

# PRACTICAL GUIDANCE FOR COMPARING GOODS AND SERVICES

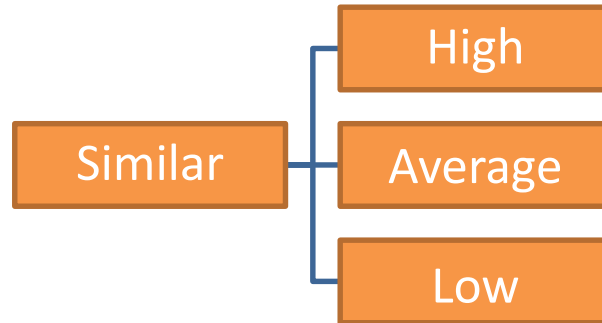
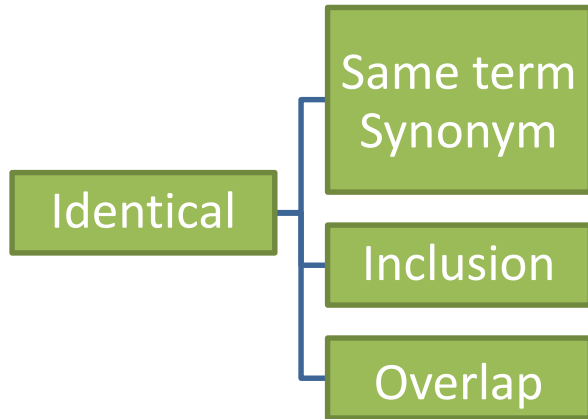
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07/02/2023

## Content

- 1. Comparison of G&S in a nutshell**
- 2. Similarity Tool & TMclass**
- 3. Comparisons step-by-step**
- 4. Recap of key points**

# 1. Comparison of G&S in a nutshell

## Possible outcomes



\*Article 33(7) EUTMR - goods or services are **not** similar or dissimilar just because they appear in the same or different classes under the Nice Classification

**Canon criteria and other factors → see Guidelines**

## **STRONG FACTORS**

### **1. Nature**

essential quality defining the product/service

### **2. Purpose**

intended use, narrow interpretation

### **4. Complementary**

indispensable for use of the other

### **5. In competition**

interchangeable products/services

### **8. Commercial origin**

usual producer/provider

## **WEAK FACTORS**



### **3. Method of use**

### **6. Distribution channels**

same points of sale, sections/shelves

### **7. Relevant public**

target consumers, general public or professionals

## Basis for assessment



### Objective approach

*comparison must be made **without** taking into account the degree of similarity of the conflicting signs or the distinctiveness of the earlier mark*

### Observations and evidence by the parties

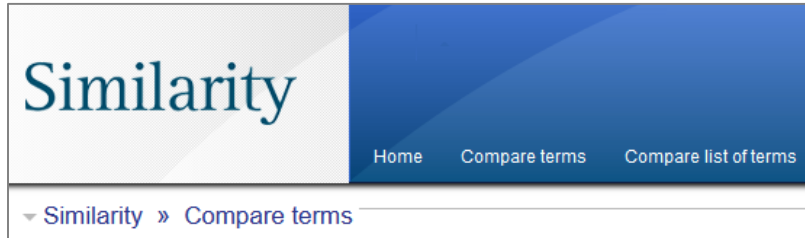
*Article 95(1) EUTMR - Office restricted to the facts, evidence and arguments provided by the parties and the relief sought*

### Well-known facts

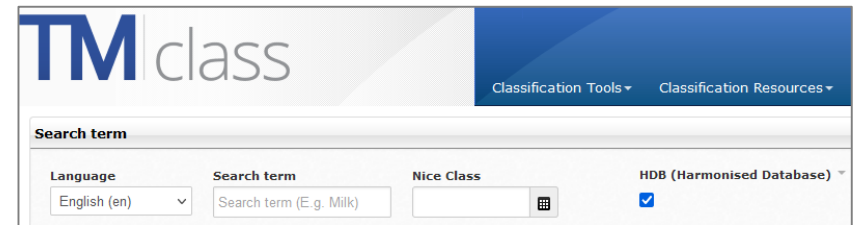
*that is to say, facts which are likely to be known by anyone - no extensive investigation by the Office (03/07/2013, T-106/12, Alpharen, § 51 and 31-32)*

