 Accessories**

An accessory is something extra that improves or completes the main product it is added to. Unlike parts, components and fittings an accessory does not constitute an integral part of the main product, although it is usually used in close connection. An accessory usually fulfils a useful technical or decorative purpose.

The rules in respect of parts, components and fittings are to a certain extent also valid in the case of accessories. The mere fact that a certain product is used in combination with another is not necessarily conclusive for a finding of similarity.

#### Examples of dissimilarity

- *Clothing* (Class 25) and *hair ornaments* (Class 26)
- *Car sun blinds* (Class 12) and *vehicles* (Class 12).

However, it is common that some accessories are also produced by the manufacturer of the main product. Consequently the consumer may expect that the main product and the accessories are produced under the control of the same entity, especially when they are distributed through the same channels of trade. In such cases there is a strong indication for similarity.

#### Examples of similarity

- *Bicycles* (Class 12) and *panniers for bicycles* (Class 12)
- *Glasses* (Class 9) and *cases for glasses* (Class 9).

## 4 Installation, Maintenance and Repair Services

These services belong to the category of goods-related services.

Since by nature goods and services are dissimilar, a similarity between goods and their installation, maintenance and repair can only be established when:

- it is common in the relevant market sector for the manufacturer of the goods to also provide such services; **and**
- the relevant public coincides; **and**
- installation, maintenance and repair of these goods are provided independently of the purchase of the goods (not aftersales services).

The installation of virtually all goods is classified in Class 37, such as *installation of air conditioning apparatus, electric appliances, elevators or lifts, fire alarms, freezing equipment, kitchen equipment, and machinery*. The *installation and repair of computer hardware* is also in Class 37 as it is a physical repair and installation activity. However, *installation and repair of computer software* is classified in Class 42 because it involves computer programming without any physical installation or repair.

#### Examples of similarity

- *Data processing equipment and computers* (Class 9) and *installation and repair of electronic apparatus* (Class 37)
- *Air conditioning apparatus* (Class 11) and *installation, maintenance and repair services* (Class 37)
- *Vending machines* (Class 7) and *maintenance services* (Class 37).

#### Examples of dissimilarity

- *Building materials* (Class 19) and *installation services* (Class 37)
- *Shoes* (Class 25) and *repair of shoes* (Class 37)
- *Vehicles* (Class 12) and *dent removal for motor vehicles* (Class 37) (judgment of 15/12/2010, T-451/09, Wind, EU:T:2010:522, § 28-30).

## 5 Advisory Services

*Advisory services* refers to providing advice that is tailored to the circumstances or needs of a particular user and that recommends specific courses of action for the user. *Provision of information*, on the other hand, refers to providing a user with material (general or specific) about a matter or service but not advising the user on specific courses of action.

With the 8th edition of the Nice Classification, *professional consultation services* in Class 42 were eliminated. Since then consultation services — as well as *advisory and information services* — are classified in the class of the service that corresponds to the subject matter of the consultation. For instance, *transportation consultancy* belongs to Class 39, *business management consultancy* falls under Class 35, *financial consultancy* is classified in Class 36 and *beauty consultancy* in Class 44. The rendering of the advice, information or consultancy by electronic means (e.g. telephone, computer) does not affect the classification of these services.

Advisory, consultancy and information services are in principle always similar, or even identical, to the *services* to which they relate.

### Examples

- *Financial information services* (Class 36) are included in *financial affairs* (Class 36) and thus identical (judgment of 27/02/2008, T-325/04, Worldlink, EU:T:2008:51, § 58).
- *Computer software advisory* (Class 42) is similar to the *installation and maintenance of software* (Class 42) because although they may not necessarily be included in *installation and maintenance of software* they are often complementary.
- When it comes to the comparison of advisory, consultancy and information services with goods, similarity can be found under conditions akin to those concerning maintenance, installation and repair (see paragraph 4 above).

### Examples of similarity

- *Advisory services in computer technologies (hard-and software)* (Class 42) and *computer software* (Class 9)
- *Beauty consultancy* (Class 44) and *cosmetics* (Class 3).

### Examples of dissimilarity

- *Information services concerning the purchase of fashion articles (shoppers guide information)* (Class 35) and *clothing, footwear and headgear* (Class 25), as it is not common in the market for the manufacturer of articles in Class 25 to provide such information services.

- *Providing information in the field of entertainment* (Class 41) and *toys* (Class 28), as it is not common in the market for the manufacturer of toys in Class 28 to provide such information services.

## 6 Rental and Leasing

**Rental services** are classified in the same classes as the service provided by means of the rented objects:

- *rental of telephones* is Class 38 because *telecommunication services* are in Class 38;
- *rental of cars* is in Class 39 because *transport services* are in this class.

**Leasing services** are analogous to rental services and therefore are classified in the same way. However, hire- or lease-purchase financing is classified in Class 36 as a financial service.

Based on the understanding that *leasing* in English means rental, these services must be clearly distinguished from any financial services. The comparison of rental and leasing services leads to the outcomes shown in the following paragraphs.

### 6.1 Rental/leasing versus related services

Even though rental services are classified in the same classes as the service provided by means of the rented objects, they are not automatically identical to this service. The comparison between these services has to be done applying normal criteria for identity and similarity.

#### Examples

- There is identity between *rental of flats* (Class 36) and *real estate affairs* (Class 36) because *rental of flats* is included in *real estate affairs*.
- The same reasoning cannot apply to *rental of bulldozers* (Class 37) and the related services of *building construction* (Class 37). *Rental of bulldozers* is not included in *building construction* and therefore these services are not considered to be identical.

### 6.2 Rental/leasing versus goods

Rental/leasing services are in principle always dissimilar to the goods rented/leased.

#### Examples

- *Vehicle rental* (Class 39) and *vehicles* (Class 12)
- *Rental of films* (Class 41) and *DVDs* (Class 9).

Exceptions exist where it is common for the manufacturer of the goods to provide rental services.

