

The effect of regional nuances on the similarity of trademark goods and services globally

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Introduction: an intriguing hypothesis about similarity

Do local nuances and cultural factors affect the assessment of trademark goods and services similarity? Observing global trends reveals important insights.

Are cosmetics considered similar to packs of gourmet chocolates? Should golf shoes be regarded in the same class as golf clubs or are they different?

The answer may depend on where in the world you plan to file your trademark application.

The decision of which goods and services class to file in has become increasingly important. The dramatic growth of trademark registrations globally has increased the likelihood of potential conflicts. The threat of goods and services being assessed similar to those of earlier registered trademarks must be carefully considered when filing a new trademark application.

Adding to the complexity is the potential for patent and trademark offices (PTOs) and courts in different countries or global regions to assess goods and services similarities differently. As organizations increasingly pursue global brand strategies, a thoughtful approach to goods and services classification that is mindful of these regional differences is crucial.

Hypothesis and methodology

As a leader in global trademark research, Clarivate™ sought to test an intriguing hypothesis: Cultural differences among jurisdictions influence the relative weight given to specific factors in determining goods and services similarity.

To test this hypothesis, we examined goods and services similarity assessments across five global regions: Europe, the United States, Mainland China, South Korea and Japan.

We used the goods and services comparison tool within Darts-ip®. With data on more than 6.7 million trademark cases worldwide, custom coding for greater granularity and AI-powered analytics, Darts-ip offers a comprehensive, searchable resource for identifying IP trends, assessing risks and spotting opportunities.

As a general rule, based on our observations of cases around the world, PTOs tend to consider the following factors in making their determinations:

- Nature
- Purpose
- Methods of use
- Complementarity of goods and services
- Goods and services in competition
- Distribution channels
- Relevant public (end users)
- Provider/producer

However, different PTOs and courts may place more or less weight on each factor when making their determinations.

This report summarizes our findings using data within the Darts-ip database for the examples highlighted. While not an exhaustive analysis, our observations reveal important insights relevant to global trademark filing strategies.

6.7M

trademark cases in Darts-ip global database

02

Goods and services

trends across jurisdictions

A comparative review across countries and cultures illustrates notable differences in goods and services similarity assessments.

In this phase of our review, we examined trademark cases from the Darts-ip database in specific classes to identify differences in how global regions weighted various factors when determining goods and services similarity. The number of cases reviewed reflect those in the Darts-ip database for the goods and services listed in the stated regions.

Tea versus cakes

We examined cases in Europe, Mainland China and the United States that involved Nice classes 30.37 (tea) and 30.29 (cakes), observing some dramatic differences in similarity assessments.

In Europe, the goods were more often deemed to differ in both nature and purpose, that they are not complementary or substitutes for each other. The fact that they tend to have distinct distribution channels in Europe was also a factor.

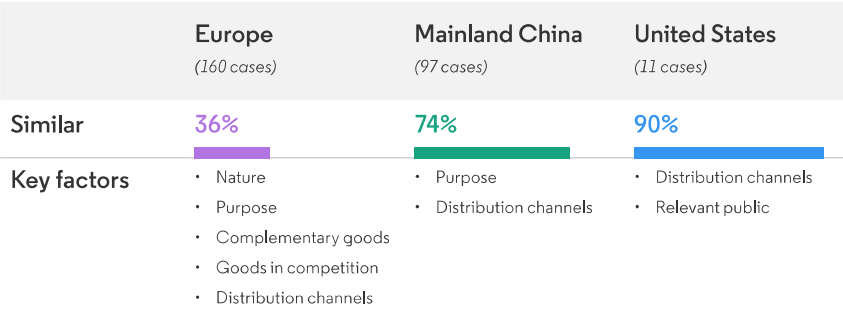
Example case: UKIPO Hearing Officer, O/0328/23, Wertform GmbH vs. T. S. (April 3, 2023)
"They differ in nature and purpose and are not substitutes or obviously complementary [...] The fact that one may be able to buy a cake or a filled roll from the same source — such as a cafe — is not a strong basis for finding similarity." (darts-535-559-O-en-4)

The view in Mainland China and the United States was quite different, where they were more often

viewed as similar goods. Judges in China tended to consider both as belonging to daily food and thus are closely related. In the United States, the distribution channels weighed heavily. Since the same entity commonly manufactures, produces, or provides the goods and markets them under the same trademark, they were considered related.

Example case: Commissioner of Trademarks USPTO (TSDR), APP/90530877/OOA (June 1, 2022)
"It is likely that the consuming public would mistake the source of one good for the source of the other. [Third-party web sites] demonstrate that applicant's and registrant's goods are commonly found in the same channels of trade and frequently purchased by the same consumers." (darts-458-033-N-en)

Figure 1: Comparison of similarity assessments for "tea" and "cakes"



Beds versus bedding

Logically, one would think of beds (20.102) and bedding (20.77) as similar for trademark registration purposes. But again, cultural considerations come into play.

In the cases we reviewed in Europe and the United States these goods were nearly always viewed as similar. European examiners tended to view the goods as having the same purpose, targeting the same consumers, being complementary and having the same distribution channels.

Similarly, in a case from the United States we found in the Darts-ip database, the goods were deemed to have the same end users,

the same distribution channels and producers. The channels of trade and the classes of customers also weighed in favor of similarity.

Example case: EUIPO Opposition Division, 003100113 (October 21, 2020) *"There is a link between the contested bedding (not including linen) and the opponent's beds, mattresses [...] in that they target the same consumers and are complementary. Furthermore, they have the same distribution channels. Therefore, they are considered similar."* (darts-932-747-J-en-2)

In South Korea, however, the view seemed quite different. In the three cases we reviewed, the goods were

deemed to have a different nature, sold via different channels with different producers. The fact that beds and bedding are complementary products did not affect similarity, in the examiners' view.

