

**COMMON COMMUNICATION**

**COMPARISON OF GOODS AND  
SERVICES: TREATMENT OF TERMS  
LACKING CLARITY AND PRECISION AND  
COMMON INTERPRETATION OF CANON  
CRITERIA AND OTHER FACTORS**

**MARCH 2025**

## 1 BACKGROUND

The Intellectual Property Offices of the [European Union Intellectual Property Network](#) continue to collaborate in the context of converging trade mark and design practices. They have now agreed on an additional Common Practice document on trade marks with the aim of establishing some general principles on the comparison of goods and services, more specifically, on the treatment of terms lacking clarity and precision and the common interpretation of the Canon criteria and other factors, as well as some examples to illustrate the agreed statements. The specific issues that are in and out of the scope of the Common Practice are detailed in section 1.3 of that document.

The Common Practice document is made public through this Common Communication with the purpose of further increasing transparency, legal certainty and predictability for the benefit of examiners and users alike.

## 2 THE COMMON PRACTICE

The following text summarises the key messages of the Common Practice. The complete text can be found in the annex to this Common Communication.

### KEY MESSAGES OF THE COMMON PRACTICE

#### *(A) Treatment of terms lacking clarity and precision*

##### KEY NOTIONS

###### ***Clarity and precision of the goods and services; Literal interpretation of the goods and services***

The first section of the Common Practice outlines the established guidance on clarity and precision of goods and services according to the IP TRANSLATOR judgment <sup>(1)</sup> and the Trade Mark Directive (TMD) <sup>(2)</sup>, as well as the principles of the CP1 Common Practice – [Acceptability of Classification Terms and the General Indications of the Nice Class Headings](#). It emphasises that such clarity and precision is a fundamental requirement, in order to define the scope of protection and thus ensure legal certainty. It further recommends that Intellectual Property Offices inform rights holders of the need to ensure that their lists of goods and services only contain clear and precise terms and gives examples of ways to achieve this. This section continues with additional excerpts from the TMD regarding the literal interpretation of goods and services.

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<sup>(1)</sup> 19/06/2012, C-307/10, IP Translator, EU:C:2012:361.

<sup>(2)</sup> Directive (EU) No 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks.

## RELEVANT CASE-LAW AND DERIVED PRINCIPLES

***The obligation not to exclude the unclear and imprecise term from the outset in the comparison simply by invoking its lack of clarity and precision; The principle of no gain from the infringement of the obligation to draw up the list of goods and services with clarity and precision***

This section briefly mentions key principles, taken from relevant judgments. It refers to the fact that unclear and imprecise terms in the earlier mark may not be excluded from the outset in the comparison of goods and services simply by invoking a lack of clarity and precision. Moreover, it describes how any unclear and imprecise term included in the list of goods and services should not be interpreted in a way favourable to the holder/owner of the trade mark that covers such term. Lastly, it explains that a registered trade mark cannot be declared invalid on the ground that the terms designating the goods and services lack clarity and precision.

## PREMISES ON WHICH THE COMMON PRACTICE IS BASED

This section sets out several premises that are assumed to be true when applying the principles of the Common Practice. The first of these is that the term to be compared is unclear and imprecise, that there are no possible procedural steps available to the competent authority or other circumstances that could assist to clarify the unclear and imprecise term and no measures were taken by the right holder to further specify it. The second group relates to the need to consider the natural and literal meaning of unclear and imprecise terms and the principles derived from the relevant case-law. The third states that, the examples used as an illustrative reference in section 2.1.3.2. of the document are derived from the [Common Practice on the Acceptability of Classification Terms and the General Indications of the Nice Class Headings \(CP1\)](#).

***Principles for comparing terms lacking clarity and precision in the earlier or the contested mark***

Unclear or imprecise terms in the earlier or the contested mark must not be excluded from the outset in the comparison of goods and services by simply invoking a lack of clarity and precision. However, these terms can only be taken into account by giving them their natural and literal meaning and also bearing in mind the Nice Classification. The use of such terms cannot be interpreted as comprising a claim to goods or services which cannot be so understood. Furthermore, when a term lacks clarity and precision and does not enable the competent authorities, on that sole basis, to clearly determine the exact scope of protection intended to be covered by that term, it cannot be interpreted in a way favourable to the owner of the earlier or the contested mark.

***The treatment of the same or synonymous unclear and imprecise term when covered by both the earlier and the contested mark***

If both marks contain the exact same unclear and imprecise term, such as 'Machines' (Class 7), or unclear and imprecise terms that are synonymous, such as 'Goods made of plastic' and 'Plastic articles' (both in Class 20), the terms coincide completely and therefore must be considered identical.

## ***(B) Common interpretation of Canon criteria and other factors***

### **KEY NOTIONS**

#### ***Comparison of goods and services; Factors***

The purpose of this section is to clarify certain concepts. It first notes that, while the Nice Classification is not decisive for the comparison of the goods and services, the explanatory notes on the classes may be useful for determining some of their characteristics. It also introduces the Canon criteria and other factors; in other words, the various factors to be considered when assessing the similarity of goods and services, as specified by the Court of Justice of the European Union.

### **COMMON DEFINITIONS AND INTERPRETATIONS OF FACTORS**

#### ***Nature; Intended purpose; Method of use; Complementarity; In competition; Distribution channels; Relevant public; Usual origin***

This section provides a non-exhaustive list of factors to be taken into account when assessing the similarity of goods and services, namely: nature, intended purpose, method of use, complementarity, whether the goods or services are in competition with each other, distribution channels, relevant public, and usual origin. Their agreed common definitions and interpretations, as well as relevant examples, are also included. It is highlighted that this information is intended to provide guidance in the assessment and not to be indicative of any specific outcomes.

### **COMMON PRINCIPLES REGARDING THE APPLICATION OF THE FACTORS**

#### ***Interrelation between the factors; Importance/weight of the individual factors in the assessment and the possibility of a single criterion leading to a finding of similarity of the goods and services compared; Applicability of the comparison factors to the situations where (i) goods are compared to other goods, (ii) goods are compared to services and (iii) services are compared to other services***