- *Rental and leasing of computer software* (Class 42) and *computer software* (Class 9) are considered to be similar to a low degree.
- *Rental of automatic vending machines* (Class 35) and *automatic vending machines* (Class 7) are considered to be similar to a low degree.

## Annex II

### Specific Industries

#### 1 Chemicals, Pharmaceuticals and Cosmetics

##### 1.1 Chemicals (Class 1) versus chemical products (Classes 3 and 5)

Although major chemical companies are usually involved in the production of all kinds of basic chemicals, speciality chemicals and life science products, including pharmaceuticals and pesticides, as well as consumer products, such as cleaning preparations and cosmetics, the mere fact that their nature coincides — as all of them can be broadly classified as chemical products — is not sufficient to find them similar. Special attention must be drawn to the specific purpose of these chemicals as well as to their public and distribution channel. What has been said above as to the relation between raw materials, semi-processed and finished products particularly applies to these products.

Consequently, although goods in Class 3 and Class 5 are usually combinations of various chemicals, they are in principle not considered similar to goods included in Class 1. Their purpose as a finished product usually differs from goods in Class 1, which are mainly in their raw, unfinished state and not yet mixed with other chemicals and inert carriers into a final product. The finished products in Class 3 and Class 5 usually also target a different public and do not share the same distribution channels.

On the other hand, it cannot be excluded that goods such as *chemicals used in agriculture, horticulture and forestry* require few processing steps to be considered a finished product such as *fungicides*. Such chemicals may be considered to already share the inherent purpose of *fungicides*: to kill or inhibit fungi or fungal spores, in particular when they consist of the fungicide's active ingredient. Furthermore, the same (agro-)chemical companies may produce the semi-processed goods as well as the final product. There is therefore a low degree of similarity between *chemicals used in agriculture, horticulture and forestry* and *fungicides* (decision of 08/10/2012, R 1631/2012-1, QUALY/QUALIDATE, § 27-28).

Furthermore, there are also goods in Class 1 that are not mere chemicals but are semi-finished or even finished products with a specific purpose of use, which is an important factor that must be taken into account when comparing goods in Class 1 to goods in other classes.

For example *manures* in Class 1 on the one hand and *pesticides, fungicides and herbicides* in Class 5 on the other are not only chemical products but also finished products with a specific use in the agricultural industry. They therefore have a similar purpose as the specific goods in Class 5 can be considered growth-enhancing by preventing conditions that could inhibit plant growth. As such they are similar to a low degree.

##### 1.2 Pharmaceuticals versus pharmaceuticals

A pharmaceutical preparation refers to any kind of medicine, that is to say, a substance or combination of substances for treating or preventing diseases in human beings or

animals. From its definition it can already be concluded that *veterinary preparations* — though separately mentioned in the class heading — are included in the broader term of *pharmaceutical preparations*. Therefore they are identical.

The same applies to herbal and homoeopathic medicines since they are comprised in the broad term of *pharmaceutical preparations*.

Equally, testing preparations, that is to say, chemical reagents for medical — including veterinary — purposes, also fall under the general indication of *pharmaceutical preparations*.

Specific pharmaceuticals are considered to be similar to other specific pharmaceuticals. This is because several, if not all, criteria for similarity are usually met: they share the same nature because they are specific chemical products; their purpose is, broadly speaking, healing and/or curing; they are sold in the same places, namely, pharmacies; and they come from the same source, which is the pharmaceutical industry. This industry manufactures a wide variety of drugs with various therapeutic indications, something the general public is aware of. Furthermore, their method of use can be the same and they can be in competition with one another (judgment of 17/11/2005, T-154/03, Alrex, EU:T:2005:401, § 48).

However, the degree of similarity found between specific pharmaceuticals may vary depending on their specific therapeutic indications.

#### Example 1

- *Sedatives versus pain killers*. These pharmaceuticals are highly similar.

#### Example 2

- *Anti-epileptics versus pharmaceutical preparations, except medicines to combat diseases in connection with the central nervous system*. These pharmaceutical preparations are considered to be similar (judgment of 24/05/2011, T-161/10, E-Plex, EU:T:2011:244, § 24-25).

#### Example 3

- *Contraceptives versus eye-washes*. These pharmaceutical preparations are only similar to a low degree. In this regard, it should be noted that a low degree of similarity should only be established in exceptional cases, e.g. when it can be clearly established that they have different therapeutic indications and different methods of use.

Whether a specific pharmaceutical is sold under prescription is not of particular relevance for the comparison of the goods. Therefore, a prescription medicine is generally to be considered similar to an over-the-counter drug for the reasons stated above. (For information on the relevant public and the degree of attention in relation to pharmaceuticals, see the Guidelines, Part C, Section 2, Double Identity and Likelihood of Confusion, Chapter 3, Relevant Public and Degree of Attention).

### 1.3 Pharmaceuticals versus dietetic substances adapted for medical use

*Dietetic substances and food supplements adapted for medical use* are substances prepared for special dietary requirements with the purpose of treating or preventing a disease. Bearing this in mind, their purpose is similar to those of *pharmaceutical products* (substances used in the treatment of diseases) insofar as they are used to improve the patient's health. The relevant public coincides and these goods generally share the same distribution channel. For the above reasons, these goods are considered to be similar.

### 1.4 Pharmaceuticals versus cosmetics

The general categories *pharmaceuticals* and *cosmetics* are considered to be similar. Cosmetics include a list of preparations used to enhance or protect the appearance or odour of the human body. Pharmaceuticals on the other hand comprise products, such as skin or haircare preparations, with medical properties. They may coincide in purpose with cosmetics. Moreover, they share the same distribution channels since they can be found in pharmacies or other specialised shops. They target the same public and are often manufactured by the same companies.

However, when comparing specific pharmaceuticals with cosmetics they may only show a low degree of similarity or they may even be entirely dissimilar. In such cases this will depend on the specific drug and its specific purpose (medical indication/effect) or its method of use.

