

**O/0256/26**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBER 3956657  
BY PC SPECIALIST LTD  
TO REGISTER THE FOLLOWING TRADE MARK:**

**LUNA SERIES**

**IN CLASSES 9, 35, 37, 40 AND 42**

**AND**

**AN OPPOSITION THERETO UNDER NUMBER OP000444380  
BY AMAZON TECHNOLOGIES, INC.**

## **BACKGROUND AND PLEADINGS**

1. On 14 September 2023, **PC Specialist Ltd** (“the Applicant”) applied to register in the UK the trade mark shown on the cover page of this decision (“the contested mark”). The application was accepted and published for opposition purposes on 29 September 2023 and registration is sought for the following goods and services:

- Class 9      Data processing equipment, computers; computer hardware; custom built computers; communications servers [computer hardware]; computer software; smart phones; tablet computers; laptop computers; data processors; parts and fittings for all the aforesaid goods.
- Class 35      Retail services connected with the sale of data processing equipment, computers, computer hardware, custom built computers, communications servers [computer hardware], computer software, smart phones, tablet computers, laptop computers, data processors and parts and fittings for all the aforesaid goods; information, advice and consultancy in relation to all the aforesaid services.
- Class 37      Installation, maintenance and repair of computers, data processing equipment and computer hardware; information, advice and consultancy in relation to all the aforesaid services.
- Class 40      Custom manufacture of computers and computer hardware for others; custom manufacture and assembly of information technology products; digital printing; printing of documents from digital media; information, advice and consultancy in relation to all the aforesaid services; custom construction of computers, data processing equipment and computer hardware.

Class 42 Customization of computer hardware and software; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer and information technology support and consultancy services; configuration of computer hardware, firmware, software, systems and networks; rental of web servers; information, advice and consultancy in relation to all the aforesaid services.

2. On 29 November 2023, **Amazon Technologies, Inc.** (“the Opponent”) opposed the application on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

3. The Opponent relies upon the four earlier rights detailed below:<sup>1</sup>

UK00003695993, filed on 16 September 2021, registered on 1 April 2022.<sup>2</sup>



(“the 993 mark”)

UK00003695994, filed on 16 September 2021, registered on 1 April 2022.



(“the 994 mark”)

UK00003695992, filed on 16 September 2021, registered on 21 January 2022.

**AMAZON LUNA**

(“the 992 mark”)

UK00003757426, filed on 21 February 2022, registered on 22 July 2022.<sup>3</sup>

Priority date: 9 September 2021 (USA)

**LUNA COUCH**

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<sup>1</sup> The first three marks listed here benefit from an earlier EU filing date of 24 September 2020 pursuant to Article 59 of the Withdrawal Agreement between the UK and the EU.

<sup>2</sup> In respect of the 993, 994 and the 992 Marks, the opponent relies upon the goods and services set out in Annex 1 to this decision.

<sup>3</sup> In respect of this mark, the opponent relies upon the goods and services set out in Annex 2 to this decision.

(“the 426 mark”)

4. The Opponent claims that the marks are similar, and the goods and services are identical or similar, with the result that there is a likelihood of confusion.

5. Given their filing/priority dates, the Opponent’s marks are earlier marks, in accordance with section 6 of the Act. In accordance with section 6A of the Act, the earlier marks are not subject to proof of use and so the opponent may rely upon all of the goods and services for which they are registered.

6. The Applicant filed a defence and counterstatement denying a likelihood of confusion on the basis of a lack of similarity between the marks and low similarity between the goods and services. The decision will proceed on the basis as set out in the ‘preliminary issue’ section below.

7. The Opponent is represented by **Morgan, Lewis & Bockius UK LLP**; the Applicant is represented by **TRADE MARK DIRECT**. During the evidence rounds, both parties filed evidence. Neither party requested a hearing, but both parties filed written submissions in lieu. This decision is taken following a careful consideration of all the papers.

## **EVIDENCE AND SUBMISSIONS**

8. Both the Opponent and the Applicant filed evidence. I do not intend to provide a stand-alone evidence summary, but will, instead, draw from the evidence, as and when relevant, during the course of this decision. I will, however, map out below who has given evidence, and about what.

9. The Opponent filed evidence in chief in the form of a witness statement in the name of Nicholas Bolter, dated 7 May 2024, and its corresponding two exhibits (labelled “NB1-NB2”). This is accompanied by submissions dated 7 May 2024 and an ‘authorities bundle’. Nicholas Bolter is a partner of the Opponent’s representative. Mr Bolter’s evidence in chief is largely concerning the meaning of the term ‘LUNA’, and the distribution channels for video games and gaming devices.

10. Submissions and an authorities bundle containing decision O/600/22 were also filed and I shall refer to them where necessary.

11. The Applicant filed evidence in chief in the form of a witness statement in the name of Daniel Martin Williams, dated 27 June 2024, and its corresponding three exhibits (labelled “DMW1-DMW3”). Daniel Martin Williams is the director of the Applicant.

12. The Opponent filed evidence in reply in the form of the second witness statement of Nicholas Bolter, dated 2 September 2024, and its corresponding two exhibits (labelled “NB1A – NB3A”). The evidence was accompanied by submissions in reply dated 2 September 2024.

13. Mr Bolter’s evidence in reply seeks to address the meaning of the word LUNA and the similarity of the relevant goods/services.

14. Submissions in lieu were filed by the Applicant dated 27 June 2024 and by the Opponent dated 28 October 2024. I have taken all evidence and submissions into consideration in reaching this decision and will refer to it below where necessary.

## **PRELIMINARY ISSUES**

### **Request for Applicant to clarify position**

15. On 17 September 2025, the Tribunal contacted the Applicant by email stating:

*“We note that in your Form TM8 you admit that the goods and services are similar to a low degree. You also admit that there is a low degree of visual and conceptual similarity, and a low to medium degree of aural similarity.*

*However, in your written submissions in lieu, you state that “LUNA SERIES is conceptually, aurally and visually dissimilar” to the opponent’s mark and that the goods and services would be considered clearly distinct by consumers.*

*Your submissions are, therefore, contradictory to the position taken in your Form TM8.”*

16. The Applicant was given a deadline of 1 October 2025 to clarify their position. On 18 September 2025 the Applicant responded as follows:

*“With the Collins dictionary defining ‘dissimilar’ as: ‘If one thing is dissimilar to another, or if two things are dissimilar, they are very different from each other’, our client’s position is that the statements made in the TM8 and submissions with respect to the similarity of the trademarks and Goods and Services are not contradictory.*

.....

