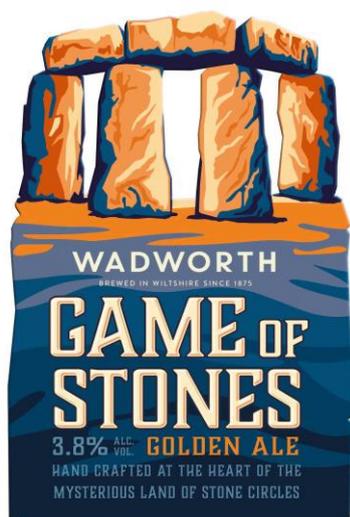


**O-072-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3251471  
BY WADWORTH AND COMPANY LIMITED TO REGISTER THE TRADE MARK**

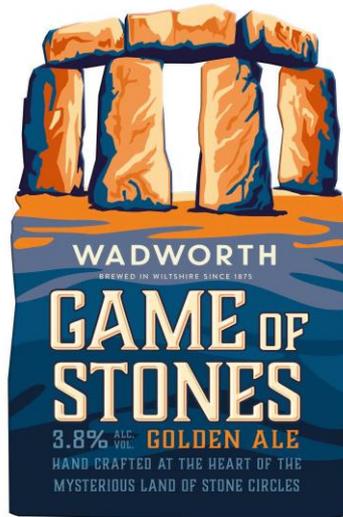


**IN CLASS 32**

**AND IN THE MATTER OF OPPOSITIONS THERETO UNDER NO. 411155 BY  
HOME BOX OFFICE, INC**

## BACKGROUND AND PLEADINGS

1) Wadworth and Company Limited (hereafter “the applicant”) applied to register the following trade mark:



2) The relevant details are:

Filing date: 21 August 2017

Publication date: 22 September 2017

**Class 32:** *Beers; ales; porter; stout; flavoured beers.*

3) Home Box Office, Inc (hereafter “the opponent”) opposes the application. The opposition is directed against all the goods. The opposition is based upon section 5(2)(b), section 5(3) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In respect of the first two grounds, the opponent relies on the following two marks:

<b>European Union Trade Mark (EUTM) 16129769 (“the ‘769 registration”)</b>
<p>GAME OF THRONES</p> <p>Filing date: 2 December 2016</p> <p>Registration date: 16 June 2017</p>
<p>The list of goods and services includes:</p> <p><b>Class 32:</b> <i>Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; Syrups and other preparations for making beverages.</i></p>

<b>EUTM 11983442 (“the ‘442 registration”)</b>
 <p>Filing date: 15 July 2013</p> <p>Registration date: 3 January 2014</p>
<p>The list of goods and services includes:</p> <p><b>Class 41:</b> <i>Providing online computer, video and interactive electronic games via computer networks and global communications networks; providing online interactive multimedia games, virtual reality games and interactive multiplayer computer games played via computer networks and global communications networks; entertainment services, namely, providing on-line, non-downloadable virtual goods, including, food and beverage products, clothing, land, real estate, weapons, armour, protective clothing, shields, armies, soldiers, animals, supernatural creatures, vehicles, beverage containers, storage barrels, coins, bags and pouches, magical charms, trinkets, potions, jewellery and crowns for use in virtual environments on social networking sites for entertainment purposes; all the aforementioned services relating to an ongoing television series.</i></p>

4) The opponent's two trade marks are both earlier marks within the meaning of section 6(1) of the Trade Marks Act 1994 ("the Act") because they both have filing dates earlier than the filing date of the contested application. Both of these earlier marks completed their registration procedures less than five years before the publication date of the contested application and, as a result, they are not subject to the proof of use provisions contained in section 6A of the Act. The consequence of this is that the opponent is entitled to rely upon the full list of goods and services contained in these earlier marks. I have reproduced what I consider to be the most relevant goods and services in the table above, but the opponent relies upon the full lists of goods and services and these are shown in the annex to this decision.

