BL O/1188/23

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3704718

IN THE NAME OF WAZDAN HOLDING LIMITED FOR THE TRADE MARK

BURNING STARS

IN CLASSES 9, 28 & 41

AND THE OPPOSITION THERETO (UNDER NO. 434427)

BY EURO GAMES TECHNOLOGY LTD.

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF CLARE BOUCHER (O/829/23) DATED 31 AUGUST 2023.

DECISION

Introduction

1. This is an appeal by Euro Games Technology Ltd ("**Appellant**") from decision O/829/23 of Ms C. Boucher ("**Decision**") concerning the opposition by the Appellant to Wazdan Holding Limited's ("**Respondent**") application for the mark BURNING STARS, made pursuant to Article 59 of the Withdrawal Agreement between the UK and the EU, in respect of the goods and services listed below ("**Application**").

   Class 9

   Sound reproduction apparatus; Coin-operated mechanisms; Computer programs, downloadable; Computer gaming software; Information technology and audiovisual equipment; Sound recording apparatus; Downloadable software; Software and applications for mobile devices; Apparatus for recording images; Sound transmitting apparatus; Apparatus for the transmission of images; Apparatus for the reproduction of images; Computer programmes for interactive television and for interactive games and/or quizzes.

   Class 28

   Coin-operated amusement machines; Ascenders [mountaineering equipment]; Toys; Amusement machines, automatic and coin-operated; Gaming machines for gambling; Counters [discs] for games; Automatic coin-operated games; Dice; Apparatus for games; Mechanical games; Arcade game machines; Board games; Coin-operated amusement gaming machines; Amusement game machines.

   Class 41

   Electronic games services; Production of television features; Gaming services for entertainment purposes; Entertainment information; Production of radio and television programmes;

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

2. The Appellant opposed the Applications under s. 5(2)(b) of the Trade Marks Act 1994, relying upon the following marks ("**Earlier Marks**"), which are protected for goods and services in Classes 9, 28 and 41, the specifications of which are set out in the Annex to this decision:

IR No. 1486143 ("the **143 mark**")  Colours claimed: The mark contains the colours Yellow, orange and green.	International registration date: 10 May 2019 Designation date: 10 May 2019 Date of protection of the IR in the UK: 7 April 2022 Priority date: 13 November 2018 (priority claimed from Bulgarian Trade Mark No. 152890).
IR No. 1487417 ("the **417 mark**")  Colours claimed: The mark contains the colours white, green and black.	International registration date: 10 May 2019 Designation date: 10 May 2019 Date of protection of the IR in the UK: 28 November 2019 Priority date: 13 November 2018 (priority claimed from Bulgarian Trade Mark No. 152879).
IR 1488604 ("the **604 mark**")  Colours claimed: The mark contains the colours white, green and black.	International registration date: 10 May 2019 Designation date: 10 May 2019 Date of protection of the IR in the UK: 12 December 2019 Priority date: 13 November 2018 (priority claimed from Bulgarian Trade Mark No. 152881).
IR No. 1491750 ("the 750 mark")  Colours claimed: The mark contains the colours white, orange, yellow, red, black, green, light blue and purple.	International registration date: 10 May 2019 Designation date: 10 May 2019 Date of protection of the IR in the UK: 28 December 2019 Priority date: 13 November 2018 (priority claimed from Bulgarian Trade Mark No. 152864).

