

Promoting Intellectual  
Property Rights in the  
ASEAN Region



## TRAINING ON THE ASEAN COMMON GUIDELINES FOR THE SUBSTANTIVE EXAMINATION OF TRADEMARKS

### MODULE 3:

COMPARISON OF GOODS AND SERVICES  
(SIMILARITY OF GOODS AND SERVICES)

Thom CLARK | 28 May 2020



Funded by the European Union



This Project is funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

- ❑ Distinctiveness of three-dimensional marks (shape marks) containing verbal and/or figurative elements when the shape is non-distinctive
- ❑ New types of trademarks – examination of formal requirements and grounds for refusal
- ❑ Comparison of goods and services (similarity of goods and services)

## COMPARISON OF GOODS AND SERVICES

- Legal framework and main rules
- Identity
- Similarity (Canon criteria)
- Particular scenarios

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## COMPARISON OF GOODS AND SERVICES – Legal framework

### **Art. 8(1)(a) / (b): Double Identity/Likelihood of confusion**

- ✓ G&S must be identical or similar
- ✓ Signs must be identical or similar
- ✓ Global assessment and interdependence

## COMPARISON OF GOODS AND SERVICES – Legal framework

- ✓ Objective approach
- ✓ Well-known facts
- ✓ Arguments of the parties

## COMPARISON OF GOODS AND SERVICES

- Legal framework and main rules
- **Identity**
- Similarity (Canon criteria)
- Particular scenarios