#### Example

- A *painkiller* is dissimilar to *nail polish*.

### 1.5 Pharmaceuticals versus services

Although pharmaceutical companies are heavily involved in research and development activities, they usually do not provide such services to third parties. Consequently, Class 5 goods are generally dissimilar to all services covered by Class 42.

Dissimilarity should also be found when comparing *pharmaceutical preparations* and *medical (including veterinary) services* in Class 44. Even though a certain link cannot be denied due to the common goal of treating diseases, the differences in nature and especially in the usual origin clearly outweigh any similarities. The relevant public does not expect a doctor to develop and market a drug.

## 2 Automobile Industry

The automotive industry is a complex industry involving various kinds of companies, including car manufacturing companies as well as suppliers that might provide the car manufacturer with their raw materials (metal, aluminium, plastics, paints, etc.), parts, modules or complete systems. Several areas of production can be distinguished: drive engineering, chassis, electronic, interior and exterior.

The complexity of the industry and the fact that the final product incorporates some component parts and accessories complicates the examination of similarity between the end product (e.g. a car) and the various parts or materials used for its production. Furthermore, when purchasing a car, the general public knows that the car incorporates many items from many sources and that the car manufacturer might assemble components that have been manufactured by others. However, as far as the consumer of a car is concerned, the goods are normally offered under only one sign, which makes it almost impossible for the general public to identify other manufacturers or to differentiate their source of production. Exceptions include car batteries or tyres, where other signs are usually visible.

As with other industries, the Canon criteria apply accordingly and in particular the general principles set out for the comparison of parts, components, and fittings have to be taken into consideration.

In particular, it should be kept in mind that there are goods that will only be purchased by the automobile industry without any possibility of them ever reaching or being purchased by the general public (end consumer). An example is the common metal (Class 6) used to form the chassis. Such goods are clearly dissimilar to the car and probably dissimilar to all other parts, components and fittings. On the other hand, there are spare parts that might also be purchased by the general public for repair or maintenance purposes. Assessment of the similarity of these goods will mainly depend on whether the specific spare part is commonly produced by the car manufacturer.

### **3 Electric Apparatus/Instruments**

The expression *electric apparatus and instruments* in Class 9 cannot be interpreted as covering all apparatus powered by electricity. Indeed, there are apparatus powered by electricity in various classes. The term *electric apparatus* included in the list of goods in Class 9 is to be understood as only covering apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity.

### **4 Fashion and Textile Industries**

Goods classified in Classes 22, 23, 24 and 25 are textile-related. There is a certain progression through these classes: *raw fibrous textile materials*, such as *fibres* (Class 22), are further made into *yarns and threads* (Class 23), then into *textiles*, such as *fabrics* (Class 24), and end up as *finished goods made of textile* (Class 24) or *clothing* (Class 25).

Moreover, Class 18 goods such as *goods made of leather and imitations of leather* are also related to the fashion and textile industries.

#### **4.1 Raw or semi-processed materials versus finished goods**

Since the relationship between the abovementioned classes is often based on the fact that one product is used for the manufacture of another (e.g. *textiles* in Class 24 are used for the manufacture of *clothing* in Class 25), in comparisons of this kind, general rules concerning raw materials apply (see Annex I, paragraph 2, on 'Raw materials and semi-processed goods' above).

For example, raw materials such as *leather and imitations of leather, animal skins and hides* (Class 18) are dissimilar to clothing, footwear and headgear (Class 25). The mere fact that leather is used for the manufacture of footwear (shoes made of leather) is not sufficient in itself to conclude that the goods are similar, as their nature, purpose and relevant public are quite distinct: raw materials are intended for use in industry rather than for direct purchase by the final consumer.

However, a low degree of similarity is found between *textiles* and *textile goods* such as *bed sheets* and *table covers*, in Class 24. In such cases, the degree of transformation required from material to end product is often insignificant: the fabric is merely cut into shape and/or sewn to obtain the finished product. Furthermore, many establishments allow customers to purchase the base material or ready-made cushions, etc. made from such material. Therefore, the relevant public may expect these goods to come from the same undertakings.

#### **4.2 Textile goods (Class 24) versus clothing (Class 25)**

The main point of contact between *textile goods* in Class 24 and *clothing* in Class 25 is that they are made of textile material. However, this is not enough to justify a finding of similarity. They serve completely different purposes: *clothing* is meant to be worn by people, or serves as a fashion article, whereas *textile goods* are mainly for household purposes and interior decoration. Therefore, their method of use is different. Moreover, the distribution channels and sales outlets of *textile goods* and *clothing* are different and the relevant public will not think that they originate from the same undertaking. Therefore, *textile goods* are considered to be dissimilar to *clothing* see decisions of 31/05/2012, R 1699/2011-4, GO/GO GLORIA ORTIZ, § 16; 26/07/2012, R 1367/2011-1, PROMO TEXTILE/Promodoro, § 17; 01/08/2012, R 2353/2010-2, REGRIGUE FOR COLD/REFRIGIWEAR et al., § 26).

#### **4.3 Clothing, footwear and headgear (Class 25)**

Class 25 goods, namely *clothing, footwear and headgear* are of an identical or very similar nature. They serve the same purpose since they are used to cover and protect various parts of the human body against the elements. They are also articles of fashion and are often found in the same retail outlets. Consumers, when seeking to purchase clothes, will expect to find footwear and headgear in the same department or shop and vice versa. Moreover, many manufacturers and designers will design and produce all of the aforementioned items. Therefore, these goods are similar to each other.

#### **4.4 Fashion accessories**

As explained in the paragraph on 'Accessories' (see Annex I, paragraph 3 above), the mere fact that a certain product is used in combination with another is not necessarily conclusive for a finding of similarity. However, it is common for some accessories also to be produced by the manufacturer of the main product. Consequently, the consumer may expect that the main product and the accessories are produced under the control of the same entity, especially when they are distributed through the same trade channels. In such cases, there is a strong indication for similarity. Therefore, not all goods that are considered as fashion accessories will be found to be similar to *clothing, footwear and headgear* (Class 25).