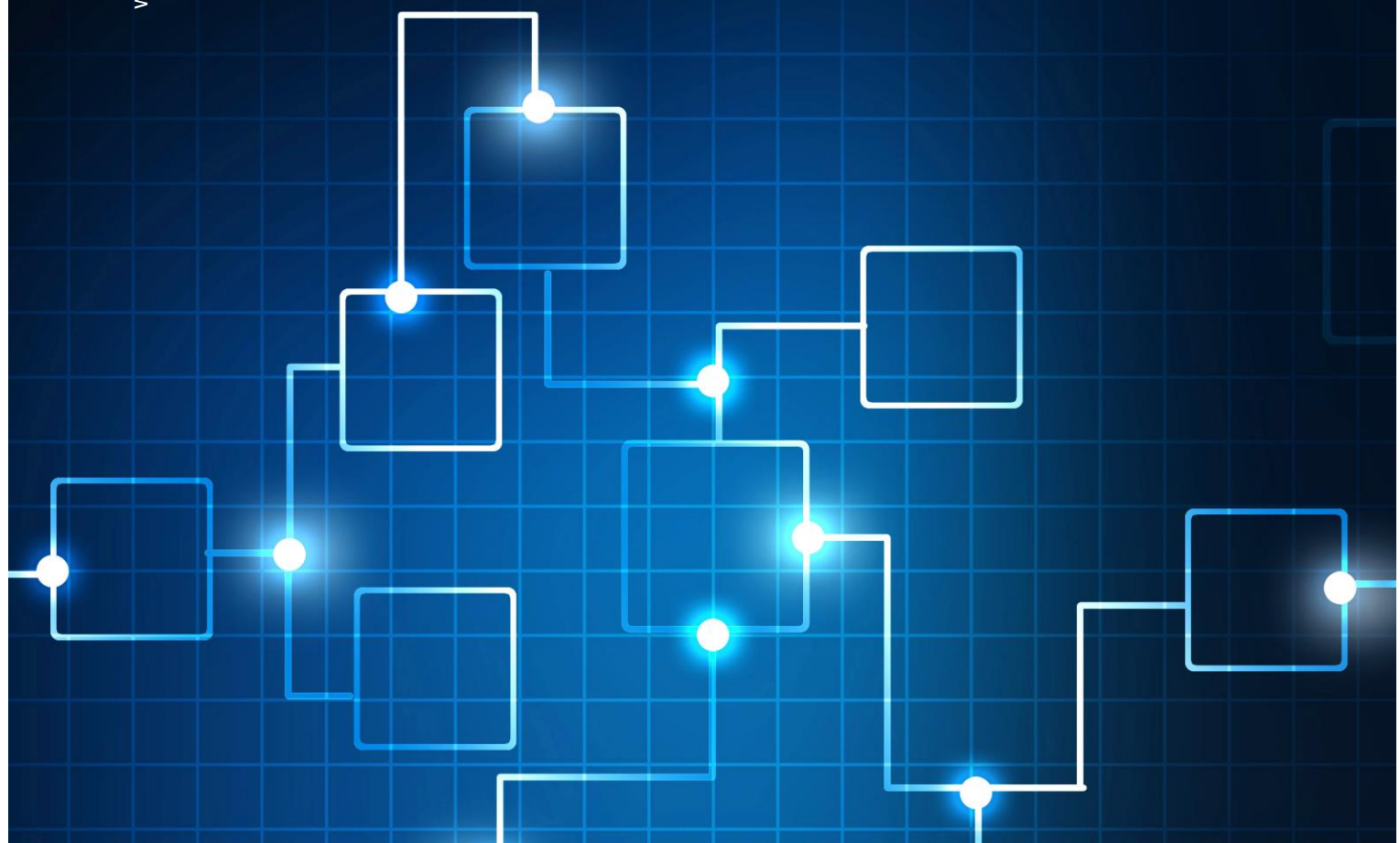
The aim of this section is to present common principles related to the application of the factors to be considered in the assessment. It first underlines that the market reality should be taken into account for the assessment of the factors, as this may have an impact on some factors. It continues with information on groups of factors that may be interrelated. This is followed by an overview of how, depending on the case, different factors may have a different weight in the assessment, and by acknowledging the possibility that a single factor could lead to a finding of similarity between the goods and services. The section ends by explaining that, in principle, the same factors for comparing goods with goods are relevant for the comparison of services with services, and goods with services, although, in applying these factors, the basic difference between goods and services (tangible versus intangible) must be considered. It adds that under certain circumstances, similarity between goods and services can be found.

### **3 IMPLEMENTATION**

As has been the case with previous common practices, this Common Practice will take effect within three months of the date of publication of this Common Communication. Further details on the implementation of this Common Practice are available in the table below. Implementing offices may choose to publish additional information on their websites.

#### **List of implementing offices**

**(\*) If there is a discrepancy between the translation of the Common Communication and the Common Practice documents in any of the official languages of the European Union and the English version, the latter will prevail.**



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## 1 INTRODUCTION

### 1.1 Objective of this document

This Common Practice document establishes some general principles on the comparison of goods and services, more specifically, on the topic of the treatment of terms lacking clarity and precision and the common interpretation of the Canon criteria and other factors, as well as some examples to illustrate the statements that have been agreed on. It serves as a reference for the European Union Intellectual Property Office (EUIPO), the Benelux Office for Intellectual Property (BOIP), and Member States' Intellectual Property Offices (MS IPOs), collectively referred to as IPOs; User Associations (UAs); applicants and representatives.

The Common Practice document will be made readily available and will be easy to access. It will provide a clear and comprehensive explanation of the principles on which it is based. The principles of the Common Practice are designed to be generally applied and aim to cover the large majority of cases. Although the comparison of goods and services will always be carried out on a case-by-case basis, the principles serve as guidance to ensure that different IPOs approach it in a similar and predictable way. Furthermore, the examples should be viewed in connection with the principles set out in the Common Practice document and should be based on the assumptions on which they rest. Furthermore, the examples should be understood as demonstrating certain principles of CP15 and not as imposing a determined outcome of the comparison of goods and services.

### 1.2 Background

IPOs and UAs have been actively cooperating to converge trade mark and design practices since the creation of the [European Union Intellectual Property Network](#) <sup>(1)</sup> (EUIPN) in 2011. Through the Convergence Programme (2011-2015), seven areas of trade mark and design practice were harmonised. The Common Practices developed as a result of the programme (CP1-CP7) have been implemented widely across the EU and have now been in force for a number of years.

In December 2015, the European Parliament and the Council adopted the EU trade mark reform package. The package contained two legislative instruments, namely [Regulation \(EU\) No 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark \(EUTMR\)](#) and [Directive \(EU\) No 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks \(TMD\)](#).

Alongside new provisions on substantive and procedural matters, the texts established a stronger legal basis for cooperative work. Under the terms of Article 151 EUTMR, cooperation with the MS IPOs and the BOIP to promote the convergence of practices and tools in the fields of trade marks and designs became a core task for the EUIPO; Article 152 EUTMR explicitly indicates that this cooperation should include the development of common examination standards and the establishment of common practices. In addition, Articles 51 and 52 TMD describe the capability of IPOs to cooperate in the convergence of practices and tools.

Based on this legislative framework, in June 2016, the Management Board of the EUIPO agreed to adopt the European Cooperation Projects. The projects were designed to build on past successes while at the same time improving processes and extending the reach of collaboration.

In the area of convergence, it included a project dedicated specifically to identifying and analysing potential

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<sup>(1)</sup> Previously known as the Trade Mark and Design Network (TMDN).



new harmonisation initiatives: the Convergence Analysis project. The project analysed the trade mark and design practices of the IPOs in order to detect areas where divergence existed and, by evaluating the likely impact, feasibility of possible scope, existing legal constraints, levels of interest among users, and practicality for the IPOs, the project aimed to determine those areas where a common practice would be most beneficial for EUIPN stakeholders. As a result of this project, five Common Practices were developed and implemented (CP8-CP12).