## COMPARISON OF GOODS AND SERVICES - Identity

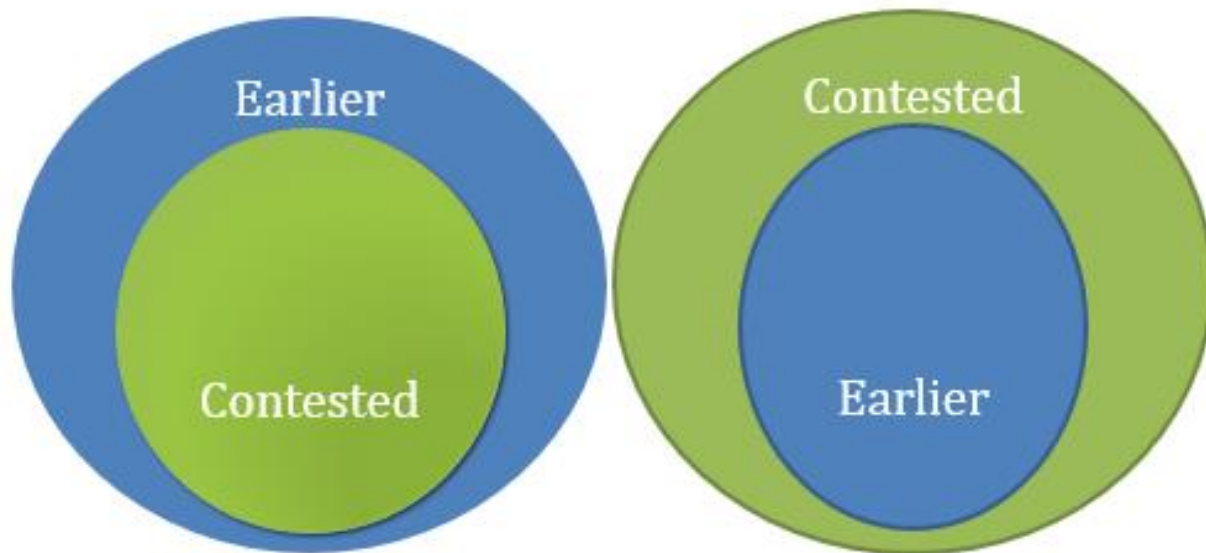
Earlier  
Footwear  
Tea



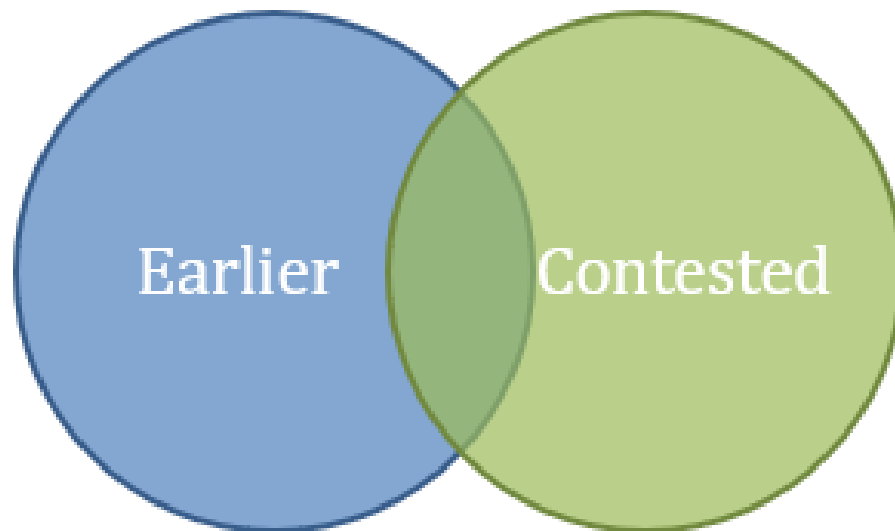
Contested  
Shoes  
Tea



## COMPARISON OF GOODS AND SERVICES - Identity



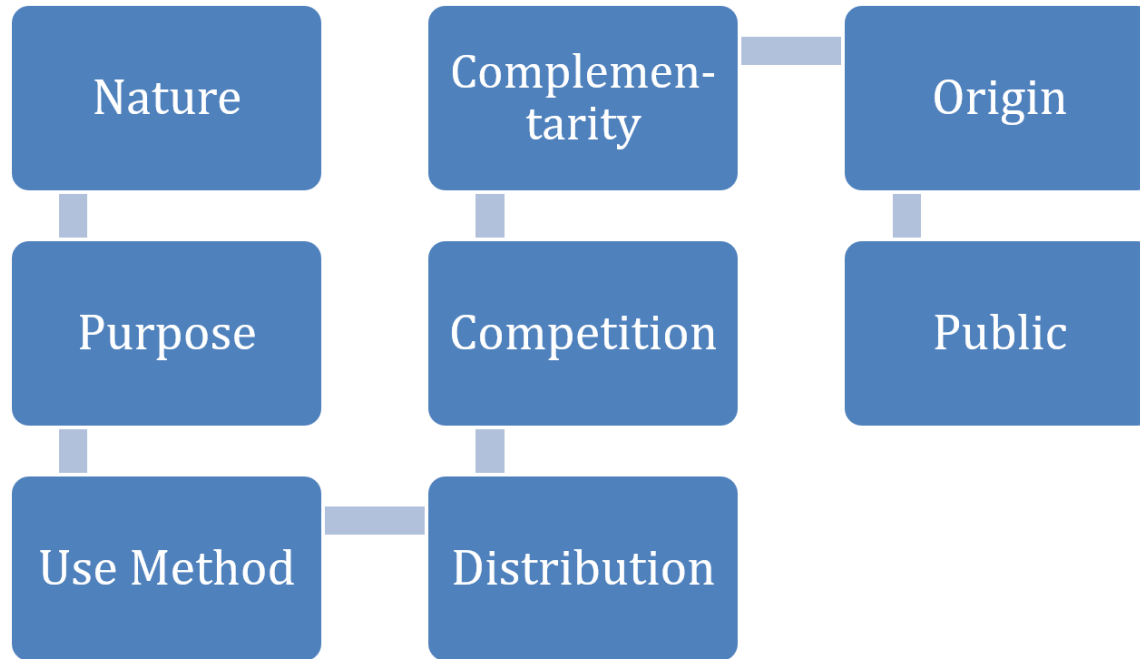
## COMPARISON OF GOODS AND SERVICES - Identity



## COMPARISON OF GOODS AND SERVICES

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## COMPARISON OF GOODS AND SERVICES - Similarity



## COMPARISON OF GOODS AND SERVICES - Similarity

Nature:

What is the product? What is the service?



