

O/0137/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. UK00003964609, UK00003964630 AND  
UK00003964653

IN THE NAME OF CODE WIZARDS LIMITED  
TO REGISTER THE TRADE MARKS:

WIZARDS

&

MULTIPLAYER WIZARDS

&



(SERIES OF TWO)

IN CLASSES 9, 35, 41 AND 42

AND CONSOLIDATED OPPOSITIONS THERETO  
UNDER NOS. 445554, 445556 AND 445557  
BY AMIGO SPIEL + FREIZEIT GMBH

## BACKGROUND AND PLEADINGS

1. On 06 October 2023, Code Wizards Limited (“the applicant”) applied to register the following trade marks in the UK:<sup>1</sup>

**UK00003964609<sup>2</sup>**

WIZARDS

***Class 9: Downloadable electronic publications; computer games programs; video games programs; digital games provided by means of local computer networks, global computer networks, the Internet, cable or wire communications services, wireless telecommunications services and broadband services; downloadable software; interactive multi-media computer games; games software for use on consoles, mobile phones, tablets and other electronic devices; mobile applications; recorded data; sound recordings; game soundtracks; none of the aforesaid relating to money management, financial planning, credit, lending, financial risk management, financial analysis and reporting, financial evaluation, financial consulting services, banking, stockbroking and exchanging money and the provision of financial advice and information, the provision of advice and information on finance for retirement, insurance, investments, pensions, mortgages, taxation, foreign exchange trading, money management, financial planning, credit, lending, financial risk management, financial analysis and reporting, financial evaluation, financial consulting services, banking, stockbroking and exchanging money.***

***Class 35: Advertising, marketing, promotional and public relations services; corporate communications services being public relations services; advertising agency, marketing agency, promotional agency and public relations agency services; project management services relating to advertising, marketing, promotional and public relations; marketing studies; online and internet advertising, promotion and marketing services; internet***

<sup>1</sup> The applications originally included other services in class 42, however, on 07 July 2025 the applicant filed 3 Forms TM12 to divide the applications and the unopposed services in class 42 proceed to registration.

<sup>2</sup> As I will explain later the goods and services which are underlined are those opposed under Section 5(2)(b) whilst those in bold are opposed under Section 3(6)

***keyword marketing services; experiential marketing, promotion and advertising services and campaigns; immersive and virtual marketing, promotion and advertising services and campaigns; viral marketing, promotion and advertising services and campaigns; video marketing, promotion and advertising services and campaigns; business consulting and advisory services; marketing, customer relationship marketing, loyalty marketing and consumer targeting; segmentation and profiling of market data; database marketing; analysis of consumer marketing; advertising, marketing and advertising consultancy services to businesses that provide data mining, data manipulation, data cleansing, data transformation, data operations and transmission of data services; writing of publicity texts, namely, creating press releases; production of video recordings, audiovisual recordings, and digital video and audiovisual recordings for advertising purposes, marketing purposes, publicity purposes, promotional purposes, and public relations purposes; promoting the goods and services of others through targeted advertising; conducting, organising, holding and arranging business conferences; corporate image development consultancy and advice; branding services, namely, consultancy, and advice and information services relating to management and marketing of brands, creating brand identity and brand development for businesses and individuals; retail services connected with the sale of computer games and computer gaming apparatus; provision of information, advisory and consultancy services in relation to the **forementioned services**; none of the aforesaid relating to money management, financial planning, credit, lending, financial risk management, financial analysis and reporting, financial evaluation, financial consulting services, banking, stockbroking and exchanging money and the provision of financial advice and information, the provision of advice and information on finance for retirement, insurance, investments, pensions, mortgages, taxation, foreign exchange trading, money management, financial planning, credit, lending, financial risk management, financial analysis and reporting, financial evaluation, financial consulting services, banking, stockbroking and exchanging money.***

**Class 41:** Entertainment services; electronic games services; provision of games by means of local computer networks, global computer networks, the Internet, cable or wire communications services, wireless telecommunications services and broadband services; provision of interactive multi-media computer games via the internet and electronic communication networks; computer game entertainment services; publishing; electronic publishing; publishing of computer game and electronic game software; providing computer games and video games via a website; production of sound recordings; writing services; information and advice relating to these services; none of the aforesaid relating to money management, financial planning, credit, lending, financial risk management, financial analysis and reporting, financial evaluation, financial consulting services, banking, stockbroking and exchanging money and the provision of financial advice and information, the provision of advice and information on finance for retirement, insurance, investments, pensions, mortgages, taxation, foreign exchange trading, money management, financial planning, credit, lending, financial risk management, financial analysis and reporting, financial evaluation, financial consulting services, banking, stockbroking and exchanging money.

**Class 42:** Design of computer games programs and video games programs; development of computer games programs and video games programs; Software as a Service (SaaS) featuring software platforms for electronic gaming; design and development of computer games; computer programming of electronic and digital games; development of games for use on mobile phones, tablets and other electronic devices; design, development and maintenance of computer software and online games; graphic design services; design of virtual reality games; design of toys and games; design services for business; product and packaging design; graphic design; website design and development; social media design and development; animation design; special-effects design; audio design; provision of websites relating to any of the aforesaid services; prototypes and roll-out design services; design and drawing for the compilation of webpages.

**UK00003964630**

MULTIPLAYER WIZARDS

**Class 9:** Downloadable electronic publications; computer games programs; video games programs; digital games provided by means of local computer networks, global computer networks, the Internet, cable or wire communications services, wireless telecommunications services and broadband services; downloadable software; interactive multi-media computer games; games software for use on consoles, mobile phones, tablets and other electronic devices; mobile applications; recorded data; sound recordings; game soundtracks.

**Class 35:** *Advertising, marketing, promotional and public relations services; corporate communications services being public relations services; advertising agency, marketing agency, promotional agency and public relations agency services; project management services relating to advertising, marketing, promotional and public relations; marketing studies; online and internet advertising, promotion and marketing services; internet keyword marketing services; experiential marketing, promotion and advertising services and campaigns; immersive and virtual marketing, promotion and advertising services and campaigns; viral marketing, promotion and advertising services and campaigns; video marketing, promotion and advertising services and campaigns; business consulting and advisory services; marketing, customer relationship marketing, loyalty marketing and consumer targeting; segmentation and profiling of market data; database marketing; analysis of consumer marketing; advertising, marketing and advertising consultancy services to businesses that provide data mining, data manipulation, data cleansing, data transformation, data operations and transmission of data services; writing of publicity texts, namely, creating press releases; production of video recordings, audiovisual recordings, and digital video and audiovisual recordings for advertising purposes, marketing purposes, publicity purposes, promotional purposes, and public relations purposes; promoting the goods and services of others through targeted advertising; conducting, organising, holding and arranging business conferences; corporate image development consultancy and advice; branding services, namely, consultancy, and advice and information services relating to management and marketing of brands, creating brand*

**identity and brand development for businesses and individuals; retail services connected with the sale of computer games and computer gaming apparatus; provision of information, advisory and consultancy services in relation to the aforementioned services.**