5) The opponent's pleadings in respect of these two grounds are as follows:

- Registration of the contested marks would be contrary to section 5(2)(b) of the Act because the it is similar to the opponent's earlier marks<sup>1</sup>, that the contested goods are identical to the opponent's Class 32 goods of its first earlier mark. It also claims that the applicant's goods are similar to all of its other goods and services because they share nature purpose and end users and they are complimentary. It concludes that because of these similarities there exists a strong likelihood of confusion;
- Use of the contested marks would offend under section 5(3) of the Act because they are similar to both of the opponent's earlier marks that have a reputation in the UK by virtue of being one of the most successful premier television companies and the GAMES OF THRONES series is its premier and most well-known television series in the UK and elsewhere. Use of the contested marks, without due cause, would:
  - (i) Inevitably ride on the coat tails of the opponent's reputation by unfairly benefiting from the recognition that attaches to the opponent's mark;

---

<sup>1</sup> The Form TM7 and statement of case are unclear as to whether, for the purposes of s.5(2)(b), the opponent relies upon both its earlier marks or just its word mark GAME OF THRONES (The Form TM7 refers only the word mark, but the accompanying statement of case refers to both earlier marks). I consider the case from the opponent's best case, namely its reliance upon the earlier word mark to the extent that is covers identical goods to goods of the contested application. Therefore, the ambiguity in the Form TM7 and statement of case is of no consequence to my considerations.

- (ii) be detrimental to the repute of the opponent's marks in the form of "blurring" or "whittling away" of its reputation and will inevitably dilute the rights of the opponent;
- (iii) be detrimental to the distinctive character of the opponent's marks by "erosion" or "dilution" of this distinctiveness making the opponent's marks much less capable of evoking an immediate association with the goods/services of the opponent;
- (iv) detrimental to the distinctive character opponent's marks in that the economic behaviour of the relevant public will be affected and the opponent's marks impaired because consumers will be less inclined to associate the goods and services with the opponent.

6) In respect of the ground based upon section 5(4)(a), the opponent relies upon its goodwill in respect of its television series and tobacco and related goods in the UK attached to three signs. The first two of these are the same as its earlier marks relied upon under its other grounds. The third sign is ~~GAME OF THRONES~~. It claims that use of the applicant's mark will cause a misrepresentation because the contested application is highly similar to the opponent's signs and would mislead the consumer into believing that the opponent and applicant are economically linked undertakings.

7) The applicant filed a counterstatement denying the claims made.

8) Only the opponent filed evidence. I will refer to this to the extent that I consider it necessary. A hearing took place before me on 13 November 2018 where the opponent was represented by Jonathan Moss of Counsel, instructed by Joshi Worldwide IP Limited. The applicant did not attend, nor did it provide written submissions in lieu of attending.

9) The applicant was represented in these proceedings by Wildbore & Gibbons.

## Opponent's Evidence

10) This takes the form of a witness statement by Judy McCool, Senior Vice President, Legal Affairs with the opponent. Ms McCool provides information and exhibits in support of the opponent's worldwide fame and the reputation of its GAME OF THRONES series.

11) The relevant aspects of the evidence can be briefly summarised as follows:

- the opponent is one of the world's most successful premium pay television channels and produces and distributes television programmes.
- Since 2011, the opponent and its licensees have marketed, broadcast and distributed the critically acclaimed and award-winning television series GAMES OF THRONES, a fantasy drama. There have been seven seasons of the series, totalling 67 episodes between 2011 and 2017<sup>2</sup>;
- In the UK, the first series aired on the Sky Atlantic channel and is also available on Sky's related internet offerings such as NOW TV. One of the series' primary filming locations is Northern Ireland and its presence there has brought in an estimated £150 million to the local economy<sup>3</sup>;
- The popularity of the series in the UK led to having the world premiere of the fifth season at the Tower of London in 2015<sup>4</sup>;
- In the UK the series has grown steadily and for the season six premiere, viewing figures were estimated to be 2.2 million<sup>5</sup>;
- The season seven premiere had nearly 3 million viewers<sup>6</sup>;
- The popularity of the series is enhanced through extensive marketing activities with *Sky* heavily promoting each season of the series throughout the UK in print, online and in commercials<sup>7</sup>;
- Recognition of the series has been enhanced by the "Game of Thrones: The Exhibition", a travelling showcase that has appeared in Belfast in 2013 and

---

<sup>2</sup> Ditto, para 3

<sup>3</sup> See the BBC News article at Exhibit JM-1

<sup>4</sup> See Daily Mail article at Exhibit JM-1

<sup>5</sup> Ms McCool's witness statement, para 8

<sup>6</sup> Ditto and Daily Mail article, dated 20 December 2017 (4 months after the relevant date in these proceedings) at Exhibit JM-4