## COMPARISON OF GOODS AND SERVICES - Similarity

Purpose and method of use:  
What for and how?



## COMPARISON OF GOODS AND SERVICES - Similarity

Complementarity:  
Is it indispensable?



## COMPARISON OF GOODS AND SERVICES - Similarity

In competition:  
Are they interchangeable?





## COMPARISON OF GOODS AND SERVICES - Similarity

Distribution channels:  
Are the points of sale the same?



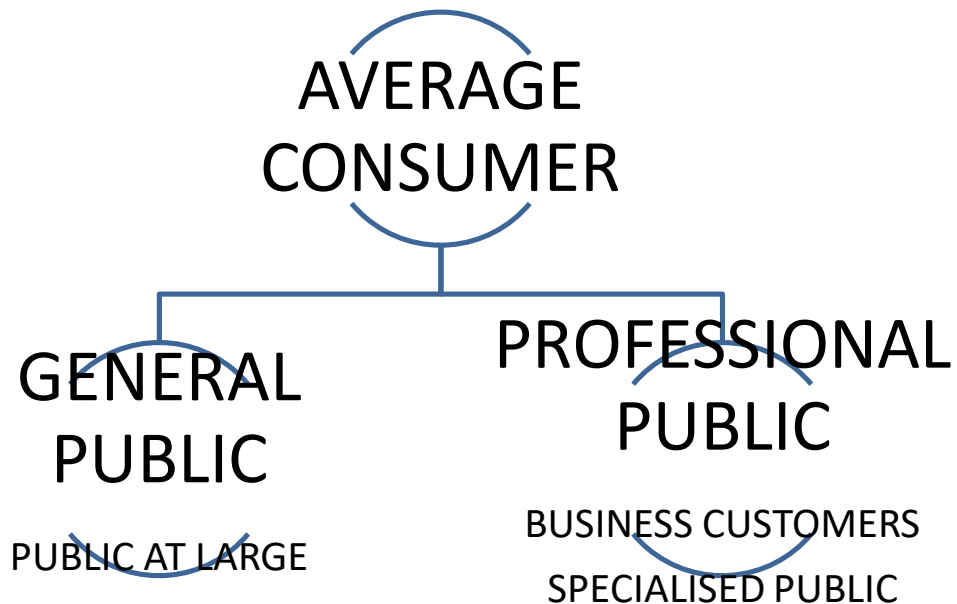
## COMPARISON OF GOODS AND SERVICES - Similarity

Relevant public:  
Who buys, and for what need?



## COMPARISON OF GOODS AND SERVICES - Similarity

Relevant public:



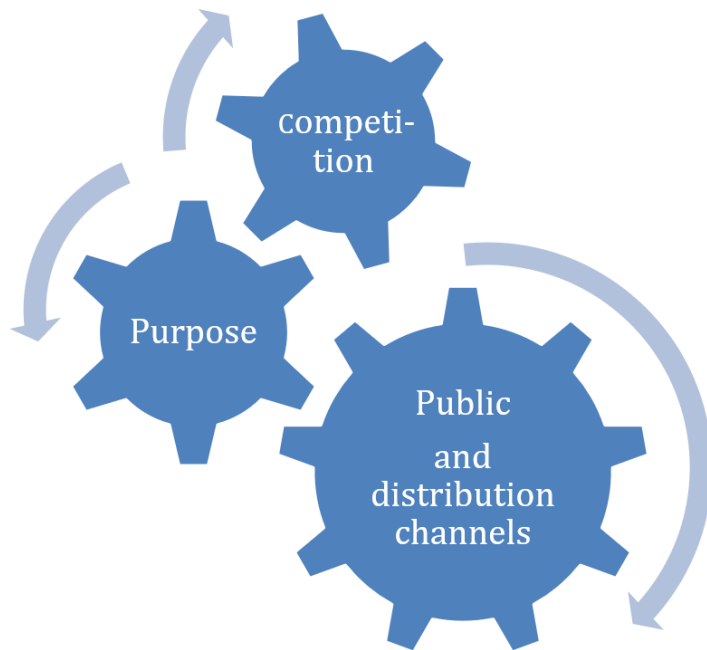
## COMPARISON OF GOODS AND SERVICES - Similarity