With its specific provisions codifying cooperation and convergence of practices into EU Law, Articles 151 and 152 EUTMR and Articles 51 and 52 TMD provide a clear mandate for further progress. Accordingly, the Convergence Analysis project was relaunched in July 2020 to identify and define new convergence projects that would best address the needs and interests of the European IP community.

‘CP15 – Comparison of goods and services: treatment of terms lacking clarity and precision and common interpretation of Canon criteria and other factors’ was recommended as the third convergence project to be launched as a result of Convergence Analysis 2.0, and the fifteenth overall.

***CP15 – Comparison of goods and services: treatment of terms lacking clarity and precision and common interpretation of Canon criteria and other factors***

In a comparison of goods and services, an interpretation of the wording of the list of goods and services is required, in particular, where the terms used are not sufficiently clear and precise to enable the competent authorities and economic operators to determine, on that sole basis, the scope of protection given to the mark, pursuant to Article 39(2) TMD. In addition, the comparison of goods and services involves comparing the goods and/or services concerned based on certain criteria, such as the Canon criteria <sup>(2)</sup> and other relevant comparison factors used in practice.

For the purpose of this Common Practice, the ‘Canon criteria and other factors’ will be collectively referred to as ‘factors’ throughout the document.

The analysis of this topic revealed a lack of harmonisation among the IPOs, in particular with regard to i) the treatment of terms lacking clarity and precision covered either by the earlier or by the contested mark in a comparison, and ii) the consistent application of the factors in the comparison of goods and services. Divergent interpretations were posing significant challenges to rights holders seeking to protect and enforce their trade marks in different jurisdictions.

In view of the above, and the interest expressed by the vast majority of IPOs and UAs in improving the level of consistency in this area, the CP15 project was approved for launch by the Management Board in November 2022. The project Working Group, composed of representatives from some of the IPOs, the EUIPO and some of the UAs, worked closely over the course of 2 years to develop a set of common principles based on settled case-law and existing practices, taking into account the feedback received from EUIPN stakeholders. The result of the EUIPN’s collaborative effort is the Common Practice outlined in this document.

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<sup>(2)</sup> 29/09/1998, C-39/97, Canon, EU:C:1998:442.

## Relevance of the Nice Classification

The goods and services in respect of which trade mark registration is applied for are classified in accordance with the Nice Classification <sup>(3)</sup>.

The scope of protection of the terms used in the list of goods and services under comparison must be determined according to their natural and usual meaning and interpreted both in the light of the Nice Classification and from a commercial perspective.

The Nice Classification mainly serves to categorise goods and services for administrative purposes and is not decisive for their comparison <sup>(4)</sup>. However, it is apparent from case-law <sup>(5)</sup> that the explanatory notes on the different classes of that Classification may be relevant in determining the nature and purpose of the goods and services in question. In particular, where the description of the goods or services for which a mark is registered is so general that it may cover very different goods or services, it is possible to take into account, for the purposes of interpretation or as a precise indication of the designation of the goods or services, the classes in the classification that the trade mark applicant has chosen.

Nevertheless, in the assessment of general terms that have been considered unclear and imprecise, the class number in which the term appears is always taken into account.

### 1.3 Practice scope

- Scope of Workstream 1 – Comparison of goods and services: treatment of terms lacking clarity and precision.

The following topics are **within** the scope of the Common Practice:

- agreement on the principles to be taken into account when comparing terms lacking clarity and precision covered by the list of goods and services of the earlier or the contested mark; and
- agreement on the treatment of the same or synonymous unclear and imprecise terms when covered by both the earlier and the contested mark.

The following topics are **out** of the scope of the Common Practice:

- provision of guidance or criteria for determining when terms are considered to be clear and precise, on the one hand, and when they lack clarity and precision, on the other <sup>(6)</sup>;
- creation of a list of concrete terms lacking clarity and precision <sup>(7)</sup>;

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<sup>(3)</sup> Article 39(1), TMD: 'The goods and services in respect of which trade mark registration is applied for shall be classified in conformity with the system of classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957 ('the Nice Classification')

<sup>(4)</sup> Article 39(7), TMD: 'Goods and services shall not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification. Goods and services shall not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification'

<sup>(5)</sup> 09/09/2019, T-575/18, The Inner Circle (fig.) / InnerCircle, EU:T:2019:580, § 38, 06/10/2021, T-397/20, Juvederm, EU:T:2021:653, § 35 and 01/09/2021, T-697/20, Donas dulcesol / Dulcesol, EU:T:2021:526, § 35.

<sup>(6)</sup> See [Common Communication on the Common Practice on the Acceptability of Classification Terms and the General Indications of the Nice Class Headings](#).

<sup>(7)</sup> *Idem*.

- convergence among the IPOs on the concrete actions/steps and procedural aspects related to the reopening of the classification, to the restriction of the list of goods and services through limitation or partial surrender, as well as to proof of use;
  - description of legal constraints preventing implementations in particular IPOs; and
  - language-related issues (e.g all examples are in English, and it will be assumed that they will be understood as a native English speaker would understand them).
- Scope of Workstream 2 – Comparison of goods and services: common interpretation of Canon criteria and other factors.

The following topics are **within** the scope of the Common Practice:

- agreement on a non-exhaustive list of factors for the comparison of goods and services and on their common definition and interpretation;
- agreement on common principles regarding the application of the factors in practice, including the following:
  - interrelation between the factors (e.g. importance/weight of the individual factors in the assessment, and the possibility of a single factor leading to a finding of similarity of the goods and services compared);
  - applicability of the factors to the situations where (i) goods are compared to other goods, (ii) goods are compared to services and (iii) services are compared to other services; and
- agreement on examples to illustrate the common definition, interpretation and application of the factors in practice.

The following topics are **out** of the scope of the Common Practice:

- creation of a list of specific pairs of terms with a determined outcome of the comparison;
- assessment of the various contexts in which the comparison of goods and services plays a role (e.g. likelihood of confusion, application by an agent, determination of the link between the signs in conflict in cases of reputation, etc.), or any other part thereof, which goes beyond the comparison of the goods and services as such;
- improvement or update of tools used for the comparison of goods and services (e.g., Similarity tool);
- description of legal constraints preventing implementations in particular MS IPOs; and
- language-related issues (e.g all examples are in English, and it will be assumed that they will be understood as a native English speaker would understand them).

## 2 THE COMMON PRACTICE

### 2.1 Comparison of goods and services: treatment of terms lacking clarity and precision

#### 2.1.1 Preliminary remarks and key notions

##### Clarity and precision of the goods and services

By issuing the IP TRANSLATOR judgment <sup>(8)</sup>, the Court of Justice of the European Union (CJEU) established the concept of ‘sufficient clarity and precision’ for the specifications of goods and services covered by a trade mark application. According to this judgment, the goods and services for which trade mark protection is sought must be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark. Moreover, the CJEU stated that some of the general indications in the class headings of the Nice Classification are not such as to meet that requirement where they are too general and cover goods or services which are too variable to be compatible with the trade mark’s function as an indication of origin <sup>(9)</sup>.