*The above notwithstanding, we would be grateful if the Tribunal would take the following statement as our client’s defining position; ‘LUNA SERIES is conceptually, aurally and visually dissimilar’ to the opponent’s mark and that the goods and services would be considered clearly distinct by consumers.”*

17. On 26 September 2025, the Opponent was given the opportunity to respond regarding the a) similarity of the marks and b) similarity of the goods and services and responded as follows on 7 October 2025:

*“the Applicant’s response of 18 September 2025 denying any degree of similarity between the marks and goods/services, does not change the Opponent’s position, namely:*

- The Applicant’s mark, LUNA SERIES, (the “Applicant’s Mark”) is highly similar to the Opponent’s LUNA & device and LUNA & purple device marks and at least similar overall to the Opponent’s AMAZON LUNA and LUNA COUCH marks (all four, collectively, the “Opponent’s Marks”), given the full reproduction of the LUNA verbal element as the initial and distinctive element in the Applicant’s Mark; and*
- All of the goods and services claimed in the Application are identical or similar to the goods and services covered by the Opponent’s Marks, particularly given that the Opponent’s Marks cover a broad range of electronic hardware,*

*computer software and electronic transmission-related goods and services which overlap with the broad goods and services covered by the Application in Classes 9, 35, 37, 40 and 42.*

*In light of the similarity between the marks, and the identity or similarity between the goods and services, the Opponent maintains that there exists a clear likelihood of confusion between the Applicant's Mark and the Opponent's Marks on the part of the relevant public. Therefore, the Opponent reiterates its request that the application be rejected in its entirety and request that an award of costs be made against the Applicant."*

18. On 31 October 2025, the Tribunal responded to both parties and issued a preliminary view that:

*"In the interests of fairness to both parties, the Hearing Officer has considered both parties' responses and the Preliminary View is that the case will proceed on the basis that the Applicant's position on the similarity of the goods/services and the marks is as follows:*

*'LUNA SERIES is conceptually, aurally and visually dissimilar" to the opponent's mark and that the goods and services would be considered clearly distinct by consumers."*

19. It is noted that no objection was lodged by either party to the above and therefore this decision will proceed on the basis of the Applicant's response as set out in paragraph 16.<sup>4</sup>

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<sup>4</sup> The Applicant's response as per email dated 18 September 2025: *'The above notwithstanding, we would be grateful if the Tribunal would take the following statement as our client's defining position; 'LUNA SERIES is conceptually, aurally and visually dissimilar" to the opponent's mark and that the goods and services would be considered clearly distinct by consumers.'*

### **Section 5(3)**

20. In its submissions in lieu the Applicant states;

*“For the reasons set out above, it is submitted that the conditions contained in section 5(2)(b), and 5(3) of the Trade Marks Act 1994 are not fulfilled. The Applicant therefore requests that the Opposition be rejected in its entirety and the Contested Mark be allowed to proceed in respect of all goods and services described in the application.”*

21. As stated above, the Opponent opposes the application on the basis of section 5(2)(b) of the Act only and therefore any reference to section 5(3) is disregarded.

### **Target audience**

22. The Opponent makes the following submission regarding the parties’ respective target audience and claims the relied upon and contested marks ‘*target the same public, namely gamers*’<sup>5</sup>, which I intend to address briefly to explain how this has been taken into consideration in the present proceedings.

23. I note that much of the Opponent’s specifications are focused upon gaming, but the same is not true of the Applicant’s specifications. Differences between the goods currently provided by the parties, such as particular characteristics of the goods, including whether they are intended for gamers or not, etc., are irrelevant, except to the extent that those differences are apparent from each party’s specification. I must compare the goods as described within the parties’ specifications, not what goods are currently marketed by the parties under their respective marks.

### **DECISION**

24. Sections 5(2)(b) and 5A of the Act state:

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

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<sup>5</sup> Opponent submissions in reply 11.1

[...]

(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.”

“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.”

## **Relevant law**

25. 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:

### The principles

(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 be dominated by one or more of its components;

(f) however, it is also 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 great 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;

(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 trade marks

26. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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 relevant 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.”

27. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade 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.

28. The marks to be compared are as follows:

The Opponent's earlier marks	The Applicant's contested mark
993 mark  luna	<b>LUNA SERIES</b>
994 mark  luna	
992 mark	

<b>AMAZON LUNA</b>	
426 mark <b>LUNA COUCH</b>	

29. With regards to the similarity of the marks, in its statement of grounds, the Opponent states the following:

*“The Opponent submits that the Applicant’s Mark and the Opponent’s Marks are similar. In particular:*

*6.3.1. Visually, the Opponent’s Marks and the Applicant’s Mark are similar to the extent that they all share the distinctive term ‘LUNA’.*

*6.3.2. Phonetically, the Opponent’s LUNA & device Marks and the Applicant’s Mark also coincide in the pronunciation of the common element ‘LUNA’, which is placed in first position with the Applicant’s Mark and thus more noticeable.*

*6.3.3. Conceptually, the marks have no specific meaning in relation to the goods and services in comparison so the marks cannot be compared on a conceptual level.”*

30. With regards to the similarity of the marks, in its counterstatement, the Applicant submits the following:

*“Both the Applicant’s trademark and the Opponent’s trademarks contain the term ‘LUNA’ which is in common use meaning moon.*

*LUNA is a common term with low distinctiveness, there being 60 other live registered trademarks that contain the term LUNA in class 9 alone at the UKIPO, those trademarks involved in this matter not included.*

*The Applicant's mark also contains the word SERIES, indicating a series of ephemeral moons that wax and wane through the lunar cycle. This is conceptually different to LUNA, a single, static, lumpen moon, and will be perceived as such by consumers.*

*Two of the Opponent's marks include the distinctive terms AMAZON and COUCH, further distinguishing the Opponent's marks. Visual, aural and conceptual similarity between the Contested mark and these marks of the Opponent is therefore low.*

*The Opponent also relies on two figurative marks which contains a distinctive device element alongside the term LUNA. Visual and conceptual similarity with LUNA SERIES is therefore low for the reasons given above, whilst aural similarity is low to medium.”*

## **Overall impression**

### **The Applicant's mark**

31. The Applicant's mark is comprised of two ordinary dictionary words 'LUNA SERIES', presented in upper case letters without stylisation. There are no other elements that contribute to the overall impression of the mark which resides in the words themselves. I find that 'LUNA' is the dominant element of the Applicant's mark and therefore plays the greater role in the overall impression of the mark. This is because the word 'SERIES' is likely to be seen as indicating that the goods or services offered under the mark are part of a series and is, therefore, non-distinctive.

### **The Earlier Marks**

32. The 993 mark comprises of both figurate and word elements. The mark consists of the very slightly-stylised word 'LUNA'. To the left of the word is a triangle device. I appreciate that the words will have more of an impact because “the average consumer will more easily refer to the goods [and services] in question by quoting their name than by describing the figurative element of the trade mark”.<sup>6</sup> However, I recognise

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<sup>6</sup> Wassen International v OHIM Case T-312/03.

that the device still plays a role due to its presence at the start of the mark and its size. Therefore, I find that 'LUNA' is the dominant element of the mark and plays a greater role in the overall impression of the mark, whilst the figurative device plays a slightly lesser role.

