

**O/0857/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003675160  
IN THE NAME OF BUBBLE ROCKET LIMITED  
TO REGISTER THE FOLLOWING TRADE MARK:**

**BUBBLE ROCKET**

**IN CLASSES 9, 35, 41 AND 42**

**AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 429317  
BY O2 WORLDWIDE LIMITED**

## Background and pleadings

1. On 29 July 2021, BUBBLE ROCKET LIMITED (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 17 September 2021 and registration is sought for goods and services in classes 9, 35, 41 and 42.

2. On 17 December 2021, O2 Worldwide Limited (“the opponent”) opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) based upon the two trade marks shown below:

UK00915145279<sup>1</sup> (“the 279 mark”)

BUBBLE

Filing date: 24 February 2016; Registration date: 04 December 2016

Relying upon some of the goods and services for which the mark is registered, namely those in classes 9, 35, 41 and 42.

UK00003527352 (“the 352 mark”)

BUBL

Filing date: 27 August 2020; Registration date: 28 May 2021

Relying upon some of the goods and services for which the mark is registered, namely those in classes 9, 35, 41 and 42.

3. The parties’ goods and services will be set out later in this decision.

4. The opponent claims that the marks are highly similar and that the goods and services are identical or highly similar, giving rise to a likelihood of confusion.

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<sup>1</sup> On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result, the opponent’s UK00915145279 mark was automatically converted into a comparable UK trade mark. The comparable trade mark shown here is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law and retains its original filing date.

5. The opponent's above trade marks have filing dates that are earlier than the filing date of the application and, therefore, are earlier marks, in accordance with Section 6 of the Act. As the opponent's marks had not completed their registration process more than 5 years before the filing date of the applicant's mark, they are not subject to the proof of use provisions contained in Section 6A of the Act. The opponent can, therefore, rely on all the goods and services it has identified.

6. The applicant filed a defence and counterstatement, denying the claims made. For the sake of completeness, I note that a request for proof of use was filed with the applicant's Form TM8, however, neither earlier mark qualifies for proof of use. I will therefore disregard the applicant's request.

7. The applicant's counterstatement made the following points:

- A. First, the applicant is a provider of video games and intends to use the mark 'BUBBLE ROCKET' in relation to a video game that is in the design phase;
- B. Second, the applicant believes that the opponent has been "*overzealous in this opposition and has stretched [its] mark into a claim, which is unfounded*". It is alleged that the opponent is using its position as a large corporation to stop any mark that has one term that is identical to its [BUBBLE] mark from being used in the context of a completely different mark. The applicant does not believe that the marks are similar and/or that there would be likelihood of confusion. The term 'ROCKET' after the term 'BUBBLE' makes the applicant's mark highly distinctive and different from the opponent's mark, so as to exclude any likelihood of confusion;
- C. Third, the opponent uses the term 'BUBL' in relation to a cartoon or fictious character that allows its customers to use it as an automated answering tool where customers may have questions about the opponent's services;
- D. Fourth, the applicant does not believe that the marks cut across the same set of goods;

- E. Fifth, there is a dilution of the brand name 'BUBBLE' and 'BUBL' to a certain degree given that there are many other marks on the UK register that contain the term 'BUBBLE' or 'BUBBL' in relation to the same goods covered by the opponent's marks, which coexist with the opponent's marks without any issues;
- F. Sixth, the applicant relies on the fact that 'BUBBLE' is a descriptive term and on the judgement in *Oatly AB & Anor v Glebe Farm Foods Ltd* [2021] EWHC 2189 (IPEC) where it was found that the term 'OAT' would be seen by the average consumer as merely descriptive.

8. The opponent did not file any evidence. The applicant attempted to file some evidence, however, due to a number of shortcomings in the evidence filed, it was deemed inadmissible. The applicant was afforded an opportunity to produce amended evidence or request a Case Management Conference ("CMC") but did not take this opportunity. Consequently, whatever the applicant attempted to file, it will not form part of these proceedings.

9. A hearing took place before me on 16 August 2023, by video conference. The applicant was represented by Mr Mo Abbas of Trademark Brothers Ltd. The opponent was represented by Mr Julius Stobbs of Stobbs.

## **EU Law**

10. Although the UK has left the EU, 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.

## **DECISION**

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

11. 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”.

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

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

13. The following principles are gleaned from the decisions of the EU courts 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.

### **My approach**

14. At the hearing Mr Stobbs stated that the opponent's best case is on the basis of the '279 mark and that, for procedural efficiency, he would focus on that mark. He also confirmed that the specifications of the two earlier marks are pretty much identical. I will therefore limit my considerations to the '279 mark and, if it becomes necessary, I will return to the other mark.

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

15. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union ("CJEU") stated that:

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

16. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* ("*Treat*") [1996] RPC 281. At [296], he identified the following relevant factors:

- (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.

17. The General Court (“GC”) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa.

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

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

19. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between the goods/services is to assess whether the relevant public are liable to believe that the responsibility for the goods/services lies with the same undertaking or with economically connected

undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

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

20. Whilst on the other hand:

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

21. The goods and services to be compared are as follows:

**Class 9: Computer software for social networking and interacting with online communities; downloadable computer software for modifying the appearance and enabling transmission of photographs; computer software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; computer software, namely, an application providing social networking functionalities; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks; downloadable computer software for viewing and interacting with a feed of images, audio, audio-visual and video content and associated text and data; downloadable computer software for finding content and content publishers, and for subscribing to content; Software; Electronic databases recorded on computer media; Electronic publications recorded on computer media; Digital books downloadable from the Internet; Prerecorded CD-ROMs; E-books; Downloadable graphics for mobile phones; Downloadable electronic books; Electronic publications, downloadable, relating to games and gaming; Downloadable information relating to games and gaming; Multi-media recordings; Video recordings; Games software; Downloadable electronic game programs; Computer games (software); computer game software; Downloadable electronic games; Video**

game software; Interactive multimedia computer game programs; Games software for use on mobile phones, tablets and other electronic mobile devices; Games software downloadable to mobile phones, tablets and other electronic mobile devices; Applications software featuring computer games; Audio speakers; Computer game software and manuals in electronic format sold as a unit; Computer game software downloadable via a global computer network and wireless devices; Computer game software for use on mobile and cellular phones; Downloadable audio-visual files featuring books, music, films, movies, television programs and audio-visual entertainment content in the field of action, animation and adventure via a global computer network and wireless communication devices; Headphones; Headsets for use with computers; In-ear headphones; Interactive computer game programs; Interactive video game programs; Sleeves for laptops; Gaming headsets for use in playing video games; Videogame program software that allows users to create, modify, upload, download, share, preview, and publish user created interactive video game content, music, and other media files; Downloadable mobile applications featuring interactive gaming content and software; Mobile applications; Mobile applications in the field of gaming; Software for the development of applications for personal computers, mobile digital electronic devices, PDAs and mobile telephones; Computer game software and entertainment software in the nature of computer games for use on mobile and cellular phones, handheld computers, computers, video game consoles, both handheld and free standing, and other wireless POS (point of service) devices; Computer programs, involving character recognition, voice recognition, touch sensitivity, sensitivity to light, sensitivity to gravity; Software for computer games for electronic computing apparatus, incorporating interactive and multimedia functions, allowing users to integrate text, audio, graphics, and still and moving images; Computer game software; Downloadable software for the development, design, modification, recording or customising of sound and speech; Downloadable software for the development, design, modification, recording or customising of video, computer and online games; Downloadable software for video games with voice and touch control; Software for enabling computer video and online games to be run on multiple platforms; Helmets and equipment for virtual reality for use in video games; Augmented reality game software; Virtual reality game

software; Computer game programs with artificial intelligence; Virtual reality computer game programmes; Virtual reality headsets adapted for use in playing video games; Computer software for detecting a user's location and displaying relevant local information of general interest; Computer software enabling users to view information about locations, events, and points of interest; Downloadable electronic game programs and computer software platforms for social networking; Augmented reality computer hardware; Augmented reality game software; Augmented reality glasses; Augmented reality headsets; Augmented reality software; Augmented reality computer game software; Augmented reality software for playing computer games; Augmented reality software for use in mobile devices; Augmented reality software for use in mobile devices for integrating electronic data with real world environments; Computer software in the nature of an application programming interface (API) for computer software which facilitates online services for social networking, building social networking applications and for allowing data retrieval, upload, download, access and management; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks.