<sup>7</sup> Ditto, para 9 and examples of such advertising at Exhibit JM-5

2014 and in London in 2015. Each was highly publicised and attended by thousands of fans<sup>8</sup>;

- The opponent operates the official website for the GAME OF THRONES series at [www.hbo.com/game-of-thrones.com](http://www.hbo.com/game-of-thrones.com) and a series viewer's guide website at [www.gameofthrones.com](http://www.gameofthrones.com). In addition, the opponent has several social media profiles bearing the GAME OF THRONES marks, including *Facebook*, *Twitter* and *YouTube*. These are popular worldwide<sup>9</sup>;
- Throughout all seven seasons, the series has received extensive press coverage and widespread acclaim and it has developed an enormous fan base worldwide and has been described as "the world's most popular show"<sup>10</sup>;
- The GAME OF THRONES series has won many prestigious entertainment industry awards including Primetime Emmy Awards and Golden Globe Awards including the Emmy for "Outstanding Drama Series" in 2015 and 2016<sup>11</sup>;
- Licensing of intellectual property derived from popular television shows is common place in the entertainment industry<sup>12</sup>. The opponent has invested substantial resources in developing and promoting merchandise for its GAME OF THRONES series, "such as DVDs, apparel, drinkware, jewellery, collectables, board games, pens, and more", many of which are available for sale in the UK<sup>13</sup>. Examples are provided including shot glasses, wine glasses, champagne flutes, steins and pint glasses<sup>14</sup>;
- The opponent "licenses in the alcoholic beverage space" in the USA and internationally. In the USA, this has included GAME OF THRONES-branded beer. It has also announced that it is collaborating with Diageo to produce a GAME OF THRONES labelled Johnnie Walker whiskey<sup>15</sup>.

---

<sup>8</sup> Ditto, para 10 and examples of marketing and media coverage at Exhibit JM-6

<sup>9</sup> Ditto, para 11 and sample website and social media pages are at Exhibit JM-7

<sup>10</sup> Ditto, para 12/13 and articles from various publications attesting to the popularity both in UK and worldwide at Exhibit JM-8

<sup>11</sup> Ditto, para 14 and a full list of awards at Exhibit JM-9

<sup>12</sup> Ditto, para 16

<sup>13</sup> Ditto, paras 17/18

<sup>14</sup> Exhibit JM-10

<sup>15</sup> Ditto, para 19 and Exhibit JM-11

## **DECISION**

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

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

“5(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”.

12) Only the opponent’s ‘769 registration includes Class 32 goods. This, together with the fact that the opponent’s ‘442 registration is for a word and device mark that includes elements absent in the applicant’s mark, results in the opponent’s ‘769 registration representing its best case. Therefore, if it cannot succeed under this ground of opposition when relying upon this mark, neither will it be successful relying on its other earlier mark. Consequently, for the purposes of the ground based upon section 5(2)(b), I will consider the opponent’s case based only on its ‘769 registration.

### ***Comparison of goods***

13) I note that the term *beer* appears in the Class 32 specification of the opponent’s ‘769 registration and in the applicant’s specification. Therefore, at least some of the respective goods are identical. For the purposes of this decision, it is not necessary that I consider the issue further.

### ***Comparison of marks***

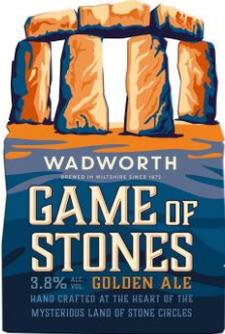
14) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23), Case C-251/95, that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the

visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

16) The respective marks are:

Earlier mark	Contested mark
<p data-bbox="400 1458 715 1491">GAME OF THRONES</p>	

17) The earlier mark consists of the words GAME OF THRONES. These three words form a unit with no one word being dominant. Its distinctive character resides in the phrase as a whole and not in any one element.

18) The applicant's mark is a complex mark that consists of the words WADWORTH GAME OF STONES, a device of a stone circle (reminiscent of Stonehenge) with a foreground that serves as the backdrop to the word elements, and other textual elements that are either negligible because of their small relative size within the mark and/or because they do no more than impart factual information about the goods. The device and the word WADWORTH both have individual distinctive character within the mark, but due to its larger size and central position within the mark, the dominant distinctive element is the words GAME OF STONES.