33. The same is true of the 994 mark, although in this mark the mark is presented in purple, with the device being in a lighter shade. I make the same findings as above, with the use of colour playing a much lesser role than either the device or the words.

34. The 992 Mark consists of the words AMAZON LUNA. The word AMAZON is likely to be recognised as the name of a rainforest/river, and so is likely to be seen as referring to the setting of the gaming goods/services in question. It is, therefore, less distinctive than the word LUNA which appears unconnected to the goods/services. Consequently, the word LUNA will play the greater role in the overall impression.

35. The 426 Mark consists of the words LUNA COUCH. The overall impression lies in both words equally.

## **Visual comparison**

### **The 993 and 994 marks**

36. Visually the marks differ in length, with the contested mark comprising two words totalling ten letters and the 993 and 994 marks four letters. The respective marks share the element 'LUNA'. However, the additional figurative element within the 993 and 994 marks has no counterpart in the Applicant's mark, and the word SERIES in the Applicant's mark has no counterpart in the 993 and 994 marks. I note that the 994 mark is presented in purple. However, I bear in mind that registration of a word only mark (as is the case for the Applicant's mark) covers use of that mark in any colour or font. Taking all into account, it is my view that the marks are visually similar to a **medium** degree.

### **The 992 mark**

37. The marks overlap in the presence of the word LUNA. They differ in the presence of the word AMAZON in the 992 mark and SERIES in the Applicant's mark. In my view, the marks are visually similar to a **medium** degree.

### **The 426 mark**

38. The marks overlap in the presence of the word LUNA, but differ in the presence of the word COUCH in the 426 mark and SERIES in the Applicant's mark. In my view, the marks are visually similar to a **medium** degree.

### **Aural comparison**

#### **The 993 and 994 marks**

39. The Opponent's marks are likely to be articulated in two syllables; LOO-NAH. The Applicant's mark is likely to be pronounced in four syllables LOO-NAH SEE-REES. The marks first two syllables are identical, the only point of aural difference between the marks derives from the element 'series', present in the Applicant's mark and absent from the Opponent's marks. Even though the word 'SERIES' plays a lesser role in the overall impression of the Applicant's mark, I consider that it will still be articulated and this aural difference will be perceived by the average consumer.<sup>7</sup> I therefore find that the respective parties' marks have between a **medium** and **high** level of aural similarity.

#### **The 992 mark**

40. The word LUNA will be pronounced identically in both marks. The word SERIES in the Applicant's mark and AMAZON in the 992 mark will be points of aural difference. In my view, this results in a **medium** degree of aural similarity.

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<sup>7</sup> On this point, I remind myself that while the allusive/descriptive nature of a word does not render it aurally invisible (as per *Purity Hemp Company Improving Life as Nature Intended*, Case BL O/115/22)

### **The 426 mark**

41. The word LUNA will be pronounced identically in both marks. The word SERIES in the Applicant's mark and COUCH in the 426 mark will be points of aural difference. In my view, this results in a **medium** degree of aural similarity.

### **Conceptual comparison**

### **The 993 and 994 marks**

42. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

43. In its written submissions, the Opponent states that the marks have "no specific meaning in relation to the goods and services in comparison, so there can be no comparison on a conceptual level".<sup>8</sup> In this regard, the Opponent relies upon the evidence of Mr Bolter and Exhibits NB1 and Exhibit NB1A.<sup>9</sup> The Collins dictionary definitions are provided to corroborate the above.

44. I note the Applicant submits that the average consumer will see 'LUNA' in both the Opponent's and Applicant's mark as a 'common term' meaning 'moon'.<sup>10</sup> Furthermore, that the word 'SERIES' is likely to be understood as 'a series of ephemeral moons that wax and wane the lunar cycle', as opposed to 'a single static, lumpen moon', thus rendering the marks 'conceptually different'.<sup>11</sup>

45. Conceptually, the word LUNA may be understood as a female forename or the Latin word for moon, therefore the similarity between the marks is with the shared word element 'Luna'. Although I do not discount it altogether, I do not consider that the

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<sup>8</sup> Opponent submissions in chief 21.3 dated 7 May 2024

<sup>9</sup> Opponent Submissions in Lieu paragraph 12

<sup>10</sup> TM8 counterstatement

<sup>11</sup> TM8 counterstatement

average consumer would make an immediate connection between 'LUNA' and 'SERIES' evoking a notion of a lunar cycle in relation to the Applicant's comments. Certainly, a significant proportion of average consumers would see these words as a reference to a series of goods/services offered by a business or person called LUNA.

46. The word 'series' in the Applicant's mark is a commonly-used English word. I believe it will be understood by the average consumer as a number of events or numbers occurring sequentially or referring to a number of objects of a related kind. In this case I believe that the 'Series' element in the Applicant's mark will convey to the consumer the concept of a collection of related goods or services.

47. For the avoidance of doubt, I do not consider that any conceptual message will be conveyed by the device in the 993 and 994 marks. In the light of the foregoing, I find the respective parties' marks to be conceptually similar to between a **medium** and **high** degree.

#### **The 992 Mark**

48. The word LUNA in both marks will share the same meaning, as discussed above. The word SERIES will be attributed the same meaning as discussed above. Similarly, the word AMAZON is, for a significant proportion of average consumers, likely to be perceived as a reference to the rainforest/river and the setting of the video game goods/services for which the opponent has protection. In my view, the marks are conceptually similar to a **medium** degree.

#### **The 426 Mark**

49. The same applies to the comparison with this mark, although the difference between the marks is the word COUCH rather than the word AMAZON. The word COUCH has no meaning in relation to the goods/services. In my view, the marks are conceptually similar to a **medium** degree.

## **My Approach**

50. Having considered the similarity between the contested mark and the Opponent's earlier marks, I note that the specification for the Opponent's 992 and 426 earlier marks do not put the Opponent in a better position than the specifications of the 993 and 994 marks, and I have found the former to be less similar to the Applicant's mark than the 993 and 994 marks. Therefore, I consider the Opponent's best case lies with its reliance upon the first two earlier marks 993 and 994. If there is no likelihood of confusion in respect of the 993 and 994 marks, it follows that there will not be a likelihood of confusion for the 992 and 426 marks. Consequently, I will focus on the 993 and 994 earlier marks, returning to consider the 992 and 426 earlier marks, only if it becomes necessary to do so.

## **Comparison of goods and services**

51. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

“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.”

52. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

53. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (“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 für 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.”

54. Further, in *Kurt Hesse v OHIM*,<sup>12</sup> the CJEU stated that complementarity is autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*,<sup>13</sup> the GC stated that “complementary” means:

“...there is 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.”

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<sup>12</sup> Case C-50/15 P

<sup>13</sup> Case T-325/06

55. 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, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. (as he then was) noted as the Appointed Person (‘AP’) in *Sandra Amalia 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.”

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.”

56. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]- [49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

57. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows: (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services. (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms. (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers. (4) A term which cannot be interpreted is to be disregarded.”