## 2. Similarity Tool & TMclass

## Similarity Tool v TMclass



- Supplement to the Guidelines on Comparison of G&S 19,985
- Pairs and outcomes are binding for examiners
- Pairs may contain useful reasoning

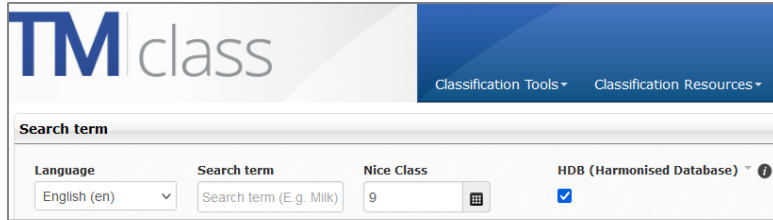


- Includes taxonomy of all terms for guidance and navigation 87.121
- Not based on literal meaning of terms, but market sectors or concepts
- Does not always show correct relationships between terms and broader categories





## TMclass



Classification Tools ▾ Classification Resources ▾

Search term

Language: English (en) ▾ Search term: Search term (E.g. Milk) Nice Class: 9 HDB (Harmonised Database)  ⓘ

++	+	+	Browse terms (Taxonomy)	Result
			<b>Classification</b>	8.274
			<b>Goods</b>	8.274
			<b>Class 9</b>	8.274
			▶ Recorded content	
			▶ Information technology and audio-visual, multimedia and photographic devices	
			▶ Communications equipment	
			▶ Data storage devices and media	
			▶ Replicating apparatus	
			▶ Data processing equipment and accessories (electrical and mechanical)	
			▶ Audio/visual and photographic devices	
			└─ Signal cables for IT, AV and telecommunication	
			└─ Magnets, magnetizers and demagnetizers	
			└─ Scientific and laboratory devices for treatment using electricity	
			▶ Apparatus, instruments and cables for electricity	
			▶ Optical devices, enhancers and correctors	
			▶ Safety, security, protection and signalling devices	
			▶ Diving equipment	
			└─ Navigation, guidance, tracking, targeting and map making devices	
			▶ Measuring, detecting, monitoring and controlling devices	
			└─ Scientific research and laboratory apparatus, educational apparatus and simulators	
			└─ Others	

- ▶ Information technology and audio-visual, multimedia and photographic devices
  - ▶ Communications equipment
  - ▶ Data storage devices and media
  - ▶ Replicating apparatus
  - ▶ Data processing equipment and accessories (electrical and mechanical)
  - ▶ Audio/visual and photographic devices
  - ▶ Signal cables for IT, AV and telecommunication

### ▶ Audio/visual and photographic devices

Displaying 1 - 25 of 160 results

<input type="checkbox"/>	9	Cable television receivers
<input type="checkbox"/>	9	Bags for cameras and photographic equipment





Browse terms (Taxonomy)		Result
<b>Classification</b>		8.274
<b>Goods</b>		8.274
<b>Class 9</b>		8.274
Recorded content		
Information technology and audio-visual, multimedia and photographic devices		
Communications equipment		
Data storage devices and media		
Replicating apparatus		
Data processing equipment and accessories (electrical and mechanical)		
Audio/visual and photographic devices		
Signal cables for IT, AV and telecommunication		
Magnets, magnetizers and demagnetizers		
Scientific and laboratory devices for treatment using electricity		
Apparatus, instruments and cables for electricity		
Optical devices, enhancers and correctors		
Safety, security, protection and signalling devices		
Diving equipment		
Navigation, guidance, tracking, targeting and map making devices		
Measuring, detecting, monitoring and controlling devices		
Scientific research and laboratory apparatus, educational apparatus and simulators		
Others		

9	Data processing equipment	Identical	9	Navigation, guidance, tracking, targeting and map making devices
9	Data processing equipment	Identical	9	Global Positioning System [GPS] apparatus