Example case (translated from Korean): KIPO, 2015당5395 (September 20, 2016) *"It is 'bedding' rather than a main component of a bed and is different in shape and quality from a bed. Also, a bed is sold in furniture stores, while these are sold in blanket stores. Also [...] the materials [they are made from] are different. Considering that the producers are different, they are judged to be dissimilar products."* (darts-684-263-D-ko)

Figure 2: Comparison of similarity assessments for "beds" and "bedding"

	Europe (16 cases)	South Korea (3 cases)	United States (1 case)
Similar	94%	33%	100%
Key factors	<ul style="list-style-type: none">• Purpose• Complementary goods• Relevant Public• Distribution channels	<ul style="list-style-type: none">• Distribution channels• Provider/producer	<ul style="list-style-type: none">• Relevant public• Distribution channels• Provider/producer



Cosmetics versus false eyelashes

This provided another example of highly divergent assessments of similarity, though not solely between East and West.

In this example, the cases we reviewed showed both Europe and Mainland China aligned in determining a high degree of similarity between cosmetics (3.65) and false eyelashes (3.42). European examiners considered them complementary goods with the same purpose—beautification. All the cases in Mainland China we reviewed cited the goods as having a similar purpose, customers and sales channels.

Example case: EUIPO Opposition Division, 003165814 (May 18, 2023) "The 'false eyelashes' are similar to a high degree to the opponent's 'cosmetics' because they are complementary and have the same purpose. Furthermore,

they coincide in producer, end users and distribution channels." (darts-634-649-O-en-4)

In Japan, however, other factors came into play, resulting in similarity for only 25% of the cases reviewed. The goods were deemed to have differing methods of use (applied or sprayed vs. attached to the body), different producers and different nature.

Example case (translated from Japanese): JPO Board of Appeals and Trials, jp-T2018-900105_U7

(August 30, 2018) "'Cosmetics' is to be applied or sprayed on the skin for the cleansing and beautifying the body, while 'false eyelashes' is artificial eyelashes, used by attaching them to the body. Even if the consumers of the two products share characteristics, there is no evidence to indicate that businesses that produce and sell the products are similar, the raw materials and quality of the products are similar, or the finished products are the same." (darts-587-515-F-ja-2)

Figure 3: Comparison of similarity assessments for "cosmetics" and "false eyelashes"

	Europe (121 cases)	Japan (4 cases)	Mainland China (8 cases)
Similar	97%	25%	100%
Key factors	<ul style="list-style-type: none">• Purpose• Complementary goods	<ul style="list-style-type: none">• Nature• Methods of use• Provider/producer	<ul style="list-style-type: none">• Purpose• Distribution channels• Relevant public

Even if the consumers of the two products share characteristics, there is no evidence to indicate that businesses that produce and sell the products are similar.

Medical apparatus versus surgical apparatus

Looking at cases in the Darts-ip database that involved medical apparatus (10.114) and surgical apparatus (10.54) revealed some interesting differences in perceptions of similarity when comparing Europe and the United States with South Korea.

In both Europe and the United States, these classes were usually deemed to be similar. Both regions focused on having the same channels of trade and same consumers as determining factors. In Europe, the similar purpose of both goods also played a factor.

Example case: Commissioner of Trademarks USPTO (TSDR), us-app-79316649-OOA_20210818 (August 18, 2021) *"The applicant's goods, namely, 'Medical apparatus for diagnosing and monitoring of respiratory conditions, and parts therefore' are closely related to the registrant's goods, namely, 'Medical apparatus and instruments, namely, surgical apparatus and instruments' because both are likely to*

involve the same channels of trade and the same classes of consumers." (darts-563-412-L-en)

In South Korea, the assessment was opposite in nearly half of the cases reviewed. In these cases, the goods were considered to have a different purpose, for different end users, manufactured by different producers and distributed by different channels.

Example case (translated from Korean): KIPO, 2016원6326 (June 27, 2018) *"'Operating tables and surgical equipment' are used for treating patients in hospitals, of metal or plastic, up to 2m. 'Microwave generator and applicators' are medical devices [...] to treat localized areas on the skin, small enough for doctors to hold, so they differ in quality, shape and use. Moreover, each of these equipment are ordered and made by manufacturers with specialized technology for different medical specifications. They are not distributed through general channels, so they have different production sectors and range of customers."* (darts-354-798-F-ko)

Figure 4: Comparison of similarity assessments for "medical apparatus" and "surgical apparatus"

	Europe (67 cases)	South Korea (10 cases)	United States (33 cases)
Similar	89%	54%	96%
Key factors	<ul style="list-style-type: none"> • Purpose • Relevant public • Distribution channels 	<ul style="list-style-type: none"> • Purpose • Distribution channels • Relevant public • Provider/producer 	<ul style="list-style-type: none"> • Distribution channels • Relevant public

Food-related services versus bakery/pastry services

For this comparison, we looked at cases from the Darts-ip database involving food services in Nice class 43, including cafes (43.24), restaurants (43.107), self-service restaurants (43.102) and supply of food and drinks (43.C17)) versus bakery services in both Europe and South Korea.

This comparison revealed a dramatic difference in similarity assessments that reflect significantly different cultural perceptions of these services. In Europe, food and bakery services are considered to share primarily the same purpose, are complementary and have the same end users and distribution channels.