58. In *Avnet Incorporated v Isoact Limited* [1998] FSR 16, Jacob J (as he then was) said at [19]:

“[...] definitions of services ... are inherently less precise than specifications of goods. [...] In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

59. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*:<sup>14</sup>

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

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<sup>14</sup> BL O/399/10

60. In its submissions, the Opponent has put forward specific combinations of some terms to compare, whereas for others, the Opponent has generally compared the applicant's classes on the basis that they fall in broader aspects of the Opponent's specification, rather than explicitly going through the *Canon* and *Treat* factors and without referring to any specific terms. I remind myself of paragraph 28 of the appeal to the Appointed Person in *SMARTX* BL O/0911/24 which states that:

"... it is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identity). If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it. The approach for which Mr Wood contends would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods which could be relied on, and for each combination a slightly different argument for similarity could be made. Furthermore, such an approach would be unfair on the Applicant for the mark, since they will have had no opportunity to address points on similarity taken by the Hearing Officer if those points are not first raised by the Opponent."

61. I bear in mind that the Opponent's specification is quite lengthy and the goods and services are quite technical. I will therefore proceed on the basis that I will only consider similarities which have been highlighted by the Opponent, or where similarity is obvious to me, otherwise, the goods and services will be found to be dissimilar.

62. The goods/services to be compared are set out in paragraph 1 of this decision and Annex 1.

63. As I have explained above, the case will proceed on the basis that the Applicant's position on the similarity of the goods/services is that they are dissimilar.

64. I bear in mind section 60A of the Act which provides that the classes in which goods/services are registered are not determinative on the question of similarity.

65. In relation to the above comparison, the Opponent claims in its statement of grounds that “the goods and services in Classes 9, 35, 37, 40 and 42 of the Application are identical or similar to the goods and services of the Opponent’s Marks”.<sup>15</sup>

### **Class 9**

*Data processing equipment, computers; computer hardware; data processors.*

66. The contested terms are physical computer hardware goods for data processing (and parts and fittings for those goods).

67. I consider that the earlier term “*electronic game and video game hardware and peripherals for accessing and transmitting data and content among electronic devices and displays*” in the specifications of both the 993 and 994 marks are also physical hardware goods for accessing and transmitting data.

68. The Applicant submits in relation to class 9 that the Opponent’s comparison in its statement of grounds “*fails to acknowledge the difference between ‘computer’ as selected by the Applicant and ‘electronic game and video game hardware and accessories’*”. They say that they are not interchangeable and are sold in different distribution channels.<sup>16</sup> By contrast, the Opponent draws attention to Exhibit NB2 in that “*goods such as electronic game and video game programs and software are offered to be played on a range of gaming devices and, importantly, also computers*”.<sup>17</sup>

69. Whilst I note that the Opponent’s goods are specifically for gaming, such goods can (and often are) still used as peripherals for hardware goods. To the extent that both parties’ specifications include peripherals for data processing, I consider that there will be identity on the principle outlined in ***Meric***.

70. However, even where there is not identity, the trade channels would overlap as these hardware goods are all likely to be sold through specialist computer hardware

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<sup>15</sup> Opponent TM7 Statement of grounds para 6 and 7

<sup>16</sup> Applicant TM8 – counterstatement

<sup>17</sup> Opponent Submissions dated 7 May 2024

suppliers. The user is also likely to overlap. There will also be a degree of overlap in nature by virtue of the fact that the goods are electronic hardware goods. Given that all of the goods have (or could include those with) a data processing focus, there will also be some overlap in purpose. There is complementarity in that the hardware in the Applicant's specification is important or indispensable to the Opponent's peripherals as they cannot function other than in conjunction with each other. The nature of the relationship is one where the average consumer may think the responsibility for those goods lies with the same undertaking. I consider these goods to be similar to at least a **medium** degree.

*Parts and fittings for all the aforesaid goods*

71. With regard to the above terms in this class, to the extent that the contested goods relate to goods where I have found similarity then there will be a degree of similarity here. I consider the level of similarity to be slightly lower than between the goods themselves.

*Communications servers [computer hardware].*

72. A server, in this context, is a computer which transfers data to other computers, via a network. In my view, this product is likely to be used in conjunction with the opponent's "*electronic game and video game hardware and peripherals for accessing and transmitting data and content among electronic devices*". They are likely to be sold through the same trade channels to the same users. Similarly, they are complementary due to one being important or indispensable to the other, and the average consumer perceiving the same undertaking to be responsible for both. In my view, the goods are similar to at least a **medium** degree.

*Parts and fittings for all the aforesaid goods*

73. With regard to the above terms in this class, to the extent that the contested goods relate to goods where I have found similarity then there will be a degree of similarity here. I consider the level of similarity to be slightly lower than between the goods themselves.

Tablet computers; laptop computers; custom built computers.

74. These terms all include computer game hardware (which would include computers for gaming) and, consequently, they are identical on the principle outlined in ***Meric*** to “*computer game hardware*” in the specifications of the 993 and 994 marks.

Parts and fittings for all the aforesaid goods

75. With regard to the above terms in this class, to the extent that the contested goods relate to goods where I have found similarity then there will be a degree of similarity here. I consider the level of similarity to be slightly lower than between the goods themselves.

Smart phones.

76. The Opponent’s earlier “*electronic game software and video game software for use on mobile and cellular phones*” is a software for the specific use of mobile and cellular phones. These goods may share producer, distribution channels and end-users. It can also be said that these goods are complementary as the opponent’s software could not operate without the Applicant’s goods, and in some circumstances, you would expect the same undertaking to be responsible for both. I find that these goods are therefore similar to a **medium** degree.

Parts and fittings for all the aforesaid goods

With regard to the above terms in this class, to the extent that the contested goods relate to goods where I have found similarity then there will be a degree of similarity here. I consider the level of similarity to be slightly lower than between the goods themselves.

Computer software.

77. This is a broad term which would encompass software in the gaming and electronic game sector.

78. In accordance with ***Merix***, I find the Applicant's "computer software" identical to the Opponent's "video game software" in earlier rights 993 and 994 on the basis that the contested terms encompass the earlier terms.

*Parts and fittings for all the aforesaid goods*

79. With regard to the above term in this class, to the extent that the computer software relates to goods where I have found similarity then there will be a degree of similarity here. I consider the level of similarity to be slightly lower than between the goods themselves.