**Class 41: Entertainment services; electronic games services; provision of games by means of local computer networks, global computer networks, the Internet, cable or wire communications services, wireless telecommunications services and broadband services; provision of interactive multi-media computer games via the internet and electronic communication networks; computer game entertainment services; publishing; electronic publishing; publishing of computer game and electronic game software; providing computer games and video games via a website; production of sound recordings; writing services; information and advice relating to these services.**

**Class 42: Design of computer games programs and video games programs; development of computer games programs and video games programs; Software as a Service (SaaS) featuring software platforms for electronic gaming; design and development of computer games; computer programming of electronic and digital games; development of games for use on mobile phones, tablets and other electronic devices; design, development and maintenance of computer software and online games; graphic design services; design of virtual reality games; design of toys and games; design services for business; product and packaging design; graphic design; website design and development; social media design and development; animation design; special-effects design; audio design; provision of websites relating to any of the aforesaid services; prototypes and roll-out design services; design and drawing for the compilation of webpages.**

UK00003964653





**Class 9:** Downloadable electronic publications; computer games programs; video games programs; digital games provided by means of local computer networks, global computer networks, the Internet, cable or wire communications services, wireless telecommunications services and broadband services; downloadable software; interactive multi-media computer games; games software for use on consoles, mobile phones, tablets and other electronic devices; mobile applications; recorded data; sound recordings; game soundtracks.

**Class 35:** *Advertising, marketing, promotional and public relations services; corporate communications services being public relations services; advertising agency, marketing agency, promotional agency and public relations agency services; project management services relating to advertising, marketing, promotional and public relations; marketing studies; online and internet advertising, promotion and marketing services; internet keyword marketing services; experiential marketing, promotion and advertising services and campaigns; immersive and virtual marketing, promotion and advertising services and campaigns; viral marketing, promotion and advertising services and campaigns; video marketing, promotion and advertising services and campaigns; business consulting and advisory services; marketing, customer relationship marketing, loyalty marketing and consumer targeting; segmentation and profiling of market data; database marketing; analysis of consumer marketing; advertising, marketing and advertising consultancy services to businesses that provide data mining, data manipulation, data cleansing, data transformation, data operations and transmission of data services; writing of publicity texts, namely, creating press releases; production of video recordings, audiovisual recordings, and digital video and audiovisual recordings for advertising purposes, marketing purposes, publicity purposes, promotional purposes,*

*and public relations purposes; promoting the goods and services of others through targeted advertising; conducting, organising, holding and arranging business conferences; corporate image development consultancy and advice; branding services, namely, consultancy, and advice and information services relating to management and marketing of brands, creating brand identity and brand development for businesses and individuals; retail services connected with the sale of computer games and computer gaming apparatus; provision of information, advisory and consultancy services in relation to the aforementioned services.*

**Class 41:** *Entertainment services; electronic games services; provision of games by means of local computer networks, global computer networks, the Internet, cable or wire communications services, wireless telecommunications services and broadband services; provision of interactive multi-media computer games via the internet and electronic communication networks; computer game entertainment services; publishing; electronic publishing; publishing of computer game and electronic game software; providing computer games and video games via a website; production of sound recordings; writing services; information and advice relating to these services.*

**Class 42:** *Design of computer games programs and video games programs; development of computer games programs and video games programs; Software as a Service (SaaS) featuring software platforms for electronic gaming; design and development of computer games; computer programming of electronic and digital games; development of games for use on mobile phones, tablets and other electronic devices; design, development and maintenance of computer software and online games; graphic design services; design of virtual reality games; design of toys and games; design services for business; product and packaging design; graphic design; website design and development; social media design and development; animation design; special-effects design; audio design; provision of websites relating to any of the aforesaid services; prototypes and roll-out design services; design and drawing for the compilation of webpages.*

2. As it can be seen, the applied for specifications are identical save for the following limitation in the 'WIZARDS' word only mark which is reproduced in the classes 9, 31 and 41 of the applied-for specification: *"none of the aforesaid relating to money management, financial planning, credit, lending, financial risk management, financial analysis and reporting, financial evaluation, financial consulting services, banking, stockbroking and exchanging money and the provision of financial advice and information, the provision of advice and information on finance for retirement, insurance, investments, pensions, mortgages, taxation, foreign exchange trading, money management, financial planning, credit, lending, financial risk management, financial analysis and reporting, financial evaluation, financial consulting services, banking, stockbroking and exchanging money"*.

3. The applications were published for opposition purposes on 27 October 2023.

4. On 29 January 2024, the applications were opposed by AMIGO Spiel + Freizeit GmbH ("the opponent") based upon Sections 5(2)(b) and 3(6) of the Trade Marks Act 1994 ("the Act").

5. In each opposition, under Section 5(2)(b), the opponent relies upon the following trade mark and all of the goods covered by the same as shown below:

UK00918078264



Filing date: 06 June 2019

Registration date: 03 October 2019

**Class 28:** Games; Parlour games; Playing cards.

6. The Section 5(2)(b) oppositions are directed at the goods and services underlined above. The opponent claims that the marks are similar, and that the goods and services are identical or similar, with the result that there is a likelihood of confusion.

7. The trade mark relied upon by the applicant qualifies as an 'earlier trade mark' pursuant to Section 6 of the Act. As it had not completed its registration process more than five years before the filing date of the contested applications, it is not subject to the use provisions set out at above.

8. Under Section 3(6) the opponent claims that the applications were filed in bad faith because they have overly broad specifications, and that the applicant does not possess a genuine intention to use the applied-for marks for all of the goods and services claimed. In particular, the opponent observes that *"the applicant claims a broad array of goods and services where there can be no genuine intent [to use the marks] in view of the Sky v SkyKick decision and [...] [the opponent] observes that the applicant's stated commercial objects on their website (<https://codewizards.co.uk>) indicate that there is no valid commercial basis for the inclusion of these goods and services in the application"*. Following the opponent's withdrawal of the Section 3(6) ground in relation to most of the originally objected goods and services,<sup>3</sup> the oppositions under the bad faith ground are now directed against the applied-for goods and services highlighted in bold in the table above (in classes 35, 41 and 42).

9. The applicant filed counterstatements denying the grounds of opposition.

10. In particular, the applicant states that the opponent cannot claim exclusive rights in the element 'WIZARD' as it co-exists with a number of other owners who utilise the word 'WIZARD' or 'WIZARDS' in the games and toys sector. In this connection, the applicant argues that the word 'WIZARD' cannot be taken as being the dominant and distinctive element in relation to the opponent's goods. According to the applicant, the distinguishing feature of the opponent's mark is the particular font and the design within the letters, and the overall visual appearance of the marks is very distinct and readily distinguishable.

---

<sup>3</sup> Opponent's skeleton argument

11. As regards the similarity of the goods and services, the applicant states that they are not similar because the opponent's goods are designed to be used in a physical context and require specific kit/games equipment to be used that are provided as part of the opponent's goods. The applicant also argues that the opponent's goods are purchased in their physical format, and are played in real time, usually with others present at the same physical location, and are often used by groups playing at gatherings and parties. Conversely, the applicant argues, computer games are played in a virtual world and are accessed using technology, or through a software download. Lastly, the applicant argues, many of the goods and services covered by the applications relate to the provision of specialist computer software services to develop games software, technology interfaces and other software for third parties, which removes the goods and services of the applications even further away from the goods of the opponent.