The broad category of *goods made of leather and imitations of leather* in Class 18 includes goods such as (hand)bags, sports bags, briefcases, wallets, purses, key cases, etc. These goods are related to articles of *clothing, headgear and footwear* in Class 25, in the sense that they are likely to be considered by the consumers as aesthetic complementary accessories to articles of outer clothing, headgear and even footwear because they are closely co-ordinated with these articles and may well be distributed by the same or linked manufacturers, and it is not unusual for clothing manufacturers to directly produce and market them. Moreover, these goods can be found in the same retail outlets. Therefore, these goods are considered to be similar to *clothing, headgear and footwear*.

In contrast, hair accessories such as *hair pins* and *ribbons* are dissimilar to *clothing*. Even though these goods might have some distant link to the fashion market, the mere fact that someone might want to match hair pins and clothing is not sufficient to conclude that these goods are complementary and therefore similar. The goods can only be considered to be complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other and is not merely ancillary. In the present case, these conditions are not fulfilled. Furthermore, the nature and method of use of these goods is different. They are not in competition with each other. The production of these goods involves different know-how, they do not belong to the same category of goods and they are not regarded as components of a general array of goods that potentially have the same commercial origin (decision of 03/10/2011, R 1501/2010-4, Wild Nature/WILD NATURE, § 18).

Likewise, luxury goods such as glasses (Class 9) and jewellery (Class 14) are considered to be dissimilar to clothing, footwear and headgear. The nature and the main purpose of these goods are different. The main function of clothing is to dress the human body whilst the main purpose of glasses is to improve eyesight, and jewels are worn for personal adornment. They do not have the same distribution channels and they are neither in competition nor complementary (decisions of 30/05/2011, R 0106/2007-4, OPSEVEN2/SEVEN, § 14; 12/09/2008, R 0274/2008-1, Penalty/PENALTY, § 20; 05/10/2011, R 0227/2011-2, OCTOPUSSY/OCTOPUSSY ET AL, § 23-26).

The same reasoning applies to luxury goods such as perfumes (Class 3) — the main purpose of which is to impart a long-lasting scent to the body, stationery, etc. — and goods such as travelling bags (Class 18), which are intended to carry things when travelling. Even though couturiers nowadays also sell perfumes, fashion accessories (such as glasses and jewellery) and travel accessories under their marks, this is not the rule, and rather applies only to (economically) successful designers.

#### **4.5 Sports clothing, footwear and headgear (Class 25) versus sporting and gymnastic articles (Class 28)**

The general category of *clothing, footwear and headgear* includes sports clothing, footwear and headgear, which are garments or items of apparel designed specifically to be used when performing an activity or sport. Although the nature of these goods is different from those of *sporting and gymnastic articles*, which are articles and apparatus for all types of sports and gymnastics, such as weights, halters, tennis rackets, balls and fitness apparatus, there are undertakings that manufacture both *sporting and gymnastic articles* as well as *sports clothing/sports footwear*. Therefore, the distribution channels can be the same. There is a low degree of similarity when *sports clothing/sports footwear* is compared to *sporting and gymnastic articles*.

#### 4.6 Fashion design (Class 42) and tailoring services (Class 40) versus clothing (Class 25)

There is a low degree of similarity between *clothing* and *fashion design* and *tailoring* services since they share the same relevant public and might coincide in the same usual origin (producer/provider). Producers of ready-made clothing (especially suits and wedding dresses) frequently provide *tailoring* services, which are closely related to *fashion design*, which is an earlier step in the clothing production process.

### 5 Food, Beverages and Restaurant Services

#### 5.1 Ingredients of prepared food

Ingredients used for the preparation of foodstuffs are a subcategory of raw materials and treated in the same way as raw material in general. Consequently, the mere fact that one ingredient is needed for the preparation of a foodstuff will generally not be sufficient in itself to show that the goods are similar, even though they all fall under the general category of foodstuffs (judgment of 26/10/2011, T-72/10, Naty's, EU:T:2011:635, § 35-36).

##### Examples of dissimilarity

- *Eggs* (Class 29) and *ice cream* (Class 30)
- *Yeast* (Class 30) and *bread* (Class 30).

#### 5.2 Main ingredient

When the ingredient can be considered as being the main ingredient of the prepared dish, a similarity will exist only if the goods share some other relevant criterion or criteria, in particular the usual origin, nature, purpose or method of use.

##### Examples of similarity (main ingredient plus other criteria)

- *Milk* (Class 29) and *yoghurt* (Class 29)
- *Fish* (Class 29) and *fish sticks* (Class 29)
- *Dough* (Class 30) and *pizzas* (Class 30).

See also judgment of the General Court of 04/05/2011, T-129/09, *Apetito*, EU:T:2011:193, where the Court confirms the finding of similarity between a particular foodstuff and prepared meals **mainly** consisting of the same particular foodstuff.

There is no complementarity in these cases simply because one ingredient is needed for the production/preparation of another foodstuff. Complementarity applies only to the use of goods and not to their production process (see chapter 'Complementarity' and judgment of 11/05/2011, T-74/10, *Flaco*, EU:T:2011:207, § 40 and decision of 11/12/2012, R 2571/2011-2, *FRUITINI*, § 18).

### **5.3 Non-alcoholic beverages (Class 32) versus alcoholic beverages (except beers) (Class 33)**

*Non-alcoholic beverages* on the one hand, and *alcoholic beverages (except beers)*, are sold side by side in shops, bars and on drinks menus, etc. These goods target the same public and may be in competition. It must be concluded that these goods are similar to a low degree (judgment of 05/10/2011, T-421/10, Rosalia de Castro, EU:T:2011:565, § 31).