**Class 35**

80. The Opponent submits that "*all of the services in Class 35 of the Application are identical or similar to the goods and services covered by the Opponent's Marks*", and claims that the services listed below are "*identical or similar to*" "*on-line retail store services in connection with video game software, electronic game software, software tools relating to video games and electronic games, video and audio relating to video games and electronic games, tools and items for in-game use, and related merchandise; distributorship services in the field of video games, electronic game software, software tools relating to video games and electronic games, video and audio relating to electronic games and video games, tools and items for in-game use, and related merchandise; digital retail store services in connection with the sale of downloadable and non-downloadable virtual goods in the nature of tools, food items, currency, clothing, fashion accessories, 3D objects, game textures, and building models for use in on-line games; promotional sponsorship of games, gamers, and gaming events.*"<sup>18</sup>

81. In relation to Class 35, the Applicant claims that the "*retail channels are distinct*" and that they differ in the sense that the 'Opponent's rights are for retail of video games, controllers and other gaming peripherals, not computer hardware'.<sup>19</sup>

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<sup>18</sup> Opponent submissions in chief 30.4

<sup>19</sup> Applicant TM8 counterstatement – page 9

Retail services connected with the sale of data processing equipment, computers, computer hardware, custom built computers, communications servers [computer hardware], computer software, smart phones, tablet computers, laptop computers, data processors and parts and fittings for all the aforesaid goods; information, advice and consultancy in relation to all the aforesaid services.

82. The above service covers the retail of a range of goods which include “*electronic game and video game hardware and accessories, namely, headphones, headsets, computer mice, keyboards*”, “*video game software*” and “*video game hardware and peripherals for accessing and transmitting data and content among electronic devices and displays*” in the specifications of the 993 and 994 marks. They would overlap in trade channels and user. Where the goods of the Opponent are specified as being sold through the applicant’s retail services, there will also be complementarity.<sup>20</sup> However, even if that is not the case, there will still be between a **low** and **medium** degree of similarity.

Information, advice and consultancy in relation to all the aforesaid services.

With regard to the above services in this class, to the extent that the information and consultancy relates to services where I have found similarity then there will be a degree of similarity here also as it would be fair to expect a person providing a service will be able to give information or advice in relation to it. I consider the level of similarity to be slightly lower than between the goods and services themselves.

### **Class 37**

Installation, maintenance and repair of computers, data processing equipment and computer hardware; information, advice and consultancy in relation to all the aforesaid services

83. In my view, the Opponent’s “*technical support services, namely, troubleshooting video game and electronic game software and hardware problems*” in Class 42 is the closest comparator since gaming consoles also contain data processing equipment.

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<sup>20</sup> *Oakley, Inc v OHIM*, Case T-116/06

The purpose of the Applicant's Class 37 services and the Opponent's Class 42 services is to provide technical support and consultancy in relation to software and/or hardware. Consequently, there is an overlap in purpose.

84. The average consumer would expect the same undertaking to provide both of these services and I also find that the same undertaking is likely to provide such support services in relation to various types of hardware/software. There is, therefore, an overlap in trade channels. The user will also be the same, and there will be an overlap in nature and method of use. Taking these factors into account, I find there to be at least a **medium** degree of similarity.

*Information, advice and consultancy in relation to all the aforesaid services.*

With regard to the above services in this class, to the extent that the information and consultancy relates to services where I have found similarity then there will be a degree of similarity here also as it would be fair to expect a person providing a service will be able to give information or advice in relation to it. I consider the level of similarity to be slightly lower than between the services themselves.

**Class 40**

*Custom manufacture of computers and computer hardware for others; custom manufacture and assembly of information technology products; custom construction of computers, data processing equipment and computer hardware.*

85. I interpret the above to encompass the customer manufacture of computer components and parts, as well as various other information technology products. These services could include the manufacture of computers and other goods for gaming, as well as their peripherals. Consequently, I consider there to be an overlap in trade channels and user with "*electronic game and video game hardware and peripherals for accessing and transmitting data and content among electronic devices and displays*" in the specifications of the 993 and 994 marks.

86. Bearing in mind that the comparison here is between goods and services, I am of the view that the nature and purpose of these will differ. Further the method of use differs. In my view, the goods and services are similar to at least between a **low** and **medium** degree.

*Digital printing; printing of documents from digital media.*

87. To my knowledge, these are services usually offered by specialist printing service providers. In the absence of any evidence or submission from the Opponent to assist me, I can see no point of overlap in nature, method of use, purpose or trade channels with the Opponent's goods. There is no competition or complementarity. Whilst the user might overlap, this is not enough on its own for a finding of similarity. I consider the goods and services to be **dissimilar**.

*Information, advice and consultancy in relation to all the aforesaid services.*

88. With regard to the above term in this class, to the extent that information, advice and consultancy relates to services where I have found similarity then there will be a degree of similarity, as I have found the above services to be dissimilar, I also find dissimilarity for information, advice and consultancy in relation to all the above services.

**Class 42**

*Customization of computer hardware and software; design and development of computer hardware and software.*

89. In my view, these services are identical on the principle outlined in **Meric** to “*video game development services*” in the specification of the 993 and 994 marks. This is because video games can include both software and hardware (such as specialist computers which are used for operating the software products) and, consequently, one term is encompassed by the other.

Computer programming.

90. In its Submissions the Opponent maintains that the services claimed in Class 42 of the Application are identical or similar to the goods and services of the Opponent's Classes 9, 38 and 42 and has provided a general comparison on the basis that they fall into broader aspects of the Opponent's specification.

91. The above term covers the service of programming computers via their software by creating codes that enables a computer to function. In the absence of any evidence or submission from the Opponent to assist me other than the submissions above, I can see no point of overlap in nature, method of use, purpose or trade channels with the opponent's goods. There is no competition or complementarity. Whilst the user might overlap in some instances with the Opponent's services, this is not enough on its own for a finding of similarity. I consider the goods and services to be **dissimilar**.

Configuration of computer hardware, firmware, software, systems and networks.

92. The above services in the Applicant's class 42 specification are services relating to the setup, integration and tuning of computer hardware, firmware, software, systems and networks. To my mind this involves installation, integrating and optimising the above to create a working, functioning system including coding and creating controls that allow software and hardware devices to communicate via networks.

93. I compare the contested services to "*Technical support services, namely, troubleshooting video game and electronic game software and hardware problems*" in the Opponents 993 and 994 marks. I consider that there may be an overlap in nature. Troubleshooting is a reactive support service, whereas configuration involves the setup and implementation of systems. However, in practice, resolving a problem during troubleshooting may require performing configuration tasks, meaning the two activities can intersect. I also consider that both involve specialist technical

intervention on computer hardware and software and share the common purpose of ensuring correct system functionality.

94. I consider that there will be an overlap in users and trade channels as I consider that they will be sought by the general public and engineers or IT/skilled professionals and may be offered by the same IT service providers. The services are unlikely to be competitive, though there may be a complementary relationship between them. This is because there may be circumstances in which the services are important to one another, and it would not seem unreasonable for the average consumer to expect that they would be offered by a shared or related undertaking. Weighing all factors, I find at least a **medium** degree of similarity between the parties' services.

*Installation, maintenance and repair of computer software.*

95. In my view, the Opponent's "*technical support services, namely, troubleshooting video game and electronic game software and hardware problems*" in Class 42 is the closest comparator since the above service will involve services that help users resolve software issues and diagnose or determine the root cause of a software problem. The purpose of the Applicant's Class 37 services is to deploy, maintain and restore software when it malfunctions and the Opponent's services provide technical support and consultancy in relation to software also to maintain or service the software. Consequently, there is an overlap in purpose.

