



EN

PRACTICE PAPER

**COMPARISON OF GOODS AND
SERVICES: TREATMENT OF TERMS
LACKING CLARITY AND PRECISION
AND INTERPRETATION OF FACTORS**

**THE NORWEGIAN INDUSTRIAL
PROPERTY OFFICE (NIPO)**

Note from the IP Office:

This Practice Paper has been prepared in line with the Common Communication resulting of the Common Practice of Trade Marks developed by the European Union Intellectual Property Network (EUIPN) and aimed to give guidance about the treatment of terms lacking clarity and precision and interpretation of factors. Tailor made to the specificities of Norway, it provides for an overview of the Office quality standards within the mentioned aspects related with general principles on the comparison of goods and services.

This Practice Paper, adopted at national level, is made public with the purpose of further increasing transparency, legal certainty, and predictability for the benefit of examiners and users alike.

1 BACKGROUND

This practice is in relation to trade marks and aims to establish some general principles on the comparison of goods and services, more specifically, on the treatment of terms lacking clarity and precision and the interpretation of relevant factors⁽¹⁾, as well as some examples to illustrate these statements. The specific issues that are in and out of the scope of the practice are detailed in section 1.2 of that Practice Paper.

This practice is made public through this Practice Paper with the purpose of further increasing transparency, legal certainty, and predictability for the benefit of examiners and users alike.

2 THE PRACTICE

The following text summarises the key messages of the practice. The complete text can be found in the second part of this document.

KEY MESSAGES OF THE 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 practice outlines the established guidance on clarity and precision of goods and services according to the IP TRANSLATOR judgment (1) and the Trade Mark Directive (TMD) (2), as well as the principles of the practice on the *Acceptability of Classification Terms and the General Indications of the Nice Class Headings* (Annex I and Annex II, respectively). It emphasises that such clarity and precision is a fundamental requirement, in order to define the scope of protection and thus ensure legal certainty. This section continues with additional excerpts from the TMD regarding the literal interpretation of goods and services.

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 [and it], 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.

⁽¹⁾ 29/09/1998, C-39/97, Canon, EU:C:1998:442.

PREMISES ON WHICH THE PRACTICE IS BASED

This section sets out several premises that are assumed to be true when applying the principles of the 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 group states that, the examples used as an illustrative reference in section 2.1.3.2. of the document are derived from the practice on the *Acceptability of Classification Terms and the General Indications of the Nice Class Headings* (Annexes I and II).

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) Interpretation 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 various factors to be considered when assessing the similarity of goods and services, as specified by the Court of Justice of the European Union.