19) Visually, the marks share some similarity because of the common occurrence of a three-word phrase that shares the same first two words "GAME OF ...." and a third word that ends -ONES. All other elements present in the applicant's mark are absent in the opponent's mark and this introduces significant visual differences. Taking all of this into account, I conclude that the respective marks share a low level of visual similarity. This is a somewhat lower level of similarity than that submitted by Mr Moss at the hearing.

20) Aurally, Mr Moss submitted that the WADWORTH element of the applicant's mark "would not be the main pronunciation of the brand as the average consumer knows of Wadworth as a beer producer". There is no evidence before me that Wadworth is known to such an extent and I, therefore, dismiss this argument. As an average consumer of beer, my experience is that a beer may be referred to or requested in a number of ways. Firstly, where the applicant's beer is the only one on display from WADWORTH, the consumer may order/request the beer by reference to the name WADWORTH and this will be sufficient to distinguish it from other beers on display. Secondly, and particularly when there are more than one WADWORTH beer on display, the beer sold under the applicant's mark may be referred to as GAME OF STONES. Thirdly, and possibly less likely than the first two instances, the applicant's beer may be referred to as WADWORTH GAME OF STONES. The opponent's beer will be referred to as GAME OF THRONES and is aurally similar to both the second and third possible pronunciations of the applicant's mark. Its best case rests with when the applicant's mark is referred to simply as GAME OF STONES. Here the same first two words and a third word that ends in -ONES results in a high level of aural similarity.

21) Mr Moss submitted that the respective marks are conceptually identical, namely both having the concept “of a game of ‘something’ wherein the ‘something’ is not a normal game, not [...] a ‘game’ in the traditional sense”. Whilst I recognise that the respective marks share some conceptual similarities, they are clearly not identical. The conceptual difference between the word THRONES and the word STONES will be easily grasped and readily identified by the average consumer and this introduces an element of conceptual dissimilarity. The word STONES is also reinforced in the applicant’s mark by the device of a stone circle. Taking all of this into account I conclude that the respective marks share a reasonably low level of conceptual similarity.

### ***Average consumer and the purchasing act***

22) 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*.

23) In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

24) The relevant average consumer will generally be the beer drinking general public who will pay a normal level of attention during the purchasing process, being neither particularly low or high. The nature of the purchasing act will vary depending upon

where the beer is being purchased from. In a public house, when ordering over the bar, aural considerations play a role as does visual considerations with the beer often be selected by sight from the pump handle labels or from a list of available beers. In a retail environment, visual considerations are paramount, but I don't ignore that in some retail establishments, the beer may be aurally requested.

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

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

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

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

26) The opponent has provided evidence that in the USA, it licences its mark for use on many products including a beer. However, there is no evidence that it has ever used, or licensed its mark for use on beer in the UK. It cannot, therefore, benefit from

any enhanced distinctive character in respect of such goods and I only need to consider the mark's inherent distinctive character. In this respect, the mark has no direct meaning in relation to beer and, consequently, has an average level of distinctive character, not as high as, for example, an invented word, but not as low as a phrase allusive of the goods or a characteristic of the goods.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion**

27) The following principles are gleaned from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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.

28) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). These factors must be assessed from the viewpoint of the average consumer. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that

exists between the marks/goods/services down to the responsible undertakings being the same or related).

29) I have found that:

- Insofar as both the earlier mark and the contested application both contain *beer*, the respective goods are identical;
- The opponent's mark consists of three words that form a unit;
- The applicant's mark is a complex mark where the words GAME OF STONES, the word WADWORTH and the device of a stone circle are all distinctive elements, but the words GAME OF STONES is the dominant distinctive element;
- The respective marks share a low level of visual and conceptual similarity and a high level of aural similarity;
- The average consumer is the ordinary beer drinking part of the general public who pays a normal level of attention during the purchasing process. The purchasing act may be visual or aural in nature, or a combination of the two;
- The opponent's mark is endowed with an average level of inherent distinctive character.