96. The average consumer would expect the same undertaking to provide both of these services and I also find that the same undertaking is likely to provide such support services in relation to various types of software. There is, therefore, an overlap in trade channels. The user will also be the same, and there will be an overlap in nature and method of use. Taking these factors into account, I find there to be at least a **medium** degree of similarity.

*Computer and information technology support and consultancy services.*

97. I consider that the Opponent's "*technical support services, namely, troubleshooting video game and electronic game software and hardware problems*" in

the Opponent's 993 and 994 marks fall within the Applicant's above broader category. The services are identical on the principle outlined in ***Meric***.

*Rental of web servers;*

98. I understand the above contested term to refer to a service whereby a consumer can hire web servers in order to run websites, apps or store data from a hosting provider. I acknowledge that web servers can be either hardware or software goods, and to that extent they are software the above service falls within the Opponent's "*providing temporary online non-downloadable software for transmitting and receiving video games and electronic games*" in Class 42.

99. However, in the event that I am incorrect in my above finding or to the extent that the term refers to physical servers, I compare this to the Opponent's "*application service provider (ASP), namely, hosting computer software applications of others in the field of gaming*" in the 993 and 994 marks. Both services relate to cloud-based technology and involve providing remote computing resources for users. Renting web servers provides the user the server space they need to run their own websites or applications, while ASP hosting uses the same type of server infrastructure to run software for customers. Their purpose is therefore similar: allowing users to operate or access online services via remote servers. Such services target the same consumers and are provided through the same distribution channels such as cloud service providers and IT hosting businesses. I also consider them to be complementary as application hosting depends on underlying server infrastructure and can therefore be indispensable to each other, and it would not seem unreasonable for the average consumer to expect that they would be offered by a shared or related undertaking. Therefore, I find that they are similar to at least a **medium** degree.

*Information, advice and consultancy in relation to all the aforesaid services.*

100. With regard to the above term in this class, to the extent that information, advice and consultancy relates to services where I have found similarity then there will be a degree of similarity here also as it would be fair to expect a person providing a service

will be able to give information or advice in relation to it. I consider the level of similarity to be slightly lower than between the services themselves.

101. In relation to the goods and services which I have found to be dissimilar, as there can be no likelihood of confusion under section 5(2)(b), I will take no further account of such services, with the opposition failing to that extent.<sup>21</sup>

### **The average consumer and the purchasing act**

102. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

103. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average

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<sup>21</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

104. Both parties provided submissions regarding the average consumer, with the Opponent arguing this would be an average consumer with an average level of attention. The Applicant's arguments are that the average consumers are members of the public who can be expected to pay a high level of attention to the purchasing process.

105. With all of the above in mind, I consider the average consumer of the goods and services at issue is likely to comprise of members of the general public, professional and specialist consumers. I bear in mind that this would include, but is not limited to, a subset of individuals who have an interest in gaming. I keep in mind that some of the services in particular will primarily target the professional consumer (services aimed at businesses or professionals, for example). I also note that whilst the Opponent draws attention to UKIPO decision O-552-22<sup>22</sup> and the Hearing Officer's finding that the average consumer of the goods and services in Class 9 and 42 'includes members of the public' paying a 'medium degree of attention' I must first point out that the Hearing Officer is considering the goods and services of the Mark at issue in that invalidity proceeding, but I also note that the Hearing Officer

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<sup>22</sup> Opponent submissions – point 36

acknowledges that there are variations in the levels of attention paid in that 'a business user is likely to pay a high degree of attention'.<sup>23</sup>As I have identified above there are goods and services that are likely to be sought after by members of the public, but also professional and business users.

106. The costs of the goods and services at issue is likely to vary fairly significantly from relatively inexpensive (some software items) to significantly expensive (custom made computers and services). The frequency of the associated purchase will also vary significantly. However, even where the cost is relatively low, factors such as useability, specifications and performance are likely to be taken into account. For the services, factors such as reputation of service provider and qualifications are likely to be considered. I find that the level of attention will vary from medium to higher than medium. The goods and services are likely to be selected following perusal of signage on websites, physical premises and advertisements. Consequently, visual considerations will dominate the purchasing process. However, I do not discount an aural component to the purchase, given that advice may be sought from retail assistants/specialists and word-of-mouth recommendations may be made.

### **Distinctive character of the earlier trade marks**

107. In *Lloyd Schuhfabrik Meyer* 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).

In making the assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not

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<sup>23</sup> [o55222.pdf](#)

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).”

108. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods/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 that has been made of it.

109. The Opponent has not shown use of its mark with its evidence and, thus, it cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent distinctiveness of the earlier mark to consider.

110. The Opponent submitted that their marks have ‘no specific meaning in relation to the goods or services’ and therefore possess a ‘normal degree of inherent distinctiveness’.<sup>24</sup> The Applicant submits that the Opponent’s marks ‘contain the term ‘LUNA’ which is in common use meaning moon’ with ‘low distinctiveness’.<sup>25</sup>

111. The word LUNA is likely to be understood as a reference to the Latin word for “moon” or as a female forename. I agree with the Opponent’s submission that to the word ‘LUNA’ is neither descriptive nor allusive of the goods or services. I also do not understand LUNA to be a particularly common name, and, in my view, it would attract a medium (or average) degree of distinctiveness in either case.

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<sup>24</sup> Opponent submissions in chief – para 35

<sup>25</sup> Applicant TM8 counterstatement – page 7

112. The device does not materially increase the distinctiveness of the mark overall. Therefore, I consider the 993 and 994 marks possess a **medium** (or average) level of inherent distinctive character.

### **Likelihood of Confusion**

113. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible undertakings being the same or related. 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. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods/services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent's trade marks, the average consumer for the goods/services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

114. I have already concluded that;

- The goods and services range from similar to between a low and medium degree to identical (except where I have found them to be dissimilar).
- I have identified that the average consumer is likely to comprise of members of the general public, professional and specialist consumers. They will select the goods primarily by visual means, although I do not discount an aural component;

- I have concluded that a medium to higher than medium degree of attention will be paid depending on the purchase;
- The contested mark is visually similar to the 993 and 994 marks to a medium degree and aurally and conceptually similar to between a medium and high degree;
- I have found the earlier 993 and 994 marks possess a medium (or average) level of inherent distinctive character.

115. Taking all of the factors listed above I consider that the similarities between the parties' marks are such that the average consumer would directly confuse the Applicant's mark with the 993 and 994 marks. This is particularly the case given the medium degree of visual and between medium and high degree of aural similarity between the marks.

116. Whilst I acknowledge that LUNA holds an average level of distinctive character, I make this finding on the basis that the word 'Series', which sits at the end of the Applicant's mark, carries little trademark significance and is likely to be forgotten or overlooked by the average consumer, particularly given that I have found 'LUNA' to be the most dominant element of the marks and the 'series' element will at best, be very low in distinctive character.