9	Computers	Identical	9	Nautical apparatus and instruments
---	-----------	-----------	---	------------------------------------

**Comment:** *Nautical apparatus and instruments includes navigational and signalling apparatus. Computers as a broader category include navigation apparatus for boats [on-board computers]. Nautical apparatus and instruments are identical to computers as the former include on-board computers used as navigation apparatus for boats.*

Class	Term	Harmonised	Harm
9	Car navigation computers	✓	M

## Car navigation computers Published

Class: **9**      Source: **Harmonized**      Reference ID: **0020725**      Scope: ✓


### TAXONOMY

Class 9 > Information technology and audio-visual, multimedia and photographic devices > Data processing equipment and accessories (electrical and mechanical) > Computers and computer hardware  
 Class 9 > Navigation, guidance, tracking, targeting and map making devices

Similarity » Compare terms

Search language English (en)	Term Search term	Term Search term	Degree of Similarity Any	Select Offices Office
Results language English (en)	Nice Class 1-45	Nice Class 1-45	Pair ID 123-456	<input type="button" value="X EUIPO"/>

\* Advanced criteria



- **Use short search words**

Instead of 'protective clothing against accidents, irradiation or fire' search for 'protect'

- **Use search word only in one class field, leave the other empty**

Instead of 'services of providing food and drink', search for 'food' in Class 43 and leave the opposite field open in Classes 29 and 30

- **Use terms without class numbers**

Instead of 'building materials made of metal' in Class 6, search for 'build mat' without class number; potentially applicable by analogy

- **Use only class numbers without terms**

Strategy technique – which goods or services are similar at all?



## Similarity

Home Compare terms Compare list of terms

My List: No pairs selected **View**

### Similarity » Compare terms

Search language: English (en) Term: mouthwashes Term: Search term Degree of Similarity: Any Select Offices: Office -

Results language: English (en) Nice Class: 5 vs Nice Class: 5 Pair ID: 123-456

Advanced criteria Reset Search

### Results

Download as Excel file

Show 25 entries

View/Hide columns

Pair ID	Office	Class 1	Term 1	Similarity	Class 2	Term 2	Reasoning	Date created	Date changed	View
0057575-0006404	EUIPO (EM)	5	Mouthwashes for medical purposes	Identical	5	Sanitary preparations for medical purposes		11/08/18	11/08/18	
0057576-0071841	EUIPO (EM)	5	Medicated mouthwash	Similar	5	Pharmaceutical preparations	2,6,7,8	17/06/18	22/09/20	
0057575-0071841	EUIPO (EM)	5	Mouthwashes for medical purposes	Similar	5	Pharmaceutical preparations	2,6,7,8	17/06/18	22/09/20	
0028940-0071841	EUIPO (EM)	5	Mouthwashes [gargles] for medical purposes	Similar	5	Pharmaceutical preparations	2,6,7,8	17/06/18	22/09/20	

Showing 1 to 4 of 4 entries

Page 1 of 1

### Assessments

Office	Similarity degree	Source	Reasoning	Documents
EM (EUIPO) (EM)	Similar	Office Practice	2,6,7,8	

Medicated mouthwashes and gargles are sanitary preparations for medical purposes. They are antiseptic solutions intended to reduce microbial load in the oral cavity. In addition, medicated mouthwashes can have other effects such as analgesic, anti-inflammatory and anti-fungal. Therefore, these goods have the same purpose as pharmaceutical preparations in that they are used when treating certain diseases and conditions of the oral cavity.



### 3. Comparisons step-by-step

## Starting point for comparison

### Consider the scope of protection of the terms

\*Taxonomy - may be helpful to show specific examples

### Natural and usual meaning

- interpretation based on literal meaning (Article 33(5) EUTMR)
- most common dictionary definition
- consider exact wording (e.g. impact of expressions and punctuation)

### Nice Classification

- may determine e.g. the nature or purpose of the goods/services

### Commercial perspective

- which is the relevant market sector?
- how are the terms used in trade?