22. The opponent's registration in class 9 covers the following goods:

*Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus; apparatus for the transmission of sound and image; telecommunications apparatus; mobile telecommunication apparatus; mobile telecommunications handsets; digital telecommunication apparatus and instruments; digital tablets; computer hardware; computer*

*application software; computer software downloadable from the Internet; recorded computer software; software applications; mobile software applications, downloadable applications for multimedia devices; computer games; computer game software; computer games programs; PDAs (Personal Digital Assistants); pocket PCs; mobile telephones; laptop computers; telecommunications network apparatus; drivers software for telecommunications networks and for telecommunications apparatus; protective clothing; protective helmets; televisions; headphones; global positioning system [GPS] apparatus; satellite navigation devices; computer software recorded onto CD Rom; SD-Cards (secure digital cards); glasses; spectacle glasses; sunglasses; protective glasses and cases therefor; contact lenses; cameras; camera lenses; MP3 players; audio tapes, audio cassettes; audio discs; audio-video tapes; audio-video cassettes; audio-video discs; video tapes; video cassettes; video discs; CDs, DVDs; downloadable electronic publications; downloadable image files; downloadable music files; mouse mats; magnets; mobile telephone covers; mobile telephone cases; hands free kits for phones; magnetic cards; encoded cards; mobile phone application software; software for telecommunication; software for the processing of financial transactions; electronic notice boards; electric batteries; battery chargers; security alarms; security cameras; security warning apparatus; security control apparatus; security surveillance apparatus; computer software for security purposes; computer software for insurance purposes; SIM cards; aerials; alarms; electric cables; chemistry apparatus and instruments; recorded computer operating programs; computer peripheral devices; data processing apparatus; diagnostic apparatus, not for medical purposes; distance measuring apparatus; distance recording apparatus; downloadable ring tones for mobile phones; electronic tags for goods; eyepieces; goggles for sports; magnetic identity cards; intercommunication apparatus; loudspeakers; magnetic data media; mathematical instruments; modems; electric monitoring apparatus; television apparatus; testing apparatus not for medical purposes; telecommunication transmitters; parts and fittings for all the aforesaid goods; none of the aforementioned goods in relation to mobile marketing services or geolocation based advertising.*

23. The opponent's specification covers *computer software* at large. It also covers *computer application software; computer software downloadable from the Internet; recorded computer software; software applications; mobile software applications, downloadable applications for multimedia devices; computer game software; computer games; computer games programs.*

24. Whilst the opponent's specification contains the limitation "*none of the aforementioned goods in relation to mobile marketing services or geolocation-based advertising*", none of the applicant's goods relate to mobile marketing services or geolocation-based advertising. Hence, the opponent's terms are sufficiently broad to encompass the following goods in the application, which are various types of computer software, mobile applications, computer programs, computer games and computer game programs and fall within the opponent's broader terms:

*Computer software for social networking and interacting with online communities; downloadable computer software for modifying the appearance and enabling transmission of photographs; computer software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; computer software, namely, an application providing social networking functionalities; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks; downloadable computer software for viewing and interacting with a feed of images, audio, audio-visual and video content and associated text and data; downloadable computer software for finding content and content publishers, and for subscribing to content; Software; Games software; Downloadable electronic game programs; Computer games (software); computer game software; Downloadable electronic games; Video game software; Interactive multimedia computer game programs; Games software for use on mobile phones, tablets and other electronic mobile devices; Games software downloadable to mobile phones, tablets and other electronic mobile devices; Applications software featuring computer games; Computer game software and manuals in electronic format sold as a unit; Computer game software downloadable via a global computer network and wireless devices;*

Computer game software for use on mobile and cellular phones; Interactive computer game programs; Interactive video game programs; Videogame program software that allows users to create, modify, upload, download, share, preview, and publish user created interactive video game content, music, and other media files; Downloadable mobile applications featuring interactive gaming content and software; Mobile applications; Mobile applications in the field of gaming; Software for the development of applications for personal computers, mobile digital electronic devices, PDAs and mobile telephones; Computer game software and entertainment software in the nature of computer games for use on mobile and cellular phones, handheld computers, computers, video game consoles, both handheld and free standing, and other wireless POS (point of service) devices; Computer programs, involving character recognition, voice recognition, touch sensitivity, sensitivity to light, sensitivity to gravity; Software for computer games for electronic computing apparatus, incorporating interactive and multimedia functions, allowing users to integrate text, audio, graphics, and still and moving images; Computer game software; Downloadable software for the development, design, modification, recording or customising of sound and speech; Downloadable software for the development, design, modification, recording or customising of video, computer and online games; Downloadable software for video games with voice and touch control; Software for enabling computer video and online games to be run on multiple platforms; Augmented reality game software; Virtual reality game software; Computer game programs with artificial intelligence; Virtual reality computer game programmes; Computer software for detecting a user's location and displaying relevant local information of general interest; Computer software enabling users to view information about locations, events, and points of interest; Downloadable electronic game programs and computer software platforms for social networking; Augmented reality game software; Augmented reality software; Augmented reality computer game software; Augmented reality software for playing computer games; Augmented reality software for use in mobile devices; Augmented reality software for use in mobile devices for integrating electronic data with real world environments; Computer software in the nature of an application programming interface (API) for computer software which facilitates online services for social networking, building social

networking applications and for allowing data retrieval, upload, download, access and management; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks. **These goods are identical according to the principle outlined in *Meric*.**

25. For the sake of completeness, I should mention that in the course of his submissions, Mr Abbas raised a point about the breadth of the opponent's specification. He stated that the applicant tried to draft a narrow specification to overcome any objection referring, in so far possible, to the field of activity in which it operates, namely that of video games, games software and mobile applications in relation to games and video games. Mr Abbas seemed to suggest in oral submissions that Mr Stobbs's point about the applicant's software goods being identical to the opponent's *computer software* is wrong, although he did not really say why. Mr Abbas stated, in this connection, that the opponent's claim that the goods are identical is "*merely a hypernym*" and that "*the idea of drafting classification descriptions is all in the art of being able to be very specific and go in depth, in so far as to create distinction through the drafting of the classification descriptions*". He also mentioned the pending determination in *Sky v SkyKick* stating that "*time will tell whether the case will bear some relevance on [the opponent's] classification description.*"

26. Mr Abbas' points have no relevance.

27. First, the particular segment of the market in which the opponent has so far chosen to trade does not deprive the opponent's marks of the normal level of protection afforded to every registered trade mark, and I must consider notional and fair use of the opponent's mark across all segments of the markets for the goods and services for which it is registered.