Example case: EUIPO Opposition Division, 003088631 (October 6, 2022) "When bakery services are concerned, it is more common to see these places, beside the

primary retail function, operate also a small restaurant or cafeteria where the products can be sampled and consumed on the spot. That indicates that these services in dispute share the same purpose." (darts-936-666-N-en)

The view in South Korea was quite different in the majority of cases reviewed. In general, Koreans do not consider baked goods or pastry as "meals" or staple food, but rather as desserts or items that do not overlap with general food provider services.

Example case (translated from Korean): KIPO, 2014원4194 (June 15, 2015) "The former belongs to the bakery business, whereas the latter belongs to the restaurant business; also, walnut bread is generally consumed as dessert, whereas noodles are consumed as a staple food [...] Considering the differences in the nature, content, and method of the services provided, it is unlikely that they are similar services in the sense of general trade." (darts-128-788-D-ko)

Bicycles versus baby carriages

Our comparison of cases involving bicycles (12.44) and baby carriages (12.163) in Europe, the United States and Mainland China revealed some very surprising differences.

Mainland China and the United States were more aligned in their assessment, finding the goods similar 78% and 100% of the time, respectively, based on cases in the Darts-ip database. Judges in China generally viewed the goods as common products in the small vehicle industry, with the same or similar functions, uses, producers, sales channels and consumers. In the United States, the goods were considered related as they are presumed to travel in the same channels of trade to the same end users.

Example case (translated from Chinese): Beijing High Court, (2012)高行终字第1503号 (February 27, 2013) "The goods such as bicycles designated for use by the opposed trademark in this case are closely related to the children's carriages, baby carriages and other goods approved by the citation trademark in terms of function, use, production department, sales channel, consumption object, etc." (darts-316-124-B-zh)

Figure 5: Comparison of similarity assessments for "food-related services" and "bakery/pastry services"

	Europe (18 cases)	South Korea (6 cases)
Similar	96%	33%
Key factors	<ul style="list-style-type: none"> • Purpose • Relevant public • Distribution channels 	<ul style="list-style-type: none"> • Purpose • Distribution channels • Provider/producer

In Europe, on the other hand, the goods were considered dissimilar in the vast majority of cases reviewed. The prevailing view was that they have a different nature, function and purpose.

Example case (translated from French): INPI, OPP 17-1775 (October 27, 2017) *"Strollers; handling trolleys' of the contested registration application designate respectively childcare articles, namely small children's cars generally foldable formed of a reclining seat suspended*

from a chassis on casters [...] they therefore do not have the same nature, function and purpose as the 'bicycles' of the earlier mark, which designate vehicles intended for transport by road, which respond to transport techniques."
(darts-566-316-E-fr-2)

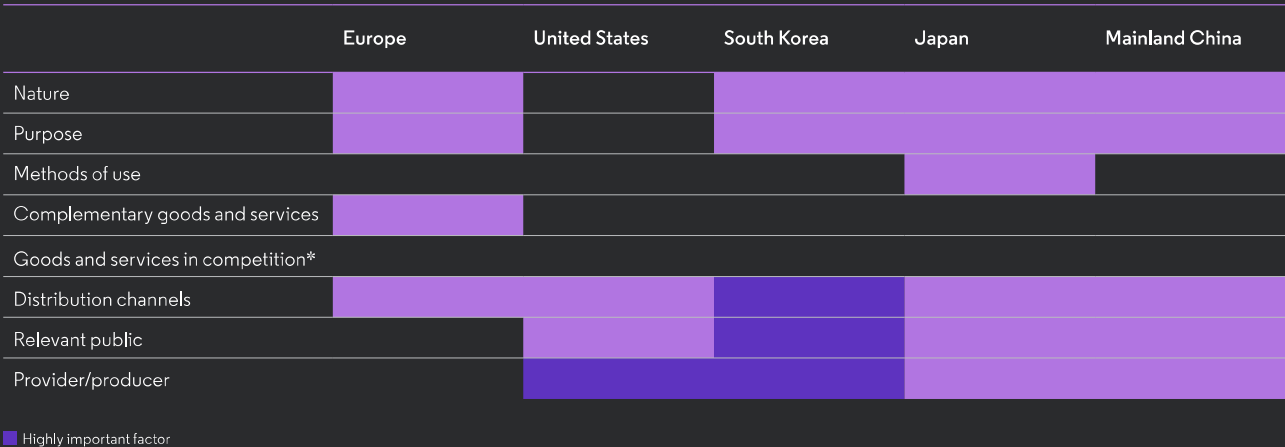
Figure 6: Comparison of similarity assessments for "bicycles" and "baby carriages"

	Europe (30 cases)	Mainland China (28 cases)	United States (3 cases)
Similar	31%	78%	100%
Key factors	<ul style="list-style-type: none">NaturePurpose	<ul style="list-style-type: none">PurposeDistribution channelsRelevant publicProvider/producer	<ul style="list-style-type: none">Distribution channelsRelevant public

Summary of trends

Our observations support the hypothesis that cultural differences among jurisdictions influence the weight given to certain factors in determining goods and services similarity. The table below highlights the factors we believe to be most emphasized in each region based on our review of cases in the Darts-ip database.

