

O-039-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2604118

BY

OLUSEGUN VICTOR IBITOYE

TO REGISTER THE TRADE MARK:

Galatopoly

AND

THE OPPOSITION THERETO

UNDER NO 103209

BY

HASBRO, INC

1) On 9 December 2011 Olusegun Victor Ibitoye filed an application to register the trade mark:

Galatopoly

(the trade mark). The application was published for opposition purposes on 13 January 2012 for the following goods:

games and playthings; playing cards.

The above goods are in class 28 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended¹.

2) Hasbro, Inc (Hasbro) filed a notice of opposition to the registration of the trade mark.

3) Proceedings are governed by the Trade Marks Act 1994 (the Act). The Act implements, inter alia, Directive 2008/95/EC of the European Parliament and the Council of 22 October 2008 (the Directive) (as it is now). Consequently, interpretation of the Act is made on the basis of judgments of the Court of Justice of the European Union (CJEU) and the General Court (GC), both with their seats in Luxembourg, as well as those of the courts in the United Kingdom. All of the judgments of the GC (previously the Court of First Instance) and the CJEU can be found at the url:

<http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=en>

¹ As per the Classification Guide of the Intellectual Property Office (IPO):

.In order to allow efficient searching of trade marks the UK uses .The International Classification of Goods and Services/, also known as the .Nice Classification/. The International Classification is administered by the World Intellectual Property Organisation (WIPO) and is used by over 140 countries throughout the world and by organisations such as The Office for Harmonization in the Internal Market (OHIM). Of these countries 78 are party to the Nice Agreement and 68, although not party to it, use the Nice Classification for their classification purposes. The system comprises 45 classes and groups together broadly similar goods or services into categories which assists the registry carrying out efficient searches of the register. Classes 1 , 34 contain goods and classes 35 , 45 contain services. It also allows businesses to check whether there are registered marks that conflict with marks they are using, or propose to use, in respect of particular goods or services. Whilst classification may be seen as an administrative tool its importance to applicants in relation to determining the boundaries of infringement rights cannot be stressed too highly. If the classification of the goods or services on an application is made incorrectly, the validity of any rights stemming from a subsequent registration might be called into question at a later date. This could result in a mark being the subject of proceedings to remove it from the register./

Judgments preceded by the letter C are from the CJEU and judgments preceded by the letter T are from the GC. The former is the higher court.

Decisions of the appointed persons, who are one of the two fora for appeal from decisions of the registrar, can be found on the website of the Intellectual Property Office at the url:

<http://www.ipo.gov.uk/types/tm/t-os/t-find/t-challenge-decision-results.htm>

Decisions of the appointed persons can be identified by the prefix BL (decisions of the registrar also have this prefix). (The other fora of appeal are the High Court of England and Wales, the High Court of Northern Ireland and the Court of Session (in Scotland).)

Where available the urls for judgments of the courts of England and Wales have been given.

The acronyms RPC, FSR and ETMR refer to Reports of Patent, Design and Trade Mark Cases, Fleet Street Reports and European Trade Mark Reports respectively. These are publications in which various decisions and judgments are reported.

In relation to the law of passing-off, the signs upon which Hasbro relies will be referred to as trade marks.

4) Hasbro has opposed the registration of the trade mark under sections 5(2)(b), 5(3) and 5(4)(a) of the Act.

5) Section 5(2)(b) of the Act states:

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

(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./

Section 5(3) of the Act states:

.(3) A trade mark which ,

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of

the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark./

Section 5(4)(a) of the Act states:

.4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented- -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade/.

6) In relation to sections 5(2)(b) and 5(3) of the Act, Hasbro relies upon the following trade mark registrations:

- United Kingdom registration no 711981 of the trade mark MONOPOLY. The application for registration was filed on 3 November 1952. It is registered for *board games*; these goods are in class 28 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.
- United Kingdom registration no 1047116 of the trade mark MONOPOLY. The application for registration was filed on 28 May 1975. It is registered for *board games and articles included in Class 28 for use in playing board games*.
- Community trade mark registration no 238352 of the trade mark MONOPOLY. The application for registration was filed on 24 April 1996 and the registration procedure was completed on 23 November 1998. Hasbro relies upon the goods in classes 9 and 28 of the registration:

electronic amusement apparatus; electronic games; computer games; computer hardware; computer software; controls for use of the aforesaid goods; cards, disks, tapes, wires and circuits all carrying or for carrying data and/or computer software; arcade games; parts and fittings for all the aforesaid goods;

toys, games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; parts and fittings for all the aforesaid goods.

The above goods are in classes 9 and 28 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

- United Kingdom registration no 2213906 of the trade mark OPOLY. The application for registration was filed on 10 November 1999 and the registration procedure was completed on 7 April 2000. It is registered for *games and articles for use in playing games; toys and playthings; parts and fittings for all the aforesaid goods*; these goods are in class 28 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.
- Community trade mark registration 5875703 of the trade mark OPOLY. The application for registration was filed on 4 May 2007 and the registration procedure was completed on 26 April 2010. It is registered for *games and articles for use in playing games; toys and playthings; parts and fittings for all the aforesaid goods*; these goods are in class 28 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

The first four trade marks had been registered for five years or more at the date of the publication of the trade mark of the application and so are liable to proof of genuine useⁱ. Hasbro states that it has used the four trade marks for all of the goods for which they are registered or for what they are relied upon, in the case of 238352. Mr Ibitoye has not requested that Hasbro prove use of the trade marks which are subject to proof of use.

