O/0829/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3704718
BY WADZAN HOLDING LIMITED

TO REGISTER:

BURNING STARS

AS A TRADE MARK IN CLASSES 9, 28 & 41

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 434427 BY
EURO GAMES TECHNOLOGY LTD.

BACKGROUND AND PLEADINGS

1. These proceedings concern the opposition to an application to register **BURNING STARS** as a trade mark in the United Kingdom. The application was filed on 30 September 2021, pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union which enabled applications pending at the European Union Intellectual Property Office ("EUIPO") on IP Completion Day (31 December 2020) to be filed as applications in the United Kingdom and retain the EU filing date. The filing date for this application is therefore 26 October 2020.

2. The goods and services in respect of which registration is sought are as follows:

> *Class 9*
> *Sound reproduction apparatus; Coin-operated mechanisms; Computer programs, downloadable; Computer gaming software; Information technology and audiovisual equipment; Sound recording apparatus; Downloadable software; Software and applications for mobile devices; Apparatus for recording images; Sound transmitting apparatus; Apparatus for the transmission of images; Apparatus for the reproduction of images; Computer programmes for interactive television and for interactive games and/or quizzes.*
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> *Class 28*
> *Coin-operated amusement machines; Ascenders [mountaineering equipment]; Toys; Amusement machines, automatic and coin-operated; Gaming machines for gambling; Counters [discs] for games; Automatic coin-operated games; Dice; Apparatus for games; Mechanical games; Arcade game machines; Board games; Coin-operated amusement gaming machines; Amusement game machines.*
>
> *Class 41*
> *Electronic games services; Production of television features; Gaming services for entertainment purposes; Entertainment information; Production of radio and television programmes; Gambling services; Training; Arcade game services; Electronic game services provided by means of the internet; Interactive computer*

game services; Casino, gaming and gambling services; Wagering services; Bookmaking [turf accountancy]; Organisation of sporting events; Education and training in the field of music and entertainment; Organising of entertainment competitions; Amusement arcades; Game services provided online from a computer network; On-line gaming services; Cultural activities; Practical training [demonstration]; Betting services; Entertainment services; Providing casino facilities [gambling].

3. On 21 June 2022, the application was opposed by Euro Games Technology Ltd. ("the opponent"). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and concerns all the goods and services in the application. The opponent is relying on the following IRs, which are protected for goods and services in Classes 9, 28 and 41 and the specifications of which can be found in the Annex to this decision:

IR No. 1486143 ("the 143 mark")  Colours claimed: The mark contains the colours Yellow, orange and green.	International registration date: 10 May 2019 Designation date: 10 May 2019 Date of protection of the IR in the UK: 7 April 2022 Priority date: 13 November 2018 (priority claimed from Bulgarian Trade Mark No. 152890).
IR No. 1487417 ("the 417 mark")  Colours claimed: The mark contains the colours white, green and black.	International registration date: 10 May 2019 Designation date: 10 May 2019 Date of protection of the IR in the UK: 28 November 2019 Priority date: 13 November 2018 (priority claimed from Bulgarian Trade Mark No. 152879).

IR 1488604 (“the 604 mark”)  Colours claimed: The mark contains the colours white, green and black.	International registration date: 10 May 2019 Designation date: 10 May 2019 Date of protection of the IR in the UK: 12 December 2019 Priority date: 13 November 2018 (priority claimed from Bulgarian Trade Mark No. 152881).
IR No. 1491750 (“the 750 mark”)  Colours claimed: The mark contains the colours white, orange, yellow, red, black, green, light blue and purple.	International registration date: 10 May 2019 Designation date: 10 May 2019 Date of protection of the IR in the UK: 28 December 2019 Priority date: 13 November 2018 (priority claimed from Bulgarian Trade Mark No. 152864).

4. The above International Registrations (IRs) qualify as earlier marks under section 6(1) of the Act by virtue of their earlier priority dates. As they completed their registration processes less than five years before the filing date of the contested application, the opponent may rely on all the goods and services for which they stand registered.

5. The opponent claims that the contested mark is similar to its earlier IRs and that the goods and services are identical, similar or complementary. It therefore claims that there is a likelihood of confusion on the part of the public.

6. The applicant filed a defence and counterstatement denying the claims made. In particular, it asserts that the word “Burning” is commonly used within the gambling and entertainment industries. It also claims that the goods and services of the respective parties are highly specialised and that the average consumer would be very well

informed and highly attentive with a significant degree of brand loyalty. It submits that the average consumer would be able to spot *"secondary differences"* between the parties' marks.