Figure 7: Summary view of differences in similarity factors

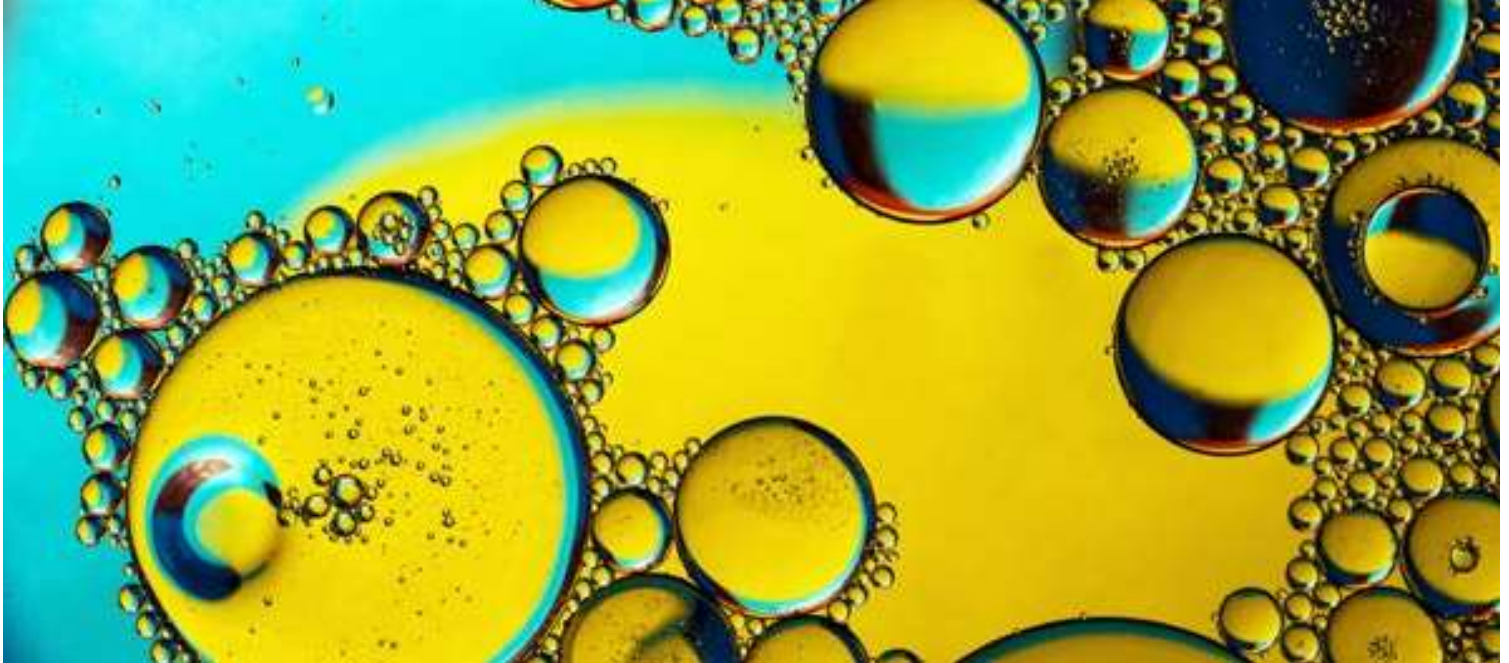


03

Some compelling findings

unique to each jurisdiction

A deeper examination of cases within each jurisdiction reveals additional insights into thought processes and cultural distinctions unique to each region.



Europe

The EUIPO guidelines for trademark classification serve as a reference used throughout the European Union.

When analyzing European case law — including EUIPO, general court and the Court of Justice of the European Union (CJEU) cases — with the Darts-ip goods and services comparison tool, we conclude that examiners offer some flexibility, often adapting their assessment based on the context of the case.

We also see evidence that national specificities exist within the EU. Similarity assessments seem to vary among the various European jurisdictions.

Finally, it seems like EU examiners and courts place more emphasis on nature, purpose, distribution channels and complementary goods and services. The following examples highlight these trends.

Edible fats and meat extracts deemed similar

EUIPO guidelines consider "edible fats" (29.5), such as cooking oils and margarine, and "meat extracts" (29.68) as dissimilar. However, our review of cases involving these goods reveals that they have been assessed as similar in 81% of the EUIPO cases in the Darts-ip database.

The predominant factors for these similar assessments have been purpose; methods of use; goods, services in competition; and relevant public. The following case excerpts from the EUIPO Opposition Division provide illustrations of this interpretation.

EUIPO Opposition division, 003167135, Industrie Rolli Alimentari vs. Ozturk Quebap Producciones (June 19, 2023):

"The contested dairy products and dairy substitutes cover goods such as butter and butter substitutes. To this extent, they are similar to the opponent's edible oils and fats as they have the same purpose. They can coincide in end user. Furthermore they are in competition." (darts-769-869-O-en)

Similarity assessments seem
to vary among the various
European jurisdictions,
with national specificities.

81%

of cases deemed
edible fats similar
to meat extracts

EUIPO Opposition division,
002804501 Kalnik vs. Kaslink
Foods (December 15, 2017):

"The contested dairy products and dairy substitutes cover goods such as butter and butter substitutes. To this extent, they are similar to the opponent's edible oils and fats as they have the same purpose. They can coincide in end user. Furthermore they are in competition." (darts-636-680-E-en)

Cultural activities and
entertainment dissimilar
in France

"Cultural activities; organization of exhibitions for cultural or educational purpose" and "entertainment" services are deemed similar in 81% of European cases in Darts-ip. However, the picture is different in France where they were considered dissimilar, as these two services are seen as having different purposes.

This focus on purpose was evident in INPI, OPP 22-3173 Royal Caribbean Cruises vs. O.B. (February 17, 2023) (translated from French):

"The former refer to intellectual services offering various activities in the fields of arts and culture for people wishing to develop their knowledge, as well as services aimed at to prepare and manage public exhibitions on cultural or instructive themes, do not fall within the general category of 'entertainment' services which are services intended to entertain and amuse the public. These services, which operate in very different fields, are therefore not identical, nor similar." (darts-853-056-O-fr-2)

United States

The United States Patent and Trademark Office (USPTO) has a more commercial or business approach to their assessment of similarity, often citing leading brands in the market and the URL address to their official websites.