12. As regards the Section 3(6) objection, the applicant states that it is a creative, software, technology and games developer and design company, that specialises in a number of areas including software development, games development, technology integration, technology development, design, online hosting and web design, and associated marketing and promotional services. The applicant also states that all of the products and services listed in the contested specifications are either offered or intended to be offered by the applicant as part of its business and the Section 3(6) objection by the opponent has no basis.

## **HEARING AND REPRESENTATION**

13. A hearing took place before me, by video conference, on 10 July 2025. The applicant was represented by Michelle Ward, instructed by Indelible IP Limited and the opponent was represented by Ms Anneliese Mondschein, instructed by JA Kemp LLP. Both parties filed skeleton arguments in advance of the hearing.

## **EVIDENCE**

14. The opponent's evidence in chief consists of the witness statement of Alexander Jost dated 17 May 2024, which is accompanied by 3 exhibits (AJ1 to AJ3). Mr Jost is the Chief Executive Officer of the opponent.

15. The applicant's evidence in chief consists of the following witness statements:

- Witness statement of Stuart Muckley dated 18 July 2024 which is accompanied by 8 exhibits (SM1 - SM8). Mr Muckley is Chief Executive Officer of the applicant.
- Witness statement of Michelle Ward dated 18 July 2024 which is accompanied by 2 exhibits (Exhibits MW1 – MW2). Ms Ward is a Chartered Trade Mark Attorney and founder of Indelible IP Limited, the applicant's legal representative.

## **EU Law**

16. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

## **DECISION**

### **Section 5(2)(b)**

17. Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(a) ....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

18. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

19. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

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

20. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the

Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

21. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

22. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity

between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

23. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that the responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC (as he then was) noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

24. Whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

25. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

26. The earlier goods are *Games; Parlour games; Playing cards* in class 28.

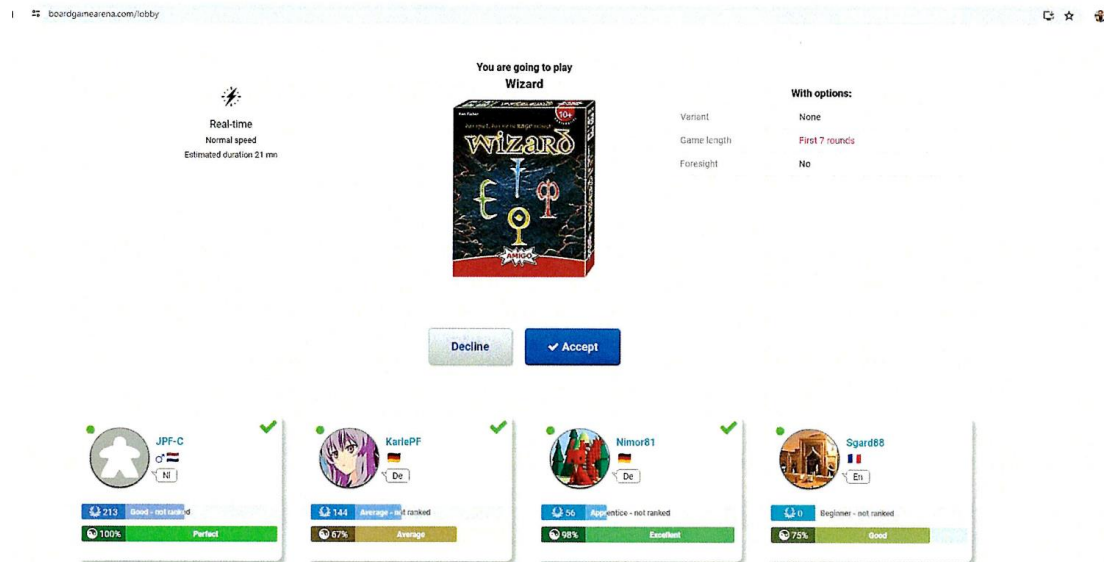
27. Before I turn to the applied-for goods and services, it is worth observing that the specification of the first contested mark also contains the limitation “*none of the aforesaid relating to money management, financial planning, credit, lending, financial risk management, financial analysis and reporting, financial evaluation, financial consulting services, banking, stockbroking and exchanging money and the provision of financial advice and information, the provision of advice and information on finance for retirement, insurance, investments, pensions, mortgages, taxation, foreign exchange trading, money management, financial planning, credit, lending, financial risk management, financial analysis and reporting, financial evaluation, financial consulting services, banking, stockbroking and exchanging money*”. However, given the nature of the goods and services at issue (which have nothing to do with finances) the limitation will make no difference to the conclusion I am going to reach on the similarity of the goods and services.

28. The contested goods and services are as follows:

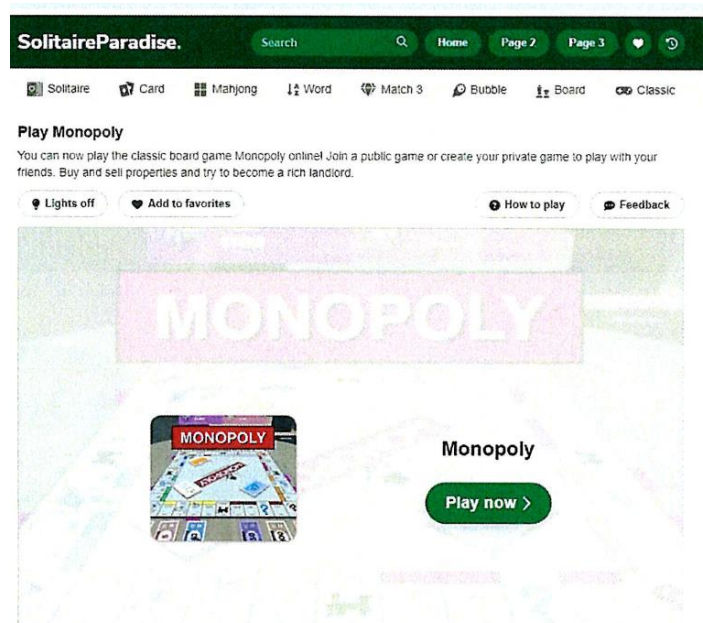
**Class 9: Computer games programs; video games programs; digital games provided by means of local computer networks, global computer networks, the Internet, cable or wire communications services, wireless telecommunications services and broadband services; interactive multi-media computer games; games software for use on consoles, mobile phones, tablets and other electronic devices.**

29. The opponent has filed evidence to support its claim that these goods in class 9 and the opponent’s goods in class 28 are similar. In particular, Mr Jost filed evidence that the opponent markets and sells a series of playing card games which are aimed at ages 10+ and are offered in printed form. These goods, Mr Jost states, are offered under the brand ‘WIZARD’. Mr Jost further states that within the playing card and board game industry, online and digital variants of the opponent’s ‘WIZARD’ card game are also available both via mobile software applications, and accessible via Internet

browsers. At exhibit AJ1 Mr Jost produces an extract taken from the third-party website 'boardgamearena.com', which he states is a leading platform for playing online board games and says that it discloses an online variant of his company 'WIZARD' card game. The screenshot looks as follows:

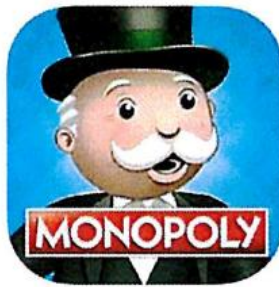


30. In addition, at exhibit AJ2 Mr Jost provides examples of online and digital variants of the well-known board and card games Monopoly, Cluedo, Risk and Solitaire from Apple's App Store and Google's Play Store where it can be seen that digital versions of these games are made available for purchase:



## App Store Preview

Open the Mac App Store to buy and download apps.