## Nice Classification - Relevance (06/10/2021, T-397/20, Juvederm)

- Where the description of the goods is so **general** that it may cover very different goods, the class number (that the applicant has chosen) can be taken into account for the interpretation or as a precise indication of those goods. (§ 35)
- However, where the specification **clearly designates specific goods**, that wording is decisive when determining the scope of protection, even if those goods would correctly belong to a different class. (§ 45)

5	Medicinal tea	Tea?	30	Tea
32	Non-alcoholic beverages flavoured with tea		30	Iced tea



## Nice Classification - Example of explanatory note - [www.wipo.int/classifications/nice](http://www.wipo.int/classifications/nice)

### Nice Classification explanatory notes

#### **Class 5**

Pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; **diabetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for human beings and animals**; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

#### **Explanatory Note**

Class 5 includes mainly pharmaceuticals and other preparations for medical or veterinary purposes.

This Class includes, in particular:

- sanitary preparations for personal hygiene, other than toiletries;
- diapers for babies and for incontinence;
- deodorants, other than for human beings or for animals;
- medicated shampoos, soaps, lotions and dentifrices;
- dietary supplements intended to supplement a normal diet or to have health benefits;
- meal replacements and diabetic food and beverages adapted for medical or veterinary use.

This Class does not include, in particular:

- ingredients for use in the manufacture of pharmaceuticals, for example, vitamins, preservatives and antioxidants (Cl. 1);
- sanitary preparations being non-medicated toiletries (Cl. 3);
- deodorants for human beings or for animals (Cl. 3);
- support bandages, orthopaedic bandages (Cl. 10);
- meal replacements and diabetic food and beverages not specified as being for medical or veterinary use, which should be classified in the appropriate food or beverage classes, for example, low-fat potato crisps (Cl. 29), high-protein cereal bars (Cl. 30), isotonic beverages (Cl. 32).

### + information note for each Class

#### **Class 5**

The goods found in Class 5 are usually pharmaceuticals, or medical and veterinary preparations. Other items in the Class Heading and in the Alphabetical List derive their classification in Class 5 from this principle.

It should be noted that most of the goods in Class 5 are *preparations*. However, there are some consumer articles included in this class, such as adhesive plasters and bandages for dressings. It should further be noted that the bandages included in this class are used for holding dressings in place. Bandages used to support muscles or any part of the body, or for orthopaedic purposes, are in Cl. 10.

**Dietary supplements for both human beings and animals are in Class 5 regardless of whether they are for medical or veterinary purposes or not. These are substances that may or may not be nutritional, such as proteins, vitamins, trace elements, herbs, dietary fibres, glucose and enzymes, in the form of pills, capsules, tablets, powders or liquids. They can be used to supplement a normal diet or just because they are considered beneficial for the health. This is equally the case for dietary supplements with a cosmetic effect which also belong to Class 5.**

**It should be noted, however, that foodstuffs and beverages, such as cereal bars, teas, biscuits and soft drinks, as well as food for animals, that contain dietary supplements, or that are, for example, lower in calories, salt, sugar or fat, are classified in Class 5 only if they are specified as being adapted for medical or veterinary purposes. If they are not designated as being for medical or veterinary purposes, they must be classified in one of the food or beverage classes (Cl. 29, Cl. 30, Cl. 31, Cl. 32 or Cl. 33) and must be worded with adequate specificity to determine the appropriate classification.**

The reference to "sanitary preparations for medical purposes" in the Class Heading focuses on the difference between general toiletry preparations in Cl. 3 and the types of preparations that belong to Class 5. Sanitary preparations in Cl. 3 are used in personal cleaning or grooming activities, and include goods such as toilet soaps, non-medicated shampoos and personal deodorants. Sanitary preparations for medical purposes in Class 5 go beyond cleaning or grooming, they sterilize or disinfect, or may be medicated preparations, all of which are Class 5 characteristics. Goods in Class 5 therefore include disinfectant soap, medicated soap, medicated shampoos and pediculicidal shampoos. The French equivalent "produits hygiéniques" also refers to menstrual products such as sanitary towels. Based on this part of the Class Heading, and on the Explanatory Note, babies' diapers, as well as absorbent pants and diapers for incontinence, are included in Class 5 as well.



