

O/103/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 226 584 BY

MAANMOHAN SINGH TO REGISTER:



IN CLASS 34

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO 409960 BY HOME BOX
OFFICE, INC

Background and pleadings

1. Maanmohan Singh (the applicant) applied to register the trade mark No 3 226



584: in the UK on 24th April 2017. It was accepted and published in the Trade Marks Journal on 5th May 2017 in respect of the following goods in Class 34:

Tobacco, Smokers' articles: Matches.

2. Home Box Office, Inc (the opponent) oppose the trade mark on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act). Under Sections 5(2)(b) and 5(3), this is on the basis of its earlier European Union (formerly Community) Trade Mark No 1 163 2635: GAME OF THRONES. The following goods and services are relied upon in this opposition:

Class 34:

Cigars; Lighters for smokers; Humidors; Holders for cigars and cigarettes; Ashtrays for smokers.

Class 39:

Travel tour operating and organizing; Organization of excursions; Organization of sightseeing travel tours; Personal travel tour guide services; Providing a web site relating to travel, namely geographic information and map images; travel booking agencies.

Class 43:

Agency services for the reservation of temporary accommodation; Arena services, namely, providing facilities for conventions and exhibitions; Providing a website featuring information in the field of hotels and temporary accommodations for travelers.

3. Under Section 5(2)(b), the opponent argues that the respective goods are identical or similar and that the marks are similar. Under Section 5(3), the opponent claims that it enjoys a reputation in respect of the goods and services outlined above. As such, the opponent argues that (the applicant) will benefit from (the opponent's) investment in advertising, leading to advantage. Further that the applicant will ride on its coat tails and will benefit from the power of attraction, reputation and prestige of the earlier mark(s). The opponent also claims that the later use will be out of its control and that poor quality or offensive goods will cause detriment to its valuable reputation and business. It claims that use of the later mark will dilute the distinctive character and reputation of its marks. Finally, the opponent claims that there is no due cause for adoption of the opposed mark.
4. Under Section 5(4)(a), the opponent argues that its enjoys a substantial goodwill in respect of GAME OF THRONES and , including in connection with a television series and tobacco and related goods. As such, use of the later trade mark would amount to a misrepresentation that the goods were those of the opponent or that they had in some way been authorised by or connected to the opponent. The later use would also lead to the belief that the parties are economically linked undertakings, when no such link exists. It is clear (according to the opponent), that the applicant is solely riding on the coat tails of the opponent.
5. The applicant filed a counterstatement denying the claims made (and requesting that the opponent provides proof of use of its earlier trade mark relied upon). In respect of the proof of use request, it is noted that the earlier

trade mark relied upon is not subject to the proof of use provisions. As such, the earlier trade mark can rely upon the entirety of the goods and services as registered.

6. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate.
7. A Hearing took place on 10th October 2018, with the opponent represented by Mr Jonathan Moss of Counsel, instructed by Joshi Worldwide IP Limited and the applicant by Mr John Lamb of Lamb & Co.

Evidence

8. This is a witness statement, dated 21st December 2017, from Ms Judy McCool, Senior Vice – President of the opponent's Legal Affairs Department. In it, she describes the fame of the TV show GAME OF THRONES. It is considered that the fame of this show is so substantial it can rightfully be classed as a notorious fact. In any event, the evidence provided is so significant to show that the opponent clearly enjoys a significant reputation and a notable goodwill in connection with an ongoing television programme under that name. As such, I consider it unnecessary to summarise the evidence further on the point.
9. The remainder of the witness statement describes the opponent's licensing and other related activities such as the GAME OF THRONES travelling showcase exhibition. The pertinent details are:
 - The aforementioned exhibition travelled to Belfast, Northern Ireland in 2013 and 2015 and also to the O2 Arena in London in 2015. According to Ms McCool, these events were highly publicized and attended by thousands of fans. Exhibit JM-6 contains some examples of marketing and media coverage of these exhibitions.