3. In the Decision, C. Boucher for the Registrar held that the opposition was unsuccessful.

4. On 27 September 2023 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.

The Hearing Officer's decision

5. The Hearing Officer held as follows (in summary, and insofar as is relevant to this appeal):

    a. the average consumer would be paying at least an average degree of attention when purchasing the goods and services;

    b. the average consumer would select the goods on a largely visual basis, although aural considerations may also be relevant;

    c. the 143 mark had a medium degree of distinctive character;

    d. the distinctive characters of the 417, 604 and 750 marks were fairly low when the marks were used for dice, dice-based games and related services, and medium for the remaining goods and services;

    e. the Application was visually and aurally similar to the 143 mark to a low degree and conceptually similar to the 143 mark to a medium degree;

    f. the Application was visually and aurally similar to the 417 and 604 marks to a low degree and conceptually similar to these marks to a low to medium degree;

    g. the Application was visually similar to the 750 mark to a low degree, aurally similar to this mark to a high degree and conceptually similar to between a low to medium degree;

    h. There is identity between some of the goods and services in the Application and the Earlier Marks;

    i. There is no likelihood of direct or indirect confusion between the Application and the Earlier Marks.

Grounds of Appeal

6. In the Statement of Grounds of Appeal and the skeleton argument, the Appellant made the following criticisms of the Decision:

    a. **Ground 1:** the Hearing Officer made a number of errors regarding the comparison of the marks. The Hearing Officer gave too much importance to the differences between the marks in question and not enough weight to the similarities, leading to an incorrect decision being made.

    b. **Ground 2:** the Hearing Officer made a number of errors in the global assessment of the likelihood of confusion and she was incorrect to dismiss the possibility of indirect confusion.

7. The Appellant's trade mark attorney, Ms Campbell, expanded upon the above at the hearing, and I set out below further details as are necessary to understand my overall conclusions. The Respondent filed a Respondent's Notice, but did not attend or otherwise participate in the hearing.

Standard of review

8. The approach to be adopted in an appeal hearing has been laid down a number of times in case law. It was recently summarised in *Axogen v Aviv* [2022] EWHC 95 (Ch) at §24-25:

"Appellate Function

24. Although I was referred to numerous cases on the subject (including *English v Emery Demibold & Struck Ltd* [2002] 1 WLR 2409, *REEF Trade Mark* [2003] RPC 5, *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, *Shanks v Unilever Plc* [2014] RPC 29, *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17, *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch), *Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 and *NINEPLUS* O/039/21), the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:

i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);

ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS* O/039/21 at [14]);

iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [81]);

iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.

v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education* at [52(iv)], *REEF* at [28] and *Fine & Country* at [50]-[51]).

vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different

judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).

vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], *Actavis Group* at [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (*Shanks* at [28] citing the warning given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).

viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English* at [17], *Fage* at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).

ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)]).

25. In the context of appeals relating to the likelihood of confusion, an evaluative issue described by Mr Iain Purvis QC sitting as an Appointed Person in *ROCHESTER Trade Mark* BL O/049/17 at [31] as "indeterminate and open to debate", Mr Purvis QC went on to say this at [33]:

"…the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

(i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case

(ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person

(iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal

(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction

with confidence. Jacob J (as he then was) made this point in the passing off case *Neutrogena v Golden* [1996] RPC 473 at 482:

'It was certainly my experience in practice that my own view as to the likelihood of deception was not always reliable. As I grew more experienced I said more and more "it depends on the evidence."'

Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.

34. I shall therefore approach this appeal on the basis that in the absence of a distinct and material error of principle, I ought not to interfere with the decision of the Hearing Officer unless I consider that his view on the issue of likelihood of confusion was clearly wrong in the sense that it was outside the range of views which could have been reasonably taken on the established facts."

9. I shall bear all the above in mind when reviewing the Decision.

Discussion

10. Looking at each of the grounds in turn, my analysis is as follows.

(1) Errors regarding the comparison of the marks

11. The Appellant contends that the Hearing Officer made three errors in her comparison of the Application and the Earlier Marks. First, she failed to recognise that the word STARS in the Application has a laudatory meaning and will "barely be seen as an indicator of commercial origin". Therefore the consumer will place emphasis, on a distinctive and conceptual level, on the word BURNING.

12. The Hearing Officer at §13 set out the applicable principles, including that:

- the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, and
- 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.