7. Both parties filed evidence, which I list below. The opponent also filed written submissions during the evidence rounds on 12 April 2023. Neither side requested a hearing, and the applicant filed final written submissions on 23 May 2023.

8. In these proceedings, the opponent is represented by IK-IP Limited and the applicant by Tierney IP.

EVIDENCE

9. The opponent filed evidence in chief in the form of a witness statement dated 12 December 2022 from Vladimir Petrov Dokov, General Manager of Euro Games Technology Limited, a position he has held since 17 May 2010. His evidence goes to the history of the opponent and goods and services offered by the applicant.

10. The applicant's evidence comes from Niall Tierney, the representative of the applicant. His witness statement is dated 10 February 2023 and presents exhibits showing trade mark registrations containing the word "Burning" in the classes at issue in these proceedings. Further exhibits purport to show active use of these and other relevant marks in the UK, EU and US.

11. The opponent filed evidence in reply in the form of a witness statement dated 12 April 2023 from Kostadin Manev, attorney-at-law at Manev & Partners, representative of the opponent before the Bulgarian patent office and the EUIPO. It challenges the applicant's evidence given by Mr Tierney. He also provides lists of trade mark proceedings brought by the opponent against marks containing the word "BURNING".

DECISION

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

"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."

13. In considering this opposition, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union ("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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):[1]

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their

[1] Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts, although the UK has left the EU.

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 greater degree of similarity between the marks and vice versa;

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

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

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

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

Comparison of goods and services

14. Some of the contested goods and services are identical to the goods and services on which the opposition is based and which are found in the specifications of all the earlier IRs. These are as follows:

- *Sound reproduction apparatus; Sound recording apparatus; Apparatus for recording images; Sound transmitting apparatus; Apparatus for the transmission of images; Apparatus for the reproduction of images* in Class 9;
- *Dice* in Class 28; and
- *Gaming services for entertainment purposes; Gambling; Arcade game services; Casino, gaming and gambling services; Amusement arcades; Providing casino facilities [gambling]* in Class 41.

15. For reasons of procedural economy, the Tribunal will not undertake a full comparison of the goods and services at issue. The examination of the opposition will proceed on the basis that the contested goods and services are identical to those covered by the earlier IRs. If the opposition fails, even where the goods and services are identical, it follows that it will also fail where the goods and services are only similar.

Average consumer and the purchasing process

16. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purposes 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 and services in question: *Lloyd Schuhfabrik*, paragraph 26.

17. The goods and services divide into those that would be purchased primarily by a member of the general public and those that would be bought by a business. Where these goods and services relate to gambling, which is an age-restricted activity, the average consumer will be an adult. The applicant submits that there will also be professional casino players. I accept that these may form a group of relevant consumers, but it is the general public that is more likely to be confused and so I shall look through their eyes rather than those of a professional.

18. When buying most of the goods and services, the average consumer will, in my view, be paying at least an average degree of attention and in some cases this will be higher. For example, the amusement machines and arcade game machines of Class 28 are likely to be relatively expensive and infrequent purchases.

19. The purchase process will largely be visual, as the consumer will select the goods from the shelves of shops or from websites. The average consumer will choose a provider of the services after browsing through websites, viewing advertisements or promotional material or seeing signage in the street. In the case of both goods and services, I do not discount the aural element of the marks, as the consumer may seek advice from sales staff or receive word-of-mouth recommendations.

Comparison of marks

20. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:

> "… it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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."[2]

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

22. The respective marks are shown below:

Contested mark	**Earlier marks**
BURNING STARS	The 143 mark:  The 417 mark:  The 604 mark:  The 750 mark: 

[2] Paragraph 34.

23. The contested mark consists of two words which, in my view, hang together as a unit. The overall impression of the mark lies in this unit.

Comparison with the 143 mark

24. The 143 mark consists of the words “BURNING” and “HOT” arranged in two rows in green capital letters, surrounded by a thin yellow border and a black shadow effect. Above the first three letters, the word “MINI” is presented in perspective in smaller orange capital letters. The green and orange colours are not block colours; rather, different shades can be seen with some very light patches. The use of different colours and sizes creates a distinction between “MINI” and “BURNING HOT”, and it is the latter that makes the greatest contribution to the overall impression of the mark, with “BURNING HOT” hanging together as a unit. The colours and stylisation play a lesser role, and the word “MINI” is non-distinctive.