- Ms McCool explains that licensing of the intellectual property derived from popular tv shows is common in the entertainment industry. In her view, consumers have become familiar with recognizing the fact that licensed or authorised merchandise exists and that the source of such merchandise is the owner of the tv series. According to Ms McCool, the opponent has both directly and as a result of agreements and licensing/distribution agreements, produced a wide range of merchandise associated with the series, such as DVDs, apparel, drink wear, jewellery, collectables, board games, pens and more. Ms McCool explains that many of these are available to buy in the UK (but she is no more specific than this). Exhibit JM-10 are examples of various merchandise for sale. It is noted that items include those as already described and also additional items such as shot glasses, wine stoppers, masks and mugs. It is noted that every item listed is described as a “game of thrones” product with no variation on this.

10. The opponent also included some additional evidence in its skeleton argument which was relied upon at the Hearing. This will be considered further below.

DECISION

Section 5(2)(b)

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of goods and services

12. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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 are complementary”.

13. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(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.

14. Further, in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

15. The earlier goods are:

Class 34:

Cigars; Lighters for smokers; Humidors; Holders for cigars and cigarettes; Ashtrays for smokers.

The later goods are:

Class 34:

Tobacco, Smokers' articles: Matches.

16. The later tobacco will likely be understood to mean rolling tobacco which can be smoked usually using tobacco rolling papers. The earlier cigars are a ready to use smoking product. As such, these goods can be alternatives to one another and may be in direct competition. Their purpose may also coincide. They are considered to be similar to a medium to high degree.

17. The later smokers' articles will include many items used by smokers' including the earlier goods: ashtrays and holders for cigars and cigarettes. They are, according to the terms in *Meric*, identical.

18. The remaining contested term is matches. These are commonly used to light, for example, cigars and cigarettes. The same function is true of the earlier lighters. They are therefore alternatives to one another. They can also coincide in channels of trade and end user. They are considered similar to a high degree.

Comparison of marks

19. 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 Court of Justice of the European Union 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.”

20. 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.

21. The respective trade marks are shown below:

<p style="text-align: center;">GAME OF THRONES</p>	
<p style="text-align: center;">Earlier trade mark</p>	<p style="text-align: center;">Contested trade mark</p>

22. The earlier trade mark is word only. The trade mark applied for consists of slightly stylised words, enclosed within a circular border. The verbal elements “GAME OF VAPES” is self evidently dominant. That is not to say that the circular border is negligible, rather that it is accorded relatively less weight.

23. Visually, notwithstanding the minimal stylisation in the later trade mark, the marks coincide in respect of “GAME OF” and differ in respect of “THRONES/VAPES” respectively. They are visually similar to a medium degree.

24. Aurally, the same is true. They are similar to a medium degree.

25. Conceptually, it is true that each of the marks coincide in respect of “GAME OF”, which will immediately communicate to the consumer the idea of a game, namely an activity or sport involving skill, knowledge or chance, with fixed rules and whereby victory against an opponent or the resolution of a puzzle is the ultimate aim. However, thrones will be understood as referring to the position(s) of being king or queen. Vapes will be understood as referring to breathing in a flavoured steam containing nicotine from a special device. These meanings are entirely different and qualify the “GAME OF” element in

each of the marks. As such, the marks are considered to have no overall concept in common, beyond both referring to games.

Average consumer and the purchasing act

26. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

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

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

28. The relevant consumer is the public at large (albeit those over the age of 18), including smokers'. To purchase, for example, tobacco products, the customer is typically required to aurally request them. However, some products such as cigarette papers, lighters, matches and the like, can also be self selected. As such, both aural and visual considerations are important. These products are neither prohibitively expensive nor particularly cheap. The level of attention expected to be displayed is therefore average.

Distinctive character of the earlier trade mark

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

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

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

30. The opponent claims that it enjoys an enhanced degree of distinctive character in respect of the goods and services upon which it relies in these proceedings. The evidence filed demonstrates that the opponent’s use goes beyond the core of television programmes, such as merchandising. However, such an activity is inextricably linked to the core business, namely the television programme. It is clearly targeted at fans of the tv show and there is no evidence that the merchandising business is independent of it. Importantly, the evidence does not demonstrate enhanced distinctiveness through use of

any of the goods and services contained within the earlier trade mark relied upon. It is difficult to see how the evidence demonstrates how the distinctiveness of GAME OF THRONES is enhanced beyond the core activity of the TV show.