The findings of the CJEU in this judgment were subsequently reflected in the TMD, namely:

Pursuant to Recital 37 TMD: ‘(...) *In order to enable the competent authorities and economic operators to determine the extent of the trade mark protection sought on the basis of the application alone, the designation of goods and services should be sufficiently clear and precise (...)*’.

Pursuant to Article 39(2) TMD: ‘*the goods and services for which protection is sought shall be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that sole basis, to determine the extent of the protection sought*’.

Pursuant to Article 39(3) TMD, the required standards of clarity and precision apply to any general term used in a list of goods and services, including the general indications in the class headings of the Nice Classification: ‘*For the purposes of paragraph 2, the general indications included in the class headings of the Nice Classification or other general terms may be used, provided that they comply with the requisite standards of clarity and precision set out in this Article*’.

Trade mark protection is granted in relation to specific goods or services whose nature determine the extent of protection afforded to the trade mark proprietor. Therefore, the clarity and precision of the specification of goods and services is a fundamental requirement when filing a trade mark application to ensure the observance of the principle of legal certainty regarding the extent of protection conferred by the trade mark. It is the ultimate aim of the provision of Article 39(2) TMD to ensure that the content of the Register meets the requisite standard of clarity and precision. The wording used for the goods and services serves to define the scope of protection of trade marks and constitutes the starting point for examination in any proceedings where relevant. This is also apparent from national case-law <sup>(10)</sup>.

At the convergence of practices level, according to the [Common Practice on the Acceptability of Classification](#)

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<sup>(8)</sup> 19/06/2012, C-307/10, IP Translator, EU:C:2012:361.

<sup>(9)</sup> 19/06/2012, C-307/10, IP Translator, EU:C:2012:361, § 54.

<sup>(10)</sup> German Federal Patent Court decision from 07.10.2019, 29 W (pat) 26/15 – limango/Mango; EuGH GRUR 2014. In this case it was outlined that the goods and services need to be specified clearly and unambiguously, so that the scope of protection of the trade mark can be established in a quick, comprehensive and unambiguous manner.

[Terms and the General Indications of the Nice Class Headings](#) (CP1 chapter 1), which is based on the findings of the IP TRANSLATOR judgment, a description of goods and services is sufficiently clear and precise when its scope of protection can be understood from its natural and usual meaning. If this scope of protection cannot be understood, sufficient clarity and precision may be achieved by identifying other relevant aspects such as characteristics, purpose and/or identifiable market sector. Elements that could help to identify the market sector may be, but are not limited to, the following:

- consumers and/or sales channels;
- skills and know-how to be used/produced;
- technical capabilities to be used/produced.

From the above, and as stated in the IP TRANSLATOR judgment, it can be concluded that a wording or a term is **not sufficiently clear and precise** when it covers goods and services that *are too general and cover goods or services which are too variable to be compatible with the trade mark's function as an indication of origin* <sup>(11)</sup>. This situation means that it is not possible to infer with a reasonable degree of certainty which specific goods and services are actually covered, and the wording or general term does not, in itself, sufficiently reveal the commercial nature and attributes of the goods and services to be covered, such as their intended purpose, method of use, the relevant public targeted, the distribution channels, relevant market sector or usual commercial origin.

In this regard, the [Common Practice on the Acceptability of Classification Terms and the General Indications of the Nice Class Headings](#) (CP1 chapter 2), sets out a list of the general indications of the Nice class headings that were deemed to lack the clarity and precision required to specify the scope of protection that they would give, and consequently cannot be accepted without further specification, as well as the reasons why.

It follows from the above-mentioned that the clarity and precision of the terms in the list of goods and services is a fundamental requirement. However, it cannot be excluded that the Register may contain terms lacking clarity and precision in the list of goods and services of an earlier mark or goods and services not classified in accordance with the Nice Classification <sup>(12)</sup>.

As a general recommendation, IPOs are encouraged to **provide general information to rights holders about the need to ensure that their lists of goods and services only contain clear and precise terms** while still respecting the principle of impartiality. This could be achieved, for example, through the following means:

- information provided in the official guidelines of the IPOs or in other official sources; or
- information provided upon trade mark renewal; or
- information provided in a notification letter sent to both parties involved in contentious proceedings, regardless of whether the lists of goods and services contain any terms lacking clarity and precision and irrespective of the proceedings concerned.

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<sup>(11)</sup> 19/06/2012, C-307/10, IP Translator, EU:C:2012:361, § 54.

<sup>(12)</sup> See to that effect 24/01/2017, T-258/08, DIACOR/DIACOL, EU:T:2017:22, in which a Portuguese registration from 1936, which covered 'products of Class 79' in accordance with the national classification of goods in force at the time, could be invoked against an EU trade mark application.

It has to be stressed that each IPO may freely choose the means to reinforce the awareness of the requirement of clarity and precision in the specification of goods and services, adapting them to their own resources and practice.

### Literal interpretation of the goods and services

Pursuant to Recital 37 TMD: '(...) *The use of general terms should be interpreted as including only goods and services clearly covered by the literal meaning of a term (...)*'.

Moreover, pursuant to Article 39(5) TMD, '*The use of general terms, including the general indications of the class headings of the Nice Classification, shall 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 or indications shall not be interpreted as comprising a claim to goods or services which cannot be so understood.*'

#### 2.1.2 Relevant case-law and derived principles

##### 2.1.2.1 The obligation not to exclude the unclear and imprecise term from the outset in the comparison simply by invoking its lack of clarity and precision

It can be deduced from the BURLINGTON judgment <sup>(13)</sup>, as also reiterated in subsequent judgments <sup>(14)</sup>, that unclear and imprecise terms in the earlier mark may not be excluded from the outset in the comparison of goods and services simply by invoking a lack of clarity and precision. Consequently, unclear or imprecise terms in the earlier mark will have to be compared with the contested goods and services.

##### 2.1.2.2 The principle of no gain from the infringement of the obligation to draw up the list of goods and services with clarity and precision

As a general rule, the rights holder of a trade mark has the obligation to ensure that the list of goods and services complies with the requirement of clarity and precision <sup>(15)</sup>.

If the right holder does not comply with the above-mentioned requirement, any unclear and imprecise term included in the list of goods and services should not be interpreted in a way favourable to the holder/owner of the trade mark that covers such term. The General Court (GC) first applied this principle in the GREEN BY MISSAKO judgment <sup>(16)</sup> (concerning 'retail services in shops' in Class 35, without any further specification, of an earlier national mark) and subsequently, the CJEU in the CLUB GOURMET judgment <sup>(17)</sup> (concerning an unclear description of services in Class 35 of an earlier national mark that read '*An advertising phrase. It will be applied to the products covered by the trade marks*'). In NANA FINK <sup>(18)</sup> (concerning 'goods of leather and imitations of leather, and goods made of these (included in Class 18)'), the GC stated that '*the proprietor of the trade mark should not gain from the infringement of its obligation to draw up the list of goods with clarity and precision*'. '*The wording concerned cannot, in any event, be interpreted in such a way as including, for the*

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<sup>(13)</sup> 04/03/2020, C-155/18 P, C-156/18 P, C-157/18 P & C-158/18 P, BURLINGTON / BURLINGTON ARCADE et al., EU:C:2020:151, § 134-135.