### **5.4 Beers (Class 32), alcoholic beverages (except beers) (Class 33)**

There is a similarity between different alcoholic beverages in Class 33, as well as between the broad category of *alcoholic beverages* and *beer* in Class 32. Although their production processes are different, these goods all belong to the same category of alcoholic drinks (nature) intended for the general public. They can be served in restaurants and in bars and are on sale in supermarkets and grocery stores. These drinks can be found in the same area of supermarkets, even if some distinction according to their respective subcategory can be made. Furthermore, some alcoholic beverages may originate from the same undertakings.

#### Examples

- *Beers* are similar to *alcoholic beverages (except beers)*
- *Wines* are similar to *alcoholic beverages (except wines)*.

### **5.5 Provision of food and drinks versus food and drinks**

The provision of food and drinks in Class 43 mainly covers services of a restaurant or similar services, such as catering, cafeterias and snack bars. These services are intended to serve food and drinks directly for consumption.

The mere fact that food and drinks are consumed in a restaurant is not enough reason to find similarity between them (judgment of 09/03/2005, T-33/03, Hai, EU:T:2005:89, § 45 and decision of 20/10/2011, R 1976/2010-4, THAI SPA/SPA et al., § 24-26).

Nevertheless, in certain situations these goods and services can be complementary (judgments of 17/03/2015, T-611/11 Manea Spa EU:T:2015:152, § 52; 15/02/2011, T-213/09, Yorma's, EU:T:2011:37, § 46). As shown in paragraph 3.2.4 above, goods or services are complementary if one is indispensable or important for the use of the other in such a way that consumers may think that responsibility for the production of those goods or provision of those services lies with the same undertaking.

The mere fact that food and/or drinks are essential to the services of restaurants, bars, cafeterias, etc. does not in itself lead consumers to think that responsibility for the production of those goods and provision of those services lies with the same undertaking (e.g. salt in restaurants).

On the other hand, consumers may think that responsibility lies with the same undertaking if the market reality is that the provision of food and drinks and the

manufacture of such goods are commonly offered by the same undertaking under the same trade mark (e.g. coffee in their coffee shops, ice cream in their ice cream parlours, beer in pubs). In such cases, there is a low degree of similarity.

## 6 Services to Support Other Businesses

All services listed in the class heading of Class 35 are aimed at supporting or helping other businesses to do or improve their business. They are therefore in principle directed at the professional public.

When comparing specific services falling within Class 35 it is very useful to focus on the question: Who is providing this kind of service? Is it an advertising agency, a management consultant, a human resources consultant, an accountant, an auditor, a sales agent or a tax advisor? Once the usual origin has been established it is easier to find the general indication to which the specific service belongs.

**Advertising services** consist of providing others with assistance in the sale of their goods and services by promoting their launch and/or sale, or of reinforcing the client's position in the market and acquiring competitive advantage through publicity. In order to fulfil this target, many different means and products might be used. These services are provided by advertising companies, which study their client's needs, provide all the necessary information and advice for the marketing of their products and services, and create a personalised strategy regarding the advertising of their goods and services through newspapers, websites, videos, the internet, etc.

Examples of advertising services are *rental of advertising time on communication media, telemarketing services, marketing, public relations and demonstration of goods*, since they are all intended to promote other companies' goods/services albeit via different means.

### Example

*Marketing research* is the collection and analysis of information about a particular market to assess the viability of a product or service.

The nature and purpose of advertising services are fundamentally different from the manufacture of goods or from the provision of many other services. Therefore, advertising is generally dissimilar to the goods or services being advertised. The same applies to the comparison of advertising services versus goods that can be used as a medium for disseminating advertising, such as DVDs, software, printed matter, flyers and catalogues.

**Management services** are in Class 35 when they relate to the business aspects of an entity. As there are management services in other classes, a management service in Class 35 is taken to relate to business purposes.

**Business management services** are intended to help companies manage their business by setting out the strategy and/or direction of the company. They involve activities associated with running a company, such as controlling, leading, monitoring, organising, and planning. They are usually rendered by companies specialised in this specific field such as business consultants. They gather information and provide tools

and expertise to enable their customers to carry out their business or to provide businesses with the necessary support to acquire, develop and expand market share.

Examples of business management are business research and appraisals, cost price analysis and organisation consultancy, since they are all intended to help in the strategy of a commercial undertaking. These services also include any 'consultancy', 'advisory' and 'assistance' activity that may be useful in the management of a business, such as how to efficiently allocate financial and human resources; improve productivity; increase market share; deal with competitors; reduce tax bills; develop new products; communicate with the public; do marketing; research consumer trends; launch new products and how to create a corporate identity; etc.

### Examples

*Business research* is the analysis and interpretation of economic information, such as income, employment, taxes, and demographics. This research information is used by entrepreneurs to make business decisions such as establishing marketing strategies.

*Business appraisals* involve an investigation into the nature and potential of a business and an assessment of its performance in relation to its competitors.

A *cost price analysis* is a combination of both an evaluation of the proposed total price of a project and the cost of the separate elements of that project (e.g. labour, materials, etc.) to determine if they are permissible, related to the project requirements and reasonable. It is used to determine whether going ahead with a project is a sound business decision. It is therefore considered as a service that helps in the management of the business affairs or commercial functions of an industrial or commercial enterprise. Using the information gained from a cost price analysis, a business may then go on to make the financial decisions associated with engaging in the project.

When comparing *business management* to *advertising* it should be noted that advertising is an essential tool in business management because it makes the business itself known in the market. As stated above, the purpose of advertising services is 'to reinforce the [business] position in the market' and the purpose of business management services is to help a business in 'acquiring, developing and expanding market share'. There is not a clear-cut difference between 'reinforcing a business position in the market' and 'helping a business to develop and expand market share'. A professional who offers advice regarding how to efficiently run a business may reasonably include advertising strategies in that advice because there is little doubt that advertising plays an essential role in business management. Furthermore, business consultants may offer advertising (and marketing) consultancy as a part of their services and therefore the relevant public may believe that these two services have the same professional origin. Consequently, considering the above these services are similar to a low degree (decision R 2163/2010-1, INNOGAME/INNOGAMES, § 13-17). This clear overlap between the two services also follows from the definitions given above of marketing research (an advertising service) and business research (a business management service).