25. The marks share the word “BURNING”, but each of the marks contains additional words not found in the other. Fair and notional use of the contested word mark would include its use in green, as a word mark protects the words themselves in whatever form, colour or typeface: see *LA Superquimica v EUIPO*, Case T-24/17, paragraph 39. However, I consider that the colour arrangement of the earlier mark, in particular the use of shading, to be a complex arrangement that would not fall within fair and notional use of the contested mark. I find that the marks are visually similar to a low degree.

26. The contested and 143 marks would be articulated as “BUR-NING-STARS” and “MIH-NIH-BUR-NING-HOT” respectively. They therefore coincide in two syllables (the first and second of the contested mark and third and fourth of the earlier mark). I find that the marks are aurally similar to a low degree.

27. The 143 mark would be seen as a reference to a very high temperature, with the word “MINI” denoting smaller or shorter versions of the goods and services sold under the mark. The contested mark will bring to the mind of the average consumer celestial objects that are visible in the night sky as points of light. They would perceive the word “BURNING” to refer to the brightness of the light, or, more likely, to a level of heat. In

the latter case, there is some conceptual similarity between the marks and I consider this is at a medium level.

Comparison with the 417 and 604 marks

28. The 417 and 604 marks share the same colour and stylisation as the words "BURNING HOT" in the 143 mark, although the numbers and letters are presented in a single line. There is no apparent gap between "20" or "40" and "BURNING", but there is between "BURNING" and "DICE". In the context of goods and services relating to gaming, "DICE" is descriptive or allusive. "BURNING DICE" will be perceived as a unit, with "BURNING" describing a quality of the dice. This makes the greatest contribution to the overall impression of the earlier marks, with a lesser role played by the number and the colour and stylisation.

29. The marks share a common element "BURNING", but, as with my previous comparison, each has additional matter that distinguishes them. I find that they are visually similar to a low degree.

30. The earlier marks would be articulated as "TWEN-TEE-BUR-NING-DYS" and "FOR-TEE-BUR-NING-DYS". The third and fourth syllables are the same as the first and second of the contested mark. I find that they are aurally similar to a low degree.

31. In the context of the earlier marks, the word "BURNING" would make the average consumer think of something hot, namely 20 or 40 dice, and so there is some shared conceptual content with the contested marks. I find they are conceptually similar to between a low and medium degree.

Comparison with the 750 mark

32. The 750 mark consists of the words "BURNING DICE" in capital letters that are coloured in shades of yellow, orange and red. The letters of the first word are surrounded by a red border and those of the second word are surrounded by a green border. These letters are shown in what appears to me to be an informal typeface. The mark also contains images of the faces of dice in yellow, light blue, purple, red and

green, along with what could be a tile decorated with a Chinese character. In my view, the impact of the tile will be minimal, given its position towards the back. It is established case law that the average consumer does not study the marks in great detail. The average consumer tends to find words more distinctive than figurative elements of marks: see *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph 37. I find that the words "BURNING DICE" make the greatest contribution to the overall impression of the mark. The figurative element reinforces the message of "DICE" and makes a small contribution, as do the colours and stylisation.

33. The verbal elements of the marks both contain two words, the first of which is identical. There the similarities end. I find the visual similarity of the marks to be low.

34. Only the verbal element of the 750 mark will be articulated ("BUR-NING-DYS"). The marks have the same number of syllables, the first two of which are identical. I find the marks to be aurally highly similar.

35. Turning to the conceptual comparison, I consider that the reasoning in paragraph 31 applies here, although I note that the 750 mark does not give the average consumer any indication as to the number of dice. I find the marks to be conceptually similar to between a low and medium degree.

Distinctive character of the earlier marks

36. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

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

37. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

38. Each of the earlier marks contains the word "BURNING". The applicant has submitted that, in the context of the goods and services at issue, this word is not distinctive:

> "… it is respectfully submitted that the relevant consumers of the goods and services in question are likely to see the common element between the Opponent's mark and that which the Applicant is seeking to register (i.e. burning) as nothing more than a suggestion that use of the relevant goods and services would elicit an intense 'burning' feeling brought about after winning a jackpot or a game of cards. Indeed the relevant consumer may even regard 'burning' as a play on the activity of 'burning' which is used to prevent cheating in cards."[3]

39. I am not persuaded on the basis of these submissions, and in the absence of evidence, that the average consumer, particularly when that average consumer is a

[3] Written submissions in lieu of a hearing, pages 3-4.

member of the general public, would interpret the common element “burning” in this way, rather than giving it its more literal meaning.