<sup>(14)</sup> 24/02/2021, T-56/20, Vroom / Pop & Vroom, EU:T:2021:103, § 31; 01/03/2023, T-295/22, The Crush Series (fig.) / Crush (fig.), EU:T:2023:97, § 30-31.

<sup>(15)</sup> 09/07/2015, EUIPO Grand Board R 863/2011-G, Malta Cross International Foundation (fig.) / Maltese cross (fig.), § 55.

<sup>(16)</sup> 11/11/2009, T-162/08, GREEN by missako (fig.) / MI SA KO (fig.), EU:T:2009:432, § 31.

<sup>(17)</sup> 06/02/2014, C-301/13 P, CLUB GOURMET / CLUB DEL GOURMET EN EL CORTE INGLÉS (fig.) et al., EU:C:2014:235, § 66-67.

<sup>(18)</sup> 06/04/2017, T-39/16, NANA FINK (fig.) / NANA, EU:T:2017:263, § 48.

*benefit of the applicant, actual 'imitations of leather' also'. This principle has been reiterated by the GC in various subsequent judgments (19).*

#### No ground for cancellation of registered marks containing unclear and imprecise terms

As ruled by the CJEU in SKY (20), it is not possible to solve the problem of having an unclear and imprecise term in a registered mark by requesting the cancellation of the mark in relation to that term. Notably, it held that a mark '*cannot be declared wholly or partially invalid on the ground that the terms used to designate the goods and services in respect of which that trade mark was registered lack clarity and precision*'.

Moreover, the GC in VROOM reiterated that the lack of clarity and precision of the terms used to designate the goods and/or services covered by the registration of an earlier mark cannot, in any event, be considered a ground for invalidity of that mark (21).

#### 2.1.3 Premises on which the Common Practice is based

Workstream 1 of this Common Practice is based on the assumption that the term to be compared is unclear and imprecise, classification cannot be reopened, no measures (restriction or partial surrender) were taken by the rights holder to further specify it and there is no proof of use requested and submitted that could otherwise potentially assist in determining its scope of protection.

Therefore, in *inter partes* proceedings, in cases where a term lacking clarity and precision in the list of goods and services is relevant for the comparison, the scope of protection of such term needs to be interpreted based on i) its natural and literal meaning and ii) taking into account the principles derived from the relevant case-law, as also mentioned above in this document.

To avoid ambiguity in relation to the clarity and precision of certain terms, the examples used as an illustrative reference in section 2.1.3.2. are derived from the [Common Practice on the Acceptability of Classification Terms and the General Indications of the Nice Class Headings \(CP1\)](#), which includes a set of guidelines agreed to by all IPOs that identifies the general indications that are not sufficiently clear and precise to reveal their scope of protection.

##### 2.1.3.1 Principles to be taken into account when comparing terms lacking clarity and precision covered by the list of goods and services of the earlier or the contested mark

As already mentioned, unclear or imprecise terms in the earlier or the contested mark must not be excluded from the outset in the comparison of goods and services by simply invoking a lack of clarity and precision.

However, these terms can only be taken into account by giving them their natural and literal meaning and also bearing in mind the Nice Classification. The use of such terms cannot be interpreted as comprising a claim to goods or services which cannot be so understood.

Furthermore, when a term lacks clarity and precision and does not enable the competent authorities, on that sole basis, to clearly determine the exact scope of protection intended to be covered by that term, it cannot be interpreted in a way favourable to the owner of the earlier or the contested mark.

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(19) 27/09/2018, T-472/17, Camele'on (fig.) / CHAMELEON, EU:T:2018:613, § 29; 18/10/2018, T-533/17, nuuna (fig.) / NANU et al., EU:T:2018:698, § 62; 28/11/2019, T-736/18, Bergsteiger / BERG (fig.) et al., EU:T:2019:826, § 80.

(20) 29/01/2020, C-371/18, Sky, EU:C:2020:45, § 71.

(21) 24/02/2021, T-56/20, Vroom / Pop & Vroom, EU:T:2021:103, § 29.

*2.1.3.2 The treatment of the same or synonymous unclear and imprecise term when covered by both the earlier and the contested mark*

If both marks contain the exact same unclear and imprecise term, such as 'Machines' (Class 7), or unclear and imprecise terms that are synonymous, such as 'Goods made of plastic' and 'Plastic articles' (both in Class 20), the terms coincide completely and therefore must be considered identical.

## **2.2 Comparison of goods and services: common interpretation of Canon criteria and other factors**

### *2.2.1 Preliminary remarks and key notions*

#### **Comparison of goods and services**

The comparison of goods and services is conducted in several examination contexts, such as in the assessment of likelihood of confusion according to Article 5(1)(b) TMD.

The goods and services in respect of which trade mark registration is applied for are classified in accordance with the Nice Classification <sup>(22)</sup>. It is not decisive for the comparison <sup>(23)</sup> as it mainly serves to categorise goods and services for administrative purposes. However, the explanatory notes on the different classes can give useful indications and may be relevant for determining certain characteristics of goods and services, such as the nature, the purpose, the function, and the composition of the goods and services in question <sup>(24)</sup>.

The comparison of goods and services involves the assessment of pairs of goods and/or services based on certain factors.

#### **Factors**

Generally speaking, two items can be similar when they have some characteristics in common. The similarity of goods and/or services does not depend on any specific number of factors that could be predetermined and applied in all cases.

The similarity of goods and services was addressed in the *CANON* judgment where the CJEU held that, in assessing the similarity of goods and/or services, all the relevant factors should be taken into account.

Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary <sup>(25)</sup>. These factors are collectively referred to as the Canon criteria.

In addition to the aforementioned, other factors are often considered in case-law and IPOs' practices when comparing goods and services, such as the distribution channels <sup>(26)</sup>, the relevant public and the usual

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<sup>(22)</sup> Article 39(1), TMD.

<sup>(23)</sup> Article 39(7), TMD.

<sup>(24)</sup> 09/09/2019, T-575/18, *The Inner Circle (fig.) / InnerCircle*, EU: T:2019:580, § 38 and 06/10/2021, T-397/20, *Juvederm*, EU:T:2021:653, § 35 and 01/09/2021, T 697/20, *Donas dulcesol / Dulcesol*, EU:T:2021:526, § 35.

<sup>(25)</sup> 29/09/1998, C-39/97, *Canon*, EU:C:1998:442, § 23.

<sup>(26)</sup> 11/07/2007, T-443/05, *PiraÑAM diseño original Juan Bolaños (fig.) / PIRANHA*, EU:T:2007:219, § 37.



origin <sup>(27)</sup>.

### 2.2.2 Common definitions and interpretations of factors

As mentioned above, the CJEU held that in assessing the similarity of goods and services all the relevant factors should be taken into account <sup>(28)</sup>.

The list of factors includes, inter alia, their nature, intended purpose, method of use, complementarity, whether the goods or services are in competition with each other, distribution channels, relevant public and usual origin. This list should be regarded as non-exhaustive because there may be other factors in addition to or instead of the above-mentioned ones that may be pertinent, depending on the particular case.