Producer / provider:  
Who is responsible?



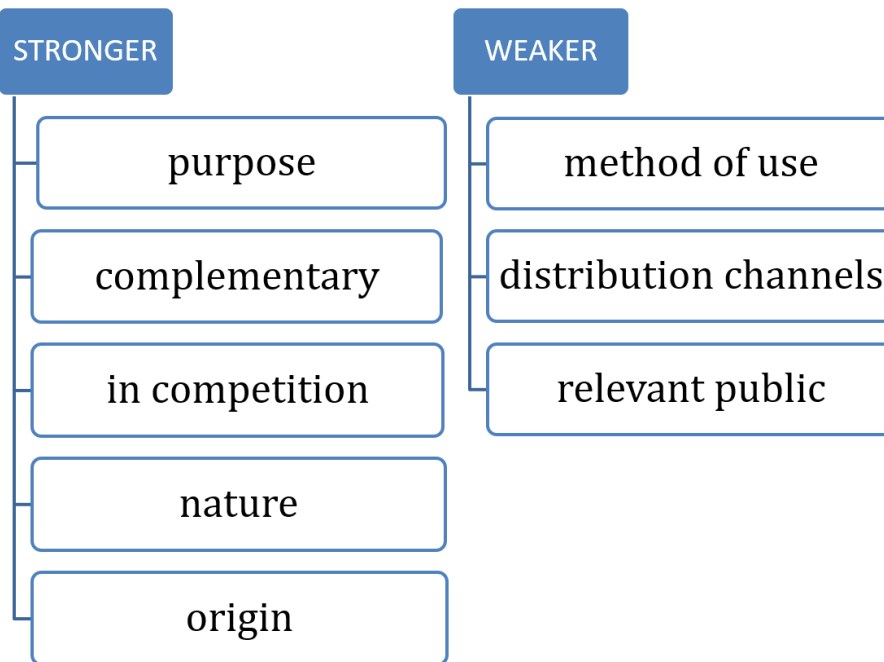
## COMPARISON OF GOODS AND SERVICES - Similarity

Interrelation of the factors:



## COMPARISON OF GOODS AND SERVICES - Similarity

Weight of the factors:



## COMPARISON OF GOODS AND SERVICES

- Legal framework and main rules
- Identity
- Similarity (Canon criteria)
- Particular scenarios

## COMPARISON OF GOODS AND SERVICES – Particular scenarios

Use in combination:





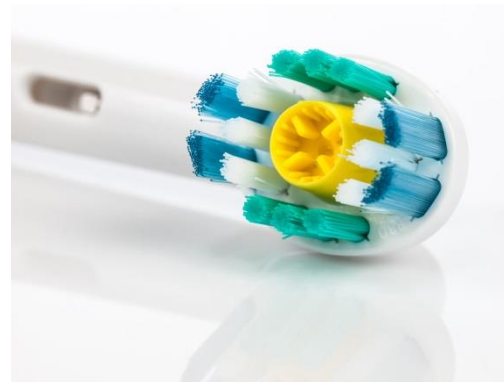
## COMPARISON OF GOODS AND SERVICES – Particular scenarios

Raw and processed, main ingredient:



## COMPARISON OF GOODS AND SERVICES – Particular scenarios

Parts, fittings and accessories:



## COMPARISON OF GOODS AND SERVICES – Particular scenarios

Parts, fittings and accessories:





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THANK YOU



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