

Recent developments in the classification practice for EUTM

Some recent developments in the classification practice for EUTM's covering virtual goods in the metaverse warrant this newsletter. For many years, EUIPO has accepted broad categories of goods, including such things as "computer software", "clothing", and "pharmaceutical preparations". In oppositions, cancellations, infringements, etc., this means that there is typically identity of goods in the similarity of goods analysis. Now EUIPO is taking the same lenient approach as regards virtual goods, which only exist in the metaverse and other online places.



examples

Some trademark owners are registering sector-specific virtual goods in Class 9, including:

- "Downloadable virtual **food and beverage** products" (Taco Bell, [EUTM No. 018682191](#))
- "Downloadable virtual goods, namely, computer programs featuring **perfumery, deodorants and antiperspirants, toiletries, skincare preparations, bath and shower preparations, hair care and styling preparations**, art, clothing for use online and in online virtual worlds" (Unilever, [EUTM No. 018709429](#))
- "**Cookies, Savoury biscuits, snack foods** consisting principally of extruded cereals, pretzels, foods produced from baked cereals to be sold for **virtual avatars**" ([EUTM No. 018670215](#))

But other trademark owners are registering very broad items in Class 9, including:

- "Virtual goods" ([EUTM No. 018696904](#))
- "Downloadable virtual goods" ([EUTM No. 018473934](#))
- "Digital collectibles and downloadable virtual goods" ([EUTM No. 018667233](#))

Similarly, the following broadly worded services have been accepted by EUIPO recently:

- “Entertainment services, namely, providing virtual goods, blockchain tokens, digital tokens, non-fungible tokens, digital media, digital files, and digital assets for entertainment purposes” in Class 41 (EUTM No. 018660705)
- “Providing on-line, non-downloadable virtual goods for use in virtual environments” in Class 42 (EUTM No. 018680343)

what should you consider?

Trademark owners not normally filing in Class 9 should consider filing for the digital versions of their goods in Class 9, or even for “digital goods” as such (or both). For licensing, this would be very-good-to-have. For enforcement, this would be on a nice-to-have and not on a need-to-have basis, because I expect that the non-virtual trademark rights ought be able to hinder registration of the virtual good in Class 9. Although I am not aware of any case law on point in this regard, there is precedent in the “retail sales” cases at EUIPO: it is clear that the service “retail sales of {an item}” is similar to the item in the similarity of goods/services analysis. Thus I would expect that a registration for e.g. “Skateboards” in Class 28 would be found similar to “Virtual goods, namely, skateboards” in Class 9.

Trademark owners already in Class 9, and others interested in broad protection, can consider filing new applications for, e.g.:

- Class 9: “Digital collectibles and downloadable virtual goods”
- Class 42: “Providing on-line, non-downloadable virtual goods for use in virtual environments”

Link concerning virtual goods in the metaverse:

[“How beauty is entering the metaverse”](#)

[“Restaurants’ Virtual Stores Test Consumers’ Appetite for Metaverse Marketing”](#)