From our observation, key factors commonly considered in the United States include distribution channels, relevant public and provider / producer. The latter is the most dominant factor, as "sold under the same brand" is often considered a higher likelihood of confusion.

The following examples clearly illustrate this emphasis specific to the United States.

Cosmetic goods and gift packs deemed similar

The USPTO decision between VANS Gourmet GIFTS and Susan S. Laycock provides a fascinating window into goods and services similarity logic in the United States, often emphasizing commercial considerations.

Applicant Susan S. Laycock's goods are cosmetics in class 3 and the registrant, VANS, offers gourmet gift packs featuring chocolates, candies, and bakery goods. What may seem surprising for a practitioner outside the United States is that the goods were considered similar because they fall within the normal field of expansion of business, potentially by the same provider or producer, and are found in the same channels of trade.

Per Commissioner of Trademarks USPTO (TSDR), APP/77700349/ OOA (February 8, 2010):

"Applicant's cosmetic goods are within the normal field of expansion of registrant's goods, as cosmetic gift packs are also be provided by the registrant in its normal course of business [...] A trademark owner is entitled to protection against the registration of a similar mark on products that might reasonably be expected to be produced by him in the normal expansion of his business. The test is whether purchasers would believe the product or service is within the registrant's logical zone of expansion [...] The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods." (darts-387-943-O-en)



Clothing and jewelry deemed similar

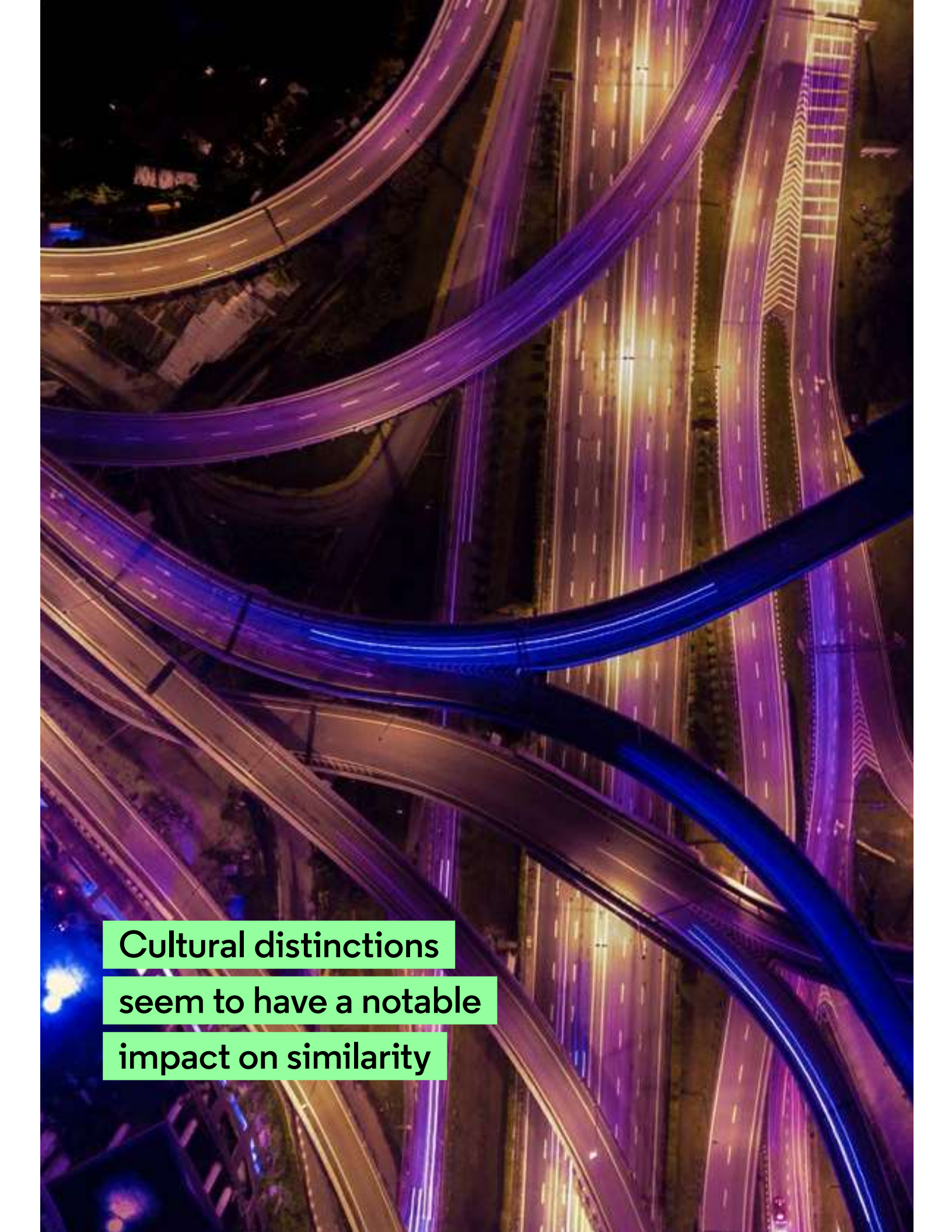
The USPTO seems to have a very different approach compared to European jurisdictions. The majority of European cases do not consider clothing (class 25) and jewelry (class 14) to be complementary products and only 13% of European cases found the goods to be similar. By contrast, 93% of cases in the United States found the goods to be similar. This may be attributed to the fact that courts and examiners in the United States tend to take a more commercial or business approach in their judgements. Decisions often place more emphasis on similar end users, channels of distribution and providers/producers, and whether the goods are complementary in nature.

