

O/0887/23

TRADE MARKS ACT 1994

IN THE MATTER OF THE REQUEST FOR PROTECTION
IN THE UK OF INTERNATIONAL REGISTRATION
NO. WO0000001617029
BY SUN AND THUNDER, LLC
FOR THE TRADE MARK:

SUN AND THUNDER

IN CLASSES 9, 41 & 42

AND

OPPOSITION THERETO
UNDER NO. 431158 BY
THUNDER PRODUCTIONS LIMITED

BACKGROUND & PLEADINGS

1. Sun and Thunder, LLC (“**the applicant**”) is the holder of the International Registration (“IR”) WO0000001617029 in respect of the mark shown on the front page of this decision with a UK designation date of 16 March 2021 and with a priority date of 18 September 2020 based on its US trade mark No. 90192850. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 19 November 2021 for the goods and services in Classes 9, 41 and 42 as annexed to this decision.
2. Thunder Productions Limited (“**the opponent**”) opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent is the proprietor of the UK registration number 0917988632¹ for the following mark:

THUNDER PRODUCTIONS

3. The opponent’s mark was filed on 21 November 2018 and registered on 17 April 2019 for various goods and services in Classes 9, 38 and 41 as annexed to this decision.
4. For the purposes of this opposition, the opponent relies on all goods and services as covered by its earlier mark.
5. Under Section 6(1) of the Act, the opponent’s trade mark clearly qualifies as an earlier trade mark. Further, as protection of the opponent’s earlier mark was completed less than five years before the designation date of

¹ 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 registered EUTM. As a result, the opponent’s earlier mark was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.

6. The opponent in its notice of opposition claims that the contested mark is highly similar to the opponent's mark for identical or similar goods and services, and there exists a likelihood of confusion.
7. The applicant filed a defence and counterstatement putting forward a blanket denial to the opponent's claims.
8. Only the opponent filed evidence and submissions in these proceedings. I shall not summarise these, but will refer to them where appropriate during the course of my decision.
9. The matter came to be heard by me via video conference on 6 July 2023. The applicant was represented by Mr Philip Harris of Lane IP Limited, and the opponent was represented by Ms Beth Collett of Counsel, instructed by Lee & Thompson LLP.

OPPONENT'S EVIDENCE

10. The evidence consists of a witness statement, dated 25 August 2022, from Amanda McDowall, a Legal Director and Chartered Trade Mark Attorney, employed by Lee & Thompson LLP, the representative of the opponent in these proceedings. The purpose of the evidence is to provide a dictionary definition of the word "thunder" with the Exhibit AMD1.

DECISION

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

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

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

12. 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.

13. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of Goods and Services

- 14. The competing goods and services, which are annexed to this decision, to be compared are voluminous, and I will refrain from reproducing them here.
- 15. There was an acceptance in the skeleton argument of the applicant that “there is at least some level of identity/similarity across at least some of the goods and services, however.”² This matter was briefly discussed during the hearing, but no further submissions were put forward.
- 16. Given the above admission and for reasons of procedural economy, I will not at this stage undertake a full comparison of the goods and services. The examination of the opposition will proceed on the basis that some contested goods and services are identical to those covered by the earlier trade mark. I shall carry out a full comparison later, if necessary.

Average Consumer and the Purchasing Act

- 17. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch),

² Applicant's skeleton argument, paragraph 21.

at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

18. The average consumer of the goods and services at issue will be either a member of the general public or professional and business users. The goods and services are likely to be self-selected from websites, promotional material, and signage, so visual considerations are likely to dominate the selection process. That said, as such goods and services may also be the subject of, for example, word-of-mouth recommendations or oral requests, aural considerations will not be ignored in the assessment.
19. The goods range, in my experience, from low to medium value, such as audio books and virtual reality headsets, respectively. Even for those at the inexpensive end of the scale, the average consumer may examine the product to ensure that they select the correct type, suitability and compatibility with other systems or components. Thus, the average consumer will pay an average degree of attention.
20. The cost of the services will be relatively significant, contributing to the selection process of the service provider. Given the more specialist nature of the services in play, especially those selected by business users, I consider that the average consumer will pay a slightly higher than average degree of attention in choosing the service provider, as prior consultation or research may be conducted before purchase.

Comparison of Trade Marks

21. 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.”

22. 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.