30) Mr Moss submitted that there is clearly a likelihood of confusion and that is even more so because of the enhanced distinctive character of the opponent's mark. As I have already explained, I find that there is no enhanced distinctive character of the opponent's mark in respect of *beer*. Therefore, I dismiss this limb of Mr Moss' submission. He also asserted that the average consumer that a likelihood of confusion would especially be the case in circumstances where the average consumer is aware of the opponent's mark in use on a wide range of merchandising including alcoholic beverages. I dismiss this also because the evidence fails to establish that, in the UK, the average consumer is aware of use in respect of alcoholic beverages.

31) The high point of the opponent's case rests where the respective parties *beer* is purchased in a pub or bar where aural considerations may play a part. Whilst the

marks share a high level of aural similarity, such purchases are rarely done solely by way of an aural request. The consumer is also likely to have an opportunity to see the pump handle label where the visual and conceptual differences will be readily obvious. The concept of a stone circle created by the device and the word STONES present in the applicant's mark creates a strong difference to the opponent's mark. Despite the common occurrence of the words GAME OF ... and a third word ending in -ONES, it is my view that this will do no more than bring the earlier mark to mind. The differences are such that the consumer is unlikely to consider that the respective goods originate from the same or linked undertaking. There is no likelihood of confusion, either direct or indirect.

32) In other purchasing scenarios, the visual characteristics of the marks become even more important and this increases further the likelihood that confusion will not occur.

33) For clarity, I add that in respect of the two earlier marks relied upon, the evidence fails to show that they benefit from any enhanced distinctive character in respect of any of the goods or services listed in their specifications and, therefore, reliance upon any goods and services other than *beer* does not place the opponent in any stronger position.

34) The opposition, insofar as it is based upon section 5(2)(b)

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

35) Section 5(3) states:

“(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark,

(b) (repealed)

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 European Union trade

mark or international trade mark (EU) in the European Union) 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.”

36) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

### **Reputation**

37) In *Iron & Smith kft v Unilever NV*, Case C-125/14, the CJEU held that:

“If the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3) of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future.”

38) In its counterstatement, the applicant denied that the opponent had the requisite reputation, but it has not provided any further submissions or evidence. Therefore, it cannot rely upon any claim to have due cause.

39) The relevant date for assessing if the opponent has a necessary reputation is the filing date of the contested mark, namely, 21 August 2017.

40) The opponent has provided cogent evidence of the strong reputation its television series GAME OF THRONES has in the UK by virtue of its seven seasons all being shown on the Sky Atlantic channel between 2011 and 2017, with the premieres of season 6 and 7 attracting viewing figures of several million or more. However, neither of the opponent's earlier marks contains, in their specifications, any entertainment services that cover such services. Its earlier EU mark '442 includes entertainment services in the nature of online, video and electronic games, however, there is no evidence that the reputation extends to such services.

41) In light of the above, the opponent does not have the requisite reputation upon which it can base a section 5(3) ground of opposition. This ground fails in its entirety and it is not necessary to consider the existence of a link, nor Mr Moss' submissions regarding the claimed unfair advantage and detriment.

42) The ground of opposition based upon section 5(3) fails in its entirety.

## Section 5(4)(a)

43) Section 5(4)(a) states:

“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, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

44) Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

45) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

### ***The relevant date***

46) The relevant date for assessing if section 5(4)(a) applies has been discussed by Mr Daniel Alexander QC sitting as the Appointed Person in *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11. A summary of the position provided by Allan James, for the Registrar, in *SWORDERS TMO-212-06* was quoted with approval and I reproduce it below:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour

complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

47) The relevant date for the purposes of these proceedings is the filing date of the contested application, namely 27 August 2017. In the absence of any counterclaim to an earlier or concurrent goodwill on the part of the applicant, this is the only relevant date for assessing the issue of passing off in these proceedings.

## **Goodwill**

48) A long standing definition of goodwill is provided in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“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.”

49) In its statement of case, the opponent asserted that its goodwill in the UK was in respect of its television series as well as tobacco and related products. The evidence does not illustrate any use in respect of tobacco or related products and, accordingly, it has no demonstrable goodwill in respect of such goods. In respect of the television series, the scale of use clearly indicates that the opponent has a significant goodwill in the UK and that this is identified by its GAME OF THRONES sign. I proceed on the basis that if the opponent's goodwill is also identified by the other two signs relied upon, reliance upon them provides the opponent with no better case than its reliance upon its word mark GAME OF THRONES.