DEFINITIONS AND INTERPRETATIONS OF FACTORS

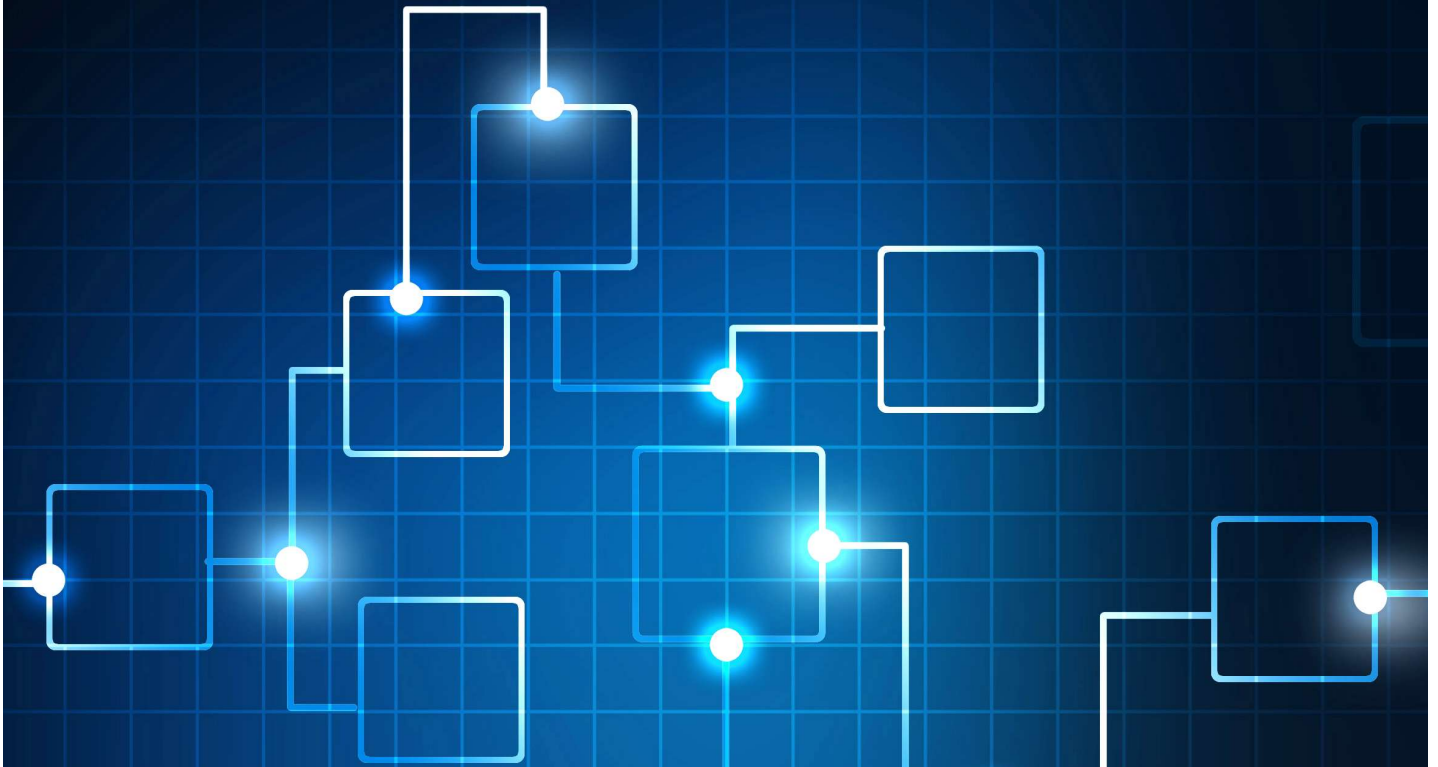
Nature; Intended purpose; Method of use; Complementarity; In competition; Distribution channels; Relevant public; Usual origin

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. 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.

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 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.



The Practice

Three glowing blue squares are positioned at the top of the text block, each with a bright white dot at its center. They are arranged horizontally with some vertical offset.

**COMPARISON OF GOODS AND SERVICES:
TREATMENT OF TERMS LACKING
CLARITY AND PRECISION AND
INTERPRETATION OF FACTORS**

TABLE OF CONTENTS

1.	INTRODUCTION	1
1.1.	OBJECTIVE OF THIS DOCUMENT	1
1.2.	PRACTICE SCOPE	1
2.	THE PRACTICE	2
2.1.	COMPARISON OF GOODS AND SERVICES: TREATMENT OF TERMS LACKING CLARITY AND PRECISION	2
2.1.1.	<i>PRELIMINARY REMARKS AND KEY NOTIONS</i>	2
2.1.2.	<i>RELEVANT CASE-LAW AND DERIVED PRINCIPLES</i>	4
2.1.2.1.	<i>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</i>	4
2.1.2.2.	<i>THE PRINCIPLE OF NO GAIN FROM THE INFRINGEMENT OF THE OBLIGATION TO DRAW UP THE LIST OF GOODS AND SERVICES WITH CLARITY AND PRECISION</i>	4
2.1.3.	<i>PREMISES ON WHICH THE PRACTICE IS BASED</i>	5
2.1.3.1.	<i>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</i>	5
2.1.3.2.	<i>THE TREATMENT OF THE SAME OR SYNONYMOUS UNCLEAR AND IMPRECISE TERM WHEN COVERED BY BOTH THE EARLIER AND THE CONTESTED MARK</i>	5
2.2.	COMPARISON OF GOODS AND SERVICES: INTERPRETATION OF FACTORS	6
2.2.1.	<i>PRELIMINARY REMARKS AND KEY NOTIONS</i>	6
2.2.2.	<i>DEFINITIONS AND INTERPRETATIONS OF FACTORS</i>	6
2.2.3.	<i>PRINCIPLES REGARDING THE APPLICATION OF THE FACTORS</i>	13
	ANNEX I – ACCEPTABILITY OF CLASSIFICATION TERMS	19
	ANNEX II – GENERAL INDICATIONS OF THE NICE CLASS HEADINGS	21