### MONOPOLY: The Board Game 4+

Roll the Dice, Pass Go & Win

[Marmalade Game Studio](#)

Designed for iPad

#1 in Family

★★★★★ 4.6 • 32.4K Ratings

£4.99 - Offers In-App Purchases

## App Store Preview

Open the Mac App Store to buy and download apps.



### Cluedo: Classic Edition 12+

Classic Cluedo Board Game

[Marmalade Game Studio](#)

Designed for iPad

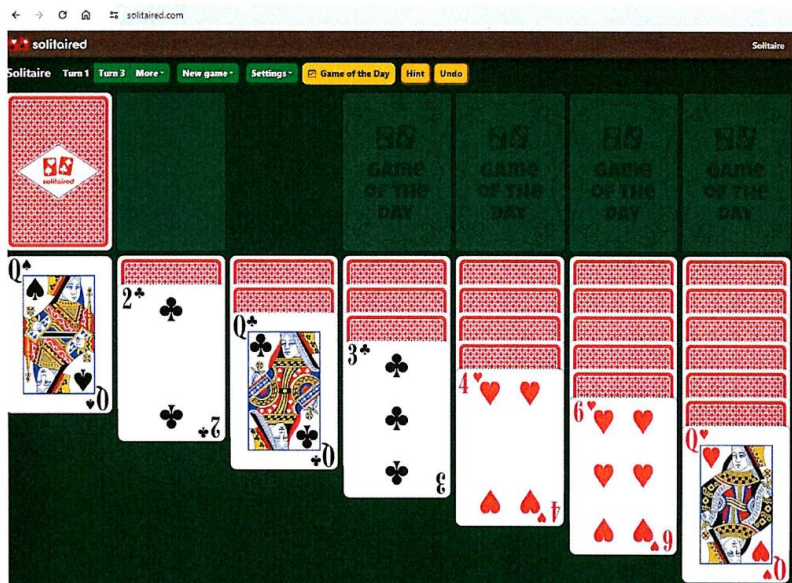
#7 in Board

★★★★★ 4.6 • 6.2K Ratings

£4.99 - Offers In-App Purchases

## Solitaire

[solitaired.com](http://solitaired.com)



31. Lastly, Mr Jost states that based on his knowledge and experience, he knows that there exist various (printed) board and card game versions of popular computer game titles and franchises and that these board/playing-card game 'spin-offs' include, but are not limited to, the following: Final Fantasy (Trading Card Game); Sonic The Hedgehog (Top Trumps) and Super Mario (Whot!). In support of these claims, Mr Jost provides screenshots showing the goods available for sale from, inter alia, Amazon UK as shown below (AJ3):

The screenshot shows two product listings on the Amazon UK website. The first listing is for 'Top Trumps Sonic The Hedgehog Specials Card Game'. The product image shows a blue blister pack with Sonic the Hedgehog and other characters. The price is £6.59, marked down from £7.99 (18% off). It has a 4.7-star rating from 333 reviews and is an Amazon's Choice product. The second listing is for 'Waddingtons Number 1 Super Mario WHOT! Card Game'. The product image shows a red blister pack with Mario and other characters. The price is £7.13, marked down from £7.99 (11% off). It has a 4.6-star rating from 205 reviews and is also an Amazon's Choice product. Both listings include 'Save 5%' on any 4 qualifying items and 'FREE Returns'.

32. Mr Muckley on the applicant's behalf provided evidence of what the applicant does, namely it provides consultancy, development, game support and game management to publishers and developers of computer games. However, whilst this information

might be important to give some context to the applied-for specification, it does not alter (restrict or broaden) the meaning of the terms for which the applications seek registration. Likewise, the opponent's specification must be considered notionally, meaning that the terms covered should be given their natural meaning and the comparison of the goods and services should be based on what the natural meaning of the relevant terms notionally covers (as opposed to what the opponent sells).

33. This leads me to one of the points raised by Ms Ward at the hearing, namely that the opponent's term 'games' is too broad. In this connection, Ms Ward referred me to paragraph 16 of the Practice Amendment Notice (PAN) 1/25<sup>4</sup>, which states:

*"This notice focuses primarily on examination practice. However, opponents and cancellation applicants involved in proceedings before the IPO's Tribunal should also take note of the guidance at paragraphs 11 to 13 above. Relying on broad specifications may lead to counterclaims on bad faith grounds. Claimants are reminded they should base their case only on the terms they are content to defend against a potential counterclaim on bad faith grounds."*

34. Following from this, Ms Ward argued that making the comparisons on the basis of the broad term *games*, which is a class heading term, "*is perhaps a little excessive*" given that the opponent's witness had specifically stated that the goods sold by the opponent are limited to a series of playing card games.

35. Ms Ward's submission would have the effect of limiting the goods for which the opponent's mark is protected to those in relation to which the same mark is actually used, which is not how the trade mark system works. In this connection, at the hearing I explained that since in the present case the opponent's mark is not subject to proof of use, the opponent can rely upon all of the goods it has identified without any consideration of the segment of the market in which the opponent has so far chosen to trade. The purpose of the PAN is to clarify the behaviour expected of trade mark applicants when filing specifications of goods and/or services. In this connection, the

---

<sup>4</sup> Practice Amendment Notice (PAN) following the Supreme Court's judgment in *SkyKick UK Ltd and another v Sky Ltd and others*.

reference in the PAN to claimants being reminded that they should base their case only on the terms they are content to defend against a potential counterclaim on bad faith grounds, is a warning which alerts trade mark applicants/owners about the risks of relying on broad specifications in oppositions and/or cancellations. This is because reliance on extremely broad terms or broad specifications might trigger an invalidity based on the Supreme Court's judgment in *SkyKick*<sup>5</sup> which provides guidance on whether a bad faith finding can stem from an overly broad specification of goods and services, or an overly broad term within it. That does not mean that the owner of a mark cannot rely on a broad term (or a broad specification) under Section 5(2)(b) to oppose or invalidate a later trade mark. Accordingly, contrary to Ms Ward's submission, the opponent is able to rely on the full width of the registered term *games*.