## **Misrepresentation and Damage**

50) In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in *Halsbury's Laws of England 4th Edition Vol.48 para 148* . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175 ; and Re Smith Hayden's Application (1945) 63 R.P.C. 97 at page 101.*”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

51) At the hearing, Mr Moss submitted that it is quite clear that the applicant seeks to imitate the opponent's signs. He pointed to the fact that the applicant's mark relegates the word “of” to lesser significance by it being represented in a smaller font as is the case in the opponent's stylised version of its sign. Further, whilst relying on the same reasoning as to why the opponent believes its grounds based on 5(2)(b) and 5(3) succeed, he also identified the following additional points:

- At a minimum, there will be initial interest confusion. If the consumer has to inspect the goods to ascertain that they are not related to the opponent, this still amounts to initial confusion which is actionable in passing off if there is damage to the opponent's goodwill;
- Where a party has chosen to intentionally make a misrepresentation to the market (in this case an association with the opponent), the decision maker should not have to "bend over backwards to allow them to get away with this". The applicant has clearly tried to imitate the opponent's sign and they should not be allowed to do so.

52) I acknowledge that it has been long established that misrepresentation can be more readily inferred where there is intent to deceive (see *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] RPC 39 (HOL)). However, in the current case it is far from obvious that such intent is present. Whilst I consider it likely that there is some inspiration taken from the opponent's sign, this may be no more than an attempt at parody, namely, an imitation of the style of the opponent's sign for comic effect, rather than an intent to deceive. My finding of no likelihood of confusion is consistent with the applicant attempting to parody the opponent's sign rather than having an intention to deceive. Further, although I consider it unlikely, if the applicant was motivated by an attempt to deceive, my finding under section 5(2)(b) is indicative that it has failed. In stating this I recognise that there is a difference between the test for misrepresentation and for likelihood of confusion because the former requires that "a substantial number" of the relevant public are deceived rather than that the average consumer needs to be confused. However, both tests are intended to be normative measures intended to exclude those who are unusually careful or careless (as per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40) and therefore, there are parallels between the two tests. In summary, I see no reason why I should be more ready to infer misrepresentation than in a passing off claim where there is no claim to an intention to deceive.

53) In respect of Mr Moss' submission regarding initial interest confusion, it is my view that no such confusion will occur. At best, the applicant's mark will bring the

opponent's signs to mind, but the nature of the connection is so weak that I find it unlikely that a substantial number of the relevant public will be deceived and believe that there is a connection between the applicant's goods and the services in which the opponent's goodwill subsists. In reaching this conclusion, I take account that not only is there no common field of activity, but the respective fields are very distant from each other. Again, I acknowledge that a common field of activity is not essential, however, it remains a consideration that I have taken into account and is a further factor pointing away from misrepresentation.

54) Taking all of the together, it is my view that whilst the applicant's mark may bring the opponent's sign fleetingly to mind, it will not lead to misrepresentation and the grounds based upon section 5(4)(a) fails.

## **Summary**

55) The opposition fails on all grounds and the application can proceed to registration.

## **Costs**

56) The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2 of 2016. At the hearing, Mr Moss made a number of submissions to the effect that I should award enhanced costs because of, what he characterised as a failure of the applicant to engage with the proceedings. The outcomes I have reached lend credence to the applicant's approach and it could be said that it reduced its costs by minimising its engagement with proceedings that have been wholly unsuccessful. Consequently, I see nothing in the points raised by Mr Moss. Accordingly, I award the following costs to the applicant based on the published scale and unfettered by any adjustment based on lack of engagement:

Considering opponent's statement and preparing counterstatement	£350
Considering evidence	£700

**TOTAL**

**£1050**

57) I order Home Box Office, Inc to pay to Wadworth and Company Limited the sum of **£1050**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 5<sup>th</sup> day of February 2019**