40. The applicant also filed evidence which it submits showed that the word “BURNING” was commonly used within the relevant industries. Exhibits NT1 and NT2 contain lists of trade marks incorporating the word in Classes 9, 28 and/or 41. This is state of the register evidence which in itself does not establish that the distinctive character of this element has been weakened: see *Zero Industry Srl v OHIM*, Case T-400/06, paragraph 73. The remainder of the applicant’s evidence purports to show that a number of these marks are in use on the market. Exhibits NT3-NT5 contain screenshots and printouts from a variety of websites for games such as “Burning Sky”, “Burning Ocean”, “Burning Chance” and “Link King Burning Buffalo”. Much of this evidence is undated, so it is difficult to ascertain how many were on the market at the relevant date of 26 October 2020. As far as I can tell, the exceptions are “One Piece: Burning Blood”, released on 3 June 2016 and described as a fighting game;[4] “Burning Daylight”, released on 19 April 2019 and described as a *“sci-fi adventure game set in a dystopian future”*;[5] “Resistance: Burning Skies”, released in 2012 and described as a shooter video game;[6] and “Burning Road”, an arcade racing game that appears to have been available in the 1990s.[7] There may be some others, but the relevant information is not in English. Even with these examples, I am unable to see whether the games were available in the UK. Consequently, this evidence does not assist the applicant.

41. The phrase “MINI BURNING HOT” consists of words that are in common English usage, and the phrase “BURNING HOT” is also a well-known English expression. I recall that I found that the word “MINI” was non-distinctive. I consider that the verbal element of the mark would have a medium degree of inherent distinctive character and that the colour and stylisation would make only a minimal difference.

[4] Exhibit NT3, pages 99-103.
[5] Exhibit NT5, pages 192-193.
[6] *Ibid*, pages 204-209.
[7] *Ibid*, pages 214-216.

42. “BURNING DICE” also consists of standard English words. For some of the goods and services at issue (namely dice and dice-based games and related services), the word “DICE” is descriptive, but the combination with the adjective “BURNING” and the figurative elements and stylisation make the marks distinctive. For dice and dice-based games and related services, the inherent distinctiveness of the 417, 604 and 750 marks is fairly low; for the remaining goods and services, it is medium, as the roles played by the figurative elements, colour and stylisation are small and do not elevate the inherent distinctive character of the marks.

43. The opponent has filed some evidence going to the history of the company, but this does not provide information on the use of the marks in the UK that would enable me to find that the inherent distinctive character of the marks had been enhanced.

Conclusions on likelihood of confusion

44. There is no arithmetical formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services or vice versa. I keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them they have in their mind.

45. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

> “16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore

requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.'

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)."

46. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

> "This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition."[8]

47. He also said:

> "As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."[9]

48. Earlier in my decision, I said that the opposition would be examined on the basis that all the goods and services are identical. I also found that:

- the average consumer would select the goods on a largely visual basis, although aural considerations may also be relevant;
- the average consumer would be paying at least an average degree of attention when purchasing the goods and services;
- the contested mark was visually and aurally similar to the 143 mark to a low degree and conceptually similar to the 143 mark to a medium degree;
- the contested mark was visually and aurally similar to the 417 and 604 marks to a low degree and conceptually similar to these marks to a low to medium degree;
- the contested mark was visually similar to the 750 mark to a low degree, aurally similar to this mark to a high degree and conceptually similar to between a low to medium degree;

[8] Paragraph 12.
[9] Paragraph 13.

- the 143 mark had a medium degree of distinctive character;
- the distinctive characters of the 417, 604 and 750 marks were fairly low when the marks were used for dice, dice-based games and related services, and medium for the remaining goods and services.

49. In my view, the differences between the marks are such that the average consumer who is paying an average degree of attention, is unlikely to mistake one for the other, even where the goods and services are identical.