23. The marks to be compared are:

Opponent's Mark	Applicant's Mark
THUNDER PRODUCTIONS	SUN AND THUNDER

Overall Impression

24. There was some discussion at the hearing about the merits of considering the comparison from the perspective of either first impression or overall impression of the marks, but both parties agree that my approach to the assessment is that which is set out in the established authorities, cited earlier in this decision.
25. The earlier word mark consists of the words “THUNDER PRODUCTIONS” in upper case and standard typeface. Registration of a word mark protects the words themselves.³ In the context of the goods and services, “PRODUCTIONS” is allusive, and, thus, “THUNDER” is the dominant and distinctive element of the word mark. The word element “THUNDER” will have greater weight in the overall impression. However, due to its allusiveness to the goods and services, the word “PRODUCTIONS” will play a lesser role in the overall impression of the earlier mark.
26. The contested mark consists of the word elements “SUN AND THUNDER” in upper case and standard typeface. I note that the words of the contested mark create a phrase which will be perceived as a unit, and they together form the dominant and distinctive element of the mark, with no word dominating the others. The overall impression of the mark lies in the combination of the words.

Visual Comparison

27. The competing marks have different lengths, with the earlier mark consisting of two words, as opposed to the contested mark, which has three words. Bearing in mind, as a rule of thumb, that the beginnings of marks tend to have more impact than the ends,⁴ the competing marks share the common word “THUNDER”, which appears as the first word

³ See *LA Superquímica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

⁴ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, where the General Court observed that the attention of the consumer is usually directed to the beginning of a mark.

element in the earlier mark and the last in the contested mark. However, the marks differ in the presence/absence of the rest of the word elements “PRODUCTIONS” and “SUN AND”. Considering all the factors, I find them to be visually similar to between a low and medium degree.

Aural Comparison

28. The earlier mark will be pronounced as “THUHN-DUH-PRUH-DUHK-SHUNS” and the contested mark as “SUHN-AND-THUHN-DUH”. There are differences in the length and syllables of the marks. The earlier mark is five syllables long, whereas the contested mark is four. Further, the marks only share the two syllables stemming from the common verbal element “THUHN-DUH” but differ in the other verbal elements. Taking into account the above factors and the overall impressions, I consider that the marks are aurally similar to between a low and medium degree.

Conceptual Comparison

29. Ms Collet submitted that the term “THUNDER” in the contested mark refers to the weather element or the sound of thunder, based on the definition provided with the witness statement of Amanda McDowall. She also reiterated the onomatopoeic nature of the term and added that the contested mark will be regarded as related to weather. Thus, Ms Collet submitted that the competing marks are conceptually identical or highly similar.
30. Mr Harris, on the other hand, submitted that the word “THUNDER” in the earlier mark should not be viewed in isolation but rather in conjunction with the word “PRODUCTIONS”. He argued that this combination creates the impression of a production company named Thunder. Mr Harris further posited that the contested mark would evoke a rare and unique weather condition of a sunny day with thunder.
31. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous

judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

32. I note that the marks in question have a shared element, namely the word “THUNDER”, which is a well-known dictionary word and has more than one meaning. However, it is likely, in my view, that consumers will interpret it either as the weather phenomenon or a loud noise. Although the earlier mark includes the word “PRODUCTIONS”, which alludes to the nature of the goods and services, the concept of “THUNDER” will still come to mind, even when viewed as a business name. As for the contested mark, it consists of the ordinary words “SUN AND THUNDER”, which the average consumer will perceive as a unit. Both parties made contentions as to the meaning of the contested mark. However, I agree with the applicant’s submissions and consider that the contested mark clearly and immediately will evoke to the mind of the average consumer the concept of a meteorological phenomenon where thunder is heard during sunny weather. Taking into account all the above, including the overall impressions, I find that the degree of conceptual similarity falls between low and medium. In the case where the consumers conceptualise the element “THUNDER” as a loud sound in the earlier mark, I find that the marks will have a low degree of conceptual similarity.

DISTINCTIVE CHARACTER OF THE EARLIER TRADE MARK

33. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect,

judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

In making 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).”

34. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
35. Ms Collet submitted that the dominant and distinctive element of the earlier word mark is the first word “THUNDER”, whilst the second word “PRODUCTIONS” is descriptive. However, Mr Harris submitted that the distinctiveness of the earlier mark lies in its entirety.
36. The opponent has not shown use of its mark and, thus, it cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent distinctiveness of the earlier mark to consider. The earlier mark consists of the ordinary and well-known words “THUNDER PRODUCTIONS”, conveying the meaning described earlier in this decision. The distinctive character of the mark lies predominantly in the word element “THUNDER”,

which is the only common element with the contested mark,⁵ being distinctive to a medium degree. As shown earlier in this decision, the word element “PRODUCTION” is allusive to the nature of the goods and services. I find that the earlier mark as a whole has, at best, a medium degree of inherent distinctive character.

LIKELIHOOD OF CONFUSION

37. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.⁶ It is essential to keep in mind the distinctive character of the opponent’s trade mark since the more distinctive the trade mark, the greater may be the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.⁷
38. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.
39. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU’s

⁵ *Kurt Geiger v A-List Corporate Limited*, BL O/075/13.

⁶ See *Canon Kabushiki Kaisha*, paragraph 17.

⁷ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

judgment in *Bimbo*, on the court's earlier judgment in *Medion v Thomson*.
He stated:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).”

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there

is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

40. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C. (as he then was) as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

41. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor QC (as he then was), sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.
42. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of

a bourbon whiskey under the sign “American Eagle”. In his decision, Lord Justice Arnold stated that:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

43. The opponent claims likelihood of confusion, including likelihood of association, based on the identity or similarity between the competing goods and services and the medium to high level of similarity of the marks.⁸
44. Taking into account my findings earlier in this decision, I find that there is no likelihood of direct confusion for identical goods and services. The primary visual interaction with the goods and services in question together with the average degree of attention for goods and slightly higher degree for the respective services, will play a crucial role in this regard. Despite imperfect recollection, I believe that the average consumer will remember that the earlier mark, “THUNDER PRODUCTIONS”, is a two-worded mark compared to the applicant’s three-worded mark, “SUN AND THUNDER”, that forms a distinctive unit. Additionally, the marks have different beginnings, and the shared common element appears in different positions. Thus, despite the medium degree (at best) of distinctiveness of the earlier mark, I consider that the average consumer will not overlook the differences between the competing marks, where “SUN AND THUNDER”

⁸ Opponent’s skeleton argument, paragraph 29.

will be perceived as a unit, and, thus, it is unlikely to mistake one mark for the other.

45. Even if the average consumer recalls the points of similarity between the marks, such as that they contain the word “THUNDER”, I still consider the marks would not be indirectly confused. Sitting as the Appointed Person in *Eden Chocolat*,⁹ James Mellor QC stated:

“81.4 [...] I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining¹⁰ in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’” (Emphasis added)

I also bear in mind the comments of Professor Ruth Annand, sitting as the Appointed Person in *BARKERS BREW*, O/476/14, where she stated:

“26. On the contrary, the CJEU makes clear in *Bimbo* that “hanging together” is not the determinative criteria in assessing a composite mark: the decisive question being whether the composite mark forms a unit having a different meaning as compared to its components taken separately (*Bimbo*, para. 25).

27. Mr. Malynicz referred me to 2 earlier decisions of Mr. Geoffrey Hobbs Q.C. sitting as the Appointed Person in *CARDINAL PLACE* Trade Mark, BL O/339/04³ [fn³ *CARDINAL PLACE* geographical whereas *CARDINAL* religious] and *CANTO* Trade Mark, BL O/021/06, as similarly expressing the same point that marks must be compared

⁹ Case BL O/547/17 *Duebros Limited v Heirler Cenovis GmbH* (27 October 2017).

¹⁰ In *L.A. Sugar*.

as wholes, considering the blend of meaning given by the composite mark against the single term.”

46. In accordance with the rationales above, the word elements of the contested mark, “SUN AND THUNDER”, form a cohesive whole. That blend of meaning emanating from the combination of the said words will convey the concept of a meteorological phenomenon that goes beyond the meaning of the shared word “THUNDER” alone. I note here that the overall impression lies within the unit of these words. In this regard, the average consumer will not consider the respective marks as variants or sub-brands of each other nor that the goods and services in question are from the same or economically linked undertakings. I consider that the word elements “SUN AND” does not represent an obvious brand extension or sub-brand. Furthermore, if the opponent’s mark is brought to mind, this will be a mere association, not confusion.¹¹ I see no other reason why a common origin or an economic connection would be assumed and so I find that, even where the goods and services are identical, there is no likelihood of indirect confusion.
47. For completeness, even when considering the group of consumers who will conceptualise the word element “THUNDER” in the earlier mark with a loud noise, I note that, in addition to the visual and aural differences, the competing marks will be conceptually further apart. As a result, the outcome above will not be altered.
48. Based on my findings above, the opponent’s case will not be helped by a full comparison of the goods and services.