7) In relation to section 5(2)(b) of the Act, Hasbro claims that its trade marks are similar to the trade mark of Mr Ibitoye and that the respective goods are similar or identical. Hasbro also claims that the distinctiveness of its trade marks has been enhanced through use.

8) In relation to section 5(3) of the Act, Hasbro claims a reputation in respect of all the goods for which its trade marks are registered or, in the case of 238252, in respect of all of the goods upon which it relies. Hasbro claims that the use of the trade mark would dilute or diminish the ability of its trade marks to identify the goods for which they are registered. It claims that use of the trade mark could tarnish the reputation of its trade marks if the goods of the trade mark were of inferior content or quality to its goods. Hasbro claims that use of the trade mark would transfer to the trade mark the benefit, goodwill and reputation associated with its trade marks. Hasbro claims that use of the trade mark, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or repute of its trade marks.

9) In relation to section 5(4)(a) of the Act, Hasbro relies upon its use of MONOPOLY and OPOLY. Hasbro claims that MONOPOLY has been used in the United Kingdom since 1935 throughout the United Kingdom. It claims that MONOPOLY has been used in relation to all of the goods covered by the registered MONOPOLY trade marks upon which it relies. Hasbro claims that

OPOLY was first used in London in 1997 and has since been used throughout the United Kingdom. It claims that OPOLY has been used in respect of all the goods of Community trade mark 5875703. Hasbro claims in respect of both trade marks that use of the trade mark will constitute a misrepresentation which is likely to lead the public to believe that the goods of Mr Ibitoye are those of Hasbro and that it is likely to suffer damage as a result.

10) Mr Ibitoye filed a counterstatement in which he denies the grounds of opposition. In the counterstatement Mr Ibitoye writes that he invented a Christian board game and named it Galatopoly. He writes:

.The invention and idea came out of the blue whilst writing a book on bible study. Precisely, I was writing the chapter/topic titled, 'Fruits of the Spirit'. The focus of the game is on 'Life by the Spirit' as explained in the book of **Galatians**, a book in the Holy Bible.

In the book titled 'A Queen Needs This', Bible Study Made Easy, written by me and published in the United Kingdom which is available worldwide, on page 63, I enjoined readers to play 'Galatopoly', a Christian board game I invented. The book went to press on the 10th of February 2012 and it was published in print and in E-book format on the 21st of March, 2012.

The mark, 'Galatopoly', will not create any bewilderment because it is a distinctively made-up word and the idea of the board game is unparalleled.

To successfully market my board game, there are a host of prerequisites to be satisfied. On the board game's Market Requirements Document (MRD), the customer's wants and needs rank highest. Since the idea of the game is unique, a strategy to market a new product is employed. I do not intend to put marketing before the product. If a product is a good, it will sell.

The mark, 'Galatopoly', the unique idea and the purpose of the game will in no way or form tarnish the reputation of the Opponent, Hasbro, Inc.

The board game, 'Galatopoly', is targeted at Christians who are literate and the general public (who are literate). Useless it is a blind-bid, a buyer, within the group described above, would certainly read the product and the maker before making a purchase./

11) Hasbro filed evidence to support its opposition and written submissions. A hearing was held on 11 January 2013. Mr Ibitoye represented himself. Hasbro was represented by Simon Malynicz of counsel, instructed by Gill Jennings & Every LLP.

Evidence of Hasbro

12) This consists of an affidavit made by Paul Normand Vanasse. Mr Vanasse is the global director of IP and enforcement of Hasbro.

13) At the hearing Mr Ibitoye was asked if he accepted that MONOPOLY was a well-known trade mark for board games. He did not accept this. Despite this, it is taken on judicial notice that MONOPOLY is a well-known trade mark used in relation to a board game; probably the best known trade mark in the United Kingdom for a board game. As Mr Vanasse states, it is a household brand name; this is a notorious fact. Taking into account the evidence of Mr Vanasse in relation to length of use, scale of use and public recognition, there can be no doubt as to this matter. Consequently, this summary of the evidence will not generally deal with matters relating to the fame of the trade mark for a board game. It will concentrate upon product diversification and use of OPOLY.

14) The game has been sold in junior, travel, deluxe and electronic versions. In the United Kingdom various versions of the game have been offered eg Star Wars, FIFA World Cup, Super Mario, Coronation Street, Pokemon, Disney, Simpsons and Lord of the Rings. Exhibits PNV5 and 6 give examples of the various forms and formats of the game that have been produced under the name MONOPOLY.

15) In the United Kingdom Winning Moves UK Limited has marketed, under licence, MONOPOLY games relating to local towns and regions; including Birmingham, Bristol, Lancashire, Glasgow, Edinburgh, Yorkshire, Wales, Manchester and Newcastle & Gateshead. Winning Moves has also marketed, under licence, the Rugby World Cup edition of the MONOPOLY game. In the United Kingdom, Benelux, Germany, France and Ireland, all of these games, since they were launched in 1998, have carried the legend .Authorised Opolo Game/ or its equivalent in the local language. At PNV9 and PNV10 pictures of various MONOPOLY games produced by Winning Moves are exhibited. On the covers of the boxes, in the left hand corner, underneath the MONOPOLY logo² the words, in smaller print, .Authorised Opolo Game/ appear (eg page 234). Page 235 also shows an intellectual property notice which reads:

.© 2000 Hasbro Inc. All rights reserved. MONOPOLY and OPOLY are registered trade marks. MONOPOLY, OPOLY and all related trade marks, copyrights and characters are the property of Hasbro Inc, used with permission./

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The notice appears to be from the rear of the box. The exhibits do not show use of OPOLY elsewhere. Winning Moves sold the following number of games in the United Kingdom, described by Mr Vanasse as licensed OPOLY games:

| | |
|------|---------|
| 1998 | 48,000 |
| 1999 | 150,000 |
| 2000 | 124,000 |
| 2001 | 86,000 |
| 2002 | 115,000 |
| 2003 | 115,500 |
| 2004 | 94,000 |
| 2005 | 112,000 |
| 2006 | 94,500 |

16) Mr Vanasse gives details of MONOPOLY games in Europe. Owing to the reputation in the United Kingdom, it is not necessary to give details of the use of MONOPOLY in Europe.