31. As such, the earlier trade mark must be assessed on a prima facie basis. In this regard, the earlier trade mark is entirely meaningless in respect of the earlier goods and services for which it is registered. Indeed, it is fanciful and has a fantastical quality. It has a higher than average degree of distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

32. 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.

The principles

(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.

33. The goods are either identical or highly similar. This is important as the interdependency principle is in full operation here. The earlier trade mark is distinctive to an above average degree and the average consumer will pay an average degree of attention during the purchasing process, which is likely to involve both visual and aural considerations. The marks are visually and aurally similar to a medium degree. However, there is no overall concept in common. In this regard, I take into account the following guidance: in *The Picasso Estate v OHIM*, Case C-361/04 P, the Court of Justice of the European Union found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

34. Further, I do not ignore the guidance in *Nokia Oyj v OHIM*, Case T-460/07, the General Court stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

35. In respect of the trade marks in conflict here, it is considered that the difference in concept is significant. As such, it will inevitably lead to the consumer noticing the differences between the marks and significantly

negates against the risk of imperfect recollection. There is no likelihood of direct confusion.

36. However, this is not the end of the matter. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., 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.

37. I also take into account the guidance in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, where Mr James Mellor Q.C., 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.

38. The trade mark applied for is not a natural brand extension to the earlier trade mark. It conjures up a notably different overall idea. It is difficult to see how it could be concluded to be another brand of the earlier trade mark. It is noted that there is no family of mark evidence presented by the opponent showing a range of “game of...” trade marks. Had there been, it may have provided stronger support for the notion that the trade mark applied for would be considered as a further family member. I accept that it is possible that upon

viewing the later trade mark, the average consumer may be reminded of earlier trade mark as the use of the words “game of.....” is unusual. However, as outlined above, it is considered that this is mere association and not confusion. As such, there is concluded to be no likelihood of indirect confusion.

Section 5(3) – Reputation

39. It is noted that the opponent claims it has a reputation in respect of goods and services in Classes 34, 39 and 43 and it is this that forms the basis of its opposition under Section 5(3). It is accepted that there has been use of GAME OF THRONES in respect of some merchandising (which could include, for example, lighters and other smoking paraphernalia). However, this falls far short of demonstrating that it has a discreet reputation in this regard. There is no context provided as to the size of the relevant markets and no market share information. As such, it is difficult to see how the public would view this use over and above the typical merchandising activities one would expect from a successful television show. The same is true of the exhibition services covered by the earlier trade mark: the use shown is for exhibitions inextricably linked to the tv show. There is no use of this as a discrete service in its own right, provided for others.

40. The evidence clearly demonstrates that the opponent’s reputation is limited to the tv show and has not transferred or extended to other activities. This point is important because, in *Tulliallan Burlington Ltd v EUIPO*,¹ the General Court considered whether a UK trade mark – BURLINGTON ARCADE – which was registered as a UK trade mark in relation to, inter alia, *the bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from general merchandise retail stores*, was entitled to benefit from the reputation of BURLINGTON ARCADE as the name of a well-known shopping arcade in the UK. The court held (at paragraph 27 of its judgment) that:

¹ Case T-123/16

“It is apparent also from the file that the applicant’s earlier trade marks, which designate services in Classes 35 and 36, are known to a significant part of the public of the relevant market as being the name of a very well-known shopping arcade in the United Kingdom, located in central London, bringing together luxury boutiques within the arcade. Since that reputation of the applicant’s earlier trade marks is not disputed by the parties, the question which arises, in the present case, is ultimately whether that reputation corresponds in fact to the services in Class 35 for which the earlier trade marks have been registered, so that the applicant is properly entitled to benefit from the protection of the reputation in question.”

41. The opponent’s reputation is in respect of the tv show. This is an entertainment service which is not included anywhere in the earlier trade mark registration relied upon. As such, the Section 5(3) claim is not valid and so must be dismissed.

Section 5(4)(a) – Passing Off

Legislation

42. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

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

(b) [.....]