***Business administration*** services are intended to help companies with the performance of business operations and, therefore, the interpretation and implementation of the policy set by an organisation's board of directors. These services consist of organising people and resources efficiently so as to direct activities toward common goals and objectives. They include activities such as personnel recruitment, payroll preparation, drawing up account statements and tax preparation, since they

enable a business to perform its business functions and are usually carried out by an entity that is separate from the business in question. They are rendered by inter alia employment agencies, auditors and outsourcing companies.

### Example

*Business auditing* involves the evaluation of a variety of business activities. It encompasses a review of organisational structures, management, processes, etc.

When comparing *business administration* to *advertising* it should be noted that these services are usually dissimilar, since a professional who helps with the execution of business decisions or the performance of business operations will not offer advertising strategies. However, the *organization of trade fairs for commercial or advertising purposes* is similar to a low degree to advertising, since they are both aimed at promoting the launch and/or sale of a company's products/services, and may target the same undertaking seeking help with the promotion of their products/services.

The line between *business management* and *business administration* is blurred, and it is sometimes very difficult to clearly distinguish between them. They both fall under the broader category of business services. As a general rule it can be said that business administration services are performed in order to organise and run a business, whereas business management follows a higher approach aimed at setting the common goals and the strategic plan for a commercial enterprise.

**Office functions** are the internal day-to-day operations of an organisation including the administration and the support services in the 'back office'. They mainly cover activities that assist in the working of a commercial enterprise. They include activities typical of secretarial services, such as shorthand and typing, compilation of information into computer databases, invoicing, administrative processing of purchase orders as well as support services, such as the rental of office machines and equipment.

### Example

*Book-keeping* is the act of recording financial transactions.

## 7 Retail Services

Retail is commonly defined as the action or business of selling goods or commodities in relatively small quantities for use or consumption rather than for resale (as opposed to wholesale, which is the sale of commodities in quantity, usually for resale).

However, it should be noted that the sale of goods is not a service within the meaning of the Nice Classification. Therefore, the activity of retail in goods as a service for which protection of an EUTM can be obtained does not consist of the mere act of selling the goods, but in the services rendered around the actual sale of the goods, which are defined in the explanatory note to Class 35 of the Nice Classification by the terms 'the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods'.

Moreover, the Court has held that the objective of retail trade is the sale of goods to consumers, which includes, in addition to the legal sales transaction, all activity carried

out by the trader for the purpose of encouraging the conclusion of such a transaction. That activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question rather than with a competitor (judgment of 07/07/2005, C-418/02, Praktiker, EU:C:2005:425, § 34).

Retail services allow consumers to satisfy different shopping needs at one stop and are usually directed at the general consumer. They can take place in a fixed location, such as a department store, supermarket, boutique or kiosk, or in the form of non-shop retailing, such as through the internet, by catalogue or mail order.

The following principles apply as regards the similarity of the goods or services at issue.

### **7.1 Retail services versus any product: dissimilar**

Retail services in general<sup>7</sup> (i.e. the specification is not limited to the sale of particular goods) are not similar to any goods that are capable of being sold by retail. Apart from being different in nature, given that services are intangible whereas goods are tangible, they serve different needs. Furthermore, the method of use of those goods and services is different. They are neither in competition with, nor necessarily complementary to, each other.

The specification of retail services relating to the sale of goods using terms such as ‘including, in particular, for example, featuring, specifically, such as’ is not precise enough since all these terms mean, in principle, ‘for example’. They do not restrict the goods that follow. Consequently, formulations such as ‘retail services, in particular of footwear’ will be treated in the same way as ‘retail services in general’, without any specification.

### **7.2 Retail services of specific goods versus same specific goods: similar to a low degree**

Retail services concerning the sale of particular goods are similar (to a low degree) to these particular goods (judgment of 05/10/2011, T-421/10, Rosalia de Castro, EU:T:2011:565, § 33). Although the nature, purpose and method of use of these goods and services are not the same, it should be noted that they display similarities, having regard to the fact that they are complementary and that those services are generally offered in the same places as those where the goods are offered for sale. Furthermore, they are directed at the same public.

The goods covered by the retail services and the specific goods covered by the other mark have to be identical in order to find a similarity, that is to say, they must either be exactly the same goods or fall under the natural and usual meaning of the category (e.g. *retail of sunglasses v sunglasses* and *retail of optical apparatus v sunglasses*).

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<sup>7</sup> ‘Retail services’ as such are not acceptable for classification purposes by the Office, unless further specified (see the Guidelines, Part B, Examination, Section 3, Classification).

### **7.3 Retail services of specific goods versus different or similar specific goods: dissimilar**

Retail services relating to the sale of particular goods and other goods are not similar. It should be remembered that in principle goods are not similar to services. Too broad a protection would be given to retail services if similarity is found where the goods sold at retail are only highly similar or similar to the goods covered by the other mark.

### **7.4 Retail services versus retail services or retail services of specific goods: identical**

Retail services in general, those that are not limited in the list to the sale of particular goods, are identical to retail services in general or retail services relating to the sale of specific goods.

### **7.5 Retail services of specific goods versus retail services of other specific goods: similar**

Retail services relating to specific goods are considered to be similar to retail services relating to other specific goods independently of whether or not there is similarity between the goods in question. The services under comparison share the same nature as both are retail services, have the same purpose of allowing consumers to conveniently satisfy different shopping needs, and have the same method of use. Furthermore, depending on whether the goods in question are commonly retailed in the same outlets, they may coincide in relevant public and distribution channels, in which case they must be considered similar.