Disinfectants, preparations for destroying vermin, fungicides and herbicides are also in Class 5 because they destroy harmful microorganisms, animals and vegetation, thereby contributing to the protection of human, animal or plant health.

It should be noted that blood, living tissues and biological tissue cultures are also in Class 5 when specified as being for medical or veterinary purposes but in Cl. 1 when they are for industrial or scientific purposes.



## Nice Classification - Example of info note

### + check info notes to individual entries in the alphabetical list

- ☑ 050484  dietary supplements with a cosmetic effect
- ☑ 050307 dietetic beverages adapted for medical purposes
- ☑ 050297  dietetic foods adapted for medical purposes
- ☑ 050350 dietetic substances adapted for medical use



### 050484: dietary supplements with a cosmetic effect

#### Definition of Good or Service

A dietary supplement is "a product taken orally that contains one or more ingredients (such as vitamins or amino acids) that are intended to supplement one's diet and are not considered food" (*Merriam-Webster Online Dictionary copyright © 2018 Merriam-Webster, Incorporated*). These particular supplements are taken in order to achieve a cosmetic effect, for example, to improve the condition of the skin or hair.

#### Classification Criteria

Even though these supplements have a cosmetic use, they are still proper to [Cl. 5](#) as they are "dietary supplements" based on the Class Heading entry "dietary supplements for human beings and animals", as well as the including Explanatory Note that states: "This Class includes... dietary supplements intended to supplement a normal diet or to have health benefits".

### 050297: dietetic foods adapted for medical purposes

#### Definition of Good or Service

Dietetic foods are for use in special diets. They may be lower in salt, significantly lower in calories, gluten-free, lactose-free or have some other characteristic that means that they are specially adapted for medical reasons.

#### Classification Criteria

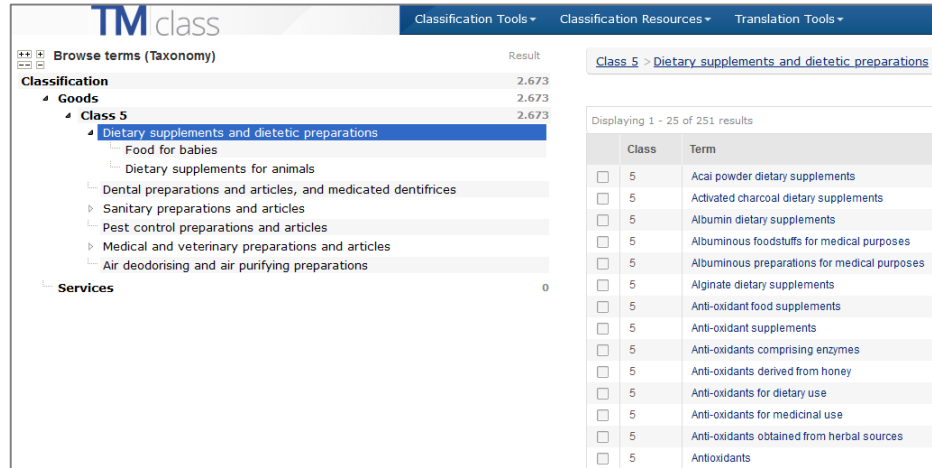
Dietetic foods and beverages are defined as being for use in special diets and belong to [Cl. 5](#) based on the mention of "dietetic food and substances adapted for medical or veterinary use" in the Class Heading. However, the term "dietetic" is often taken to mean general use foods or beverages that may be lower in calories or salt and are used for general health purposes but not prescribed by a medical professional. The appropriate classes for such foods and beverages are [Cl. 29](#), [Cl. 30](#) or [Cl. 32](#). Only those dietetic foods and beverages that are specially formulated and prescribed by medical professionals to meet the dietary needs of patients are in [Cl. 5](#).