In a practice unique to the United States, courts often cite online evidence to demonstrate the products are capable of emanating from the same source. This is highlighted in Commissioner of Trademarks USPTO (TSDR), APP/90792450/OOA, Dasan Inc. vs. 10 Summers Merchandising LLC (March 18, 2022):

"The attached Internet evidence [...] establishes that (1) the same entity commonly manufactures, produces, or provides the relevant goods and markets the goods under the same mark, (2) the relevant goods are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use, and/or (3) the goods are similar or complementary in terms of purpose or function. Thus, applicant's and registrant's goods are considered related for likelihood of confusion purposes." (darts-021-313-N-en)

93%

of cases deemed
clothing and jewelry similar



Cultural distinctions
seem to have a notable
impact on similarity

South Korea

In South Korea, producers and channels of distribution play the biggest role — goods and services in the same class are often ruled dissimilar unless they are produced and/or sold by the same sources.

Like in Europe, guidelines provided by the Korean IP Office (KIPO) are not absolute and are intended only as a reference. We observe that KIPO examiners are relatively flexible in their judgements.

In Korea, the trademark seems to be viewed as connecting the product and the producer which results as an emphasis often placed on provider/producer, distribution channels, relevant public and purpose in determining similarity.

What we also observe is that when goods and services are highly specific, they are often found to be different than the general description (e.g., in one specific case, "software for washing cars" has been deemed different than the general class "software"). It appears that applicants often use this strategy to appeal rejections in order to achieve registration.

The following examples demonstrate these specificities:

Sports equipment and clothing different except for golf

In South Korea, sporting articles (class 28) and sportswear (class 25) are deemed different in 83% of relevant cases in Darts-ip. Golfing equipment, however, is more often found similar to golf apparel. Golf clubs, for example, have been deemed similar to golf shoes and clothes 50% of the time. This is quite surprising, as examiners in Korea do not often rule goods of different classes to be similar. This suggests a recognition by KIPO of the size and popularity of the golf industry in Korea, with many companies exclusively producing and selling golf clothes and equipment.

This represents a significant difference with the United States, where the similarity rate for sporting articles and clothes is 78%. We can conclude that certain sports do not receive the special recognition of golf in Europe as they do in Korea.

KIPO examiners are sensitive to consumer perceptions and the market dynamics of industries, including the financial value or size of sectors, the major market players and their revenue. Often it is a financial/business evaluation analyzing target consumers, channels of distribution, price points and major producers, often using statistics and product images to support their decisions — something uncommon in other jurisdictions.



A notable example of this "golf exception" is shown in this excerpt from KIPO, 2015당3358, Moncross Korea vs. K.K.U. (May 31, 2016) (translated from Korean):

Similar: *"As these are generally manufactured and sold by the same golf equipment manufacturer, and displayed and sold together in specialized golf equipment stores, and the range of customers is extremely similar, they are considered similar."*

Different: *"While the rest are sports equipment and can be purchased in stores specializing in sports equipment, sports apparel and are sold in sports apparel stores or general apparel stores, so even though the similarity group code is the same, it is difficult to view them as similar goods due to their different uses, production sectors, and sales sectors." (darts-592-696-D-ko)*

Science classes and art classes are not similar

In South Korea, there are many after-school courses or academies (called hakwon) to help students keep up with the demanding educational curriculum and obtain admission to top universities. An estimated 70% of all elementary, middle and high school students are taking some form of private education after school, which is considered nearly mandatory.



A specificity to the Korean educational system is that art is not included as a selective subject for university entrance exams, whereas science is. Since there is little or no overlap among students attending these academies or among the educators in their respective fields, it has been concluded that there would be no likelihood of confusion between these services.

KIPO, 2011원5216, H.Y.H. vs. K.S.Y. (May 4, 2012) illustrates this thinking (translated from Korean):

"The first one involves education of the subject in the school educational curriculum and will be provided by an academy that teaches school subjects such as English, math, science and provide those services to students in the humanities and natural sciences, whereas the latter seeks to promote

artistic talent through education on art or various practical training, and the provider will be someone who operates an art academy where the consumers are mainly students who select and study art subjects among the arts and physical education major. Therefore the quality, use, production and consumers are dissimilar, and they are dissimilar services." (darts-942-754-B-ko)

83%

**of cases deemed
sportswear and sporting
articles different**

Japan

The Japan Patent Office (JPO) publishes extensive and detailed guidelines to assess similarity.

It has its own "similar group" system based on the Nice classification system, though different Nice classes can belong within the same group. As a result, there are goods and services classes that exist solely exclusively in the JPO system.

While we observe that these guidelines are followed more strictly and office decisions are not often overturned, we also observe different outcomes. These often occur at the court level, where judgements may differ from the JPO ruling.

In general, we also observe that in Japan emphasis seems to be placed more on methods of use, provider/producer, distribution channels, relevant public, purpose and nature.

The following examples showcase these trends:

Online game services and game programs are different

Japan has a large gaming industry in terms of both products—game software and consoles—and services by companies operating game servers. JPO examiners have consistently ruled that game software developers and game servers do not overlap.

Even in cases where the same company provides both the software and the gaming service, they are considered as providing two distinct products/services to consumers. This approach is unique to Japan. The premise is that gamers (consumers) are generally aware of the developers of the gaming software, while they may not be aware of the providers of gaming services.

JPO Board of Appeals and Trials, Jp-T2010-900348_J7, Alvion vs. Smilemaker (August 25, 2011) provides an illustration of this (translated from Japanese):

"'Provision of online games through computer networks' are mainly provided by game server operators, and the players (consumers) are not aware of the operators. They receive such services while connected to the server through a PC or a household game machine.