¹¹ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

OUTCOME

49. The opposition has been unsuccessful. **There is no likelihood of confusion. The opposition on the basis of the claim under Section 5(2)(b) fails.** Therefore, subject to appeal, the application can proceed to registration.

COSTS

50. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. The sum is calculated as follows:

Considering the other side's statement and preparing a counterstatement	£300
Considering the opponent's evidence and submissions	£500
Preparing for and attending the hearing	£900
Total	£1,700

51. I, therefore, order Thunder Productions Limited to pay Sun and Thunder, LLC, the sum of £1,700. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 19th day of September 2023

Dr Stylianos Alexandridis

For the Registrar,

The Comptroller General

ANNEX

Applicant's Specification

Class 9: Motion picture films featuring adventure, comedy and drama; motion picture films about animated cartoons; motion picture films featuring children's entertainment; downloadable audio and video recordings featuring adventure, comedy and drama; downloadable motion pictures, television shows and video recordings featuring adventure, comedy and drama; downloadable films, movies and television programs featuring adventure, comedy and drama provided via a video-on-demand service; visual recordings and audiovisual recordings featuring music and animation; musical sound recordings; audiovisual recordings featuring music and musical based entertainment; visual and audiovisual recordings featuring music, soundtrack, and animated live action imagery combining three-dimensional computer-generated imagery (CGI) painted environments, two-dimensional animation, and live action footage; pre-recorded CD-ROMs, compact discs, and DVDs featuring pre-recorded films, animation, games, music, computer game software and video game software; downloadable software for accessing augmented reality (AR), virtual reality (VR), mixed reality (MR) and extended reality (XR) platforms and environments in order to interact with other users and AI-enabled characters via third party computer hardware, gaming apparatus, mobile smartphones, tablets, and computers; downloadable virtual reality software for interactive entertainment; downloadable computer software development tools; downloadable software for developing motion picture films, animated films, television programs, video games and digital content using artificial intelligence; downloadable computer software for creating digital animation and special effects of images; downloadable software for facilitating interaction and communication between humans and AI (artificial intelligence) platforms; downloadable computer programs for entertainment, namely, interactive animation programs and computer animation; downloadable computer software, namely, movie, television, media, and game engine software used to design, develop, and

manipulate interactive entertainment content, programs, and computer games; downloadable software that enables manipulation of a multimedia virtual environment; downloadable software for providing access to, and immersion in, a 3D virtual environment; downloadable software for use in creating, manipulating, and participating in extended reality (XR) environments; downloadable software for providing access to an online virtual environment; downloadable and recorded software for use in manipulating real-world images, displays, structures, tools, and landscapes; downloadable virtual goods, namely, computer programs featuring avatars, tools, clothing, vehicles, equipment, and toys for use in virtual environments; downloadable computer software for use as an application programming interface (API) for use in building software applications; downloadable application programming interface (API) software; downloadable software for creating augmented reality (AR), virtual reality (VR), mixed reality (MR), and extended reality (XR) environments; downloadable software for recording, organizing, transmitting, manipulating, reviewing, and receiving data, audio, image and digital files; computer hardware; computer peripheral devices; personal electronic devices comprised primarily of downloadable software and display screens for connecting to mobile phones, mobile devices, and handheld computers in order to enable access to augmented reality (AR), virtual reality (VR), mixed reality (MR) and extended reality (XR) platforms and environments; downloadable cloud computing software for use in recording, organizing, transmitting, manipulating, reviewing, and receiving data, audio, image and digital files; downloadable computer software and firmware for operating system programs; downloadable computer software and firmware for enabling electronic devices to communicate and exchange data; recorded computer software for computer animation and computer games; downloadable game software; downloadable augmented reality (AR), virtual reality (VR), mixed reality (MR), and extended reality (XR) game software; downloadable interactive computer game programs featuring science fiction, action, adventure, animation, drama, or music; downloadable interactive multimedia software featuring motion picture films and television programs; downloadable electronic

publications in the nature of books, magazines in the field of entertainment, video games, and animation technology; downloadable MP3 files and podcasts featuring music, audio books and news broadcasts; downloadable computer application software for mobile phones, mobile devices, and handheld computers for purchasing, downloading, accessing, and sharing music, videos, audiovisual content, literary works, and audiobooks in the nature of novels and short stories; audio books featuring fiction and nonfiction content in the field of entertainment; virtual reality headsets for playing video games and accessing virtual environments.