36. Turning to the question of similarity, in response to the opponent's evidence, Ms Ward stated as follows:<sup>6</sup>

*"The Opponent has attempted to demonstrate that it is common for physical games to cross over to the digital space. However, the evidence at Exhibits AJ1 and AJ2 post date the date of the Application, and in the case of Exhibit AJ1, cannot be clearly shown to relate to the UK. The attempt to demonstrate that digital games have physical versions at Exhibit AJ3 is flawed as these are trading card type games where it is the visuals/characters that are being used to play a card game, not the game itself being translated to the physical space. This is character merchandising".*

37. Nevertheless, at the hearing Ms Ward accepted that some of the board games shown in evidence such as Monopoly and Cluedo are well-known board games and have an app (or online version) available. She further accepted that many of the board games' manufacturers may well have tried to extend across online gaming but contended that it is not proven that online games have extended across into the physical world. Quite frankly, I do not think the point makes any difference. In *Comic Enterprises v Twentieth Century Fox* [2016] EWCA 41, the Court of Appeal ruled that

---

<sup>5</sup> *SkyKick UK Ltd & Anor v Sky Ltd & Ors* (Rev1) [2024] UKSC 36

<sup>6</sup> Skeleton argument

'wrong way round confusion' can be relevant to establish whether there is a likelihood of confusion. In that case Kitchin LJ explained at §80:

“80. ...whether a particular instance of confusion is “right way round” or “wrong way round” may be a consequence of nothing more meaningful than the order in which the consumer happened to come across the mark and the sign. Further, in both cases the consumer thinks that the goods or services in issue come from the same undertaking or economically linked undertakings, and they may be equally damaging to the distinctiveness and functions of the mark.”

38. Accordingly, whether the consumer comes across the opponent's goods first, or the applicant's goods first, makes no difference whatsoever. In this case, the scenario is one whereby a consumer who is familiar with the opponent's board games later encounters the applicant's computer games (the right way round confusion), which is exactly the scenario Ms Ward accepted is feasible (i.e. that a manufacturer of board games transitions to online gaming and offers a digital version of the game). In that scenario, the producers of the goods would be the same. The fact that it might be less usual to see online games being moved into physical versions is neither here nor there.

39. Ms Ward also argued that the evidence about Sonic and Super Mario playing cards is not an example of a digital game being transformed into a physical format, but it is character merchandising, where the characters are being used on trading cards. I do not think the argument, even if accepted, would reduce the significance of the previous point that it is not unusual for manufacturers of board games to offer a digital version of the same.

40. Accordingly, the right way of proceeding here is for me to consider the full scope of opponent's terms *Games; Parlour games; Playing cards* as covering any type of game including (as it was discussed at the hearing) board games. Further, the evidence demonstrates, and Ms Ward accepted, that manufacturers of board games might offer digital version of the same, which would be covered by the applied for terms *Computer games programs; video games programs; digital games provided by means of local computer networks, global computer networks, the Internet, cable or wire communications services, wireless telecommunications services and broadband*

services; interactive multi-media computer games; games software for use on consoles, mobile phones, tablets and other electronic devices. This means that there is an overlap in terms of producers, as both sets of goods might be offered by the same undertakings and is likely to result in the goods being in competition, as a user might chose to purchase a physical or online version of the same game. It also results in the goods targeting the same users. In addition, whilst the method of use and nature of the goods might differ, they both have the same purpose, which that of entertaining the user with the same game (offered in both a physical and online version). Lastly, the trade channels through which the goods are distributed are likely to be the same but there is not complementarity in the true sense. Overall, I consider these goods to be similar to a medium degree.

41. Alternatively, although neither party considered this aspect of the opponent's case, the UKIPO classification tool<sup>7</sup> confirms that electronic games and hand-held electronic video games fall in class 28 and would be encompassed by the opponent's broad term *games*. This is within the consideration of notional and fair use of the opponent's mark because the opponent's earlier mark is entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of the earlier mark for the goods on which the opponent relies for the purposes of this opposition. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd*<sup>8</sup> like this:

"22. ....It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very

---

<sup>7</sup> <https://www.search-uk-trade-mark-classes.service.gov.uk/searchclasses>

<sup>8</sup> [2004] RPC 41

limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.”

42. Accordingly, comparing the applicant’s computer video games in class 9 and electronic games and hand-held electronic video games which is a sub-category of the opponent’s games in class 28, I find that the goods have a similar purpose and nature, although the method of use is different because electronic video games are not played on a computer but on a media player. The goods target the same users, i.e. those who like playing video games, are in competition, and might be distributed through the same trade channels, although there is no complementarity. Overall, I consider these goods to be similar to a medium to high degree.

**Class 35: Retail services connected with the sale of computer games and computer gaming apparatus.**

43. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

44. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b),

it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are '*similar*' to goods are not clear cut."

45. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM*, Case T-105/05, at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd* Case C-398/07P, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

46. When comparing the applicant's computer games in class 9 with the opponent's games in class 28, I have concluded that there is a medium (in respect to the specific scenario discussed at the hearing of comparing a physical versus an online version of

the same board game) or high to medium degree of similarity (in respect to the notional scenario of comparing a computer game versus a hand-held electronic video game). Here I am comparing the retail of computer games and computer gaming apparatus in class 35 versus games in class 28, the latter including hand-held electronic video games and board games. In those circumstances, I find that the retail services normally associated with the applied-for goods are sufficiently close to the opponent's goods for there to be a degree of similarity. Although the goods the subject of the retail services are not identical to the opponent's goods, they are all types of games which may be distributed through the same trade channels. Further, the goods and services target the same consumers and the complementarity between them is sufficiently close that, from the consumer's point of view, they are likely to be offered by one and the same undertaking. Overall, I consider these goods and services to be similar to a low to medium degree.

**Class 41:** electronic games services; provision of games by means of local computer networks, global computer networks, the Internet, cable or wire communications services, wireless telecommunications services and broadband services; provision of interactive multi-media computer games via the internet and electronic communication networks; computer game entertainment services; publishing of computer game and electronic game software; providing computer games and video games via a website.

47. In relation to these services, I consider two scenarios. The first scenario is that of the opponent's games covering board games and the applicant's services covering the provision of a computer game version of the opponent's board game through a website or online. In such a scenario, for similar reasons to those I have set out above in relation to the applied-for goods in class 9, I consider that whilst the similarity between the goods and services is slightly less pronounced, it is still sufficiently meaningful to engage the question of likelihood of confusion. Overall, I consider that there is a low to medium degree of similarity here.

48. The second scenario is that of the opponent's games covering handheld video games and the applicant's services covering the provision of a computer game version of the opponent's handheld video games through a website or online. Once again, I consider that whilst the similarity between the goods and services is slightly less

pronounced, it is still sufficiently meaningful to engage the question of likelihood of confusion. Overall, I consider that there is a medium degree of similarity here.

**Class 42:** Design of computer games programs and video games programs; development of computer games programs and video games programs; Software as a Service (SaaS) featuring software platforms for electronic gaming; design and development of computer games; computer programming of electronic and digital games; development of games for use on mobile phones, tablets and other electronic devices; design, development and maintenance of computer software and online games; design of virtual reality games; design of toys and games.