50. Turning now to indirect confusion, I do not consider that “STARS” represents a logical sub-brand of “BURNING HOT” or “BURNING DICE”. Neither do I find that the common element “BURNING” is so distinctive that only the opponent would be using it. I see no reason why the average consumer would assume the marks to come from the same undertaking or businesses that are related to each other. I find no likelihood of indirect confusion.

OUTCOME

51. The opposition has failed and Application No. 3704718 will proceed to registration.

COSTS

52. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice No. 2/2016. In making this award, I have taken account of the fact that the evidence filed by the applicant was of no assistance to it. The cost award is calculated as follows:

Preparing a statement and considering the other side’s statement: £200
Preparing evidence and considering the other side’s evidence: £300
Preparing written submissions in lieu of a hearing: £300
TOTAL: £800

53. I therefore order Euro Games Technology Ltd to pay Wadzan Holding Limited the sum of £800. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 31st day of August 2023

Clare Boucher,
For the Registrar
Comptroller-General

Annex

IR No. 1486143

Class 9

Electronic components for gambling, gambling machines, gambling games on the internet and via telecommunication network; electronic components for gambling machines; computer operating system software; software drivers; operating computer software for main frame computers; computer programs for network management; computer hardware; monitors (computer hardware); communications servers [computer hardware]; apparatus for recording images; monitors (computer programs); apparatus for recording, transmission or reproduction of sound or images.

Class 28

Parlor games; boxes for coin-operated machines, slot machines and gaming machines; housings for coin-operated machines, gaming equipment, gaming machines, machines for gambling; Chips for gambling; gaming chips; gaming tables; roulette chips; poker chips; chips and dice [gaming equipment]; roulette tables; gaming roulette wheels; mah-jong; arcade games.

Class 41

Gambling; gaming services for entertainment purposes; casino, gaming and gambling services; training in the development of software systems; provision of equipment for gambling halls; providing casino equipment [gambling]; gaming machine entertainment services; providing casino facilities [gambling]; gaming hall services; amusement arcade services; games equipment rental; rental of gaming machines; providing amusement arcade services; rental of gaming machines with images of fruits; editing or recording of sounds and images; sound recording and video entertainment services; hire of sound reproducing apparatus; provision of gaming equipment for casinos; providing of casino facilities; casino, gaming and gambling services; provision of gaming establishments, gaming halls, internet casinos.

IR Nos. 1487417, 1488604 and 1491750

Class 9

Software; computer gaming software; computer software packages; computer operating system software; computer software, recorded; software drivers; virtual reality software;

games software; entertainment software for computer games; computer programs for network management; operating computer software for main frame computers; monitors (computer hardware); computer hardware; apparatus for recording images; monitors (computer programs); computer game programs; computer programs for recorded games; apparatus for recording, transmission or reproduction of sound or images; communications servers [computer hardware]; electronic components for gambling machines; computer application software featuring games and gambling; computer software for the administration of on-line games and gaming; computer hardware for games and gaming; electronic components and computer software for gambling, gambling machines, gambling games on the internet and via telecommunication network.

Class 28

Gaming machines for gambling; chips for gambling; mah-jong; arcade games; gambling machines operating with coins, notes and cards; games; electronic games; parlor games; gaming chips; gaming tables; slot machines [gaming machines]; LCD game machines; slot machines and gaming devices; coin-operated amusement machines; roulette chips; poker chips; chips and dice [gaming equipment]; equipment for casinos; roulette tables; gaming roulette wheels; casino games; gambling machines and amusement machines, automatic and coin-operated; coin-operated amusement machines and/or electronic coin-operated amusement machines with or without the possibility of gain; boxes for coin-operated machines, slot machines and gaming machines; electronic or electrotechnical amusement machines and apparatus, gaming machines, coin-operated entertainment machines; housings for coin-operated machines, gaming equipment, gaming machines, machines for gambling; electropneumatic and electrical gaming machines (slot machines).

Class 41

Gambling; services related to gambling; gaming services for entertainment purposes; casino, gaming and gambling services; training in the development of software systems; provision of equipment for gambling halls; providing casino equipment [gambling]; gaming hall services; amusement arcade services; games equipment rental; rental of gaming machines; providing amusement arcade services; rental of gaming machines with images of fruits; editing or recording of sounds and images; sound recording and video entertainment services; hire of sound reproducing apparatus; provision of gaming equipment for casinos; providing of casino facilities; online gambling services; casino, gaming and gambling services; provision of gaming establishments, gaming halls, internet casinos, online gaming services.