1. INTRODUCTION

1.1. Objective of this document

This Practice Paper aims to establish 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 interpretation of factors, as well as some examples to illustrate these statements. It is meant to serve as a reference for the Intellectual Property Office, users associations, applicants, representatives and other interested persons.

The Practice Paper is made readily available and easily accessible, providing a clear and comprehensive explanation of the principles on which the practice is based. The principles of the 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 for the office. The examples should be viewed in connection with the principles set out in the Practice Paper and should be based on the assumptions on which they rest. Furthermore, the examples should be understood as demonstrating certain principles and not as imposing a determined outcome of the comparison of goods and services.

1.2. Practice scope

- Comparison of goods and services: treatment of terms lacking clarity and precision.

The following topics are **within** the scope of the practice:

- 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
- 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 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 (see Annex I);
 - creation of a list of concrete terms lacking clarity and precision (see Annex II);
 - 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 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).
- Comparison of goods and services: interpretation of factors.

The following topics are **within** the scope of the practice:

- non-exhaustive list of factors for the comparison of goods and services and their definition and interpretation;
- 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
 - examples to illustrate the definition, interpretation and application of the factors in practice.

The following topics are **out** of the scope of the 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;
- tools used for the comparison of goods and services, and their improvement or update; 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 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 ⁽¹⁾, 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 ⁽²⁾.

The findings of the CJEU in this judgment were subsequently reflected in the TMD, namely on recital 37, article 39(2) and 39(3). For more reference, please consult the TMD [here](#).

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 certain provisions, such as 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.

Annex I provides that 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

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

⁽²⁾ 19/06/2012, C-307/10, IP Translator, EU:C:2012:361, § 54.

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, 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* ⁽³⁾. 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, Annex II of this Practice Paper 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 ⁽⁴⁾.

The IPO is 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.

It has to be stressed that the 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 its 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*

⁽³⁾ 19/06/2012, C-307/10, IP Translator, EU:C:2012:361, § 54.

⁽⁴⁾ 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.

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 ⁽⁵⁾, as also reiterated in subsequent judgments ⁽⁶⁾, 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 ⁽⁷⁾.

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 ⁽⁸⁾ (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 ⁽⁹⁾ (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 ⁽¹⁰⁾ (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 benefit of the applicant, actual "imitations of leather" also*'. This principle has been reiterated by the GC in various subsequent judgments ⁽¹¹⁾.

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

As ruled by the CJEU in SKY ⁽¹²⁾, 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*'.

⁽⁵⁾ 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.

⁽⁶⁾ 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.

⁽⁷⁾ 09/07/2015, EUIPO Grand Board R 863/2011-G, Malta Cross International Foundation (fig.) / Maltese cross (fig.), § 55.

⁽⁸⁾ 11/11/2009, T-162/08, GREEN by missako (fig.) / MI SA KO (fig.), EU:T:2009:432, § 31.

⁽⁹⁾ 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.

⁽¹⁰⁾ 06/04/2017, T-39/16, NANA FINK (fig.) / NANA, EU:T:2017:263, § 48.

⁽¹¹⁾ 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.

⁽¹²⁾ 29/01/2020, C-371/18, Sky, EU:C:2020:45, § 71.

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 ⁽¹³⁾.

2.1.3. Premises on which the practice is based

The first part of this 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 set of guidelines in Annex I identifying 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.

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.

⁽¹³⁾ 24/02/2021, T-56/20, Vroom / Pop & Vroom, EU:T:2021:103, § 29.