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

43. In terms of the evidence filed by the opponent, it has been assessed above. For the purposes of Section 5(4)(a), it is accepted that GAME OF THRONES (both the word only and figurative signs) enjoys a significant goodwill in respect of the tv show. However, I am unconvinced that it extends beyond this for the same reasons as already outlined. As such, the position under Section 5(4)(a) will be considered on the basis of the (significant) goodwill which centres around the tv show.

44. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

45. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

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

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

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

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

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

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

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

46. At the hearing, the skeleton argument of the opponent contained the following information, namely details of a previous trade mark application, applied for by the applicant in these proceedings:



47. This information was not filed during the evidence rounds. It was included in the skeleton argument and relied upon for the purposes of Section 5(3). The Section 5(3) claim has already been dismissed for the reasons given above. At the hearing, the applicant's representative, Mr Lamb argued that the opposition must be considered on the basis of the current application and not previous applications.

48. It is considered that this evidence may also have relevance under the law of Passing Off, particularly in respect of misrepresentation (and subsequent damage) and so it will also be considered in this context. This is because it is

clear from the case law that misrepresentation can be more readily inferred if it can be shown there is an intent to deceive².

49. It is clear that in its previous trade mark application, the applicant drew heavily upon the overall get up and themes from the Game of Thrones television programme. Further, the overall presentation is very similar. That said, this application was then withdrawn and the applicant has gone on to apply for a trade mark which is a significant departure from that previously. There is no evidence in these proceedings as to how the applicant is using the trade mark (if in fact, he is).

50. It is considered that the most that can be concluded is that the applicant has, prior to applying for the current attacked trade mark, attempted a parody of the earlier rights and that if this has any effect, it will merely be comedic. This is very different from attempting to misrepresent, that is, to deceive consumers as to the origin of the products. This line of argument therefore fails.

“Initial Interest Confusion”

51. This argument was included in the opponent’s skeleton argument:

“ 43. Firstly, there will, quite clearly, be at a minimum initial interest confusion. Whilst the Applicant’s position is that there will be confusion, if the IPO thinks otherwise and decided that the consumer may inspect the goods and upon reflection think that are not related to the Opponent, that still amounts to initial confusion – which is actionable in passing off if there is damage to the Opponent’s goodwill. For the reasons set out above, the Opponent will clearly suffer damage to its goodwill by virtue of the association.

² Office Cleaning Services Limited v Westminster Window & General Cleaners Limited (1946) RPC 39 (HOL)

44. Whilst the doctrine of initial interest confusion has been side-lined in trade mark law in this jurisdiction, it is still very much a part of the law of passing off”.

52. The applicability of initial interest confusion is noted. Though crucially, it must still lead to a misrepresentation (and consequent damage) to bite.

53. It is accepted that the earlier signs enjoy a significant goodwill. It is also accepted that a potential consumer (who will be the general public) upon being presented with Game of Vapes, may fleetingly be reminded of Game of Thrones. However, even if that occurred, it is considered that a consumer would either instantly (or very quickly) be aware that this product has not emanated from that source. Instead it is more likely that the consumer would understand the application to be a comedic play on “game of thrones”. As such, a (fleeting) impression of this nature will, in effect, have no consequence and is not considered to result in a misrepresentation as the consumer will be clear that this is not a game of thrones product. It is true that the earlier trade mark has been used on a wide variety of different items of merchandise. However, these are always clearly marked as game of thrones with no variations on the name or theme. I also take into account the respective fields of activity. They have nothing in common. Though commonality is not an essential factor in passing off, it is a notable consideration that I have taken into account and it is my view that this is a further aspect which makes misrepresentation unlikely. Bearing in mind all of the aforesaid, it is concluded that it is difficult to see how misrepresentation and therefore damage could occur. As such, the claim fails.

54. The net result of all of the above is that the opposition fails in its entirety.

COSTS

55. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £800 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement - £300

Preparing for and attending a hearing - £500

TOTAL - £800

56. I therefore order Home Box Office, Inc to pay Maanmohan Singh the sum of £800. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 21st day of February 2019

Louise White
For the Registrar