**Mark Bryant**

**For the Registrar**

**The Comptroller-General**

## ANNEX

### Details of earlier marks with full list of goods and services relied upon

#### EU16129769 GAME OF THRONES

**Class 3:** Bleaching preparations and other substances for laundry use; cleaning polishing, scouring and abrasive preparations; soaps; Perfumery, essential oils, cosmetics, hair lotions; dentifrices; lip balm, lip gloss, lip liner, lip stick, lip gloss palette, make-up kits comprised of lip gloss; eye make-up, eye liner, eye pencils, eye shadow, eye make-up corrector pen, mascara, make-up kits comprising of eye shadows, make-up kits comprising of mascara and eye liner, brow stencils, brow gel, brow powder, brow pencils; make-up kits comprising of blush; blush, body powder, face powder, loose face powder, make-up powder, pressed face powder, perfumed powder; concealers for face; nail enamel, nail enamel remover, nail enamel corrector pen; cosmetic facial blotting papers; fragrances and perfumes, cologne, perfume oils, eau de perfume; face and body soaps, bath beads, bath crystals, bath foam, bath gel, bath lotion, bath oil, bath salts, bubble bath, liquid bath soaps, shower and bath foam, shower and bath gel, shower and bath scrub; body scrub, facial scrub, body masks, facial masks, skin masks; massage oil; body cream, face and body glitter, body lotion, body oil, body powder, scented body spray, sparkly body glitter in the form of paste; body deodorant; scented room spray; wax strips for removing body hair; shaving balm, shaving cream, shaving foam, shaving gel, shaving lotion, shaving mousse, shaving soap, after-shave, after-shave balms, after-shave creams, after-shave emulsions, after-shave gel, after-shave lotions, pre-shave creams; adhesives for affixing false eyelashes, false eyelashes, false eyelash glue, kits comprising of false eyelashes and false eyelash glue; cologne; fragrances and perfumes.

**Class 4:** Industrial oils and greases; Lubricants; Dust absorbing, wetting, and binding compositions; Fuels (including motor spirit) and illuminants; Candles and wicks for lighting; Candle torches, candles, Christmas tree candles, scented wax for use in candle warmers, candle-making kits, decorative tabletop fueled torches, fragrant wax for use in potpourri burners, lamp oil.

**Class 24:** Textiles and textile goods, not included in other classes; Bed and table covers. Bed sheets, pillowcases, comforters, bedspreads, quilts, pillow shams, bed dust ruffles, bed skirts, duvet covers, comforter covers, bed throws, blanket throws, bed blankets, bed sheets; towels, bath towels, kitchen towels, washcloths; textile wall hangings; fabric banners; handkerchiefs; tablecloths, napkins and placemats.

**Class 29:** Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; olive oil; prepared meals; frozen and/or chilled prepared meals and desserts.

**Class 30:** Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; prepared meals; frozen and/or chilled prepared meals and desserts; flour and preparations made from cereals, bread, pastry and confectionery, bruschetta, pizza, all being fresh or frozen; cookies, biscotti; ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); steak sauces; barbeque sauces; salad dressings; spices; ice; cookies, cupcakes and pastries.

**Class 32:** Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; Syrups and other preparations for making beverages.

**Class 33:** Alcoholic beverages (except beers).

**Class 39:** Providing a website featuring information in the field of tours and tour guide services.

**Class 43:** Agency services for the reservation of temporary accommodation; arena services, namely, providing facilities for conventions and exhibitions; providing a website featuring information in the field of hotels and temporary accommodations for

travelers.

**EU11983442**



**Class 21:** *Mugs, drinking glasses, beverage ware, shot glasses, barware, bottle openers, cocktail shakers, wine buckets, wine openers, coolers for wine, coasters not of paper and other than table linen; porcelain figurines.*

**Class 25:** *Clothing; shirts, tank tops, sweat shirts, sweat pants, t-shirts, loungewear, pants, jackets, sleepwear, robes, coats, hooded pullovers, hooded sweat shirts; headwear; hats and caps; footwear; Halloween and masquerade costumes.*

**Class 41:** *Providing online computer, video and interactive electronic games via computer networks and global communications networks; providing online interactive multimedia games, virtual reality games and interactive multiplayer computer games played via computer networks and global communications networks; entertainment services, namely, providing on-line, non-downloadable virtual goods, including, food and beverage products, clothing, land, real estate, weapons, armour, protective clothing, shields, armies, soldiers, animals, supernatural creatures, vehicles, beverage containers, storage barrels, coins, bags and pouches, magical charms, trinkets, potions, jewellery and crowns for use in virtual environments on social networking sites for entertainment purposes; all the aforementioned services relating to an ongoing television series.*