For the purpose of this Common Practice, the definitions and interpretations of the factors should enable the user to understand under which circumstances the goods and services under comparison can be considered coinciding or not coinciding in certain factors. Therefore, these definitions, interpretations and examples serve the purpose of providing guidance in the assessment and should not be taken as indicative of specific outcomes in the comparison of specific goods and services.

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

#### Nature

The question to be asked is: 'What is it?'

The nature of a product or service means the essential, basic, inherent features, qualities, or characteristics by which this product or service is recognised from a commercial perspective. These could be composition, functioning principle, and physical condition in relation to goods, and the kind or category of activity provided to third parties concerning services.

The importance of the commercial perspective is illustrated in the following example: 'Car shampoo' is considered to have a different nature than 'Hair Shampoo' (both in Class 3) as a cosmetic preparation. Even though both are washing substances, it is important that, from a commercial perspective, one of them is marketed as a hair care preparation, while the other is marketed as a vehicle cleaning product.

The fact that goods and services to be compared fall under the same broad category does not automatically mean that they are of the same nature.

However, where goods and services to be compared fall under a sufficiently narrow category, it favours the finding of coincidence in their nature.

With respect to **goods**, a variety of features may be useful for defining their nature. These include the following:

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<sup>(27)</sup> 04/11/2003, T-85/02, CASTILLO / El Castillo (fig.), EU:T:2003:288, § 38; 02/06/2021, T-177/20, Hispano Suiza / Hispano Suiza, EU:T:2021:312, § 51 and the case-law cited therein; 18/07/2013, EUIPO Grand Board R 233/2012-G, PAPANAYO ORGANIC / PAPANAYO, § 67; 13/04/2022, EUIPO Grand Board R 964/2020-G, ZORAYA / VIÑA ZORAYA, § 33.

<sup>(28)</sup> 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 23.

- **Composition:** for example, ingredients, and materials of which the goods are made.

‘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 <sup>(29)</sup>.

- **Functioning principle:** for example, mechanical functioning, with or without engine/motor; optical, electrical, biological, or chemical functioning.

‘Telescope’ and ‘Binoculars’ (both in Class 9) share the same nature because they coincide in the same functioning principle, which is optical.

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

All drinks are liquid. However, when comparing two different drinks, their physical condition should not be conclusive: ‘Milk’ (Class 29) is not of the same nature as an ‘Alcoholic beverage’ (Class 33).

The above list of examples of features should clearly be regarded as non-exhaustive.

Substantial differences in those features, qualities, or characteristics often preclude the finding that the goods and services coincide in their nature.

When defining the nature of **services**, the composition of features, functioning principle and physical condition cannot be used since services are intangible. The nature 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. For example, ‘Taxi services’ (Class 39) have the same nature as ‘Bus services’ (Class 39) as they are both transport services.

### Intended purpose

The questions to be asked are: 1) ‘What need do these goods and/or services satisfy?’ and 2) ‘What problem do they solve?’.

The purpose is defined by the function of the goods and services.

The ‘intended purpose’ means the intended use of the goods and services, including the intended uses of multi-functional products, and not any other possible use.

For example, ‘Vinegar’ (Class 30) can also be used as a homemade cleaning solution. However, its intended purpose is to be used as everyday seasoning.

The purpose must be defined in a sufficiently narrow way. The more precisely the goods and services coincide in satisfying the same needs of the consumers or solving the same problems, the greater the weight of the

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<sup>(29)</sup> 04/11/2003, T-85/02, CASTILLO / El Castillo (fig.), EU:T:2003:288, § 33.

factor of intended purpose.

In contrast, where the goods and services are aimed at the same needs of the public only in very broad terms, this decreases the importance of the factor of intended purpose and may even preclude the finding of a coincidence in this factor at all.

As regards the first question in this subsection, a 'Kitchen knife' (Class 8) can be used as a screwdriver. However, its intended purpose is to be used for cutting food in the culinary sector.

In response to the second question, 'Advertising services' (Class 35), for example, 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 enabling them to acquire a competitive advantage through publicity. As another example for the second question, 'Real estate affairs' (Class 36) comprise real estate property management and evaluation, real estate agency services, as well as the consultancy and provision of related information. This mainly involves finding a property, making it available for potential buyers and acting as an intermediary.

### **Method of use**

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

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

The method of use often follows directly from the nature and/or intended purpose of the goods and services and therefore has little or no significance of its own in the similarity analysis. Notwithstanding the explanation above, the method of use may be important, independent of nature and purpose, where it characterises the goods and/or services.

However, even where the method of use characterises the goods and/or services under comparison and where it is identical for both goods and/or services, this fact alone will not be sufficient to establish similarity. For example, 'Chewing gum' (Class 30) and 'Nicotine gum for use as an aid to stop smoking' (Class 5) share the same method of use, but they have a different nature and purpose.

### **Complementarity**

The cumulative questions to be asked are: 'Is one indispensable (essential) or important (significant) for the use of the other?' **and** 'Is the connection/link so close that the consumers may think that responsibility for the production of those goods or provision of those services lies with the same undertaking?'

Goods and 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 <sup>(30)</sup>.

The connection between the goods and/or services must be established with sufficient certainty. When their connection is not close enough for each to be indispensable (essential) or important (significant) for the use of the other, no complementarity can be found.

A **functional link** between goods and/or services will usually be a strong indication of complementarity: for instance, when one product or service is required for the proper functioning of the other, one enables the use of the other, or one cannot be used without the other. For example, 'Applicators for hair dye lotions' (Class 21) complement 'Hair dye lotions' (Class 3) and are used for applying the latter properly.

There may also be a link between a certain product on the one hand, and its parts, components and fittings on the other. There is therefore complementarity when the respective part/component/fitting is sold independently and is required for proper use of the final product and/or when the part/component/fitting cannot serve its intended purpose if it is not included in the finished product.

However, any joint use of goods and/or services, where it is a question of convenience or of consumer habits or preferences, does not constitute complementarity. Where their use together is merely optional and not indispensable or important, the necessary close link is missing <sup>(31)</sup>.

The relevant public and usual commercial origin of the goods and services are important factors for establishing complementarity.

Therefore, in that sense:

1. By definition, complementary goods or services must be capable of being used together, so goods and services that are directed at different publics cannot be complementary <sup>(32)</sup>.
2. There is no complementarity between goods and/or services that are not expected to share the same commercial origin <sup>(33)</sup>.
3. When assessing whether or not the consumer would usually expect there to be a link between the goods and/or services, it is appropriate to take into account the economic reality of the market as it currently exists <sup>(34)</sup>.

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<sup>(30)</sup> 11/05/2011, T-74/10, FLACO / FLACO, EU : T:2011:207, § 40; 21/11/2012, T-558/11, ARTIS / ARTIS, EU: T:2012:615, § 25 and 04/02/2013, T-504/11, DIGNITUDE / Dignity, EU:T:2013:57, § 44.

<sup>(31)</sup> 28/10/2015, T-736/14, MoMo Monsters / MONSTER et al., EU:T:2015:809, § 29.