2.2. Comparison of goods and services: interpretation of 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 ⁽¹⁴⁾. It is not decisive for the comparison ⁽¹⁵⁾ 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 ⁽¹⁶⁾.

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.

In assessing the similarity of goods and/or services, all the relevant factors should be taken into account¹⁷.

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 ⁽¹⁸⁾.

In addition to the aforementioned, other factors are often considered when comparing goods and services, such as the distribution channels ⁽¹⁹⁾, the relevant public and the usual origin ⁽²⁰⁾.

2.2.2. 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 ⁽²¹⁾.

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.

⁽¹⁴⁾ Article 39(1), TMD.

⁽¹⁵⁾ Article 39(7), TMD.

⁽¹⁶⁾ 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.

⁽¹⁷⁾ 29/09/1998, C-39/97, *Canon*, EU:C:1998:442, § 23.

⁽¹⁸⁾ 29/09/1998, C-39/97, *Canon*, EU:C:1998:442, § 23.

⁽¹⁹⁾ 11/07/2007, T-443/05, *PiraÑAM diseño original Juan Bolaños (fig.) / PIRANHÁ*, EU:T:2007:219, § 37.

⁽²⁰⁾ 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, *PAPAGAYO ORGANIC / PAPAGAYO*, § 67; 13/04/2022, EUIPO Grand Board R 964/2020-G, *ZORAYA / VIÑA ZORAYA*, § 33.

⁽²¹⁾ 29/09/1998, C-39/97, *Canon*, EU:C:1998:442, § 23.

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 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:

- **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 ⁽²²⁾.

- **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.

⁽²²⁾ 04/11/2003, T-85/02, CASTILLO / El Castillo (fig.), EU:T:2003:288, § 33.

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 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 ⁽²³⁾.

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

⁽²³⁾ 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.

or preferences, does not constitute complementarity. Where their use together is merely optional and not indispensable or important, the necessary close link is missing ⁽²⁴⁾.

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 ⁽²⁵⁾.
2. There is no complementarity between goods and/or services that are not expected to share the same commercial origin ⁽²⁶⁾.
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 ⁽²⁷⁾.

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 ⁽²⁸⁾. The GC defines 'aesthetic complementarity' [can be defined] 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 ⁽²⁹⁾.

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 ⁽³⁰⁾. 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.

⁽²⁴⁾ 28/10/2015, T-736/14, MoMo Monsters / MONSTER et al., EU:T:2015:809, § 29.

⁽²⁵⁾ 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.

⁽²⁶⁾ 17/09/2015, T-323/14, Bankia / BANKY, EU:T:2015:642, § 35, 37-38.

⁽²⁷⁾ 16/01/2018, T-273/16, METAPORN / META4 et al., EU:T:2018:2, § 41-42.

⁽²⁸⁾ 11/07/2007, T-150/04, TOSCA / TOSCA BLU (fig), EU:T:2007:214, § 35.

⁽²⁹⁾ 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.

⁽³⁰⁾ '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.

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.

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 ⁽³¹⁾.
- '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 ⁽³²⁾.
- '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).

⁽³¹⁾ 29/06/2023, T-719/22, Puma/EUIPO - Herno (HERZO), EU:T:2023:369, § 39.

⁽³²⁾ 02/03/2022, T-171/21, FOR HONOR/HONOR, EU:T:2022:104, § 62-63.

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.

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 ⁽³³⁾.

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 ⁽³⁴⁾.

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 distributors of those goods and services are the same ⁽³⁵⁾.

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 ⁽³⁶⁾.

2.2.3. 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 ⁽³⁷⁾.

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 ⁽³⁸⁾.

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.

⁽³³⁾ 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.

⁽³⁴⁾ 02/07/2015, T-657/13, ALEX / ALEX et al., EU:T:2015:449, § 87.

⁽³⁵⁾ 23/01/2014, T-221/12, SUN FRESH / SUNRIDER SUNNY FRESH (fig.), EU:T:2014:25, § 91.