117. Even when the average consumer pays a fairly high level of attention to the purchasing process, it is my view that the consumer may mistake the earlier marks for the Applicant's mark since I have found the figurative element in the earlier marks play a lesser role in the overall impression and imperfect recollection means they would fail to notice whether the device and the word 'Series' is present or absent. I consider this to be the case where the goods and services are similar to between a low and medium degree or higher. Accordingly, I find there is a likelihood of direct confusion for all goods/services that I have found to be similar to between a low and medium degree or above.

118. For the sake of completeness, I will also consider indirect confusion. Indirect confusion was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:<sup>26</sup>

“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 recognised 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’.

119. 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.).

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<sup>26</sup> BL O/375/10

(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).”

120. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

121. In the present case, even if the differences between the marks are noticed, I have found the word ‘LUNA’ to be the dominant and distinctive element of the marks. The addition of the word SERIES is likely to be understood as referring to a series of goods/services offered under the LUNA mark and so will be a non-distinctive addition. The device is likely to be seen as an alternative logo version of the sign being used by the same company or from economically linked companies. I find this to be the case where the goods and services are similar to between a low and medium degree or higher. Consequently, I consider there to be a likelihood of indirect confusion between the marks for all goods/services that I have found to be similar to between a low and medium degree or higher.

## **CONCLUSION**

122. The opposition under section 5(2)(b) has been partially successful in respect of the following goods and services, for which the application is refused:

Class 9      Data processing equipment, computers; computer hardware; custom built computers; communications servers [computer hardware]; computer software; smart phones; tablet computers; laptop computers; data processors; parts and fittings for all the aforesaid goods.

- Class 35 Retail services connected with the sale of data processing equipment, computers, computer hardware, custom built computers, communications servers [computer hardware], computer software, smart phones, tablet computers, laptop computers, data processors and parts and fittings for all the aforesaid goods; information, advice and consultancy in relation to all the aforesaid services.
- Class 37 Installation, maintenance and repair of computers, data processing equipment and computer hardware; information, advice and consultancy in relation to all the aforesaid services.
- Class 40 Custom manufacture of computers and computer hardware for others; custom manufacture and assembly of information technology products; information, advice and consultancy in relation to all the aforesaid services; custom construction of computers, data processing equipment and computer hardware.
- Class 42 Customization of computer hardware and software; design and development of computer hardware and software; installation, maintenance and repair of computer software; computer and information technology support and consultancy services; configuration of computer hardware, firmware, software, systems and networks; rental of web servers; information, advice and consultancy in relation to all the aforesaid services.

123. The application can proceed to registration in respect of the following services for which the opposition has been unsuccessful:

- Class 40 Digital printing; printing of documents from digital media; information, advice and consultancy in relation to all the aforesaid services.
- Class 42 Computer programming; information, advice and consultancy in relation to all the aforesaid services.

## **COSTS**

124. The Opponent has enjoyed a greater degree of success in the opposition and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. I will make an appropriate reduction in the award of costs made to reflect the Opponent's partial success. In the circumstances, I award the Opponent the sum of **£1180**, calculated as follows:

Official filing fee for Notice of Opposition	£100
Preparing a statement of grounds and considering the other side's counterstatement	£225
Preparing evidence and considering and commenting on the other side's evidence;	£540
Preparing written submissions in lieu of a hearing	£315
<b>Total</b>	<b>£1180</b>

125. I therefore order **PC Specialist Ltd** to pay **Amazon Technologies, Inc.** the sum of **£1180**. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

**Dated this 25<sup>th</sup> day of March 2026**

**Janeve Manca**

**For the Registrar**

## Annex 1

### The 992, 993 and 994 mark (see note for Class 38 of the 993 mark)

#### Relying upon:

#### Class 9

Electronic game and video game programs; electronic game and video game hardware and accessories, namely, headphones, headsets, computer mice, keyboards; video game software; electronic game software; electronic game and video game hardware and peripherals for accessing and transmitting data and content among electronic devices and displays; software that connects game servers in the cloud with video game hardware and accessories, namely, headphones, headsets, computer mice, keyboards, game controllers, game consoles; video game hardware and accessories that connect to game servers in the cloud, namely, headphones, headsets, computer mice, keyboards; software for accessing, viewing, playing, managing, sharing, downloading, uploading, and providing electronic games and video games via the cloud; software for accessing cloud-based electronic games and video games; software for video gaming and electronic gaming subscription service; software for accessing cloud-based electronic gaming and video gaming subscription service; electronic game and video game programs downloadable via the internet or other communications network; electronic game software and video game software for use on mobile and cellular phones; software for compressing and decompressing data and video images related to electronic games and video games; interactive electronic game and video game devices; interactive game programs; mobile game software; game engine software; software for streaming audio and video content related to electronic games and video games on electronic devices, televisions, personal computers, monitors, tablets, mobile phones, and screens; downloadable virtual goods, namely, computer programs featuring 3D objects, game textures, building models, tools, food items, currency, clothing, and fashion accessories for use in online games.

### Class 28

Video game consoles; video game controllers; video game machines; hand-held video game machines; electronic game machines other than for television receivers; computer game hardware; controllers for game consoles; video game machines for use with televisions, mobile phones, tablets, and other electronic screens; video games; video game consoles for use with an external display screen or monitor; video game interactive remote control units; electronic game and video game hardware and accessories, namely, game controllers and game consoles; video game hardware and accessories that connect to game servers in the cloud, namely, game controllers and game consoles.

### Class 35

Arranging subscriptions for gaming, audiovisual, and streaming content in the field of electronic games and video games; promotion of others' electronic games and video games; operation, implementation, creation, and supervision of a membership program relating to computer game software and application software; on-line retail store services in connection with video game software, electronic game software, software tools relating to video games and electronic games, video and audio relating to video games and electronic games, tools and items for in-game use, and related merchandise; distributorship services in the field of video games, electronic game software, software tools relating to video games and electronic games, video and audio relating to electronic games and video games, tools and items for in-game use, and related merchandise; digital retail store services in connection with the sale of downloadable and non-downloadable virtual goods in the nature of tools, food items, currency, clothing, fashion accessories, 3D objects, game textures, and building models for use in on-line games; promotional sponsorship of games, gamers, and gaming events.