Class 41: Animation production services; entertainment services in the field of film and television, namely, the production and distribution of motion picture films, animated movies, television programs and creation, production and distribution of computer generated images for motion picture films, animated movies, videos, animated videos, television programs; providing television and motion picture audio and visual special effects animation services for film, video and television; film studios services, namely, pre-production, and post-production for motion pictures, videos, animation and television programs; post-production editing services in the field of music, videos and film; entertainment services, namely, providing non-downloadable movies, television shows, webcasts, audiovisual, and multimedia works via the internet; entertainment services, namely, providing comedy, drama, documentary, animation, mystery, and reality web and television series provided over the internet; providing information, reviews, and recommendations regarding movies, television shows, webcasts, audiovisual, and multimedia works; production of sound recordings; music video production; entertainment services in the nature of live musical performances; entertainment services in the nature of recording, production and post-production services in the field of music; special effects animation services for film and video; entertainment services in the field of film and television, namely, the creation, production of films, videos, animation, and computer generated images; providing online entertainment, namely, providing sound and audiovisual recordings

in the field of music and musical based entertainment; providing information on musical artists over a global computer network; providing information about performances to be given by musical artists on tours; providing information in the field of entertainment; providing information and news in the field of entertainment; providing general interest news, entertainment and information related to movies and books over a global computer network; providing information in the field of entertainment relating to motion picture films, television programs, animated cartoons, and video games, via a website; publication of on-line journals [blogs] on the Internet related to movies and books; publication of non-downloadable online journals, namely, blogs about Augmented reality (AR), virtual reality (VR), mixed reality (MR) and extended reality (XR); entertainment services, namely, providing online non-downloadable comic books and graphic novels; production and distribution of movies and television shows; augmented reality (AR), virtual reality (VR), mixed reality (MR) and extended reality (XR) video production; entertainment services, namely, providing online video games, computer games, electronic games, and interactive games; providing computer games for use network-wide by network users; augmented reality (AR), virtual reality (VR), mixed reality (MR) and extended reality (XR) game services provided via the internet and other communications networks; entertainment services, namely, providing interactive entertainment and augmented reality (AR), virtual reality (VR), mixed reality (MR) and extended reality (XR) content and experiences; educational services, namely, developing, arranging and conducting workshops, seminars and educational programs in the field of entertainment.

Class 42: Software as a service (SaaS) services featuring software for accessing augmented reality (AR), virtual reality (VR), mixed reality (MR) and extended reality (XR) platforms and environments in order to interact with other users and AI-enabled characters via third party computer hardware, gaming apparatus, mobile smartphones, tablets, and computers; providing information in the fields of technology, software, software development, software used for entertainment production, and

extended reality (XR) technology, via a website; software as a service (SaaS) services featuring software for designing, developing, and manipulating interactive entertainment content, programs, and computer games; software as a service (SaaS) services featuring virtual reality software for interactive entertainment; software as a service (SaaS) services featuring software that enables manipulation of a multimedia virtual environment; software as a service (SaaS) services featuring software for providing access to, and immersion in, a 3D virtual environment; software as a service (SaaS) services featuring software for use in creating, manipulating, and participating in extended reality (XR) environments; software as a service (SaaS) services featuring software for providing access to an online virtual environment; software as a service (SaaS) services featuring software for use in manipulating real-world images, displays, structures, tools, and landscapes; provision of an online, non-downloadable computer program featuring avatars, tools, clothing, vehicles, equipment, and toys for use in virtual environments; application service provider (ASP) featuring application programming interface (API) software for use in building software applications; providing temporary use of non-downloadable software for creating, editing and processing images, videos, illustrations, characters and graphics; providing temporary use of non-downloadable software for processing digital images and videos; providing temporary use of non-downloadable software for facilitating interaction and communication between humans and platforms, namely, bots, artificially intelligent characters, virtual agents, and virtual assistants; providing temporary use of on-line non-downloadable software and applications using artificial intelligence for developing motion picture films, animated films, television programs, video games and digital content; providing temporary use of non-downloadable software development tools; providing temporary use of non-downloadable software for developing motion picture films, animated films, television programs, video games and digital content using artificial intelligence; providing temporary use of non-downloadable software for creating digital animation and special effects of images; providing temporary use of non-downloadable software for facilitating interaction and communication between humans