⁽³⁶⁾ 18/11/2014, T-308/13, ELECTROLINERA / ELECTROLINERA, EU:T:2014:965, § 38.

⁽³⁷⁾ 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.

⁽³⁸⁾ 16/01/2018, T-273/16, METAPORN / META4 et al., EU:T:2018:2, § 41-43.

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 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 ⁽³⁹⁾.

- 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 ⁽⁴⁰⁾.

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 ⁽⁴¹⁾.

⁽³⁹⁾ 22/01/2009, T-316/07, *easyHotel* / *EASYHOTEL*, EU:T:2009:14, § 58.

⁽⁴⁰⁾ 09/09/2020, T-50/19, *Dayaday* (fig.) / *DAYADAY* (fig.) et al., EU:T:2020:407, § 128.

⁽⁴¹⁾ 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.

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:

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 ⁽⁴²⁾.

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 ⁽⁴³⁾.

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

⁽⁴²⁾ 02/06/2021, T-177/20, Hispano Suiza / Hispano Suiza, EU:T:2021:312, § 53.

⁽⁴³⁾ 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.

services and services also apply in cases where goods are compared with services.

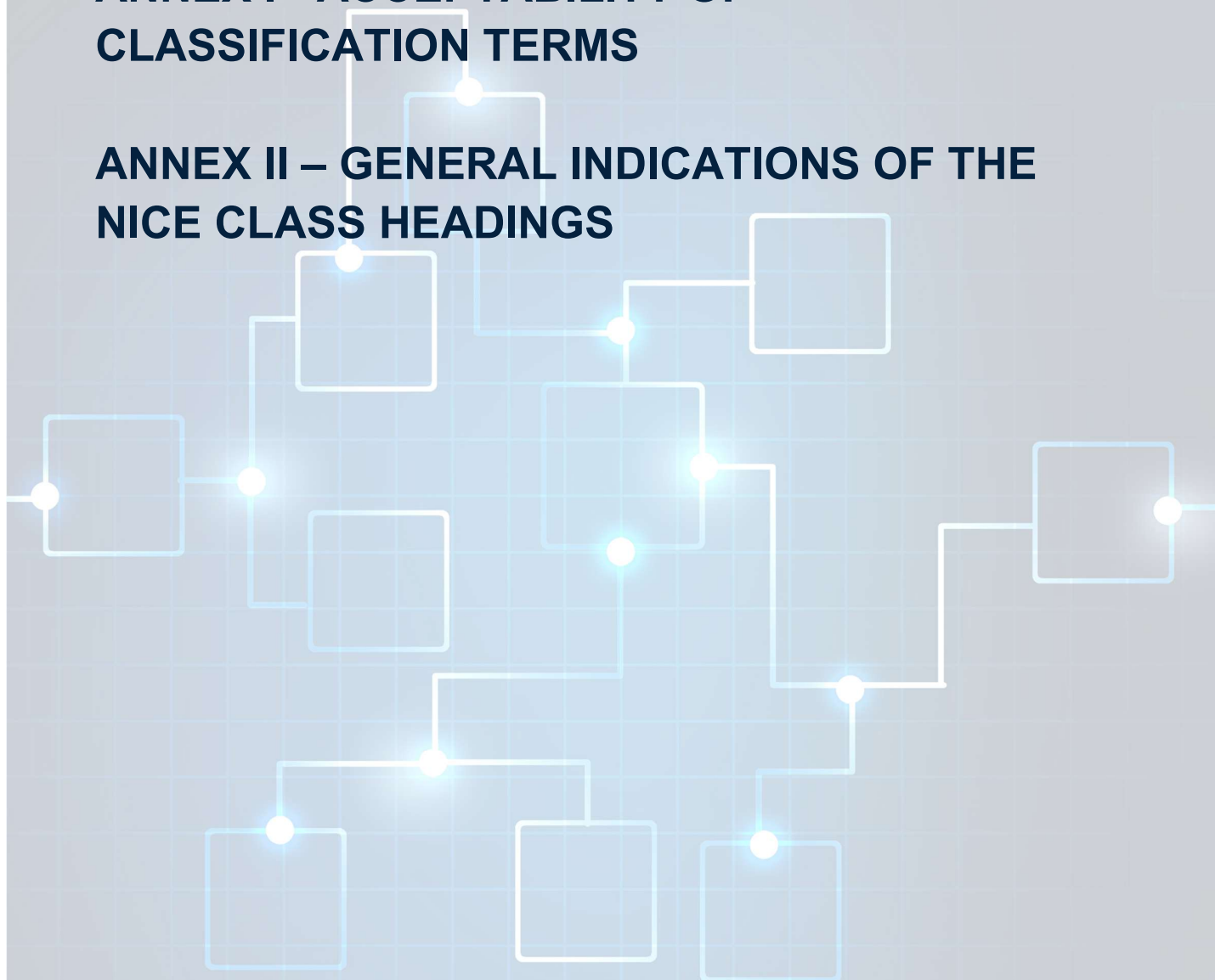
By their nature, goods are generally dissimilar to services. This is because goods are articles of trade, wares or merchandise. Their sale usually entails the transfer in title of something physical. On the other hand, services consist of the provision of intangible activities.