<sup>(32)</sup> 22/01/2009, T-316/07, easyHotel / EASYHOTEL, EU:T:2009:14, § 57-58; 25/01/2017, T-325/15, Choco Love (fig.) / CHOCOLATE, EU:T:2017:29, § 40.

<sup>(33)</sup> 17/09/2015, T-323/14, Bankia / BANKY, EU:T:2015:642, § 35, 37-38.

<sup>(34)</sup> 16/01/2018, T-273/16, METAPORN / META4 et al., EU:T:2018:2, § 41-42.

It cannot be excluded that in some sectors, such as the fashion and body and facial care sectors, goods whose nature, purpose and/or method of use are different, may be considered ‘aesthetically complementary’ in the eyes of the relevant public <sup>(35)</sup>. The GC defines ‘aesthetic complementarity’ as a connection between the products that must involve a true aesthetic necessity, in the sense that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use those products together <sup>(36)</sup>.

### **In competition**

The question to be asked is: ‘Can one of the goods and/or services substitute the other?’.

Goods and/or services are in competition with each other when there is an element of interchangeability between them <sup>(37)</sup>. That means that they serve the same basic need of the consumer.

Although specific marketing strategies, including pricing of goods and services, may differ significantly, this fact alone does not affect the analysis of whether goods and services may be in competition with each other or not.

For example, in response to the question mentioned above in this subsection, ‘Wallpapers’ (Class 27) and ‘Paints’ (Class 2) are in competition because both cover or decorate walls and one can substitute the other.

### **Distribution channels**

The questions to be asked are: 1) ‘Do the goods and/or services have the same points of sale?’ or 2) ‘Are they usually provided or offered at the same points of sale?’.

The distribution channels are the places of distribution and/or the points of sale of the goods and services.

The term ‘distribution channel’ does not refer so much to the way of selling or promoting a company’s product as to the place of distribution. For the analysis of the similarity of goods and services, the distribution system — whether direct or indirect — is not decisive.

Where the goods under comparison are offered on the same shelves, in the same sections of supermarkets or department stores where homogeneous goods are sold together, or where the services are offered in the same sections of establishments, these goods and services coincide in their distribution channels. Furthermore, this factor may apply in cases in which goods and/or services are sold exclusively or commonly in specialised shops.

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<sup>(35)</sup> 11/07/2007, T-150/04, TOSCA / TOSCA BLU (fig), EU:T:2007:214, § 35.

<sup>(36)</sup> 11/07/2007, T-150/04, TOSCA / TOSCA BLU (fig), EU:T:2007:214, § 36; 20/10/2011, T-214/09, COR / CADENACOR, EU:T:2011:612, § 32; 25/09/2018, T-435/17, HIPANEMA (fig.) / Ipanema (fig.) et al., EU:T:2018:596, § 53.

<sup>(37)</sup> ‘Interchangeability’ as used in 18/11/2020, T-21/20, K7 / K7, EU: T:2020:550, § 51 and ‘to be used as substitutes’ as in 04/11/2003, T-85/02, CASTILLO / El Castillo (fig.), EU:T:2003:288, § 35.

However, the point of sale is less important in cases where the goods and/or services under comparison move through trade channels such as supermarkets, department stores, and online platforms, which sell goods and services of all kinds, as the relevant public is aware that the goods and services sold in these places come from a multitude of independent undertakings.

For example:

- ‘Boats’ (Class 12) and ‘Sails’ (Class 22) are commonly found in specialised stores dealing with sailing equipment.
- ‘Sports clothing’ (Class 25) and ‘Gymnastic and sporting articles’ (Class 28) may share the same distribution channels and may, in particular, be sold in the same specialised shops <sup>(38)</sup>.
- ‘Electronic game consoles’ (Class 28) and ‘Computers’ (Class 9) may have the same distribution channels, in particular when the computers are fitted with specific adapted components for playing games <sup>(39)</sup>.
- ‘Chewing gum’ (Class 30) and ‘Milk’ (Class 29), even when found in supermarkets, would not be placed on the same shelf or in the same section.

### Relevant public

The question to be asked is: ‘Do the goods and/or services target the same consumers, the same business customers or the same public?’.

The relevant public is considered the actual and potential customers of the goods and services.

It can be composed of the general public (public at large) and/or a professional public (business customers or specialised public).

The relevant public is not necessarily synonymous with the end user. For instance, the end users of ‘*food for animals*’ in Class 31 are animals; however, the relevant public in this case would be the animal owners.

Some considerations can be extracted from this factor:

1. 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 and services of the most diverse origin and nature. The goods and services under comparison may target the public at large, but the purpose (of covering customers’ needs) may be different in each case. For instance, television sets, cars and books are bought by the same relevant public, namely the public at large, but they address different customers’ needs.
2. While a coincidence in the relevant public is not necessarily an indication of similarity, largely diverging publics weigh heavily against similarity.

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<sup>(38)</sup> 29/06/2023, T-719/22, Puma/EUIPO - Herno (HERZO), EU:T:2023:369, § 39.

<sup>(39)</sup> 02/03/2022, T-171/21, FOR HONOR/HONOR, EU:T:2022:104, § 62-63.

Diverging customers can be found in certain cases, for example:

1. The goods and services of both lists target business customers, who may, however, be acting in a very different market sector. Example: 'Chemicals used in forestry' versus 'Solvents for the lacquer industry' (both in Class 1).
2. The goods and services of one list target the general public whereas the goods and services of the other list target business customers. Example: 'Containers for contact lenses' (Class 9) versus 'Surgical apparatus and instruments' (Class 10).

### Usual origin

The question to be asked is: 'Are the goods and services commonly produced or provided by the same undertaking?'

The usual origin means the entity responsible for manufacturing the goods (producer) or providing the service (provider).

This factor should be assessed in the context of the market sector (industry) concerned. Account should be taken of the kind of undertakings producing the goods or offering the services in question.

In determining the usual origin of goods and services, the following features may be relevant: manufacturing sites and methods, (technical) know-how, established trade customs and market practices that are known to the relevant public (well-known facts).

In particular, the place of production can be a strong indicator that the goods and 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 'E-books' (Class 9) (goods in competition, with e-media substituting books) are both goods of a publishing company, even though the manufacturing sites may be different.

The relevant public will perceive different goods and services as having a common commercial source only where a large part of the producers/providers of the goods and services in question are the same <sup>(40)</sup>.

Different categories of goods and services which, as a general rule, are produced/provided by separate, specialist undertakings cannot be considered to have a common commercial source simply because they may be offered by very well-known brands since those cases are marginal <sup>(41)</sup>.

The mere fact that some manufacturers produce two different categories of goods, or some providers offer different categories of services, is not sufficient to demonstrate that a large part of the manufacturers or

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<sup>(40)</sup> 18/07/2013, EUIPO Grand Board R 233/2012-G, PAPAGAYO ORGANIC / PAPAGAYO, § 67; 13/04/2022, EUIPO Grand Board R 964/2020-G, ZORAYA / VIÑA ZORAYA, § 33.

<sup>(41)</sup> 02/07/2015, T-657/13, ALEX / ALEX et al., EU:T:2015:449, § 87.

distributors of those goods and services are the same <sup>(42)</sup>.