17) Mr Vanasse gives details of promotion of MONOPOLY games.

18) Licensed MONOPOLY themed computer games and video games have been offered since 1987 and have been released for a number of gaming platforms such as Sega Master System, Commodore 64, Nintendo NES, SNES and Nintendo Game Boy, Sega Genesis, Nintendo 64, Sony Playstation, Playstation 2, Playstation 3, GameCube, Xbox and Nintendo DS. Material in relation to various MONOPOLY computer games is exhibited at PNV24. MONOPOLY game applications are available for the iPod, iPhone and iPad. The free online game website UK Pogo.com offers a licensed MONOPOLY game produced by Electronic Arts. Hasbro's online game MONOPOLY CITY STREETS was launched on 9 September 2009. The MONOPOLY trade mark has been licensed in the United Kingdom since 1995 for fruit machines (examples of which can be seen at PNV29). MONOPOLY has been licensed for online gaming. Licensees in the United Kingdom from 2005 to 2009 were Camelot plc, Wagerworks and Gamesys. Exhibit PNV30 shows various examples of these games.

19) Hasbro has licensed third parties to use the MONOPOLY name in the United Kingdom for footwear, bed linen, key chains, floor rugs, chocolate products, electronic games, computer games/software, clothing, jewellery, Christmas crackers, competitions/promotions, advertising, wrapping paper, food/beverages, lotteries and printed matter. MONOPOLY card games have also been produced (illustrations of these are exhibited at PNV33). United Kingdom licensing revenue has been:

| | |
|------|------------|
| 2006 | £2,032,221 |
| 2007 | £2,059,508 |

2008 £2,573,233
2009 £1,381,774

20) Exhibited at PNV36 are examples of press coverage relating to MONOPOLY.

21) Hasbro has licensed the game MAKE YOUR OWN OPOLY, which is sold in the United Kingdom by Paul Lamond Games Ltd. .Make-your-own-opoly contains everything you need to hand customise the game board cards and play money for your very own property trading board game. Construct a custom-made game using your PC printer and scissors! Customise the board, cards, money and box³./

22) Mr Vanasse ends his statement by referring to actions taken by Hasbro to prevent use of signs such as COFFEOPOLY, VINOPOLY, TEAMOPOLY, GLOBOPOLY, BINGOPOLY, BIBLIOPOLY, LOCALOPOLY, TOWNOPOLY, VIRTUAL MONOPOLY, THE IDEA MONOPOLY, EUROPOLY and SEXOPOLY.

Material date(s)

23) Trade mark and passing-off cases have to be considered in relation to a particular point(s) in time. It is the position at this point(s) in time that has to be considered. Evidence should relate to the period up to and including that point(s) in time, the material date(s). In relation to sections 5(2) and 5(3) of the Act the material date is the date of application.

24) A similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20,1993 (this is the regulation that governs the Community trade mark). This was the subject of consideration by the GC in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07, in which the GC stated:

.50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000./

³ PNV49

The reasoning of the GC, *mutatis mutandis*, is followed in relation to the Act. An opponent must establish goodwill at the date of the filing of the application which is being opposed. If the opponent fails to establish this its claim under section 5(4)(a) of the Act must fail.

25) Consideration has also to be given to the position at the date that the behaviour complained of commencedⁱⁱ, if this is earlier than the date of application. This has to be considered when the trade mark the subject of the application has been used prior to the date of application for the same or some of the goods of the application. In this case there is neither evidence nor suggestion that at the date of application that the trade mark had been used for the goods the subject of the application.

26) The material date in respect of all three grounds of opposition is the date of application, 9 December 2011.

Intentions of Mr Ibitoye

27) In his submissions Mr Ibitoye regularly referred to his intentions for the use of the trade mark; that the trade mark was to be used for a game for educated Christians based on a book of the Bible. The current, past or proposed marketing of Mr Ibitoye is not relevant to the issues to be determined, as the GC stated in *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-414/05*:

.71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant's goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors, whether carried out or not, which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59)./

The same reasoning can be seen in *Phildar SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-99/06, Oakley, Inc v*

Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-116/06, Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 147/03, Sadas SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-346/04 and Daimlerchrysler AG v Office for Harmonization In the Internal Market (Trade Marks and Designs) Case T-358/00. The matter has to be considered on the basis of notional and fair use of the trade marks and of their specifications. If Mr Ibitoye were to limit his goods to the type of board game that he describes, the specifications of Hasbro's registrations would include such games, as they are not limited to any specific type of game. Of course, Mr Ibitoye cannot limit his goods, within the terms of a specification, to be sold only to educated Christians; one cannot apply a test as to who purchases the goods.

28) These proceedings are not about the game that Mr Ibitoye wishes to market but the name which he intends to use in relation to the game. Hasbro's trade marks are items of property. The proceedings have been brought as Hasbro considers that the rights in its property would be invaded by the registration of the trade mark.