"On the contrary, 'game programs' are developed or sold by manufacturers of home video game machines, and game software makers. The trademark owner is a developer or a distributor. Even if the services share the same purpose and use of games, they focus on mainly the operation of a game server. Therefore, the business operators are different, and the scope of business is also different." The products are distributed by entertainment facility operators

Even in cases where the same company provides both the software and the gaming service, they are considered distinct.

and dealers not involved in the provision of such services. Therefore, even if the same trademarks were used for both the services and the goods in question, they should be considered dissimilar services and goods." (darts-988-505-A-ja)

Footwear and sports footwear deemed different

Another compelling example is how the JPO makes a clear distinction in their guidelines between regular footwear for everyday purposes and "special footwear for sports" (this is encoded in Darts-ip as 25.141 "boots for sports" for distinction). Generally, in other parts of the world, the term "footwear" is an encompassing term that includes all the shoes, sandals and heels within class 25.

For the JPO, shoes such as golf shoes, soccer cleats or ski boots are not commonly worn for everyday use, whereas athletic shoes designed for more "casual" sports such as basketball or running are often worn outside of the sports environment and could classify as regular footwear. This would indicate a broader range of consumers and availability in general retail stores. In considering these goods different, the JPO tends to focus on their differing purpose, distribution channels and end users.

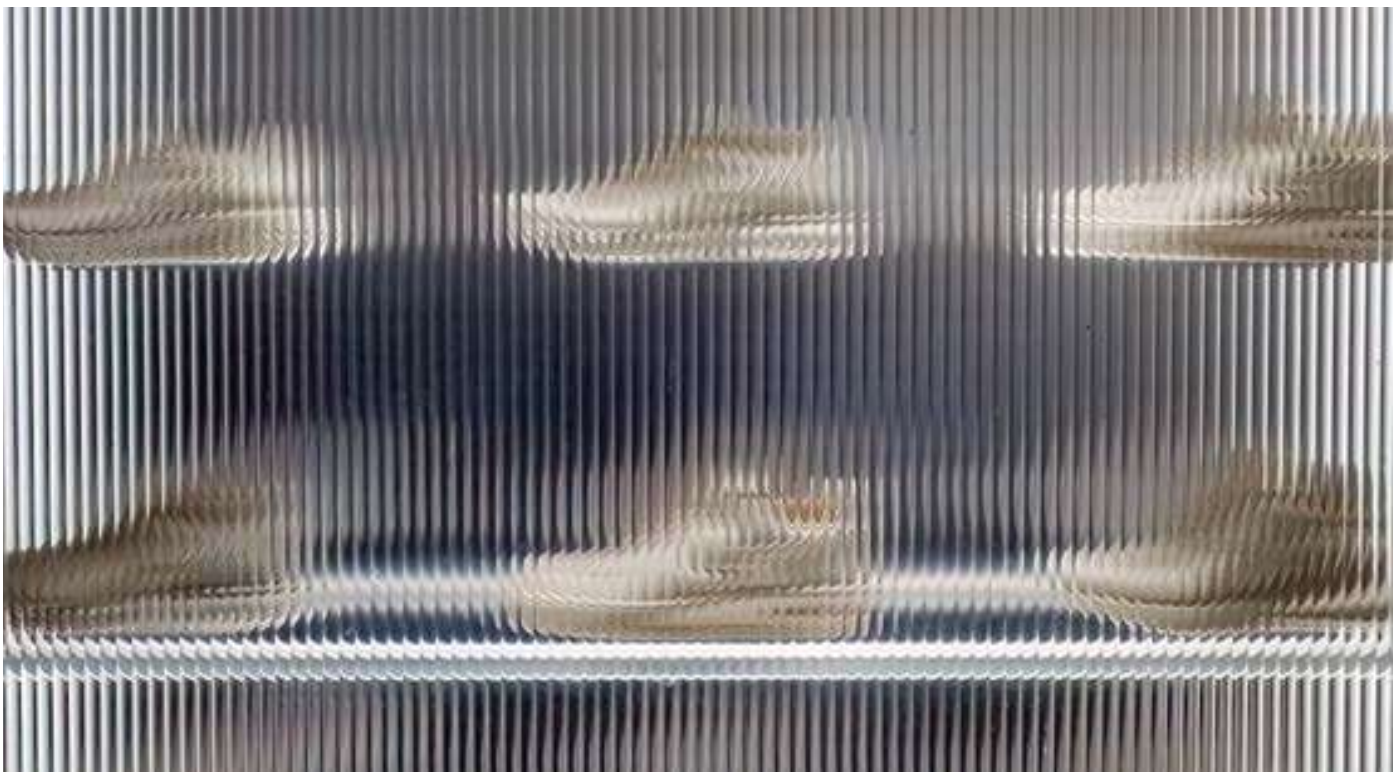
JPO Board of Appeals and Trials, Jp-T2017-900152_J7, Asco Group vs. Okamoto (October 16, 2017) illustrates this distinction (translated from Japanese):

"The product 'footwear' is a general term for foot coverings such as zori (sandals), geta (sandals), and shoes' (Kojien Dictionary 6th edition). It refers to items such as leather

shoes, sandals, sneakers, women's shoes, children's shoes, etc., that are primarily used for daily walking. It is generally sold at stores that sell footwear.

On the other hand, 'special footwear for sports' [...] such as golf shoes, soccer shoes and ski shoes, are used exclusively for when playing those certain sports and its use is limited. They are sold at specialty stores that handle sporting goods.

Therefore, 'footwear' [...] and the cited [...] 'special footwear for sports' have different intended uses and points of sales. In addition, 'footwear' is used on a daily basis and has a wide range of consumers, whereas 'special footwear for sports' are used for when playing various sports and its users are sports players, so they have a different range of consumers." (darts-371-414-E-ja-2)



Mainland China

The China Trademark Office takes multiple factors into consideration in reviewing goods and services, unlike other IP offices where there are more dominant factors in the assessment.