28. Second, the long-running trade mark case *Sky v SkyKick* concerns circumstances in which a trade mark registration may be declared invalid for bad faith within the meaning of Section 3(6) of the Trade Marks Act 1994, on the basis that the applicant applied for a broad category of goods or services but did not intend to use the mark

on all items within that category. Whilst there is a pending appeal to the Supreme Court on the issue of whether overly broad specifications amount to bad faith, the final outcome of the decision in *Sky v SkyKick* is not relevant here. This is because, even if the Supreme Court were to hold that overly broad specifications amount to bad faith, the validity of the opponent's mark would need to be challenged with an application for invalidity, and, at the moment, there is no challenge to the validity of the opponent's mark.

29. Electronic publications recorded on computer media; Digital books downloadable from the Internet; E-books; Downloadable electronic books; Electronic publications, downloadable, relating to games and gaming; downloadable audio-visual files featuring books, music, films, movies, television programs and audio-visual entertainment content in the field of action, animation and adventure via a global computer network and wireless communication devices; Downloadable information relating to games and gaming; Multi-media recordings; Video recordings; Downloadable graphics for mobile phones. These goods are all encompassed by the opponent's broad terms *downloadable electronic publications; downloadable image files; downloadable music files*. **These goods are identical according to the principle outlined in *Meric*.**

30. Alternatively, if *downloadable audio-visual files featuring books, music, films, movies, television programs and audio-visual entertainment content in the field of action, animation and adventure via a global computer network and wireless communication devices; Multi-media recordings; Video recordings* are not identical to *downloadable electronic publications; downloadable image files; downloadable music files*, they would still be similar (to a at least a medium degree) to the opponent's *computer software downloadable from the Internet* which includes movie and media player software for playing the applicant's audio-visual files and recordings. The goods have the same purpose, i.e. they allow users to access audio-visual files and/or recordings, target the same users, share trade channels and are complementary.

31. Audio speakers; Headphones; Headsets for use with computers; In-ear headphones; Gaming headsets for use in playing video games; Virtual reality headsets adapted for use in playing video games; Augmented reality headsets. These goods

are all encompassed by the opponent's broad term *headphones, loudspeakers and apparatus for recording, transmission or reproduction of sound or images*. **These goods are identical according to the principle outlined in Meric.**

32. Augmented reality computer hardware. These goods are encompassed by the opponent's broad term *computer hardware*. **These goods are identical according to the principle outlined in Meric.**

33. The opponent's specification cover *laptop computers* which are similar to the applicant's sleeves for laptops. Although the goods have a different nature and purpose, they target the same user, share trade channels and are complementary. Likewise, the applicant's helmets and equipment for virtual reality for use in video games; augmented reality glasses and the opponent's *computer games* are highly complementary, target the same users and share trade channels. **These goods are similar to a low to medium degree.**

34. Electronic databases recorded on computer media. The opponent's *computer software downloadable from the Internet* includes software for reading the applicant's *electronic databases recorded on computer media*. The goods have the same purpose, i.e. they allow users to access electronic databases, target the same users and are complementary. **These goods are similar to a medium degree.**

35. Prerecorded CD-ROMs. These goods encompass the opponent's *computer software recorded onto CD Rom*. **These goods are identical according to the principle outlined in Meric.**

**Class 35: Electronic commerce services, namely, providing information about video game and computer game software products via telecommunication networks for advertising and sales purposes; Online retail store services in relation to video game and computer game software products and services; subscription services, namely, providing subscriptions to text, data, image, audio, video, and multimedia content in the nature of publications and computer games, provided via the Internet and other electronic and communications networks; Providing subscriptions to downloadable pre-recorded text, data,**

image, audio, video, and multimedia content in the nature of publications and computer games and for a fee or pre-paid subscription, via the Internet and other electronic and communications networks; Advertising; Business management; Business administration; Office functions; Marketing services; Promotion services; Dissemination of advertising for others via computer and communication networks; Promoting the goods and services of others via computer and communication networks; Online advertisements; Business consultation regarding marketing activities; Design of advertising materials; Advertising services for tracking advertising performance, for managing, distributing and serving advertising, for analysing advertising data, for reporting advertising data, and for optimizing advertising performance; Commercial information services; Advertisement targeting; Management of electronically stored advertising; Facilitating the exchange and sale of services and products of third parties via computer and communication networks; Retail, wholesale and online retail services relating to computer hardware, computer software, magnetically encoded gift cards, computer peripheral devices, computers, mobile devices, wearable peripherals for computers, tablet computers, mobile devices and mobile telephones, computer peripherals, video game equipment, telecommunications equipment, smartphones, handheld computers, computer tablets, amusement and video game machines; Business networking; Compilation of online computer databases and online searchable databases; Organising exhibitions and events in the field of software and hardware development for commercial or advertising purposes; Association services that promote the interests of professionals and businesses in the field of mobile software application development; Incentive award programs for software developers; Online business networking services; Online business networking services accessible by means of downloadable mobile applications; Providing information in the form of databases featuring information in the fields of online business networking; Information, advisory and consultancy services relating to all of the aforesaid.

36. The opponent's specification in class 35 covers the following services:

*Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; retail services and online retail services connected with the sale of scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images; retail services and online retail services connected with the sale of magnetic data carriers, recording discs, compact discs, DVDs and other digital recording media, mechanisms for coin-operated apparatus, cash registers, calculating machines, data processing equipment, computers, computer software, fire-extinguishing apparatus, apparatus for the transmission of sound and image, telecommunications apparatus, mobile telecommunication apparatus, mobile telecommunications handsets; retail services and online retail services connected with the sale of digital telecommunication apparatus and instruments, digital tablets, computer hardware, computer application software, computer software downloadable from the Internet, recorded computer software, software applications, mobile software applications, downloadable applications for multimedia devices, computer games, computer game software, computer games programs, PDAs (Personal Digital Assistants); retail services and online retail services connected with the sale of pocket PCs, mobile telephones, laptop computers, telecommunications network apparatus, drivers software for telecommunications networks and for telecommunications apparatus, protective clothing, protective helmets, televisions, headphones, global positioning system [GPS] apparatus, satellite navigation devices, computer software recorded onto CD Rom, SD-Cards (secure digital cards), glasses, spectacle glasses, sunglasses; retail services and online retail services connected with the sale of protective glasses and cases therefor, contact lenses, cameras, camera lenses, MP3 players, audio tapes, audio cassettes, audio discs, audio-video tapes, audio-video cassettes, audio-video discs, video tapes, video cassettes, video discs, CDs, DVDs, downloadable electronic publications, downloadable image files, downloadable music files, mouse mats, magnets, mobile telephone covers, mobile telephone cases; retail*