Findings of fact

29) In relation to the law of passing-off, Hasbro must establish it has goodwill in a business in relation to which the trade marks upon which it relies are related; MONOPOLY and OPOLY. Goodwill was described by Lord Macnaghten in *IRC v Muller & Co's Margarine Ltd* [1901] AC 217 in the following terms:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates. Goodwill is composed of a variety of elements. It differs in its composition in different trades and in different businesses in the same trade. One element may preponderate here and another element there. To analyse goodwill and split it up into its component parts, to pare it down as the Commissioners desire to do until nothing is left but a dry residuum ingrained in the actual place where the business is carried on while everything else is in the air, seem to me to be as useful for practical purposes as it would be to resolve the human body into the various substances of which it is said to be composed. The goodwill of a business is one whole, and in a case like this it must be dealt with as such. For my part, I think that if there is one attribute common to all cases of goodwill it

is the attribute of locality. For goodwill has no independent existence. It cannot subsist by itself. It must be attached to a business. Destroy the business, and the goodwill perishes with it, though elements remain which may perhaps be gathered up and be revived again."

Goodwill has to be situated in the jurisdictionⁱⁱⁱ ie Hasbro must have a business within the United Kingdom.

30) Hasbro has a substantial business in the United Kingdom. In relation to the trade mark OPOLY the goodwill relates to board games only. In relation to MONOPOLY, there has been a diversification to include electronic games and card games. Taking into account the parameters of the claim under section 5(4)(a) of the Act, the goodwill relates to games at large, both electronic and non-electronic.

31) In relation to section 5(3) of the Act, Hasbro must establish that its trade marks were known by a significant part of the public concerned by the products or services covered^{iv} at the date of application. The use in relation to OPOLY is limited to use by a licensee. More importantly, it is used very much in the shadow of the MONOPOLY trade mark. Its use is not prominent on packaging and, taking into account the dominance of the MONOPOLY trade mark, it is quite possible that the average consumer will not have taken any cognisance of it. It has also only been used in relation to board games. Hasbro has not established that its OPOLY trade marks are known by a significant part of the public concerned with board games, which will be the public at large.

32) MONOPOLY is a household name for board games. Taking into account the overlap between the physical and the electronic games, Hasbro has established that it has the requisite reputation for the purposes of section 5(3) in respect of the following goods included in its earlier registrations: *board games and articles included in Class 28 for use in playing board games; electronic games; computer games.*

33) The sequitur of paragraph 32 is that MONOPOLY has enhanced distinctiveness through use for the purposes of section 5(2)(b) of the Act. The evidence of use does not establish that the OPOLY trade mark has such enhanced distinctiveness.

Monopoly and OpolY

34) The consideration of the case of Hasbro will be made first on the basis of its MONOPOLY trade mark. Only if it does not succeed in relation to this trade mark will the OPOLY trade mark be considered.

Likelihood of confusion – section 5(2)(b) of the Act

Average consumer and the purchasing process

35) *Games, playthings and playing cards* will be bought by the public at large. They will be bought by children as well as adults. They could be of low cost and be purchased on impulse, eg at a motorway services to try and keep children amused. Consequently, the potential effects of imperfect recollection will be increased. Imperfect recollection has to be considered as the average consumer rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant^v. Imperfect recollection does not, however, affect indirect confusion, as in such cases there is no direct confusion of one trade mark with another (see paragraph 49).

36) In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined Cases T-117/03 to T-119/03 and T-171/03 the GC stated:

.49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs./

The goods will be primarily bought from displays in stores, from mail order catalogues and via the Internet. Consequently, they will be bought primarily by the eye and visual similarity will have greater weight than aural similarity in the consideration of likelihood of confusion.

Comparison of goods

37) There has been no request for proof of genuine use of the MONOPOLY trade marks. Consequently, their specifications must be considered in their entirety. **Community trade mark no 238352 includes *toys, games and playthings* which are identical to the *games and playthings* of the application.**

38) This leaves *playing cards* of the application.

39) In construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade^{vi}/. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning^{vii}. Consideration should be given as to how the average consumer would view the goods and services^{viii}. In *YouView TV Limited v Total Limited* [2012] EWHC 3158 (Ch)^{ix} Floyd J stated:

.12. There are sound policy reasons for this. 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) (IPTRANSLATOR)* [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./

The class of the goods in which they are placed may be relevant in determining the nature of the goods^x. In assessing the similarity of goods it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary^{xi}. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed^{xii}.

40) Mr Malynicz submitted that the term *playthings* includes *playing cards*. *Playthings* in its natural meaning means toys and the like, to submit that this term encompasses *playing cards* is to deny the natural meaning of the former term⁴. It is difficult to envisage that *playing cards* would normally be described as *playthings*; Mr Malynicz was straining the natural meaning of *playthings* to give too wide a meaning to the term. Prior to 1 January 2002, *playing cards* were classified in class 16 of the Nice Classification, *playing cards* were placed in class 28 of the Nice Classification in the eighth edition with effect from 1 January 2002. As per the judgments in *General Electric Co Ltd (USA) v General Electric Co Ltd* [1969] RPC 418 and *Avnet Incorporated v Isoact Limited* [1998] FSR 16, it is necessary to see in what class goods were at the time of the filing of an application. The three MONOPOLY registrations and the United Kingdom

⁴ *The New Shorter Oxford Dictionary* defines plaything as .A thing to play with, a toy; a person, animal or thing treated as a thing to be played or trifled with./

OPOLY registration were filed when *playing cards* were in class 16; consequently, *playthings* could not have included *playing cards*. Mr Malynicz submitted that *articles for use in playing games* include *playing cards*. However, this can only apply to the Community trade mark OPOLY, as only the class 28 specification of this registration could include *playing cards* (owing to the dates of application).