An established trade custom, such as when manufacturers expand their businesses to adjacent markets, is of particular importance for concluding whether goods and services of a 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.

For example, it is customary in the market for the producers of 'Leather belts' (Class 25) to also produce 'Leather handbags' (Class 18).

In contrast, even though 'Fuels' (Class 4) are very important for the operation of 'Vehicles' (Class 12), the goods are neither produced by the same undertakings nor marketed under the same trade mark. The relevant public would not consider those goods as having the same commercial origin, as the public would not expect a manufacturer of vehicles to also operate in the field of the extraction or refining of fuels <sup>(43)</sup>.

### 2.2.3 Common principles regarding the application of the factors

The comparison should focus on identifying the relevant factors that specifically characterise the goods and/or services to be compared. Once the relevant factors have been identified, the examiner must determine the relationship between them, and the weight attributed to the relevant factors.

In assessing the factors mentioned above, it is appropriate to take into account the economic reality of the market as it currently exists. On some occasions, the GC mentioned the market reality in the reasoning <sup>(44)</sup>.

The tendencies currently prevailing in the market practice can have an impact on the factors that the consumer expects the goods and services to usually share. The relevant factors for the comparison of goods and services in question may change over time, depending on the development in the industry concerned and how the market evolves <sup>(45)</sup>.

### Interrelation between the 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.

In principle, the following interrelations will apply:

- Complementarity, relevant public and usual origin:

Goods and services that are complementary share the same commercial origin or give consumers some cause to believe that the same undertaking is responsible for producing the goods and/or providing the services.

For example, 'Skis' (Class 28) and 'Ski boots' (Class 25) are complementary because the use of one is needed

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<sup>(42)</sup> 23/01/2014, T-221/12, SUN FRESH / SUNRIDER SUNNY FRESH (fig.), EU:T:2014:25, § 91.

<sup>(43)</sup> 18/11/2014, T-308/13, ELECTROLINERA / ELECTROLINERA, EU:T:2014:965, § 38.

<sup>(44)</sup> For example, as 'market practice' in 02/06/2021, T-177/20, Hispano Suiza / Hispano Suiza, EU:T:2021:312 and as the 'economic reality on the market' in 16/01/2018, T-273/16, METAPORN / META4 et al., EU:T:2018:2, § 43.

<sup>(45)</sup> 16/01/2018, T-273/16, METAPORN / META4 et al., EU:T:2018:2, § 41-43.



for the use of the other. The relevant public may think that the production of these goods lies with the same undertaking and that they are necessary to each other for their use.

Goods and services directed at different publics are not considered complementary. For example, the goods and services which are necessary for the running of a commercial undertaking – and therefore are designed for a limited public of specialists or of businesses – and the goods and services produced or supplied by that undertaking – that are intended for the public at large – may not be found complementary <sup>(46)</sup>.

- Purpose and relevant public:

The purpose of the goods and/or services often helps to define the relevant public.

As an example, ‘Sparkling water’ and ‘Fruit juices’ (both in Class 32) have the same purpose (to quench thirst) and they satisfy the needs of the same relevant public.

- Purpose, in competition and relevant public:

The purpose of the goods and services, together with the relevant public, may also reveal whether they could be in competition.

For example, ‘Bath towels’ (Class 24) and ‘Bathrobes’ (Class 25). The purpose of both sets of goods is to absorb moisture from wet skin, and they satisfy the needs of the same public, who can perceive them as interchangeable goods <sup>(47)</sup>.

As another example, ‘Oral contraceptives’ (Class 5) and ‘Condoms’ (Class 10) serve the same purpose and target the same relevant public, who perceives these alternative forms of contraceptives to be in competition with each other.

- Distribution channel and relevant public:

The same distribution channel goes hand in hand with the same relevant public.

For example, ‘Beer’ (Class 32) and ‘Cider’ (Class 33) are both characterised by a low alcohol content. These goods are intended to quench thirst, and they are consumed on the same occasions and in the same places. Moreover, they are offered to the same relevant public in the same commercial establishments, placed in the same sections <sup>(48)</sup>.

Similarly, ‘Precious stones’ and ‘Jewellery’ (both in Class 14) share the distribution channels, as they can both be obtained in jewellery shops, and they target the same relevant public.

- Nature, purpose and method of use:

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<sup>(46)</sup> 22/01/2009, T-316/07, *easyHotel / EASYHOTEL*, EU:T:2009:14, § 58.

<sup>(47)</sup> 09/09/2020, T-50/19, *Dayaday (fig.) / DAYADAY (fig.) et al.*, EU:T:2020:407, § 128.

<sup>(48)</sup> 15/11/2006, T-366/05, *BUDWEISER / BUDWEISER et al.*, EU:T:2006:347, § 45; 05/10/2011, T-421/10, *ROSALIA DE CASTRO / ROSALIA*, EU:T:2011:565, § 31.

The method of use usually depends on the nature and purpose of the goods.

For example, 'Bread' and 'Pretzels' (both in Class 30) are both bakery products. They are consumed on the same occasions and in the same manner, to accompany other foodstuffs, as a snack, etc. It follows that these goods coincide in nature, purpose and method of use.

As another example, retail services in relation to clothing and retail services in relation to footwear (both in Class 35) have 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.

### **Importance/weight of the individual factors in the assessment and the possibility of a single criterion leading to a finding of similarity of the goods and services compared**

The Canon criteria were enumerated in the corresponding judgment without any indication of relationship or hierarchy among them and were considered one by one.

Each factor developed by the case-law is only one factor among others and they are autonomous <sup>(49)</sup>.

In assessing the similarity of goods and services, all the relevant factors should be taken into account. However, depending on the kind of goods and services, a particular factor may be more or less important. Different factors have a different weight in the assessment, depending on the specific case.

Coincidence in the factor of nature, intended purpose, complementarity, whether they are in competition, and their usual origin, generally has a greater weight in the comparison between goods and/or services, whereas a coincidence in the factor of method of use, distribution channels, and relevant public generally has a lesser weight.

However, the factors that are relevant in a comparison of goods and/or services should be assessed on a case-by-case basis. The particularities of the specific comparison may result in some factors having a higher impact than others.

It cannot be excluded that the similarity between the goods and services may be based on a single factor <sup>(50)</sup>.

### **Applicability of the comparison factors to the situations where (i) goods are compared to other goods, (ii) goods are compared to services and (iii) services are compared to other 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 versus intangible) must be considered.

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

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<sup>(49)</sup> 02/06/2021, T-177/20, Hispano Suiza / Hispano Suiza, EU:T:2021:312, § 53.

<sup>(50)</sup> 21/01/2016, C-50/15 P, Carrera / CARRERA, EU:C:2016:34, § 23; 01/12/2021, T-467/20, ZARA / LE DELIZIE ZARA, EU:T:2021:842, § 122; 02/06/2021, T-177/20, Hispano Suiza / Hispano Suiza, EU:T:2021:312, § 53.

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. On the other hand, services consist of the provision of intangible activities.

Services can, however, be complementary to goods, and they 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.