*services and online retail services connected with the sale of hands free kits for phones, magnetic cards, encoded cards, mobile phone application software, software for telecommunication, software for the processing of financial transactions, electronic notice boards, electric batteries, battery chargers, security alarms, security cameras, security warning apparatus, security control apparatus, security surveillance apparatus, computer software for security purposes; retail services and online retail services connected with the sale of computer software for insurance purposes, SIM cards, aerials, alarms, electric cables, chemistry apparatus and instruments, recorded computer operating programs, computer peripheral devices, data processing apparatus, diagnostic apparatus, not for medical purposes, distance measuring apparatus, distance recording apparatus, downloadable ring tones for mobile phones, electronic tags for goods; retail services and online retail services connected with the sale of electronic tags for goods, eyepieces, goggles for sports, magnetic identity cards, intercommunication apparatus, loudspeakers, magnetic data media, mathematical instruments, modems, electric monitoring apparatus, television apparatus, testing apparatus not for medical purposes, telecommunication transmitters, paper, cardboard, printed matter, photographs, stationery; retail services and online retail services connected with the sale of office requisites, instructional and teaching material, packaging material, educational equipment, writing implements, writing instruments, writing materials, books, catalogues, cards, instruction manuals, magazines, mail order catalogues, newspapers, pamphlets, periodical publications, calendars, diaries, gift cards, labels, maps, printed publications, postcards, posters, printed tariffs, printed forms; retail services and online retail services connected with the sale of gift boxes, gift bags, clothing, footwear, headgear, household or kitchen utensils and containers, jewellery, precious stones, horological and chronometric instruments, musical instruments, apparatus for lighting, textiles and textile goods, leather and imitations of leather, handbags, rucksacks, purses, bags and sports bags, travel bags, backpacks, duffel bags; retail services and online retail services connected with the sale of boot bags, holdalls, wallets, purses, credit card holders, games and playthings, gymnastic and sporting articles, meat, fish, poultry, game, coffee, tea, cocoa, sugar, rice, beers, mineral waters, aerated waters and other non-alcoholic drinks, alcoholic beverages, matches;*

*retail services and online retail services relating to telecommunication goods, clothes shops, garden centres, foodstuffs, white goods, electric household and electronic household goods; arranging subscriptions to telecommunications for others; compilation and systemisation of information into computer databases; compilation of statistics; cost price analysis; arranging of competitions for advertising purposes; recruitment services; employment recruitment; employment consultancy; employment agencies; providing employment information; commercial administration of the licensing of the goods and services of others; commercial information and advice for consumers [consumer advice shop]; opinion polling; personnel recruitment; price comparison services; procurement services for others [purchasing goods and services for other businesses]; rental of advertising space; rental of advertising time on communication media; sales promotion for others; sponsorship search; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network; none of the aforementioned services in relation to mobile marketing services or geolocation based advertising.*

37. The following services in the applicant's specification are all advertising, business and office-related services. As such, they fall within the opponent's *advertising; business management; business administration; office functions*:

*Electronic commerce services, namely, providing information about video game and computer game software products via telecommunication networks for advertising and sales purposes; Advertising; Business management; Business administration; Office functions; Marketing services; Promotion services; Dissemination of advertising for others via computer and communication networks; Promoting the goods and services of others via computer and communication networks; Online advertisements; Business consultation regarding marketing activities; Design of advertising materials; Advertising services for tracking advertising performance, for managing, distributing and serving advertising, for analysing advertising data, for reporting advertising*

data, and for optimizing advertising performance; Advertisement targeting; Organising exhibitions and events in the field of software and hardware development for commercial or advertising purposes; management of electronically stored advertising. **These services are identical according to the principle outlined in *Meric*.**

38. The same goes for the applicant's business networking services, namely *Business networking; Online business networking services; Online business networking services accessible by means of downloadable mobile applications; Providing information in the form of databases featuring information in the fields of online business networking,* which fall within the opponent's *business management services*. If I am wrong, the services are similar to a medium degree. This is because business networking services help businesses expand by putting companies in contact and/or negotiation with each other and are usually provided by business consultants, which gets commission for such services. To this extent they have the same purpose as the opponent's business management services, coincide in providers and relevant public are share trade channels. **These services are either identical (*Meric*) or similar to a medium degree.**

39. The applicant's *incentive award programs for software developers* are encompassed by the opponent's *organisation, operation and supervision of loyalty and incentive schemes*. **These services are identical according to the principle outlined in *Meric*.**

40. The applicant's *online retail store services in relation to video game and computer game software products and services; retail, wholesale and online retail services relating to computer hardware, computer software, magnetically encoded gift cards, computer peripheral devices, computers, mobile devices, wearable peripherals for computers, tablet computers, mobile devices and mobile telephones, computer peripherals, video game equipment, telecommunications equipment, smartphones, handheld computers, computer tablets, amusement and video game machines* are identical to the opponent's retail services which include retail services relating to the sale of identical or highly similar goods, namely *gift cards, apparatus for the*

*transmission of sound and image, telecommunications apparatus, mobile telecommunication apparatus, mobile telecommunications handsets; digital telecommunication apparatus and instruments, digital tablets, computer hardware, computer application software, computer software downloadable from the Internet, recorded computer software, software applications, mobile software applications, downloadable applications for multimedia devices, computer games, computer game software, computer games programs, magnetic data carriers, pocket PCs, mobile telephones, laptop computers, telecommunications network apparatus, drivers software for telecommunications networks and for telecommunications apparatus, televisions, headphones.* **These services are identical according to the principle outlined in *Meric*.**

41. The applicant's *subscription services, namely, providing subscriptions to text, data, image, audio, video, and multimedia content in the nature of publications and computer games, provided via the Internet and other electronic and communications networks; Providing subscriptions to downloadable pre-recorded text, data, image, audio, video, and multimedia content in the nature of publications and computer games and for a fee or pre-paid subscription, via the Internet and other electronic and communications networks* fall within the opponent's *arranging subscriptions to telecommunications for others*. **These services are identical according to the principle outlined in *Meric*.**

42. The applicant's *compilation of online computer databases and online searchable databases* is identical to the opponent's *compilation and systemisation of information into computer databases*. **These services are identical.**

43. The applicant's *commercial information services* encompass the opponent's *commercial information and advice for consumers [consumer advice shop]*. **These services are identical according to the principle outlined in *Meric*.**

44. The applicant's *facilitating the exchange and sale of services and products of third parties via computer and communication networks* is in my view encompassed by the opponent's *sales promotion for others*. If not identical the services have the same purpose, i.e. helping businesses to sell their goods and services, target the same

users, share trade channels and are in competition. **These services are identical according to the principle outlined in *Meric* or are at least similar to a medium degree.**

45. The applicant's association services that promote the interests of professionals and businesses in the field of mobile software application development are **similar to a low degree** to the opponent's *sponsorship search*. The applicant's association services could in fact offer *sponsorship search* to their members so that the services would have a similar purpose, i.e. promote the interest of their associates, target the same users and share trade channels.

46. The applicant's information, advisory and consultancy services relating to all of the aforesaid are **identical** to the opponent's information and advisory services relating to the aforesaid services provided over a telecommunications network.