41) In relation to the MONOPOLY trade marks, there cannot be identity of goods with the *playing cards* of the application. *Games* and *playing cards* are for entertainment and amusement, they are for playing games. They have the same purpose. Both sets of goods will be used by persons who wish to play games; they have the same end users. The goods could all be of card, they have the same nature. The goods will be sold in shops specialising in games and toys and in superstores they will be found in proximity. The respective goods will share the same channels of trade. *Playing cards* and *games* are alternatives for entertainment, they could be in competition. ***Playing cards of the application and games of the Community trade mark for MONOPOLY are highly similar.***

Comparison of trade marks

42) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^{xiii}. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components^{xiv}. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{xv}.

43) MONOPOLY is a well-known word. The average consumer would not divide the word. The distinctiveness lies in the trade mark as a whole; there is no separate distinctive element. GALATOPOLY for the average consumer is an invented word. The average consumer will not see any reference to a book of the Bible. There is, therefore, conceptual difference between the respective trade marks.

44) The font of the application is not particularly unusual; primarily the trade mark will be seen as a word mark. The two trade marks coincide in the ending OPOLY, this gives a visual and aural similarity. The first parts of the trade marks MON and GALAT have no point of coincidence.

45) In comparing trade marks the reputation of Hasbro has not been taken into account. The GC stated in *Ravensburger AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-243/08*:

.27 It is appropriate at the outset to reject that complaint as unfounded. The reputation of an earlier mark or its particular distinctive character must

be taken into consideration for the purposes of assessing the likelihood of confusion, and not for the purposes of assessing the similarity of the marks in question, which is an assessment made prior to that of the likelihood of confusion (see, to that effect, judgment of 27 November 2007 in Case T-434/05 *Gateway v OHIM – Fujitsu Siemens Computers (ACTIVY Media Gateway)*, not published in the ECR, paragraphs 50 and 51)./

A finding that can also be found in *Accenture Global Services GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-244/09*, *Lan Airlines, SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-194/09* and *Ferrero SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-140/08*. The comparison is trade mark to trade mark, reputation is taken into account in the global appreciation of a likelihood of confusion.

46) It is decided that there is a very low degree of similarity between MONOPOLY and GALATOPOLY.

Conclusion – global appreciation of likelihood of confusion

47) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle, a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{xvi}. The respective goods are identical or, in the case of *playing cards* highly similar. However, it is not an automatic sequitur that because goods are identical or highly similar that the trade marks have to be very different to avoid a finding of likelihood of confusion^{xvii}. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^{xviii}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xix}. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings^{xx}. MONOPOLY for games is a household name, it is at the very highest level of distinctiveness owing to use. There is a low degree of similarity between the trade marks.

48) Mr Malynicz did not submit that there would be direct confusion between the trade marks but that there would be indirect confusion ie the average consumer would believe that the respective goods came from the same or economically linked undertakings. Mr Iain Purvis QC, sitting as the appointed person, in BL O/375/10 stated:

.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)./

In *Sabel BV v Puma AG* Case C-251/95 the CJEU stated:

.16. According to those governments, the likelihood of association may arise in three sets of circumstances: (1) where the public confuses the sign and the mark in question (likelihood of direct confusion); (2) where the public makes a connection between the proprietors of the sign and those of the mark and confuses them (likelihood of indirect confusion or association); (3) where the public considers the sign to be similar to the mark and perception of the sign calls to mind the memory of the mark, although the two are not confused (likelihood of association in the strict sense).

17. It must therefore be determined whether, as those governments claim, Article 4(1)(b) can apply where there is no likelihood of direct or indirect confusion, but only a likelihood of association in the strict sense. Such an interpretation of the Directive is contested by both the United Kingdom Government and by the Commission./

This is a case where paragraph 17(a) of the decision of Mr Purvis applies in relation to those goods of the application for which Hasbro has a reputation, ie *games*. Owing to the proximity of *playing cards* to the goods for which Hasbro has a reputation, the same applies to these goods. There is a likelihood of indirect confusion in respect of *games and playing cards* of the application. There is a grey area between playthings and games. A handheld computer game player, which is in class 28, would be a plaything, being a toy, but its sole purpose is to play games. Hasbro has established that it has entered the market generally for electronic games whether they be on computers, tablets or smart phones. Its reputation in relation to *games* will have an effect on the likelihood of confusion in relation to *playthings*. Owing to this fundamental overlap, there will also be a likelihood of indirect confusion with *playthings*. **The application is refused under section 5(2)(b) of the Act.**

OPOLY trade mark

49) Owing to the above finding it is not necessary to consider the OPOLY trade mark. Owing to the absence of comparable reputation with MONOPOLY, Hasbro's position would have been no better in relation to this trade mark. Although, as OPOLY is an invented word, there would not be the conceptual difference between the respective trade marks.

Section 5(3) of the Act

50) In *Intel Corporation Inc v CPM United Kingdom Ltd* Case C-252/07, the CJEU considered Article 4(4)(a) of the Directive, which is the basis of section 5(3) of the Act:

.26 Article 4(4)(a) of the Directive establishes, for the benefit of trade marks with a reputation, a wider form of protection than that provided for in Article 4(1). The specific condition of that protection consists of a use of the later mark without due cause which takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark (see, to that effect, in respect of Article 5(2) of the Directive, *Marca Mode*, paragraph 36; *Adidas-Salomon and Adidas Benelux*, paragraph 27, and Case C-102/07 *adidas and adidas Benelux* [2008] ECR I-0000, paragraph 40).

27 The types of injury against which Article 4(4)(a) of the Directive ensures such protection for the benefit of trade marks with a reputation are, first,

detriment to the distinctive character of the earlier mark, secondly, detriment to the repute of that mark and, thirdly, unfair advantage taken of the distinctive character or the repute of that mark.