49. In relation to these services, Ms Ward argued that they are “complementary services to the provision of games to the end user”. She stated that “games must be designed, developed and tested before release, as well as maintained and updated for performance and quality assurance, as well as to be rendered user-friendly and therefore attractive” and argued that “the decision to use and/or purchase the end product will be impacted by these inputs, and by way of example, the designer, format, platform and quality of maintenance of the game will all have a great bearing on the appeal of the end-product to the end user member of the general public.” Lastly, Ms Ward argues that “without a detailed understanding of the segmentation of the supply chain it is likely that the end user will assume that the game and the design and maintenance of it come from the same undertaking.”

50. I think Ms Ward’s submission suffers from a basic misconception. She seems, in fact, to mix the question of the similarity between the applied-for services in class 42 (which are business to business services provided by IT companies and designed to help game developers and publishers to create high-quality games, as well as update and optimize the games) and the opponent’s games (which target the public at large), with the question of whether the end-consumer of games might believe that the design, development and maintenance of the games is also the responsibility of the manufacturer of the game. First of all, this argument cannot apply to the applicant’s services which relate to computer games, namely Design of computer games programs and video games programs; development of computer games programs and video games programs; design and development of computer games; design,

development and maintenance of computer software and online games; design of virtual reality games because the opponent's goods in class 28 do not include computer games (but only electronic games which are a different thing); hence, even following Ms Ward's argument, the services are one step removed from the goods.

51. As regards Software as a Service (SaaS) featuring software platforms for electronic gaming; computer programming of electronic and digital games; development of games for use on mobile phones, tablets and other electronic devices; design of toys and games, proceeding on the basis that the opponent's games include electronic games and hand-held electronic video games, the scenario predicted by Ms Ward would be feasible as these services relate to electronic games which would be covered by the opponent's goods. Design of games could also relate to board games. However, the point about the consumer of the opponent's games assuming that the opponent is also responsible for creating the game and carrying out all the updates that are necessary to keep the game engaging and running smoothly, is irrelevant to the question of the similarity between the goods and services. Such a question engages with the likelihood of confusion, not with the similarity between the goods and services. By definition, goods intended for different publics cannot be complementary. In case Case T-237/21 *Fidelity National Information Services v EUIPO*, the GC upheld the BoA finding that there could be no complementary connection between, on the one hand, the goods or services which were necessary for the running of a commercial undertaking and, on the other, the goods or services produced or supplied by that undertaking, confirming that the two categories of goods and services are not used together, because those in the first category are used by the relevant undertaking itself, whereas those in the second are used by the customers of that undertaking. Similarly in this case, the goods and services have a different nature, purpose, use and method of use, they target different consumers (i.e. the manufacturer of video and electronic games versus the end-user of the games), are distributed through different trade channels and are neither complementary nor in competition. Overall, there is no meaningful similarity between these services and the opponent's goods, and I find that they are dissimilar.

## **Conclusion of the goods and services comparison.**

52. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

53. Under the Section 5(2)(b) ground, a likelihood of confusion can only exist where there is at least some similarity between the goods and services. This means that as a result of my findings above, the present grounds fail in relation to the applied-for services in class 42.

## **Average consumer**

54. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words

“average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

55. The average consumer for the goods and services which I found to be similar is a member of the general public. The goods and services will be provided online with the consumer selecting the goods and services having viewed an image displayed on a webpage; in addition, the goods can also be provided through retail premises. Considered overall, the selection process will be a predominantly visual one, although aural considerations will play their part, through, for example, word of mouth recommendations. As regards the level of attention, it will be neither higher, no lower than the norm, as there are no specific considerations which would warrant a low or high degree of attention being applied by the consumer during the selection.



### **Comparison of marks**

56. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

57. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and, therefore,

contribute to the overall impressions created by the marks. The respective marks are shown below:

The applied-for marks	The opponent's mark
<p style="text-align: center;">WIZARDS &amp; MULTIPLAYER WIZARDS &amp;</p>  <p style="text-align: center;">(SERIES OF TWO)</p>	

### Overall Impression

#### The applicant's marks

58. The word-only mark 'WIZARDS' consists of the single word 'WIZARDS'. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself.

59. The word-only mark 'MULTIPLAYER WIZARDS' consists of the two words 'MULTIPLAYER' and 'WIZARDS'. Given the nature of the goods and services at issue, which relate to video games, the meaning of the word 'MULTIPLAYER' is relevant because it describes a characteristic of the game, being *“used to refer to computer games in which several players can compete against each other”* (Cambridge online dictionary). It follows that being a descriptive element of the mark, the word

'MULTIPLAYER' has less weight than the word 'WIZARDS' which dominates the overall impression of the mark.

60. The figurative marks 'MULTIPLAYER WIZARDS' consist of the two words 'MULTIPLAYER' and 'WIZARDS' presented in black and white within a rectangular background with the word 'MULTIPLAYER' written in a standard font, in a smaller size and placed above the word 'WIZARDS' which is presented in a larger and highly stylised font. Whilst the font in which the element 'WIZARDS' is presented is striking, it does not prevent the word from being perfectly readable. Bearing in mind the descriptive nature of the word 'MULTIPLAYER' in the context of the goods and services at issue as well as its smaller size, I consider that it plays a lesser role compared to the word 'WIZARDS' which dominates the overall impression of the mark.

### **The opponent's mark**

61. The opponent's mark consists of the word 'WIZARD' presented in a stylised font in grey within a rectangular background. Whilst the background and the stylisation of the letters contribute to the overall impression of the mark, they do so to a much lesser extent than the word 'WIZARD' which is the most distinctive and dominant element of the mark.

### **Visual similarity**

#### *WIZARDS v the opponent's WIZARD*

62. These marks coincide in the letters 'WIZARD' which are the entirety of the verbal element of the opponent's mark and the first six letters of the applied-for mark. The marks differ in the presence of a final letter 'S' in the applied-for mark and in the background and stylisation of the opponent's mark. Overall, I consider these marks to be similar to a high degree.

### *MULTIPLAYER WIZARDS word marks v the opponent's WIZARD*

63. These marks coincide in the letters 'WIZARD' which are the entirety of the verbal element of the opponent's mark and the first six letters of the second verbal element of the applied-for mark. The marks differ in the addition of the word 'MULTIPLAYER' at the beginning of the applied-for mark and the presence of a final letter 'S' at the end of the word 'WIZARD' in the same mark, as well as in the background and stylisation of the opponent's mark. However, although the word 'MULTIPLAYER' is placed at the beginning of the mark, where the consumer's attention tends to focus, it is a descriptive element which reduces its impact in the overall impression. Overall, I consider these marks to be similar to a medium to high degree.

### *MULTIPLAYER WIZARDS figurative marks v the opponent's WIZARD*

64. Similar considerations to those I have set out above apply to these marks. However, I also need to factor in the impact of the stylisation of the letters and the background. Overall, I consider these mark to be similar to a medium degree.

### **Aural similarity**

65. Aurally, the applied-for *WIZARDS* mark is either identical or nearly identical to the *opponent's WIZARD* mark, the final letter 'S' in the applied-for mark being silent or nearly silent.