**Class 41: Entertainment in the nature of competitions in the field of computer and video games; Entertainment provided via mobile or cellular telephone and/or other wireless devices; Entertainment provided via the Internet or other computer network; Online gaming services; Production and distribution of short video or audio recordings; Providing a web site featuring musical performances, musical videos, film clips, photographs and other multimedia entertainment; Providing a web site featuring video and audio recordings made within computer games; Providing computer and video games accessed and played via mobile and cellular phones and other wireless devices; Providing downloadable audio and video files in the field of entertainment relating to interactive computer game software, interactive video game software and interactive computer and video games; Providing touch and voice driven games for electronic digital mobile devices; Providing games for use on mobile devices; Providing news and information in the field of entertainment regarding interactive computer game software, interactive video game software and interactive computer and video games, via electronic, wireless and computer networks; Providing online computer and video games accessed and played via electronic, Wireless and computer networks; Providing online entertainment in the nature of multiplayer tournaments; The creation, production and distribution**

**of films, videos, animation, and computer generated images; Electronic games services, including provision of computer games on line, on social networks, or by means of a global computer network; Providing electronic games for use on mobile phones, tablets and other electronic mobile devices; Providing enhancements within online computer and electronic games; Providing electronic games for download to mobile phones, tablets and other electronic mobile devices; Providing interactive single and multi-player electronic games via the internet, electronic communication networks or via a global computer network; Publishing of computer game software, electronic games and video game software; Entertainment services, namely, providing online computer games; Educational explainer videos in the field of online gaming and gaming on portable devices such as tablets and mobile phones; Entertainment services, namely, providing a website featuring non-downloadable videos featuring live video game tournaments played by video game players; Providing online computer games; Production of flash animations; Game services provided online from a computer network; Organisation of exhibitions for cultural or educational purposes; Arranging and conducting of congresses; Presentation of live performances; Gaming; Gaming services; Providing online video games [entertainment services]; Rental of video games.**

47. The opponent's specification in class 41 covers the following services:

*Education; providing of training; entertainment; sporting and cultural activities; academies [education]; amusement parks; amusements; arranging and conducting of colloquiums; arranging and conducting of concerts; arranging and conducting of conferences; arranging and conducting of congresses; arranging and conducting of seminars; arranging and conducting of symposiums; arranging and conducting of workshops [training]; arranging of beauty contests; booking of seats for shows; cinema presentations; club services [entertainment or education]; coaching [training]; discotheque services; education information; educational examination; electronic desktop publishing; entertainer services; entertainment information; organisation of fashion shows for entertainment purposes; film production, other than advertising films; gambling; game services provided on-line from a computer*

*network; games equipment rental; health club services [health and fitness training]; holiday camp services [entertainment]; music-halls; news reporters services; organization of shows [impresario services]; organization of sports competitions; party planning [entertainment]; personal trainer services [fitness training]; physical education; practical training [demonstration]; production of music; production of radio and television programmes; production of shows; providing amusement arcade services; providing karaoke services; providing on-line electronic publications, not downloadable; providing sports facilities; publication of books; publication of electronic books and journals on-line; publication of texts, other than publicity texts; radio entertainment; recording studio services; providing recreation facilities; sport camp services; subtitling; television entertainment; theatre productions; ticket agency services [entertainment]; timing of sports events; tuition; interactive entertainment services; electronic games services provided by means of any communications network; entertainment services provided by means of telecommunication networks; information services relating to education, training, entertainment, sporting and cultural activities provided by means of telecommunication networks; provision of news information; television production services; television programming services; television production and television programming services provided by means of Internet protocol technology; provision of musical events; entertainment club services; discotheque services; presentation of live performances; night clubs; rental of music venues and stadiums; casino services; ticket reservations for entertainment, sporting and cultural events; ticket information services for entertainment, sporting and cultural events; ticket agency services for entertainment, sporting and cultural events; provision of on-line computer games; rental of computer games programs; computer amusement services; provision of information, news and commentary in the field of computer games; arranging, organising and conducting computer game competitions; publishing services; providing on-line electronic publications, not downloadable; publication of books; publication of electronic books and journals on-line; publication of texts, other than publicity texts; arranging, organising and conducting of competitions, games and quizzes; arranging, organising and conducting of competitions, games and quizzes for entertainment, recreational, cultural and educational purposes;*

*organisation of awards; conducting of phone-in competitions; issuing of tickets for entertainment events; employment training; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network; none of the aforementioned services in relation to mobile marketing services or geolocation based advertising.*

48. Most of the applicant's services in class 41 are entertainment services relating to gaming services. The applied-for specification also includes other services such as *presentation of live performances; organisation of exhibitions for cultural or educational purposes; arranging and conducting of congresses; creation, production and distribution of films, videos, animation, and computer-generated images; providing news and information in the field of entertainment regarding interactive computer game software, interactive video game software and interactive computer and video games, via electronic, wireless and computer networks.* The applicant's services all fall within the opponent's broader term *entertainment, education, sporting and cultural activities, academies [education], arranging and conducting of concerts; film production, other than advertising films; production of radio and television programmes.* Further, the opponent's specification in class 41 include services which are self-evidently identical to the applicant's services, for example *electronic games services provided by means of any communications network; entertainment services provided by means of telecommunication networks; provision of on-line computer games; computer amusement services; provision of information, news and commentary in the field of computer games; arranging, organising and conducting of competitions, games and quizzes.* **All of the applicant's services in class 41 are either self-evidently identical to the opponent's services in the same class or are identical on the principle outlined in *Meric*.**

**Class 42: Computer software design; Rental of computer software; Technical services for the downloading of video games; Providing a website and web based services for online management of personal computer game software; Software as a service, namely, software for recording time in computer games**

and video games, software for displaying in-game data and scores, software for recording computer game and video game footage, software for taking screenshots of computer games and video games, software for computer game and video game enhancers; Software as a service [SaaS]; Platform as a service [PaaS]; Software development in the framework of software publishing; Information technology [IT] consultancy; Installation of computer software; Computer software consultancy; Computer virus protection services; Providing search engines for the internet; Monitoring of computer systems by remote access; Web site design consultancy; Computer game design; Electronic data storage; Cloud computing; Outsource service providers in the field of information technology; Computer technology consultancy; Computer security consultancy; Graphic arts design; Industrial design; Styling [industrial design]; Programming of video games; Video game development services; Video game software design; Design of video game software; Development of video game software; Programming of video game software; Providing temporary use of non- downloadable video game development software; Design of games; Design, development, and maintenance of computer games software, video games, downloadable games, electronic games; Hosting of online game sites; Computer software technical support services; Providing online information about the use of computers and software; Providing online support services for computer software and game software users; Maintenance and updating of computer software and game software; Software advisory and consultancy services; Advisory and consultancy services relating to computer software and game software; Hosting online facilities for conducting interactive discussions; Providing a website and web based services for online management of personal computer game software; Providing a web site that gives users the ability to upload photographs; computer services, namely, providing an interactive web site featuring technology that allows users to manage their online photograph and social networking accounts; Computer services, namely, creating virtual communities for registered users to participate in discussions and engage in social, business and community networking; Application service provider (ASP) featuring software to enable or facilitate the uploading, downloading, streaming, posting, displaying, linking, sharing or otherwise providing electronic media or information over communication networks; Providing a web site featuring

**technology that enables online users to create personal profiles featuring social networking information; Providing temporary use of non-downloadable software applications for social networking, creating a virtual community, and transmission of audio, video, photographic images, text, graphics and data; Computer software development; Computer software development services; Developing computer software; Development of computer software.**

49. The opponent's specification in class 42 covers the following services:

*Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; calibration [measuring]; cloud seeding; computer programming; computer rental; computer software consultancy; computer software design; updating of computer software; computer system analysis; computer system design; construction drafting; consultancy in the design and development of computer hardware; consultancy in the field of energy-saving; conversion of data or documents from physical to electronic media; creating and maintaining web sites for others; data conversion of computer programs and data [not physical conversion]; digitization of documents [scanning]; duplication of computer programs; engineering; hosting computer sites [web sites]; industrial design; installation of computer software; scientific laboratory services; land surveying; maintenance of computer software; material testing; mechanical research; monitoring of computer systems by remote access; packaging design; technical project studies; providing search engines for the internet; provision of scientific information, advice and consultancy in relation to carbon offsetting; quality control; recovery of computer data; rental of computer software; rental of web servers; research and development for others; surveying; technical research; it services; computer programming services; services of a programmer; recovery of computer data; consultancy in the field of computer hardware; rental of computer hardware; application service provider (ASP); consultancy in the field of computer software; creating and maintaining blogs for others; services of engineers; expert advice and expert opinion relating to technology; rental of data processing apparatus and computers; technical services relating to projection and planning of equipment*