28 Just one of those three types of injury suffices for that provision to apply.

29 As regards, in particular, detriment to the distinctive character of the earlier mark, also referred to as *dilution*, *whittling away* or *blurring*, such detriment is caused when that mark's ability to identify the goods or services for which it is registered and used as coming from the proprietor of that mark is weakened, since use of the later mark leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is notably the case when the earlier mark, which used to arouse immediate association with the goods and services for which it is registered, is no longer capable of doing so.

30 The types of injury referred to in Article 4(4)(a) of the Directive, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them (see, in relation to Article 5(2) of the Directive, *General Motors*, paragraph 23; *Adidas-Salomon and Adidas Benelux*, paragraph 29, and *adidas and adidas Benelux*, paragraph 41).

31 In the absence of such a link in the mind of the public, the use of the later mark is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

32 However, the existence of such a link is not sufficient, in itself, to establish that there is one of the types of injury referred to in Article 4(4)(a) of the Directive, which constitute, as was stated in paragraph 26 of this judgment, the specific condition of the protection of trade marks with a reputation laid down by that provision.....

37 In order to benefit from the protection introduced by Article 4(4)(a) of the Directive, the proprietor of the earlier mark must adduce proof that the use of the later mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark

38 The proprietor of the earlier trade mark is not required, for that purpose, to demonstrate actual and present injury to its mark for the purposes of Article 4(4)(a) of the Directive. When it is foreseeable that such injury will ensue from the use which the proprietor of the later mark may be led to make of its mark, the proprietor of the earlier mark cannot be required to

wait for it actually to occur in order to be able to prohibit that use. The proprietor of the earlier mark must, however, prove that there is a serious risk that such an injury will occur in the future.

44 As regards the degree of similarity between the conflicting marks, the more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public. That is particularly the case where those marks are identical.

45 However, the fact that the conflicting marks are identical, and even more so if they are merely similar, is not sufficient for it to be concluded that there is a link between those marks.

46 It is possible that the conflicting marks are registered for goods or services in respect of which the relevant sections of the public do not overlap.

47 The reputation of a trade mark must be assessed in relation to the relevant section of the public as regards the goods or services for which that mark was registered. That may be either the public at large or a more specialised public (see *General Motors*, paragraph 24).

48 It is therefore conceivable that the relevant section of the public as regards the goods or services for which the earlier mark was registered is completely distinct from the relevant section of the public as regards the goods or services for which the later mark was registered and that the earlier mark, although it has a reputation, is not known to the public targeted by the later mark. In such a case, the public targeted by each of the two marks may never be confronted with the other mark, so that it will not establish any link between those marks.

49 Furthermore, even if the relevant section of the public as regards the goods or services for which the conflicting marks are registered is the same or overlaps to some extent, those goods or services may be so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public.

50 Accordingly, the nature of the goods or services for which the conflicting marks are registered must be taken into consideration for the purposes of assessing whether there is a link between those marks.

51 It must also be pointed out that certain marks may have acquired such a reputation that it goes beyond the relevant public as regards the goods or services for which those marks were registered.

52 In such a case, it is possible that the relevant section of the public as regards the goods or services for which the later mark is registered will make a connection between the conflicting marks, even though that public is wholly distinct from the relevant section of the public as regards goods or services for which the earlier mark was registered.

53 For the purposes of assessing where there is a link between the conflicting marks, it may therefore be necessary to take into account the strength of the earlier mark's reputation in order to determine whether that reputation extends beyond the public targeted by that mark.

54 Likewise, the stronger the distinctive character of the earlier mark, whether inherent or acquired through the use which has been made of it, the more likely it is that, confronted with a later identical or similar mark, the relevant public will call that earlier mark to mind.

55 Accordingly, for the purposes of assessing whether there is a link between the conflicting marks, the degree of the earlier mark's distinctive character must be taken into consideration.

56 In that regard, in so far as the ability of a trade mark to identify the goods or services for which it is registered and used as coming from the proprietor of that mark and, therefore, its distinctive character are all the stronger if that mark is unique, that is to say, as regards a word mark such as INTEL, if the word of which it consists has not been used by anyone for any goods or services other than by the proprietor of the mark for the goods and services it markets, it must be ascertained whether the earlier mark is unique or essentially unique.

57 Finally, a link between the conflicting marks is necessarily established when there is a likelihood of confusion, that is to say, when the relevant public believes or might believe that the goods or services marketed under the earlier mark and those marketed under the later mark come from the same undertaking or from economically-linked undertakings (see to that effect, inter alia, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17, and Case C-533/06 *O2 Holdings and O2 (UK)* [2008] ECR I-0000, paragraph 59).

58 However, as is apparent from paragraphs 27 to 31 of the judgment in *Adidas-Salomon and Adidas Benelux*, implementation of the protection introduced by Article 4(4)(a) of the Directive does not require the existence of a likelihood of confusion.

59 The national court asks, in particular, whether the circumstances set out in points (a) to (d) of Question 1 referred for a preliminary ruling are sufficient to establish a link between the conflicting marks.

60 As regards the circumstance referred to in point (d) of that question, the fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark would call the earlier mark to mind is tantamount to the existence of such a link.

61 As regards the circumstances referred to in paragraphs (a) to (c) of that question, as is apparent from paragraph 41 to 58 of this judgment, they do not necessarily imply the existence of a link between the conflicting marks, but they do not exclude one either. It is for the national court to base its analysis on all the facts of the case in the main proceedings.