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.

ANNEXES

ANNEX I - ACCEPTABILITY OF CLASSIFICATION TERMS

ANNEX II – GENERAL INDICATIONS OF THE NICE CLASS HEADINGS



Note from the Office on Annexes

Annex I and Annex II have been prepared in line with the Common Communication resulting of the Common Practice of Trade Marks developed by the European Union Intellectual Property Network (EUIPN) and aimed to give guidance about the acceptability of classification terms and the general indications of the Nice class headings. Tailor made to the specificities of Norway, it provides set of guidelines that will help to identify when any classification term is sufficiently clear and precise, and provides information on the Nice class headings considered to lack the clarity and precision to specify the scope of protection that they would give, and consequently cannot be accepted without further specification.

ANNEX I – ACCEPTABILITY OF CLASSIFICATION TERMS

Below is a set of three guidelines that will help to identify when any classification term is sufficiently clear and precise.

The set of guidelines is the following:

- I. Explanation when a description of goods and services is sufficiently clear and precise
- II. Examples of factors that can add sufficient clarity and precision
- III. Specification of terms in a number of classes

The guidelines can be of help to reason the acceptance or rejection of any classification term that is applied for.

Explanatory notes

The Nice Classification is a system of classifying the goods and services that can be found in the global marketplace into “classes”.

The Nice Classification is based on the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, which is administered by the World Intellectual Property Office (WIPO).

It consists of a list of classes, explanatory notes and an alphabetical list of goods and services. The list of classes of Nice Classification, guidelines, explanatory notes, and general remarks on classification practice published by WIPO is the primary source of interpretation of the acceptability of any classification term.

There are 34 classes of goods and 11 classes of services. The class headings are general indications relating to the fields to which, in principle, the goods and services belong. The general indications of the Nice class headings are the expressions that appear in the class headings between semicolons, for example, Class 13 is made up of 4 general indications: “Firearms;”, “ammunition and projectiles;”, “explosives;” and “fireworks”. The class number may give further clarification but is not a decisive factor.

Tools such as TMclass are available to assist in searching for and identifying acceptable terms.

Guidelines

I. Explanation when a description of goods and services is sufficiently clear and precise

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.

II. Examples of factors that can add sufficient clarity and precision

If this scope of protection cannot be understood, sufficient clarity and precision may be achieved by identifying factors such as characteristics, purpose and/or identifiable market sector⁴⁴. Elements that could help to identify the market sector may be, but are not limited to, the following

- consumers and/or sales channels

⁴⁴ Market sector describes a set of businesses that are buying and selling such similar goods and services that they are in direct competition with each other.

- skills and know-how to be used/produced
- technical capabilities to be used/produced.