and AI (artificial intelligence) platforms; providing temporary use of non-downloadable software for entertainment, namely, interactive animation software and computer animation; providing temporary use of non-downloadable software for computer animation; providing temporary use of non-downloadable software for creating augmented reality (AR), virtual reality (VR), mixed reality (MR), and extended reality (XR) environments; providing temporary use of non-downloadable software for recording, organizing, transmitting, manipulating, reviewing, and receiving data, audio, image and digital files; providing temporary use of non-downloadable software to enable sharing and editing of multimedia content featuring motion picture films and television programs; providing a website featuring non-downloadable electronic publications in the nature of books, magazines in the field of entertainment, video games, and animation technology (term considered too vague by the International Bureau - Rule 13 (2) (b) of the Regulations); providing a website featuring non-downloadable MP3 files and podcasts featuring music, audio books and news broadcasts (term considered too vague by the International Bureau - Rule 13 (2) (b) of the Regulations); providing temporary use of non-downloadable software for purchasing, downloading, accessing, and sharing music, videos, audiovisual content, literary works, and audiobooks in the nature of novels and short stories; platform as a service (PAAS) featuring computer software platforms for use in accessing, online ordering, sampling, and transmission of e-books, audio books, and audio programs; design and development of computer game software and virtual reality software; software development; software development and product development in the field of extended reality (XR); design and development of computer-modeled versions of human beings using computer animation for use in movies, television, internet, games and other applications; creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities and engage in social networking; computer programming services for creating videos and games; cloud computing featuring software for use in recording, organizing, transmitting, manipulating, reviewing, and receiving data, audio, image and digital files; cloud computing featuring software for

enabling electronic devices to communicate and exchange data; providing online non-downloadable game software.

Opponent's Specification

Class 9: Apparatus for recording, transmitting, storage or reproduction of sound, music, images, data and videos, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; sound, music, image, data and video recordings, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; digital sound, music, image, data and video recordings, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; multimedia productions recorded on CD, DVD, DAT, DAC, HD discs, 3D discs, mini-discs, records, tapes, cassettes, discs and flash drives, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; motion picture films; television films and programmes; animations; 3D motion picture films, television films and programmes, and animations; radio programmes; recording materials used for storage and transmission of digital and analogue data, images, videos, sounds and recordings, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; pre-recorded audio and/or video media, CDs, CDRs, DVDs, DVDRs, DATs, DACs, HD discs, 3D discs, mini-discs, records, tapes, cassettes, discs and flash drives, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; laser-read discs for recording, reproducing, storing, transmitting and playing sound, images, music, data or video, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; optical-read discs for recording, reproducing, storing, transmitting and playing sound, images, music, data or video, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and

animations; flash drives for recording, reproducing, storing, transmitting and playing sound, images, music, data or video, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; audio, sound, image, data and video files provided from the Internet; audio or sound files in MP3 format; audio and/or video files in electronic format provided from the Internet, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; video files in MP4 format, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; MP4 videos, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; application software for mobile devices, tablet computers, mobile computers, handheld computers and smartphones; mouse pads; downloadable digital music or sound files provided from the Internet, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; downloadable digital video, image, film and TV files and programmes provided from the Internet, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; downloadable digital video, image, film and TV files and programmes provided from MP4 web sites on the Internet, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; refrigerator magnets; downloadable electronic media, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; publications downloaded in electronic form from the Internet, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; downloadable electronic publications provided from databases or the Internet, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; e-books, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; audio books on CD, mini-disc, record, cassette, disc

or flash drives, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; talking books, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; printed matter in electronic form, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; on-line publications, magazines, periodicals and newspapers, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; photographs and stills in electronic form, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; parts, fittings and accessories for the aforesaid goods.