While the guidelines cover the vast majority of goods and services, some new products may not be included initially. For example, "laptop stand," describing a product used to support a computer with adjustment for height and angle, was not included when it was first introduced to the market.

A key difference between Mainland China and the United States and Europe is the assessment of similarity of goods across classes. China has compiled a Similar Goods and Services Table subdividing similar groups of specific goods and services, based on the International Nice Classes of


Goods and Services for Trademark Registration of the World Intellectual Property Organization (WIPO). However, only a small number of cross-class goods or services are considered similar and are explicitly enumerated where Nice Classes differ. In Europe and the United States, the identification of cross-class goods or services doesn't seem to be so strict and is, in fact, relatively broad.

Finally, we observe that in Mainland China the emphasis is often placed on nature, purpose, distribution channels, relevant public, provider and producer when making similarity assessments.

The following examples illustrate these observations:

Wedding dress and clothing are different

The trademark office guidelines consider "wedding dress" and "clothing" to be similar. However, in some decisions, the court held that the two are different because a wedding dress is only worn on specific occasions, while clothing is worn every day. In these cases, different purpose,



A key difference between Mainland China and the United States and Europe is the assessment of similarity of goods across classes.

distribution channels, end users and provider/producer come into play.

This was the case in Beijing IP Court, (2017)京73行初4443, Miniconf vs. Hiersun Industrial (November 25, 2019) (translated from Chinese):

"The wedding dress goods used in the trademark dispute belong to the specific clothing worn at a special time and on a specific occasion. Compared with the daily ordinary clothing, shoes and hats used by the citation trademark, there are obvious differences between them in function, use, production department, sales channel, consumption object and so on.

[...] as far as the actual use is concerned, it is rare for the relevant producers and operators to concurrently engage in wedding dress goods and ordinary clothing goods and there are obvious differences between the two types of goods in terms of sales places and publicity channels, and the frequency of consumption of the two types of goods by relevant consumers is also significantly different." (darts-533-550-K-zh)

Clothing and shower curtains deemed similar

"Shower covers" refers to drapes or curtains that go around or over the shower booth, a household product made of textile in class 24. One would assume that shower

covers are different from clothing items in class 25 due to their differing nature or purpose, in addition to the observed tendency not to deem similar cross-class goods. In one case, however, these two cross-class goods have been deemed similar based on the following logic: that clothing and shower covers are both created by refining textile materials, can be created by the same producers and travel via the same distribution channels. These factors often outweigh their very different purposes.

This is clearly stated in Beijing High Court, (2019)京行终9683号, Facebook vs. Hui Jiang (August 26, 2020) (translated from Chinese):

"Although the disputed trademark 'shower cover' and the cited trademark approved 'men's clothing, women's clothing, children's clothing, shirts, T-shirts' and other commodities belong to a different group in the 'similar goods and services,' they overlap or have greater relevance in terms of sales channels, production sectors, consumer groups.

In view of this, if the disputed trademark and the cited trademark are jointly used on the above goods, it is easy for the relevant public to think that the goods come from the same source, or that there is a specific connection between their providers, thus creating confusion and misidentification of the source of the goods, and the registration of the disputed trademark violates Article 30 of the 2013 Trademark Law. The judgment of the trial was correct and the court supports it." (darts-614-968-J-zh)

04

Conclusion: uncovering valuable insights in case data

Case data from different global regions show surprising differences in goods and services similarity assessments, often mirroring cultural distinctions.

**Delving into Darts-ip data can
reveal insights that may help
improve your chances for
successful registration.**

Our review of cases across global regions clearly shows that thought processes can vary greatly from one country and culture to another when it comes to similarity assessments.

Gaining insight into these distinctions is critical to minimize the risk of rejection or conflict when filing a new mark in jurisdictions around the world.

While there historically has been an East-West duality, our observations suggest this might not be the case with the goods and services similarity assessment. In many cases, notions of goods and services proximity in the United States appear closer to those of

the Asia-Pacific region rather than Europe. Not surprisingly, we see many differences among regions in the area of food, but interesting differences also exist in other areas, from fashion to small vehicles and expert tools.

In jurisdictions with well-defined guidelines for assessing similarity, we occasionally observe cases with outcomes that run counter to the guidelines, according to the circumstances of the case — even in Japan and China.

Looking at the individual jurisdictions, we can make some general observations:

Europe

Among the jurisdictions examined, Europe is the least commercial-centric and tends to consider nature, purpose and complementarity as most important when assessing similarity.

United States

This jurisdiction appears to take the most commercial/business approach to the similarity assessment of goods and services. Goods and services that may appear quite different in their nature or purpose may be deemed similar if they are sold under the same trademark or via the same distribution channels.

South Korea

More weight is commonly given to the provider and distribution channels of goods and services, reflecting an emphasis on the commercial aspects of similarity assessment.

Japan

While there appears to be no single factor that greatly influences the similarity outcome, the commercial aspect often matters more, with the nature of the goods and services sometimes emphasized, as well as methods of use that can be the determining factor when goods and services are deemed different.

Mainland China

Our observations suggest a combination of factors are determinant, rather than one or two predominant factors. Chinese examiners tend to consider several factors that together determine the outcome of the similarity assessment.

This report merely scratches the surface of global goods and services similarity trends. It does, however, illustrate the importance of a thoughtful and strategic approach to choosing goods and services classes with attention paid to regional and cultural differences. Delving into

Darts-ip case data for the targeted regions and jurisdictions can reveal patterns and insights that may help improve your chances for successful registration and reduce the risk of a costly conflict. To learn more about Darts-ip and how you can access global case law data please visit clarivate.com/darts-ip/.

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