Non-exhaustive list of examples

Not clear and precise term	Proposals / possible solutions: (examples from harmonised database⁴⁵)
Goods of common metal not included in other classes (cl 6)	Construction elements of metal (cl 6)
	Building materials of metal (cl 6)
Machines (cl 7)	Agricultural machines (cl 7)
	Machines for processing plastics (cl 7)
	Milking machines (cl 7)
Goods in precious metals or coated therewith (cl 14)	Works of art of precious metal (cl 14)
Goods made from paper and cardboard (cl 16)	Filtering materials of paper (cl 16)
Goods made from rubber, gutta-percha, gum, asbestos and mica (cl 17)	Rings of rubber (cl 17)
Goods made of these materials [leather and imitations of leather] (cl 18)	Briefcases [leather goods] (cl 18)

III. Specification of terms in a number of classes

A term may be part of the description of goods and services in a number of classes; it may be clear and precise in a particular class without further specification. For example Furniture (cl 20), Clothing (cl 25).

If protection is sought for a specialised category of goods and services or a specialised market sector belonging to a different class, further specification of the term may be necessary. For example Furniture especially made for medical purposes (cl 10), Furniture especially made for laboratories (cl 9), Protective clothing (cl 9), Clothing especially for operating rooms (cl 10), Clothing for pets (cl 18).

Tools such as [TMclass](#) are available to determine whether the particular category of goods and services needs this further specification or not.

⁴⁵ Harmonised database, accessible in [TMclass](#).

ANNEX II – GENERAL INDICATIONS OF THE NICE CLASS HEADINGS

The general indications are the expressions that appear in the class headings between semicolons; for example, Class 13 is made up of 4 general indications: “Firearms;”, “ammunition and projectiles;”, “explosives;” and “fireworks”.

The general indications of the Nice class headings were examined with respect to the requisites of clarity and precision. Of these, five were considered to lack the clarity and precision to specify the scope of protection that they would give, and consequently cannot be accepted without further specification. These are set out below, highlighted in bold⁴⁶.

- Cl. 7 – **Machines** and machine tools
- Cl. 37 – **Repair**
- Cl. 37 – **Installation services**
- Cl. 40 – **Treatment of materials**
- Cl. 45 – **Personal and social services rendered by others to meet the needs of individuals**

In some cases, a part of a general indication may be considered to be sufficiently clear and precise if used on its own, for example, in the general indication “Machines and machine tools”, the description ‘machine tools’ on its own would be acceptable because it describes a specific type of goods. Where this applies, the part of the general indication is shown in grey.

The reasons why each of the five general indications of the Nice class headings are not clear and precise are expressed below.

- Cl. 7 – **Machines** and machine tools - In light of the need for clarity and precision, the term “machines” does not provide a clear indication of what machines are covered. Machines can have different characteristics or different purposes, they may require very different levels of technical capabilities and know-how to be produced and/or used, could be targeting different consumers, be sold through different sales channels, and therefore relate to different market sectors.
- Cl. 37 – **Repair** - In light of the need for clarity and precision, this term does not provide a clear indication of the services being provided, as it simply states that these are repair services, and not what is to be repaired. As the goods to be repaired may have different characteristics, the repair services will be carried out by service providers with different levels of technical capabilities and know-how, and may relate to different market sectors.
- Cl. 37 – **Installation services** - In light of the need for clarity and precision, this term does not provide a clear indication of the services being provided, as it simply states that these are installation services, and not what is to be installed. As the goods to be installed may have different characteristics, the installation services will be carried out by service providers with different levels of technical capabilities and know-how, and may relate to different market sectors.
- Cl. 40 – **Treatment of materials** - In light of the need for clarity and precision, this term does not give a clear indication of the services being provided. The nature of the treatment is unclear, as are the materials to be treated. These services cover a wide range of activities performed by different service providers on materials of different characteristics requiring very different levels of technical capabilities and know-how, and may relate to different market sectors.

⁴⁶ After an update in Nice Class version (2016 version of the Nice 10th Edition).

-
- Cl. 45 – **Personal and social services rendered by others to meet the needs of individuals** - In light of the need for clarity and precision, this term does not give a clear indication of the services being provided. These services cover a wide range of activities performed by different service providers requiring very different levels of skill and know-how, and may relate to different market sectors.