Class 38: Sound, television and radio broadcasting of music, entertainment, concerts and videos via the Internet; radio and television broadcasting services; communication services, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; telecommunication services, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; delivery of digital files by telecommunications, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; providing access to digital file websites on the Internet, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; providing access to MP3 websites on the Internet, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; providing access to sound, video and data recordings and to electronic publications on the Internet, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; electronic transmission of streamed and downloadable audio and video files via computer and other communication networks, all featuring or relating to television shows and programmes,

radio shows and programmes, motion picture films and animations; electronic bulletin board services, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; providing computer bulletin boards in the fields of music, entertainment, video and television; providing on-line bulletin boards for the transmission of messages among computer users concerning music, entertainment, concerts, videos, radio and television programs; communication services, namely matching users for the transfer of music, video and audio recordings via communication networks; provision of telecommunication connections to electronic communication networks for transmission or reception of audio, video or multimedia content; video broadcasting featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; broadcasting pre-recorded videos featuring music, concerts and entertainment; radio, film and television broadcasting services; cable television broadcasting services featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; satellite transmissions featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; broadcasting of television programmes, theatre shows, theatrical performances, sound and video recordings; broadcasting of sound, film, theatre, audio, data and video recordings on compact discs, records, tapes, video tapes, laser discs, DVDs, CDs and CD ROMs; broadcasting of cinematographic films, motion pictures, radio programmes, television programmes, theatre shows and theatrical performances; streaming of video content via a global computer network; audio broadcasting; subscription audio broadcasting via a global computer network, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; provision of access to multi-media information and interactive multimedia services, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; providing access to mobile telephone ring tones via a wireless network; transmission of information relating to television shows and programmes,

radio shows and programmes, motion picture films and animations, podcasts and rss feeds; digital audio broadcasts featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; networking of sound and/or visual recordings featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; providing online blogs, discussion groups, chat rooms and electronic bulletin boards, all featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; providing access to an internet discussion website featuring or relating to television shows and programmes, radio shows and programmes, motion picture films and animations; transmission of radio and television programmes; information, advisory and consultancy services in relation to the aforesaid services.

Class 41: Entertainment services, namely, live, televised and movie appearances by a professional entertainer; entertainment services, namely, providing a web site featuring non-downloadable television shows and programmes, radio shows and programmes, motion picture films and animations, related film clips, and photographs; entertainment services, namely, providing prerecorded television shows and programmes, radio shows and programmes, motion picture films and animations, related film clips, and photographs online via a global computer network; entertainment services, namely, presenting non-downloadable pre-recorded television shows and programmes, radio shows and programmes, motion picture films and animations, related film clips, and photographs to mobile communications devices via a global computer network and wireless networks; preparation, presentation, production, post-production, editing, writing, scripting and direction of television shows and programmes, radio shows and programmes, motion picture films and animations; audio and video production, mixing, re-mixing, editing and recording services; recording, mixing, re-mixing and editing studio services; publishing services; production of television shows and programmes, radio shows and programmes, motion picture films and animations; artistic direction of performing artists; production services in

the field of sound and/or visual recordings and entertainment; audio production services; provision and production of live entertainment, live performances and live shows; production of audio/visual presentations; production of entertainment in the form of a television or radio series; production of shows; production of sound recordings; arrangement, conducting and production of dance, music and drama; arrangement, conducting and production of radio and television programmes, films, shows, and/or recordings of sound, music or images; arrangement, conducting and production of theatrical and stage entertainment; provision of on-line information services relating to television shows and programmes, radio shows and programmes, motion picture films and animations, related film clips, and photographs; provision of news relating to television shows and programmes, radio shows and programmes, motion picture films and animations, related film clips, and photographs; production and presentation of shows; arranging and conducting of colloquiums, conferences, congresses, seminars, symposiums, shows and workshops [training]; arranging and conducting of lectures, demonstrations, displays, exhibitions, presentations, seminars, concerts, gigs, shows, events and festivals for educational, entertainment, teaching and training purposes; conducting instructional, teaching and coaching classes, courses, seminars, presentations, shows and workshops; organisation of competitions; electronic library services for the supply of electronic information (including archive information) in the form of electronic texts, audio and/or video information and data, games and amusements; providing on-line publications (non-downloadable); providing digital sound and video recordings, not downloadable, from the Internet; providing digital sound and video recordings, not downloadable, from MP3 and MP4 Internet websites; providing digital sound recordings, not downloadable, from the Internet; providing digital sound recordings, not downloadable, from MP3 Internet websites; providing digital video, image, film, radio and TV recordings and programmes, and motion picture films, not downloadable, from the Internet; providing digital video, image, film radio and TV recordings and programmes, and motion picture films, not downloadable, from MP4 Internet websites; provision of information

relating to television shows and programmes, radio shows and programmes, motion picture films and animations; information, advisory and consultancy services relating to all of the aforesaid services.