*for telecommunications; services of information brokers and providers, namely product research for others; weather forecasting; research in the field of telecommunication technology; monitoring of network systems in the field of telecommunications; technical support services relating to telecommunications and apparatus; data security services; data security services [firewalls]; research relating to security; computer security system monitoring services; maintenance of computer software relating to computer security and prevention of computer risks; updating of computer software relating to computer security and prevention of computer risks; computer virus protection services; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network; none of the aforementioned services in relation to mobile marketing services or geolocation based advertising.*

50. The applicant's services in class 42 are computer and IT-based services some of which relate to video games. The services include *computer software design, rental of computer software, software as a service, platform as a service, application service provider (ASP), providing a website and web based services, data storage, cloud computing, industrial and graphic arts design, programming, development and maintenance of computer game software, hosting online gaming websites, computer-related information, advisory and consultancy services* and so on. Many of the services listed in the applicant's specification are self-evidently identical to the registered services, which include, for example *computer rental, computer software consultancy, computer software design, updating of computer software, creating and maintaining web sites for others, industrial design, maintenance of computer software, services of a programmer and application service provider (ASP)*. In addition, all of the applied-for services in class 42 fall within the opponent's broad terms *it services; scientific and technological services and research and design relating thereto; design and development of computer hardware and software; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet*. **All of the applicant's services in class 42 are either self-evidently**

**identical to the opponent's services in the same class or are identical on the principle outlined in *Meric*.**

### **Average consumer**

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

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

52. The average consumer of the goods and service at issue is a member of the general public or a business user. The purchasing process is likely to be dominated by visual considerations. However, I do not discount aural considerations entirely as it is possible that the purchasing process would involve oral discussions with sales representatives or word of mouth recommendations. The degree of attention may vary from medium to high, depending on the specialised nature of the goods and services, the frequency of the purchase and the price.

### **Comparison of marks**

53. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual

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

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

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

The applicant's mark	The opponent's mark
BUBBLE ROCKET	BUBBLE

55. The opponent's mark is a word-only mark consisting of the word 'BUBBLE' presented in upper-case letters. The overall impression lies in the word itself.

56. The applicant's mark consists of the two words 'BUBBLE' and 'ROCKET' presented in upper-case letters with no additional stylisation.

*The parties' submission on whether the element 'BUBBLE' retains an independent distinctive role in the composite mark 'BUBBLE ROCKET'*

57. An essential submission that was pressed upon me at the hearing by Mr Stobbs was that 'BUBBLE' is "*the first and dominant element*" of the mark 'BUBBLE ROCKET' and retains an independent distinctive role within the mark. Mr Stobbs stated (quoted from his skeleton argument):

*"The BUBBLE element continues to be recognised as a word in its own right, and the addition of ROCKET does not alter the meaning or visual nature of the BUBBLE element. It is clear that the BUBBLE ROCKET mark is not a composite mark where the BUBBLE element loses its independence. The two words BUBBLE and ROCKET are not ones that naturally hang together and there is not clear composite meaning. As such, it is clear that consumers would see the BUBBLE ROCKET mark as two words rather than one composite term."*

58. In this connection, Mr Stobbs referred me to the decision in *Next Retail v Ys Garments* BL-O-37919, where it was held by the hearing officer that there was no likelihood of confusion between the applicant's mark 'NEXT LEVEL' and the opponent's mark 'NEXT'. In that case, it was held that the term 'NEXT' did not retain an independent distinctive role within the mark 'NEXT LEVEL' because the latter had a recognised meaning that served to change the meaning of the shared element 'NEXT'. Mr Stobbs took me to the passage in the decision where the hearing office discussed the difference between 'NEXT LEVEL' and 'NEXT SIGNATURE' (an example given by the opponent in that case):

"27. That then leads to indirect confusion. Ms Newnes' submissions on this front focused on the fact that NEXT could be seen as an independent element within NEXT LEVEL, with confusion arising as per the *Medion* case. She further argued that NEXT LEVEL could be seen as a variant brand, in a similar way to the way in which the opponent has made use of the mark NEXT SIGNATURE, in relation to some of its goods. Mr Stobbs argued that *Medion* did not apply because NEXT did not perform an independently distinctive role in NEXT LEVEL and, further, that the construction of NEXT LEVEL, and its known concept, meant that it would not be seen as a variant brand. In relation to the NEXT SIGNATURE argument, he submitted that this was not on a par.

28. I agree with Mr Stobbs that this is not a true *Medion* scenario. Arnold J provided guidance on the application of *Medion* (and other cases) in *Whyte and MacKay Ltd v Origin Wine UK Ltd & Anor* [2015] EWHC 1271 (Ch) (06 May 2015)

[...]

29. Given what I have already said about the conceptual significance of NEXT LEVEL, I come to the view that NEXT within NEXT LEVEL would not be perceived as having distinctive significance independently of the whole – this is because the average consumer would perceive NEXT LEVEL as a unit having a different meaning to the meaning of the word NEXT separately.

30. That NEXT (within NEXT LEVEL) does not have independent distinctive significance is not the end of the matter. Indirect confusion could still be found if the average consumer assumes that the inclusion of the word NEXT within NEXT LEVEL is indicative of a same stable product. Ms Newnes gave NEXT SIGNATURE as an example. Such a phrase could also be seen as a unit, but she argued that it would still be regarded (and in fact is used and regarded) as a NEXT variant brand. Whilst I understand the argument, I do not agree that NEXT LEVEL would be seen in the same way. This is because SIGNATURE is a known term often used to indicate a designer's signature range, with the consequence that NEXT SIGNATURE (irrespective that the words could still form a unit) might be perceived as NEXT's SIGNATURE range. The same does not apply to NEXT LEVEL, what would be NEXT's LEVEL range? Ms Newnes further argued that the average consumer, aware of the opponent's reputation, would simply see the reference to NEXT LEVEL as indicating NEXT's high quality (surpassing all others) range. Again, I understand the argument, but I think this would require too great a level of mental arithmetic to reach that view".

59. Whilst I understand why Mr Stobbs' referred to the above example, it is not particularly useful to try to identify factual analogy with other cases, or cite previous decisions, on a question of fact such as whether an element of a mark retains an independent distinctive role within a composite mark – which is something that has to be decided before answering the question of whether there is a likelihood of confusion.

60. Mr Stobbs also relied on the judgments in *Medion*, *Bimbo* and *Aveda*. I do not think it is necessary to discuss these cases in any depth, but it is sufficient to note that in all those cases the independent distinctive role was found to be present.

61. In *Medion*<sup>2</sup> it was held that the earlier registered mark 'LIFE' was infringed by use of the composite sign 'THOMSON LIFE' because the earlier mark retained an "independent distinctive role". In *Bimbo*<sup>3</sup> it was held that most Spanish consumers would perceive the word 'DOUGHNUT' as a foreign or fantasy term which leads to an assessment in which 'DOUGHNUTS' was deemed to play an independent distinctive role within the composite mark 'BIMBO DOUGHNUTS' giving rise to a likelihood of confusion in Spain. Finally, in *Aveda*<sup>4</sup> the High Court found that there was a likelihood of confusion between the trade marks 'DABUR UVEDA' and 'AVEDA' on the basis that the average consumer would perceive 'UVEDA' to have significance independently of 'DABUR UVEDA' and would misread or mishear 'UVEDA' as 'AVEDA'.