66. Turning to the *MULTIPLAYER WIZARDS* marks (both the word-only and the figurative marks) the stylisation of the figurative marks has no bearing on the aural comparison, and I find that the marks are similar to a medium degree.

### **Conceptual similarity**

67. Conceptually, all of the marks share the concept of a 'WIZARD' or of multiple 'WIZARDS'. The only other concept conveyed by the marks is that introduced by the word 'MULTIPLAYER', however, as noted above, it is descriptive. I consider that the

'WIZARDS' word only mark is conceptually identical or similar to a very high degree, whilst the others are similar to a high degree.

### **Distinctive character of the earlier mark**

68. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

69. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

70. The earlier mark consists of the words 'WIZARD'. At the hearing Ms Ward on the applicant's behalf, argued that mystical adventures, including those involving wizards and goblins, are commonplace across literature and fantasy genres, including in games, and referred to the popularity of Harry Potter and Lord of the Rings. According to Ms Ward, reference to "wizard" is not something that one party can say is distinctive of their adventure, meaning that the distinctiveness of the earlier mark 'WIZARD' is reduced. In support of such claim, Ms Ward provided evidence of two products, namely a board game called 'LIZARD WIZARD' and a product called 'WIZARD TAROT CARD'. These two examples being undated, are far from establishing that at the relevant date of 6 October 2023 the relevant market was saturated with traders offering games under trade marks incorporating the word 'WIZARD'/'WIZARDS' to the point that the word on its own was incapable of distinguishing the products of one manufacturer from another or had become less distinctive.

71. In my view the word 'WIZARD' is neither descriptive nor allusive of the earlier games, which might relate to any topics other than wizards. Accordingly, I find that the earlier mark has an average degree of inherent distinctiveness. Lastly, whilst the opponent has filed evidence, it is all about the type of product sold by the opponent and the overlap between board games and their online version; as such, it is not sufficient for enhanced distinctiveness to be triggered.

### **Likelihood of confusion**

72. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

73. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example).”

74. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] ‘a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

75. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

76. Earlier in this decision I found that:

- The marks are visually and aurally similar to a medium, medium to high and high degree and conceptually identical or similar to a high or very high degree.
- The goods and services are similar to a medium or low to medium degree.
- The goods and services will be selected visually with a medium degree of attention. However, aural considerations cannot be discounted completely.
- The earlier mark is inherently distinctive to a medium degree.

77. I consider that given the similarity of the goods and services, and the medium degree of distinctiveness of the earlier mark, the identity or high degree of conceptual similarity between the marks and the medium to high degree of visual and aural similarity, it is likely that the average consumer will directly confuse the opponent's mark with the applicant's word-only marks, misreading or mis recalling the dominant and distinctive elements ‘WIZARDS’ and ‘WIZARD’ for each other. In reaching this

conclusion, I bear in mind that the element 'MULTIPLAYER' (in the applications) is descriptive and that the stylisation (in the earlier mark) is not particularly memorable and can be overlooked, and that the only difference between 'WIZARD' and 'WIZARDS' is the final letter 'S' which is placed at the end of the word, where consumer attention is less focused. Added to this, the absence of any striking conceptual difference between the marks, one can easily foresee the marks being confused in the imperfect recollection of the average consumer.

78. Turning to the 'MULTIPLAYER WIZARD' figurative mark, admittedly the stylisation is more striking, however, it is not so striking to prevent the words from being read. In those circumstances I consider that the presence in both marks of the nearly identical element 'WIZARDS'/'WIZARD' will result in the average consumer thinking that the applicant's marks are variant marks used by the opponent, incorporating the brand 'WIZARD'. There is a likelihood of confusion in relation to the goods and services which I have found to be similar.

### **Section 3(6)**

79. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

80. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* (“*SkyKick*”) [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

“(i) [...]

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation [...], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 (“*Malaysia Dairy*”)], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 (“*Sky CJEU*”)], para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the [...] law of trade marks, namely the establishment and functioning of [...] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 (“*Koton*”)], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case ([*Hasbro Inc v EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 (“*Hasbro*”)], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87).”

81. Earlier in *SkyKick*, Lord Kitchin considered the question of what amounts to bad faith. He underlined that the categories of bad faith and the circumstances which may constitute bad faith are not closed, and continued:

“152. In seeking to identify the relevant principles, it is necessary to have in mind two fundamental aspects of trade mark law to which I have already referred: first, it is concerned with the use of marks in trade to denote the origin of goods and services. Secondly, the aim of the trade mark regime is to contribute to a system of undistorted competition in which businesses are able to attract and retain customers by the quality of their goods and services, and for that purpose are able to have registered signs which enable consumers to distinguish the goods and services of one undertaking from those of another.

Such a system must also provide an incentive and protection for the investment by a brand owner in the quality and other beneficial aspects of its goods and services, and so allow it to develop a goodwill in its business relating to their sale and supply.

153. Against this background, the essence of the objection that an application to register a mark was made in bad faith may be understood: it is that the motive or intention of the applicant was to engage in conduct that departed from accepted principles of ethical behaviour or honest commercial practices having regard to the purposes of the trade mark system which I have described. Whether the conduct was undertaken with that motive or intention and did indeed depart from such ethical behaviour or honest commercial practices must be assessed having regard to all the objective circumstances of the case: see, for example, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*"), paras 46 and 47 [...]."

82. The correct approach to assessing bad faith was set out in *Alexander Trade Mark*, BL O/036/18, where Mr Geoffrey Hobbs sitting as the Appointed Person stated that the key questions for determination in a claim of bad faith are:

- (a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?
- (b) Was that an objective for the purposes of which the contested application could not be properly filed? and
- (c) Was it established that the contested application was filed in pursuit of that objective?

83. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani*

*(Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

84. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

85. The caselaw shows that the initial evidential burden falls upon the opponent: the opponent must present evidence from which a rebuttable presumption of lack of good faith can be drawn. If it does that, then the burden shifts to the applicant to rebut the allegation.

86. At the hearing Ms Mondschein confirmed that the Section 3(6) ground of opposition was withdrawn in relation to the applied-for goods in class 9. Further in relation to the applied-for goods in class 35 the parties agreed that the contested marks would proceed to registration based on the fallback specification offered by the applicant, namely with the addition of the limitation “*all being provided to the computer games, digital games and video games industry*”.

87. This leaves the objection under Section 3(6) as being directed to the following services:

**Class 41:** *publishing; electronic publishing; production of sound recordings; writing services.*

**Class 42:** *graphic design services; design services for business; product and packaging design; graphic design; website design and development; social media design and development; prototypes and roll-out design services; design and drawing for the compilation of webpages.*

88. Ms Mondschein’s argument on bad faith is that the applicant does not use the earlier mark in relation to these services and has no intention to use them in the future.

Although Ms Mondschein referred to the judgment in *SkyKick*, her analysis and arguments about bad faith appear to reflect the logic of a revocation action, rather than that of an objection based on bad faith. Overly broad specifications that can give rise to a bad faith attack are those which are manifestly and self-evidently broad and the guidance from *SkyKick* does not mean that the owner of a registered mark must prove that it has used or intends to use the mark for each of the registered terms individually. The test for bad faith is not the same as that for proof of use. In this case the parties seem to agree that the contested mark has been used for most of the goods and services for which it is protected and the terms that are still objected fall within the framework of the goods and services belonging to the sector in which the opponent operates. Hence, I reject the Section 3(6) ground of opposition.