### **7.6 Services to which the same principles apply**

The principles set out above apply to the services rendered in connection with different forms exclusively consisting of activities around the actual sale of goods, such as **retail store services, wholesale services, internet shopping, catalogue or mail order services**, etc. (to the extent that these fall into Class 35).

### **7.7 Services to which the same principles do not apply**

In contrast, the principles set out above do not apply to other services that are not limited to services around the sales of goods, or that do not fall into Class 35, such as **auctioneering services** (Class 35), **import and export services** (Class 35), **distribution services** (Class 39), **transport or repair services** (Class 37), etc.

#### Example

- **Auctioneering services**

Auctions are public sales in which goods are sold to the highest bidder. Similarity between these services and the retail of specific products will only be found insofar as

the retail services relate to goods that are commonly sold in auctions, such as objects of art.

Therefore, the specific retail or wholesale services of *pharmaceuticals, veterinary and sanitary preparations and medical supplies* for example, would be considered dissimilar to auctioneering services, since it is not common on the market for pharmaceuticals, etc. to be sold to the highest bidder.

#### Example

- **Import and export services**

Import and export services are not considered to be a sales service and thus cannot be subject to the same arguments as the comparison of goods with retail services.

Import and export services relate to the movement of goods and normally require the involvement of customs authorities in both the country of import and the country of export. These services are often subject to import quotas, tariffs and trade agreements. As they are classified in Class 35, they are considered to relate to business administration. These services do not relate to the actual retail or wholesale of the goods; they would be preparatory or ancillary to the commercialisation of such goods. For these reasons, goods are to be considered dissimilar to import and export services for those goods. The fact that the subject matter of the import/export services and the goods in question are the same is not a relevant factor for finding a similarity.

#### Example

- *Import and export of tobacco products* (Class 35) is dissimilar to *tobacco products* (Class 34).

Judgment of 09/06/2010, T-138/09, Riojavina, EU:T:2010:226, where a low degree of similarity was found between import/export of vinegar and wine, is not followed.

## **8 Financial Services**

Financial services refer to services provided by the finance industry. The finance industry encompasses a broad range of organisations that deal with the management, investment, transfer, and lending of money. Among these organisations are, for example, banks, credit card companies, insurance companies, consumer finance companies, stock brokerages and investment funds.

### **8.1 Banking services (Class 36) versus insurance services (Class 36)**

Providing *banking services* consists of the provision of all those services carried out for savings or commercial purposes concerning the receiving, lending, exchanging, investing and safeguarding of money, issuing of notes and transacting of other financial business.

Providing *insurance services* consists of accepting liability for certain risks and respective losses. Insurers usually provide monetary compensation and/or assistance in the event that a specified contingency occurs, such as death, accident, sickness, breaking of a contract and, in general, any event capable of causing damages.

Insurance services have different purposes from the services usually provided by banks, such as providing credit or asset management, credit card services, financial evaluation or stocks and bonds brokerage. Nevertheless, they have some significant aspects in common.

*Insurance services* are of a financial nature, and insurance companies are subject to similar rules of licensing, supervision and solvency as banks and other institutions providing financial services. Most banks also offer insurance services, including health insurance, or act as agents for insurance companies, with which they are often economically linked. Additionally, it is not unusual to see financial institutions and an insurance company in the same economic group.

Therefore, although *insurance services* and *banking services* have different purposes, they have a similar nature, may be provided by the same undertaking or related undertakings and share the same distribution channels. These circumstances show that *insurance services* are similar to *banking services*.

## **8.2 Real estate affairs (Class 36) versus financial affairs (Class 36)**

The term 'real estate affairs' comprises real estate property management and evaluation, and real estate agency services, as well as the consultancy and provision of information related thereto. This mainly involves finding property, making it available for potential buyers and acting as an intermediary. Consumers clearly distinguish real estate agents' services from those of financial institutions. They do not expect a bank to find housing or a real estate agent to manage their finances.

The mere fact that real estate may have to be financed in order to be purchased is not enough to find similarity between real estate affairs and financial services. Even if financial services can be important for the acquisition of real estate, the consumers usually turn first to a real estate agent to search for a property, and secondly to a financial institution to finance the property.

Any other conclusion would mean that all non-financial transactions subject to funding would be complementary to a financial service. It must therefore be concluded that these services are dissimilar even if financial services are essential or important for the use of real estate. The consumers would not attribute responsibility for both services to the same company. (judgment of 11/07/2013, T-197/12, Metro, EU:T:2013:375, § 47-51).

## **8.3 Credit cards (Class 9) versus financial services (Class 36)**

A credit card is a small plastic card issued to users as a system of payment. It allows its holder to buy goods and services based on the holder's promise to pay for these goods and services. The issuer of the card creates a revolving account and grants a line of credit to the consumer (or the user) from which the user can borrow money for payment to a merchant or as a cash advance to the user.

Financial services are offered by institutions like banks for the facilitation of various financial transactions and other related activities in the world of finance.

Even though credit cards are related to some extent to financial services, for example they can be used to withdraw money from the cash dispenser of a bank, this link is too remote to render the goods and services similar. The customers are aware of the fact that financial institutions are not responsible for the technological aspects of issuing magnetic or chip cards (decision of 07/05/2012, R 1662/2011-5, CITIBANK, § 29).

## **9 Transport, Packaging and Storage**

### **9.1 Transport of goods (Class 39) versus any product**

Services of *transport* are not considered to be similar to goods. These services are provided by specialist transport companies whose business is not the manufacture and sale of those goods. As regards the nature of the goods and services, *transport services* refer to a fleet of trucks or ships used to move goods from A to B.

#### Example

- *Pastry and confectionery* are dissimilar to *transport services*. They are different in terms of their nature, intended purpose and method of use; they are neither complementary nor in competition. All these differences explain why the service of transport and the goods of pastry and confectionery target different consumers. Transport is predominantly aimed at professionals (those who need to move goods) whereas pastry and confectionery target non-professional consumers (ordinary people who require food) (decision of 07/01/2014, R 1006/2012-G, PIONONO, § 28-36).