62. These cases are all authority for the proposition that the determinative criteria is whether the composite mark forms a unit having a different meaning as compared to its components taken separately. In *Bimbo* the principle was explained as follows (my emphasis):

"24. In this connection, the Court of Justice has stated that it is possible that an earlier mark used by a third party in a composite sign that includes the name of the company of the third party retains an independent distinctive role in the composite sign. Accordingly, in order to establish the likelihood of confusion, it suffices that, on account of the earlier mark still having an independent distinctive role, the public attributes the origin of the goods or services covered by the composite sign to the owner of that mark (Case C- 120/04 *Medion* EU:C:2005:594, paragraphs 30 and 36, and order in Case C- 353/09 P *Perfetti Van Melle v OHIM* EU:C:2011:73, paragraph 36).

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<sup>2</sup> Case C-120/04 *Medion AG v Thomson*

<sup>3</sup> Case C 591/12 P *BIMBO SA V OHIM*

<sup>4</sup> *Aveda Corporation v Dabur India Ltd* [2013] EWHC 589 (Ch)

25. None the less, a component of a composite sign does not retain such an independent distinctive role if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately ...”

63. What these cases say was not in dispute at the hearing; what seemed to be in dispute was the result of applying the guidance from these cases to the facts.

64. Mr Stobbs’s view was that the average consumer would perceive ‘BUBBLE’ to have significance independently of ‘BUBBLE ROCKET’ as a whole because there is no blend of meaning given by the composite mark against the single term.

65. Mr Abbas attempted to counter Mr Stobbs’ argument by referring to the cases in C-334/05<sup>5</sup> (*Shaker - Limoncello*) and BL-O-298-15, although he did not really expand on how these cases support the conclusion that ‘BUBBLE’ does not retain an independent distinctive role in the composite mark ‘BUBBLE ROCKET’.

66. In *Shaker - Limoncello* Shaker filed a EUTM application for a mark depicting a dish decorated with lemons and the word ‘limoncello’ which was opposed based on an earlier mark for the word LIMONCHELO. The CJEU considered that the dominant element of Shaker’s mark was the decorated dish, and that therefore the marks were visually dissimilar and there was no likelihood of confusion with the earlier word mark.

67. In BL-O-298-15 the hearing officer decided that there was no likelihood of confusion between the marks ‘LIFE’ and ‘FRIENDS LIFE’ on the basis that that the words ‘FRIENDS LIFE’ “hang together” as a natural word combination, effectively rejecting the submission that ‘FRIENDS’ and ‘LIFE’ would be seen as two independently distinctive elements.

68. I do not think that the cases mentioned by Mr Abbas are close to the factual circumstances of the present case. Nor do I think that comparing the present

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<sup>5</sup> *European Union Intellectual Property Office v Shaker di L. Laudato & C. Sas*

opposition to these cases strengthens the applicant's argument that 'BUBBLE' is not independently distinctive in 'BUBBLE ROCKET'.

69. Finally, in his skeleton argument, Mr Abbas stated that *"the applicant is of the belief that the mark as a whole is not comparable to the opponent's earlier marks in the way they are said, heard, seen or conceptually"* because *"BUBBLE ROCKET in its own right is distinctive and does not have any meaning assigned to it other than meaning created and provided by the applicant amongst its consumers that will be looking at it in the guise of a video game production studio"*. This somehow goes against the oral submission made by Mr Abbas at the hearing that 'BUBBLE ROCKET' is a known term, claiming that a Google search would show that 'BUBBLE ROCKET' relates to toys. I have already addressed the latter submission at hearing. As I have explained, the notion that 'BUBBLE ROCKET' is a term used for toys is evidence. If the applicant wished to rely on the fact that 'BUBBLE ROCKET' is a composite term used to denote (or meaning) a toy, it should have filed evidence of fact – however, this has not been done. For the sake of completeness, I have searched the term 'BUBBLE ROCKET' on two online English dictionaries<sup>6</sup> which returned no results. This, in my view, assists Mr Stobbs' arguments that the elements 'BUBBLE' retains an independent distinctive role within the composite mark 'BUBBLE ROCKET' because there is no blend of meaning of the two terms. If, with his submission, Mr Abbas meant that 'BUBBLE ROCKET' has the meaning created by the applicant in relation to the name of a video game, that would not change the relevant test for determining whether an element of a composite mark is independently distinctive; but, in any event, even if I were to accept that consumers might recognise in the name of a video game an indication of origin, notional use of the opponent's mark would also cover use of 'BUBBLE' as the name of a video game.

70. Hence, I agree with the opponent that the message that the mark conveys corresponds to the meanings of the two words 'BUBBLE' and 'ROCKET' which remains the same (and separate) as if the words were perceived independently. However, I am not convinced that the element 'BUBBLE' is more distinctive than the element 'ROCKET' because being the applicant's mark made up of two words, the

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<sup>6</sup> Collins and Cambridge English dictionary

principle that consumers tend to focus on beginning of marks is not really applicable.<sup>7</sup> In my view, both words contribute equally to the overall impression of the mark. However, if the word 'ROCKET' is perceived as somehow evoking a laudatory meaning (see below), it would have slightly lesser weight in the overall impression conveyed by the mark.

### **Visual and aural similarity**

71. Visually and aurally, both marks include the word 'BUBBLE' which is the entirety of the earlier mark. The applicant's mark also includes the word 'ROCKET' which has no counterpart in the opponent's mark. Overall, the marks are visually and aurally similar to a medium degree.

### **Conceptual similarity**

72. The words 'BUBBLE' and 'ROCKET' are both dictionary words meaning "*small balls of air or gas in a liquid*" and "*a space vehicle that is shaped like a long tube*", respectively.<sup>8</sup>

73. As I have already said the word 'BUBBLE' in the applicant's mark will be perceived as independently distinctive because there is no blend of meaning given by the mark as a whole against the single terms. As the marks coincide in the concept of a 'BUBBLE', which will convey the same meaning in both marks, this creates a certain conceptual similarity between the marks. However, the presence of the word 'ROCKET' in the applicant mark introduces a conceptual difference. Overall, I consider the marks to be conceptually similar to a medium degree.

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

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

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<sup>7</sup> Combe International LLC & Anor v Dr August Wolff GmbH & Co KG Arzneimittel & Anor [2022] EWCA Civ 1562 at paragraph 120

<sup>8</sup> Collins online dictionary

“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).”

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

76. The opponent did not file any evidence of use in these proceedings. Hence, I only have the inherent distinctiveness of the earlier mark to consider.

77. In its skeleton argument Mr Abbas stated that there are numerous other marks on the register which contain the word ‘BUBBLE’ which points to a dilution of the opponent’s brand name and to co-existence with the opponent's mark without any issues. He also argued that the opponent “*also flaws all of its arguments on the basis*

*that they have allowed a mark, namely BUBBL under UKTM No. UK00003134612 to pass without any objection”.*

78. I reject these arguments. First, the applicant did not file any evidence of other registered marks containing the word ‘BUBBLE’, but, in any event, state of the register evidence is in principle irrelevant when considering the distinctiveness of a trade mark.<sup>9</sup> Second, and perhaps more importantly, there is no evidence that any of those allegedly registered marks are in use and that consumers have become accustomed to differentiating between them. Third, it is not open to me (or the applicant) to infer the reasons for the opponent’s decision to oppose or not oppose an application, simply on the basis of the state of the register, as this is a matter for the parties involved and the opponent is free to pursue its own commercial and/or legal strategies without this having an impact on its ability to protect the rights deriving from its trade mark registration(s).