#### See also, in the same class

[\(050307\)](#) dietetic beverages adapted for medical purposes ([Cl. 5](#))

## Taxonomy - Example of group titles

### Harmonised Data Base (HDB)



The screenshot shows the 'TM class' interface with the following structure:

- Classification Tools
- Classification Resources
- Translation Tools
- Browse terms (Taxonomy) Result
- Classification 2,673
- Goods 2,673
  - Class 5 2,673
    - Dietary supplements and dietetic preparations**
    - Food for babies
    - Dietary supplements for animals
    - Dental preparations and articles, and medicated dentifrices
    - Sanitary preparations and articles
    - Pest control preparations and articles
    - Medical and veterinary preparations and articles
    - Air deodorising and air purifying preparations
  - Services 0

Class 5 > Dietary supplements and dietetic preparations

Displaying 1 - 25 of 251 results

Class	Term
<input type="checkbox"/> 5	Acai powder dietary supplements
<input type="checkbox"/> 5	Activated charcoal dietary supplements
<input type="checkbox"/> 5	Albumin dietary supplements
<input type="checkbox"/> 5	Albuminous foodstuffs for medical purposes
<input type="checkbox"/> 5	Albuminous preparations for medical purposes
<input type="checkbox"/> 5	Alginate dietary supplements
<input type="checkbox"/> 5	Anti-oxidant food supplements
<input type="checkbox"/> 5	Anti-oxidant supplements
<input type="checkbox"/> 5	Anti-oxidants comprising enzymes
<input type="checkbox"/> 5	Anti-oxidants derived from honey
<input type="checkbox"/> 5	Anti-oxidants for dietary use
<input type="checkbox"/> 5	Anti-oxidants for medicinal use
<input type="checkbox"/> 5	Anti-oxidants obtained from herbal sources
<input type="checkbox"/> 5	Antioxidants

### Which goods might be covered?

- Slimming pills
- Vitamins
- Effervescent beverages containing trace elements and minerals
- Meal replacement cereal bars
- Feed supplements for livestock



**Taxonomy structure not based on literal meaning**

## Commercial perspective - Example of term used in trade

### Class 9: *connected bracelets*

Actual commercial nature as per use in trade may be revealed by conducting a **brief internet search**

→ *wearable activity trackers*

Info note in Nice Classification:

[\(090739\)](#) connected bracelets [measuring instruments] ([Cl. 9](#))

Connected bracelets is a general term to describe devices worn on the wrist that measure various factors, particularly physical activity, and then send the data to a connected device, such as a smartphone or computer.



## Identical goods/services - principles

### Goods are not identical to services

- Goods: any kind of item that may be traded (tangible)
- Services: any economic activity provided to **third parties** (intangible)



### Goods/services in **different** classes not identical

- Exceptions (e.g. revision of the Nice Classification, obvious mistakes)

## Identical goods/services - principles

**Obvious identity** - the goods are listed in exactly the same terms

**Synonyms** - terms have the same meaning



39	Supply of electricity	Identical	39	Distribution and transmission of electricity
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**EM**  
**(EUIPO)**  
**(EM)**






Identical

Office Practice

According to the natural and usual meaning of the words, there is no difference between supply, transmission or distribution of energy: the terms basically mean the same thing when used in a list of goods and services.

## Identical goods/services - principles

### Other scenarios of identity

- Class 25: *Clothing*  *trousers* = identical by inclusion 
- Class 28: *Golf clubs*  *sporting equipment* = identical by inclusion
- Class 9: *Scientific instruments*  *measuring instruments* = identical by overlap  
  
*laboratory pipettes*

**Comparison step-by-step** → Read the whole list → Literal meaning → TMclass → Similarity Tool

Class 12: *Vehicles; parts and fittings for vehicles.*

V

Class 12: *Apparatus for locomotion by land, air, water or rails; vehicle chassis; safety belts for vehicles; car safety seats for children.*