### **9.2 Packaging and storage of goods (Class 39) versus any product**

Equally, *packaging and storage services* merely refer to the service whereby a company's or any other person's goods are packed and kept in a particular place for a fee. Those services are not similar to any kind of goods, including any of the goods that may be packaged and stored (judgments of 07/02/2006, T-202/03, Comp USA, EU:T:2006:44; 22/06/2011, T-76/09, Farma Mundi Farmaceuticos Mundi, EU:T:2011:298, § 32 and decision of 07/01/2013, R 1006/2012-G, PIONONO, § 38).

## **10 Information Technology**

### **10.1 Computers versus software**

What we call a *computer* is actually a 'system', a combination of components that work together. The hardware devices are the physical components of that system. The hardware is designed to work hand in hand with *computer programs*, referred to as *software*. Computer hardware companies also manufacture software, share the same distribution channels and target the professional public (e.g. for use in banking and finance, education, medicine, business and entertainment/recreation) and/or the

general public. Moreover, they are complementary (see paragraph 10.2 below). These goods are considered to be similar.

## 10.2 Software versus apparatus that use software

In today's high-tech society almost all *electronic or digital apparatus* function using integrated *software*. This does not, however, lead to the automatic conclusion that software is similar to goods that use software to function successfully (see also Annex I, paragraph 1, Parts, components and fittings).

### Example of dissimilarity

- Although a *digital scale* functions using integrated *software*, this does not lead to the conclusion that software and scales are similar. One could argue that the software is important for the use of the scale; however, they are not complementary because they are not aimed at the same public. The digital scale is for the general public, whereas the software is aimed at the actual manufacturer of these scales. The producers are not the same, nor are the distribution channels, and they do not have the same purpose.

However, when the software is not an integrated part of an apparatus, can be purchased independently from it and serves, for example, to give more or different functionalities, similarity can be established.

### Example of similarity

- A *digital camera* and *software* to increase its functionalities are both aimed at the same public and produced by the same or related undertakings. They are distributed through the same channels and use of the one is indispensable for use of the other. Consequently, *digital cameras* and *software* (which includes software to e.g. increase functionalities of a digital camera) are considered to be similar.

## 10.3 Software, downloadable 'apps' and downloadable electronic publications

*Application software*, also known as 'an app', is *computer software* that is designed to help the user perform various tasks on the computer. Application software differs from system software in that it can be accessed by the user and run on the computer. Application software is usually designed with the user in mind. The new definition of *application* is used to refer to the small 'apps' that are designed for mobile phones; however, the definition covers all applications on smart phones, tablets and computers. Consequently, *software*, *application software* and *downloadable applications* are considered to be identical.

*Downloadable electronic publications* are electronic versions of traditional media, like e-books, electronic journals, online magazines, online newspapers, etc. It is becoming common to distribute books, magazines and newspapers to consumers through tablet reading devices by means of so-called 'apps' in the form of electronic publications. Consequently, there is a complementary relationship between software/'apps' and

downloadable electronic publications. Their producers can be the same; they follow the same distribution channels and the public is generally also the same. These goods are considered to be similar.

#### **10.4 Specific software versus specific software**

There are many types of software, and although software by nature (a set of instructions that enables a computer to perform a task) is the same, this does not mean that their specific purpose is the same. This implies that very specific software could even be dissimilar to another type of software.

##### Example

The field of application of *computer games software* is not the same as *software for apparatus that diagnose diseases*. Due to these significantly different fields of application, the expertise needed to develop these types of software is not the same, nor are their end users or distribution channels. These goods are therefore dissimilar.

#### **10.5 Computers and software (Class 9) versus computer programming (Class 42)**

*Computer programming* consists, inter alia, of the process of writing source code (judgment of 29/03/2012, T-417/09, Mercator Studios, EU:T:2012:174 § 26), and a computer program is a set of coded instructions that enables a machine, especially a computer, to perform a desired sequence of operations.

*Computers* are devices that compute, especially programmable electronic machines that perform high-speed mathematical or logical operations or that assemble, store, correlate, or otherwise process information. Computers need programs to operate.

*Software* is composed of programs, routines, and symbolic languages that control the functioning of the hardware and direct its operation.

Therefore, *computer programming services* are closely linked to *computers* and *software*. This is because in the field of computer science, producers of computers and/or software will also commonly provide computer and/or software-related services (as a means of keeping the system updated, for example).

Consequently, and in spite of the fact that the nature of the goods and services is not the same, both the end users and the producers/providers of the goods and services coincide. Furthermore, they are goods and services that are complementary. For these reasons these goods and services are considered similar.

## **10.6 Apparatus for recording, transmission, reproduction of sound or images, computers and software (Class 9) versus telecommunication services (Class 38)**

*Apparatus for recording, transmission or reproduction of sound or images* are apparatus and devices used to communicate audio or video information over a distance via radio waves, optical signals, etc., or along a transmission line.

*Telecommunication* services are those that allow people to communicate with one another by remote means.

Since the 1990s the boundary between *telecoms equipment* and *IT hardware/software* has become blurred as a result of the growth of the internet and its increasing role in the transfer of telecoms data. Equipment used for purposes of telecommunication, like modems, mobile phones, landline telephones, answering machines, fax machines, pagers, routers, etc. is also considered to cover the telecommunications control software that must be in place to successfully support telecommunications activities. Any software that provides the ability to perform telecommunication activities operations can be considered telecommunications control software.

Clearly, a link exists between the above goods in Class 9 and telecommunication services in Class 38. These goods and services are similar given their complementary character; although their nature is different, their purpose and distribution channels are the same (judgment of 12/11/2008, T-242/07, Q2web, EU:T:2008:488, § 24-26).