79. The word ‘BUBBLE’ in the opponent’s mark is neither descriptive nor allusive of the goods and services in question and, as such, it has a medium degree of distinctiveness.

### **Likelihood of confusion**

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

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<sup>9</sup> *Zero Industry Srl v OHIM*, Case T-400/06

81. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. (as he was then) as the Appointed Person explained that:

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

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

82. These three categories are not exhaustive. Rather, they are intended to be illustrative of the general approach, as it was confirmed in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*<sup>10</sup> in which Court of Appeal stated:

“12. 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. For example, one category of indirect confusion which is not mentioned is where the sign complained of incorporates the trade mark (or a similar sign) in such a way as to lead consumers to believe that the goods or services have been co-branded and thus that there is an economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licensing)”.

83. Earlier in this decision I found that:

- Most of the applicant’s goods and services are identical to the goods and services of the earlier mark, whilst others are similar to various degree;
- The average consumer would be a member of the general public or a business user who would pay a degree of attention ranging from medium to high during the purchasing process. The purchasing process would be predominantly visual, although aural considerations cannot be excluded entirely;
- The overall impression of the earlier mark predominantly lies in the word ‘BUBBLE’, whilst the words ‘BUBBLE’ and ‘ROCKET’ make a roughly equal contribution to the distinctiveness of the applicant’s mark and the overall impression it conveys;

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<sup>10</sup> [2021] EWCA Civ 1207

- The applicant's mark 'BUBBLE ROCKET' does not form a unit having a different meaning as compared to its components taken separately. It follows from this that the word 'BUBBLE' retains an independent distinctive role in the applicant's mark;
- The marks are visually, aurally and conceptually similar to a medium degree;
- The opponent's 'BUBBLE' mark has a medium degree of inherent distinctive character, which has not been shown to have been enhanced through use.

84. Mr Stobb's position as regards the likelihood of confusion was that there could be direct confusion because the element 'ROCKET' in the applicant's mark could be overlooked, and the average consumer could simply confuse one mark for another.

85. Alternatively, Mr Stobbs argued that the element 'ROCKET' could be perceived by the average consumer as a non-distinctive addition of the kind which one would expect to find in a sub-brand or brand extension denoting "*a higher powered or more extreme version of the original 'BUBBLE' offering*" which would fall within the second category of indirect confusion identified by Mr Purvis. The last proposition advanced by Mr Stobbs was that 'BUBBLE ROCKET' could be seen as a natural development or logical extension of the brand 'BUBBLE' falling within the third category of indirect confusion listed by Mr Purvis.

86. Mr Abbas argued that there is no likelihood of confusion because consumers in today's day and age are savvy and are able to differentiate one undertaking from another. He also stated that consumers are aware of Search Engine Optimisation (SEO) and how to conduct searches using an internet browser and that when the term 'BUBBLE ROCKET' is searched on the Internet, "*no relevance or links appear for the opponent's company let alone the marks that relied upon for the purposes of their opposition*". Both points are irrelevant. The test as to whether there is a likelihood of confusion already considers that the average consumer is well informed and reasonably circumspect and observant, so Mr Abbas' comments about consumers being savvy cannot add anything to it. As to the SEO's argument, that is not the scenario in relation to which confusion must be assessed, the relevant scenario being

that of the average consumer who is already familiar with the opponent's mark coming across the applicant's mark for identical or similar goods and services.

87. During the course of his oral submissions, Mr Abbas also stated that he did not believe that the average consumer would see 'BUBBLE ROCKET' as a reference to an accelerated version of a software good, based on the analogy with the fact that a rocket is fast. He also reiterated his arguments that the average consumer will take a global appreciation of the term 'BUBBLE ROCKET' as a standalone term and that 'BUBBLE ROCKET' is a term. However, I have already rejected these arguments.

88. Having considered all of the above, my conclusion is that the addition of the word 'ROCKET' in the applicant's mark is sufficient to differentiate the marks in the mind of the consumer, even taking account the effects of imperfect recollection. In reaching this conclusion, I reject Mr Stobbs' argument that 'ROCKET' serves in a totally descriptive or non-distinctive way and that the only distinctive element of the applicant's mark is the word 'BUBBLE'.

89. Having said that, the fact that 'ROCKET' is not purely descriptive or non-distinctive and/or that in the composite expression 'BUBBLE ROCKET' the word 'BUBBLE' is not dominant, does not mean that there is no possibility of indirect confusion. Such a conclusion would evidently be in contrast with *Medion* (and with all the case-law that followed on from the test set out in *Medion*).

90. In my view, the word 'ROCKET' although it is not purely descriptive or non-distinctive, it has some laudatory connotations, being used as a synonym for something that rises, increases, or moves very quickly and/or being associated with the idea of something that can reach the space and/or with the image of fireworks. Whilst it is difficult to pin the concept down more specifically than that, adding to this the fact that the word 'ROCKET' appears in the applicant's mark after the independently distinctive word 'BUBBLE' (with which I must assume the relevant public is familiar), I think that the average consumer is likely to consider 'BUBBLE ROCKET' as variant mark which adds the term 'ROCKET' to the main brand 'BUBBLE'. The average consumer could, for example, conclude that the term 'ROCKET' suggests, in a metaphorical (rather than directly descriptive) way, some

extreme, advanced, high-performance or high-quality characteristics of the goods and services in question. Alternatively, the average consumer might assume that the mark 'BUBBLE ROCKET' indicates a cooperation between the brands 'BUBBLE' and the brand 'ROCKET'. Either way, there is a likelihood of indirect confusion.

### **Final remarks**

91. During the course of his oral submissions, Mr Abbas requested to file a fall-back specification. Mr Stobbs correctly pointed out that if a party intends to put forward a fall-back specification it must do so in good time before the hearing. I do not need to go into the details of the discussion that followed; it suffices to say that having agreed to give Mr Abbas a week to submit a fall-back specification, to date, nothing has been received.

### **OUTCOME**

**92. The opposition succeeds in its entirety. Subject to any appeal against this decision, the application will be refused.**

### **COSTS**

93. The opponent has been successful, so it is entitled to a contribution towards the costs incurred in these proceedings. At the hearing Mr Stobbs asked to take into account the fact that the applicant's representatives had caused unnecessary expenses by not complying with the Tribunal's directions and timetables. Whilst admittedly, the applicant requested a hearing after the deadline for making such a request had expired, filed skeleton argument late, and filed inadmissible evidence, I am not convinced that this warrants an award of costs off the scale (or a significant increase in the costs awarded to the opponent compared to what I would normally award in similar cases). I will therefore award costs to the opponent based on the guidance given in TPN 2/2016 as follows:

£100: Official fees

£400: Preparing a statement and considering the applicant's statement

£800: Attending a hearing

**£1,300: Total**

94. I therefore order BUBBLE ROCKET LIMITED to pay O2 Worldwide Limited the sum of **£1,300**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

**Dated this 12th day of September 2023**

**Teresa Perks**

**For the Registrar**