**vehicle 1.** any conveyance in or by which people or objects are transported, esp one fitted with wheels

Class 12	1.1
<ul style="list-style-type: none"> <li>▸ <b>Vehicles</b> and conveyances               <ul style="list-style-type: none"> <li>▸ <b>Land vehicles</b> and conveyances                   <ul style="list-style-type: none"> <li>↳ Mobility conveyances</li> <li>↳ <b>Rail vehicles</b></li> </ul> </li> <li>↳ <b>Air and space vehicles</b></li> <li>↳ <b>Water vehicles</b></li> </ul> </li> <li>▸ <b>Parts and fittings for vehicles</b> <ul style="list-style-type: none"> <li>↳ Wheels and tyres, and continuous tracks for vehicles</li> <li>↳ Anti-theft, security and <b>safety devices and equipment for vehicles</b></li> <li>↳ Parts and fittings for air and space vehicles</li> <li>↳ Parts and fittings for water vehicles</li> </ul> </li> <li>▸ <b>Parts and fittings for land vehicles</b> <ul style="list-style-type: none"> <li>↳ Powertrains, including engines and motors, for land vehicles</li> </ul> </li> </ul>	

### Safety seats for children



### Safety belts



### Safety seats covered by 'vehicle parts'?

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

## Similarity Tool - Examples

<http://euipo.europa.eu/sim/search>

1. Class 3: *Shampoo vs Car shampoo*
2. Class 9: *USB flash drives vs Computers*
3. Class 9: *Helmets for motorcyclists vs Vehicles (Class 12)*



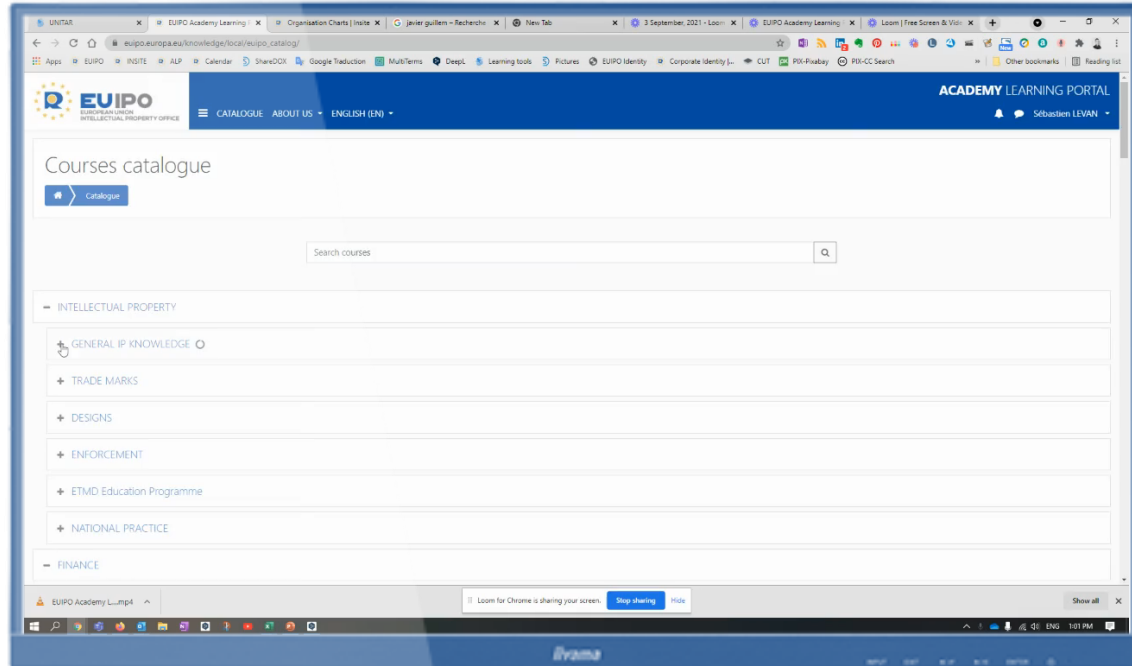
## 4. Recap of key points

## Comparison of G&S - Recap of key points

1. Determine scope of protection of the terms:
  - Dictionary definitions
  - Nice Classification - Explanatory Notes
  - TMclass - Taxonomy structure (bearing in mind literal meaning)
  - Commercial nature - internet searches
2. Consult the [Similarity Tool](#) - pairs with the **specific terms** as well as pairs with **broader or narrower terms** (look for analogies)
3. Consider which **factors** (e.g. purpose, public, producers) apply → assess the **outcome** (identical, similar or dissimilar)
4. **No extensive research** conducted by the Office: if no obvious coincidences between goods/services → **submit evidence** to prove your case



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