### Class 38

Webcasting services related to video games and electronic games provided via the cloud; electronic streaming, transmission, and delivery of visual, audio, and multimedia content relating to video games and electronic games via the cloud; streaming and electronic transmission of digital media content via cloud-based computer networks; electronic transmission, transfer, delivery, communication, and streaming of electronic game and video game controller and game input data between the game controller and cloud-based game servers; electronic streaming, transmission, and delivery of visual, audio, and multimedia content relating to video games and electronic games via the internet or other communications network; webcasting services related to video games and electronic games provided via the internet or other communications network; providing chatrooms and online forums for users to search, share, watch, transmit messages, blog, post, critique, rate, review, discuss, recommend, and comment on activities, events, and on visual and multimedia content, all in the field of video games and electric games, via the internet or other communications network; electronic streaming, transmission, and delivery of visual, audio, and multimedia content relating to video games and electronic games provided through a subscription; electronic transmission and streaming of digital media content for others via cloud-based computer networks; video-on-demand transmission services in the fields of gaming; provision of chatrooms and online forums for users to search, transmit messages, post, blog, share, watch, rate, critique, review, discuss, recommend, and comment on activities, events, and on visual, audio, and multimedia content, all in the field of electric games and gaming, via a website.

### Class 38

Webcasting services related to video games and electronic games provided via the cloud; electronic streaming, transmission, and delivery of visual, audio, and multimedia content relating to video games and electronic games via the cloud; streaming and electronic transmission of digital media content via cloud-based computer networks; electronic transmission, transfer, delivery, communication, and streaming of electronic game and video game controller and game input data between the game controller and cloud-based game servers; electronic streaming, transmission, and delivery of visual, audio, and multimedia content relating to video games and electronic games via the internet or other communications network; webcasting services related to video

games and electronic games provided via the internet or other communications network; providing chatrooms and online forums for users to search, share, watch, transmit messages, blog, post, critique, rate, review, discuss, recommend, and comment on activities, events, and on visual and multimedia content, all in the field of video games and electric games, via the internet or other communications network; electronic streaming, transmission, and delivery of visual, audio, and multimedia content relating to video games and electronic games provided through a subscription; electronic transmission and streaming of digital media content for others via cloud-based computer networks; video-on-demand transmission services in the fields of gaming; provision of chatrooms and online forums for users to search, transmit messages, post, blog, share, watch, rate, critique, review, discuss, recommend, and comment on activities, events, and on visual, audio, and multimedia content, all in the field of electric games and gaming, via a website.<sup>27</sup>

#### Class 41

Entertainment services, namely, providing on-line video games and electronic games; entertainment services, namely, providing a cloud-based video gaming and electronic gaming subscription service; entertainment services, namely, providing information in the field of video games and electronic games; entertainment services, namely, providing multimedia content, instructional electronic media, movies, videos, images, pictures, photos, text, user-generated content, audio content, and gaming content, all in the field of video games and electronic games, via a website; entertainment services, namely, providing virtual environments relating to video games and electronic games in which users can interact for entertainment, recreational, or leisure purposes; entertainment services, namely, providing information in the field of gaming; Providing subscription-based online and electronic gaming services provided via the internet or other communications network; providing subscription-based online and electronic gaming services provided via the cloud.

#### Class 42

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<sup>27</sup> The '993' mark contains a comma after 'gaming, via a website' – although this comma is not present in the '992' and '994' mark, the presence of this comma does not alter the identical nature of the Opponents services in Class 38 in earlier rights '992', '993' and '994'.

Application service provider (ASP) featuring application programming interface (API) software for the storage, sharing and streaming of video games, electronic games and related content, data and information; application service provider (ASP), namely, hosting computer software applications of others in the field of gaming; providing temporary online non-downloadable application program interface (API) that enables developers to integrate video content and functionality into software applications, websites, and devices for use in electronic games and video games; providing temporary online non-downloadable computer software development tools relating to video games and electronic games; providing temporary use of online non-downloadable software development tools for the design and development of video games and electronic games; providing temporary online non-downloadable applications featuring video games and electronic games; providing temporary online non-downloadable video game engine software and electronic game engine software; providing temporary online non-downloadable software for video games and electronic games via the cloud; providing temporary use of online non-downloadable software for gaming; providing temporary online non-downloadable software for transmitting and receiving video games and electronic games; video game development services; technical support services, namely, troubleshooting video game and electronic game software and hardware problems; providing temporary use of online non-downloadable cloud computing software for use with video games and electronic games; providing online software that allows users to create, edit, store, capture, manage, view, tag, post, download, upload, stream, transmit, and link to content in the form of images, photos, videos, and other audiovisual and video content, all in the field of electronic games and gaming; electronic data storage, namely, storage and archival of data, electronic media, and digital content relating to video games and electronic games; providing computer software that allows users to manage, transmit, view, create, capture, store, upload, download, post, tag, and link to content in the form of images, photos, videos, and other audiovisual and video content relating to video games and electronic games; providing computer software allowing users to create video games and electronic games and for displaying, sharing, uploading, posting, showing, or otherwise providing electronic media or information regarding the fields of electronic gaming; providing online software that connects game servers in the cloud with video game hardware and accessories, namely, game controllers, keyboards,

computer mice, headphones, headsets, game consoles; platform-as-a-service (PAAS) services featuring computer software platforms for creating and collaborating with others to create games and gaming applications and for uploading, sharing or otherwise providing electronic media or information regarding the fields of electronic gaming; providing temporary use of non-downloadable software and software as a service (SAAS) for streaming and interactive streaming of gaming and e-sports tournaments and competitions; platform as a service (PAAS) featuring computer software platforms for gaming and e-sports; hosting online discussions in the fields of gaming, e-sports and competitions; software as a service (SAAS) that enables users to broadcast and view live game play; software as a service (SAAS) to enable users to collaborate with others.

#### Class 45

Social networking services in the field of video games, electronic games, and gaming.

## **Annex 2**

### **The 426 mark**

Relying upon:

#### **Class 41**

Entertainment services, namely, providing on-line video games and electronic games; providing online interactive games in a virtual environment that allow players to interact simultaneously; entertainment services, namely, providing virtual environments in which users can interact simultaneously for entertainment purposes; entertainment services, namely, providing virtual environments relating to video games and electronic games in which users can interact for entertainment, recreational, or leisure purposes; providing temporary use of online non-downloadable electronic game and video game programs; providing temporary use of online non-downloadable video game software and electronic game software; providing temporary use of online non-downloadable software for playing video games and electronic games.

#### **Class 42**

Computer services, namely, creating an on-line virtual environment for social interaction that allows players to interact simultaneously; software as a service (SAAS) services featuring software for streaming games and enabling users to interact with others in a virtual environment; platform as a service (PAAS) featuring computer software platforms streaming games and enabling users to interact with others in a virtual environment; providing temporary use of online non-downloadable software for transmitting and receiving video games and electronic games; providing temporary use of online non-downloadable software that allows users to create, edit, store, capture, manage, view, tag, post, download, upload, stream, transmit, and link to content in the form of images, photos, videos, and other audiovisual and video content, all in the field of electronic games and gaming; providing temporary use of online non-downloadable software and software as a service (SAAS) featuring software for streaming and interactive streaming of gaming and e-sports tournaments and competitions for viewing purposes; platform as a service (PAAS) featuring computer

software platforms for gaming and e-sports; software as a service (SAAS) services featuring software for enabling users to broadcast and view live game play.