## **OVERALL CONCLUSIONS**

89. The opposition under Section 5(2)(b) has been successful in relation to the contested goods and services in classes 9, 35 and 41.

90. The opposition under Section 3(6) has failed, however, since the parties have agreed a fall back-specification for the services in class 35, this class will proceed to registration for the agreed fall-back specification regardless of the outcome of Section 5(2)(b). Consequently, the application will proceed to registration as follows: (a) for class 9: only for the terms that have not been objected: (b) for class 35: for the fall-back specification; (c) for class 41: only for the terms that have not been objected: (d) for class 42: for the entire class:

### **UK00003964609**

**Class 9:** *Downloadable electronic publications; downloadable software; mobile applications; recorded data; sound recordings; game soundtracks; none of the aforesaid relating to money management, financial planning, credit, lending, financial risk management, financial analysis and reporting, financial evaluation, financial consulting services, banking, stockbroking and exchanging money and the provision of financial advice and information, the provision of advice and information on finance for retirement, insurance, investments, pensions, mortgages, taxation,*

*foreign exchange trading, money management, financial planning, credit, lending, financial risk management, financial analysis and reporting, financial evaluation, financial consulting services, banking, stockbroking and exchanging money.*

**Class 35:** *Advertising, marketing, promotional and public relations services; corporate communications services being public relations services; advertising agency, marketing agency, promotional agency and public relations agency services; project management services relating to advertising, marketing, promotional and public relations; marketing studies; online and internet advertising, promotion and marketing services; internet keyword marketing services; experiential marketing, promotion and advertising services and campaigns; immersive and virtual marketing, promotion and advertising services and campaigns; viral marketing, promotion and advertising services and campaigns; video marketing, promotion and advertising services and campaigns; business consulting and advisory services; marketing, customer relationship marketing, loyalty marketing and consumer targeting; segmentation and profiling of market data; database marketing; analysis of consumer marketing; advertising, marketing and advertising consultancy services to businesses that provide data mining, data manipulation, data cleansing, data transformation, data operations and transmission of data services; writing of publicity texts, namely, creating press releases; production of video recordings, audiovisual recordings, and digital video and audiovisual recordings for advertising purposes, marketing purposes, publicity purposes, promotional purposes, and public relations purposes; promoting the goods and services of others through targeted advertising; conducting, organising, holding and arranging business conferences; corporate image development consultancy and advice; branding services, namely, consultancy, and advice and information services relating to management and marketing of brands, creating brand identity and brand development for businesses and individuals; retail services connected with the sale of computer games and computer gaming apparatus; provision of information, advisory and consultancy services in relation to the aforementioned services; none of the aforesaid relating to money management, financial planning, credit, lending, financial risk management, financial analysis and reporting, financial evaluation, financial consulting services, banking, stockbroking and exchanging money and the*

*provision of financial advice and information, the provision of advice and information on finance for retirement, insurance, investments, pensions, mortgages, taxation, foreign exchange trading, money management, financial planning, credit, lending, financial risk management, financial analysis and reporting, financial evaluation, financial consulting services, banking, stockbroking and exchanging money; all being provided to the computer games, digital games and video games industry.*

**Class 41:** *Entertainment services; publishing; electronic publishing; production of sound recordings; writing services; information and advice relating to these services; none of the aforesaid relating to money management, financial planning, credit, lending, financial risk management, financial analysis and reporting, financial evaluation, financial consulting services, banking, stockbroking and exchanging money and the provision of financial advice and information, the provision of advice and information on finance for retirement, insurance, investments, pensions, mortgages, taxation, foreign exchange trading, money management, financial planning, credit, lending, financial risk management, financial analysis and reporting, financial evaluation, financial consulting services, banking, stockbroking and exchanging money.*

**Class 42:** *for the entire class, namely: Design of computer games programs and video games programs; development of computer games programs and video games programs; Software as a Service (SaaS) featuring software platforms for electronic gaming; design and development of computer games; computer programming of electronic and digital games; development of games for use on mobile phones, tablets and other electronic devices; design, development and maintenance of computer software and online games; graphic design services; design of virtual reality games; design of toys and games; design services for business; product and packaging design; graphic design; website design and development; social media design and development; animation design; special-effects design; audio design; provision of websites relating to any of the aforesaid services; prototypes and roll-out design services; design and drawing for the compilation of webpages.*

**UK00003964630 and UK00003964653**

**Class 9:** Downloadable electronic publications; downloadable software; mobile applications; recorded data; sound recordings; game soundtracks.

**Class 35:** Advertising, marketing, promotional and public relations services; corporate communications services being public relations services; advertising agency, marketing agency, promotional agency and public relations agency services; project management services relating to advertising, marketing, promotional and public relations; marketing studies; online and internet advertising, promotion and marketing services; internet keyword marketing services; experiential marketing, promotion and advertising services and campaigns; immersive and virtual marketing, promotion and advertising services and campaigns; viral marketing, promotion and advertising services and campaigns; video marketing, promotion and advertising services and campaigns; business consulting and advisory services; marketing, customer relationship marketing, loyalty marketing and consumer targeting; segmentation and profiling of market data; database marketing; analysis of consumer marketing; advertising, marketing and advertising consultancy services to businesses that provide data mining, data manipulation, data cleansing, data transformation, data operations and transmission of data services; writing of publicity texts, namely, creating press releases; production of video recordings, audiovisual recordings, and digital video and audiovisual recordings for advertising purposes, marketing purposes, publicity purposes, promotional purposes, and public relations purposes; promoting the goods and services of others through targeted advertising; conducting, organising, holding and arranging business conferences; corporate image development consultancy and advice; branding services, namely, consultancy, and advice and information services relating to management and marketing of brands, creating brand identity and brand development for businesses and individuals; retail services connected with the sale of computer games and computer gaming apparatus; provision of information, advisory and consultancy services in relation to the aforementioned services; all being provided to the computer games, digital games and video games industry.

**Class 41:** Entertainment services; publishing; electronic publishing; production of sound recordings; writing services; information and advice relating to these services.

**Class 42:** *Design of computer games programs and video games programs; development of computer games programs and video games programs; Software as a Service (SaaS) featuring software platforms for electronic gaming; design and development of computer games; computer programming of electronic and digital games; development of games for use on mobile phones, tablets and other electronic devices; design, development and maintenance of computer software and online games; graphic design services; design of virtual reality games; design of toys and games; design services for business; product and packaging design; graphic design; website design and development; social media design and development; animation design; special-effects design; audio design; provision of websites relating to any of the aforesaid services; prototypes and roll-out design services; design and drawing for the compilation of webpages.*

## **COSTS**

91. Since each party has achieved a measure of success, I order that each party bears their own costs.

Dated this 20<sup>th</sup> day of February 2026

TERESA PINTO  
For the Registrar