62 The answer to point (i) of Question 1 and to Question 2 must therefore be that Article 4(4)(a) of the Directive must be interpreted as meaning that whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier mark with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.

63 The fact that for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks.

64 The fact that:

, the earlier mark has a huge reputation for certain specific types of goods or services, and

, those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and

, the earlier mark is unique in respect of any goods or services,

does not necessarily imply that there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks./

In the same judgment the CJEU stated:

.77 It follows that proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future./

Henderson J in *32Red Plc v WHG (International) Limited and others* [2011] EWHC 62 (Ch)^{xxi} stated:

.133. Is there evidence of a change in economic behaviour brought about by the use of the Vegas signs? In the nature of things, direct evidence of such a change is likely to be hard to find in cases of the present type, although Mrs F provides a suggestive example of a customer who was nearly persuaded to change her allegiance as a result of a perceived connection between 32Red and 32Vegas. However, I see no reason why I should not have regard to the inherent probabilities of the situation, and in particular to the contrast between the marketing models of the two casinos. The similarity of their names, and the fact that 32Vegas was always operated as one of a number of linked casinos on the carousel model, lead me to conclude that an average online gambler would have been far readier to switch his allegiance from 32Red to 32Vegas, or to play with 32Vegas in the first place, than he would have been in the absence of such similarity. These are changes in economic behaviour, and I am satisfied on the balance of probabilities that such changes are likely to have occurred to a significant extent./

51) Hasbro has the requisite reputation. It has been decided that there is a likelihood of confusion and that decision has firmly turned upon the reputation that Hasbro has in respect of games for its MONOPOLY trade mark. If there is a likelihood of confusion, there must be detriment to the distinctive character of Hasbro's trade mark, as the nature of that decision is that the average consumer will confuse the goods of Hasbro and those of Mr Ibitoye; a sine qua non of the decision in relation to section 5(2)(b) of the Act is that a link will be created in the mind of the average consumer for the goods under consideration, otherwise there could be no confusion. (There, however, does not have to be a likelihood of confusion for a finding in favour of an opponent under section 5(3) of the Act.)

52) Use of the trade mark of Mr Ibitoye would be detrimental to the distinctive character of Hasbro's trade mark.

53) In *Premier Brands UK Ltd v Typhoon Europe Ltd & Another* [2000] ETMR 1071 Neuberger J stated:

.Thirdly, it appears to me that this conclusion is consistent with the view of the Benelux Court in *Lucas Bols* [1976] I.I.C. 420 at 425, where, when discussing the meaning of .without justifiable reason/ which appeared in a similar context in the Uniform Benelux Trade Mark Act as .without due cause/ in section 10(3), the Court said this:

.What this requires, as a rule, is that the user (of the mark) is under such a compulsion to use this very mark that he cannot honestly be

asked to refrain from doing so regardless of the damages the owner of the mark would suffer from such use, or that the user is entitled to the use of the mark in his own right and does not have to yield this right to that of the owner of the mark .../.

On the same page, the court went on to suggest that a .justifiable reason/ may be .if the user can assert an older right than that of the [registered proprietor]/ but went on to emphasise that whether the alleged infringer can establish a .justifiable reason/ must be .resolved by the trial judge according to the particular facts of each case/.

In my judgment, those observations represent the approach which should be adopted to the words .being without due cause/ in section 10(3), although it is fair to say that two criticisms can be made of this conclusion. The first criticism raises a practical problem, in the sense that this construction could be said to produce a degree of uncertainty; the second point which may be made is that, on this construction, it is not entirely to see what function the words .being without due cause/ actually have. So far as the practical problem is concerned, I do not consider that it has a great deal of weight. Most cases of alleged trade mark infringement turn on their own particular facts; further, the protection potentially accorded to a trade mark proprietor by section 10(3) can be pretty wide. It does not therefore seem to me inappropriate that the tribunal considering the question of infringement under this provision is accorded some degree of flexibility as to how the provision is to be enforced. It should be made clear that I am certainly not suggesting that the court has some sort of roving commission or wide discretion; the observations I have quoted from Lucas Bols are quite clear on that point./

Mr Ibitoye has put forward no basis for his use of his trade mark falling within the parameters set out by Neuberger J. He cannot rely upon the defence within section 5(3) of the Act.

54) The application is to be refused under section 5(3) of the Act.

55) Mr Malynicz also submitted that the use of the trade mark would take unfair advantage of the reputation of Hasbro. He equated unfairness with undeserved. Owing to the finding above it is not necessary to consider this particular part of the grounds of opposition.

Passing-off –section 5(4)(a) of the Act

56) Malynicz submitted that the section 5(4)(a) objection does not raise any different or additional issues to those under section 5(2)(b) of the Act. The written submissions of 12 November 2012 do not put forward any basis for objection that is fundamentally different to that has been put forward in relation to section 5(2)(b) of the Act. This ground of opposition, therefore, stands or falls, on the basis of the submissions of Hasbro, with the opposition under section 5(2)(b) of the Act. No more will, therefore, be said in relation to this ground of opposition.

Examination report

57) At the hearing Mr Ibitoye commented that the examination report of 4 January 2012 had stated that the requirements for registration appeared to have been met. Mr Ibitoye appeared to be surprised that, following this letter, that these proceedings had commenced. The letter advises that the application could be subject to opposition. Mr Ibitoye was warned of the possibility of opposition when Hasbro filed a form TM7A. Hasbro also wrote to Mr Ibitoye in relation to this matter on 4 April 2012. Consequently, prior to filing his defence he had an opportunity to consider his position re the opposition.

Costs

58) Hasbro having been successful is entitled to a contribution towards its costs. Costs are awarded upon the following basis:

| | |
|--|--------|
| Preparing a statement and considering the statement of Mr Ibitoye: | £300 |
| Preparing evidence: | £1,000 |
| Preparing for and attending a hearing: | £500 |
| Total: | £1,800 |

No sum has been awarded for the written submissions as Hasbro availed itself of a hearing.

59) Olusegun Victor Ibitoye is ordered to pay Hasbro, Inc the sum of £1,800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of January 2013

**David Landau
For the Registrar
the Comptroller-General**

ⁱ Section 6A of the Act reads:

(1) This section applies where ,

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if ,

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes ,

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects ,

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration)./

ⁱⁱ *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] RPC 429 and *Inter Lotto (UK) Ltd v Camelot Group PLC* [2004] RPC 8 and 9. The *Inter Lotto* judgments can be found at:

<http://www.bailii.org/ew/cases/EWHC/Ch/2003/1256.html>
and
<http://www.bailii.org/ew/cases/EWCA/Civ/2003/1132.html>

ⁱⁱⁱ See for instance *Plentyoffish Media Inc v Plenty More LLP* [2011] EWHC 2568 (Ch). The full judgment can be found at the url:

<http://www.bailii.org/ew/cases/EWHC/Ch/2011/2568.html>

^{iv} *General Motors Corporation v Yplon SA* Case C-375/97.

^v *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

^{vi} *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

^{vii} *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

^{viii} *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

.In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use/

The full judgment can be found at the url:

<http://www.bailii.org/ew/cases/EWCA/Civ/2002/1828.html>

^{ix} The full judgment can be found at the url:

<http://www.bailii.org/ew/cases/EWHC/Ch/2012/3158.html>

^x *Altecnic Ltd's Trade Mark Application* [2002] RPC 34. The full judgment can be found at the url:

<http://www.bailii.org/ew/cases/EWCA/Civ/2001/1928.html>

^{xi} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{xii} He considered that the following should be taken into account when assessing the similarity of goods and/or services:

- (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./

^{xiii} *Sabel BV v Puma AG Case C-251/95.*

^{xiv} *Sabel BV v Puma AG Case C-251/95.*

^{xv} *Succession Picasso v OHIM - DaimlerChrysler (PICARO) Case T-185/02.*

^{xvi} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc Case C-39/97.*

^{xvii} See *Meda Pharma GmbH & Co KG c Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI) Affaires jointes T-492/09 et T-147/10:*

« 50 La requérante soutient que, en cas d'identité de produits, il est nécessaire, pour exclure tout risque de confusion, que les signes présentent une plus grande différence que dans une situation où l'écart entre les produits est important. Or, dans les circonstances de l'espèce où l'identité des produits n'est pas contestée, la chambre de recours aurait dû conclure au risque de confusion, à l'instar de ce qui a été considéré dans la décision R 734/2008-1 de la première chambre de recours de l'OHMI, du 14 septembre 2009 (Alleris et Allernil). Selon la requérante, plusieurs décisions de l'OHMI démontrent que les décisions attaquées s'écartent de la pratique décisionnelle de l'OHMI, ce qui viole les principes d'égalité et de non-discrimination.

51 Il ressort de la jurisprudence que l'OHMI est tenu d'exercer ses compétences en conformité avec les principes généraux du droit de l'Union. Si, eu égard aux principes d'égalité de traitement et de bonne administration, l'OHMI doit prendre en considération les décisions déjà prises sur des demandes similaires et s'interroger avec une attention particulière sur le point de savoir s'il y a lieu ou non de décider dans le même sens, l'application de ces principes doit toutefois être conciliée avec le respect du principe de légalité. Au demeurant, pour des raisons de sécurité juridique et, précisément, de bonne administration, l'examen de toute demande d'enregistrement doit être strict et complet afin d'éviter que des marques ne soient enregistrées de manière induue. C'est ainsi qu'un tel examen doit avoir lieu dans chaque cas concret. En effet, l'enregistrement d'un signe en tant que marque dépend de critères spécifiques, applicables dans le cadre des circonstances factuelles du cas d'espèce, destinés à vérifier si le signe en cause ne relève pas d'un motif de refus [voir, en ce sens, arrêt de la Cour du 10 mars 2011, *Agencja Wydawnicza Technopol/OHMI*, C-51/10 P, non encore publié au Recueil, points 73 à 77, et la jurisprudence citée, et arrêt du Tribunal du 22 novembre 2011, *LG Electronics/OHMI (DIRECT DRIVE)*, T-561/10, non publié au Recueil, point 31).

52 Or il apparaît que, dans la présente affaire, la chambre de recours a correctement pris en compte les circonstances de l'espèce. À cet égard, elle a, à juste titre, constaté l'identité des produits concernés en l'espèce, elle a aussi retenu une similitude très faible des signes en cause sur les plans phonétique et visuel et une impossibilité de comparaison de ces mêmes signes sur

le plan conceptuel, comme il ressort des points 40, 41 et 46 ci-dessus. Dès lors, comme le soutient à juste titre l'OHMI, l'identité entre les produits désignés est compensée par un très faible degré de similitude entre les signes en cause et la chambre de recours a pu conclure à bon droit à l'absence de tout risque de confusion, d'autant que le degré d'attention du public est accru et qu'il n'est pas démontré que la marque antérieure présente un caractère distinctif élevé. »

^{xviii} *Sabel BV v Puma AG* Case C-251/95.

^{xix} *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

^{xx} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.

^{xxi} The full judgment can be found at the url:

<http://www.bailii.org/ew/cases/EWHC/Ch/2011/62.html>