13. Clearly, the above two factors pull in opposite directions, and it is a matter for a Hearing Officer to decide, on the precise facts of each case, where the balance lies. In this instance, the Hearing Officer, after reminding herself again at §20-21 of the above principles, held that:

- The Application "consists of two words which, in my view, hang together as a unit. The overall impression of the mark lies in this unit" (§23);
- For the 143 mark, the words BURNING HOT "makes the greatest contribution to the overall impression of the mark, with "BURNING HOT" hanging together as a unit" (§24);
- For the 417 and 604 marks, ""BURNING DICE" will be perceived as a unit, with "BURNING" describing a quality of the dice. This makes the greatest contribution to the overall impression of the earlier marks, with a lesser role played by the number and the colour and stylisation" (§28); and

- For the 750 mark, "the words "BURNING DICE" make the greatest contribution to the overall impression of the mark" (§32). Although she does not expressly say so, I assume that again she regarded that "BURNING DICE will be perceived as a unit.

14. The difficulty for the Appellant in this regard is that that the Hearing Officer made a finding that the distinctive character of the Application lies jointly in the words BURNING and STARS (and indeed that the distinctive character of the Earlier Marks lies in their combination of words). The contention that the Hearing Officer should nonetheless have gone on to analyse the distinctive and dominant components of the Application is a contention that she should have fallen into the trap identified by Iain Purvis QC (as he then was) in *Kurt Geiger Limited v A-List Corporate Limited* O-075-13. In *Kurt Geiger*, Mr Purvis QC said:

"29. The Hearing Officer appeared to proceed on the basis that it was necessary to determine what were the 'distinctive and dominant' elements of the two marks before making any assessments of similarity and likelihood of confusion ...

30. I believe that this approach was wrong in principle. It is not necessary to identify one particular element of a mark as being its 'distinctive and dominant element'. It is right of course that "*in certain circumstances*" there may be such an element which dominates the overall impression of a mark (see the quote from Matratzen above), but that is very often not the case, and even if it is the case it does not absolve the tribunal from the obligation to consider the overall impression given by the marks as a whole.

31. The problem with forcing marks through an analysis such as that carried out by the Hearing Officer in paragraphs 38 and 39 is that it necessarily involves mentally dividing the mark into its component parts, thus losing the overall impression given by the combination of those parts and by the way in which they are combined. This is not the approach which the average consumer is deemed to take, nor the approach he or she would actually take in real life. When assessing likelihood of confusion, this approach is therefore likely to lead to error".

15. In my view, once the Hearing Officer had decided that the words BURNING and STARS "hang together as a unit. The overall impression of the mark lies in this unit", she would have fallen into error had she gone on to analyse each word separately. The only challenge which could be made to her decision is to contend that she was simply wrong in deciding that the overall impression lies in the words together. No such challenge is made by the Appellant, and nor could it be – her decision was clearly one within the bounds within which reasonable disagreement is possible.

16. Secondly, and (as I understand it) alternatively, the Appellant contends that:

"The Application consists of the combination of elements BURNING and STARS, to form the mark BURNING STARS. The conceptual meaning conveyed by this mark is one of very bright or hot and a luminous point in the sky. Alternatively, it could be seen to refer to the level of quality or it can be defined as someone who is a principal performer - a film starring Liza Minelli.

There are very clear conceptual identities between the marks BURNING STARS and BURNING HOT. BURNING has the same conceptual meaning of very hot or bright".

17. The Appellant accordingly submits that the Hearing Officer should have found a high degree of conceptual similarity between the Application and the 143 mark.

18. This issue was expressly addressed by the Hearing Officer at §27:

> "The 143 mark would be seen as a reference to a very high temperature, with the word "MINI" denoting smaller or shorter versions of the goods and services sold under the mark. The contested mark will bring to the mind of the average consumer celestial objects that are visible in the night sky as points of light. They would perceive the word "BURNING" to refer to the brightness of the light, or, more likely, to a level of heat. In the latter case, there is some conceptual similarity between the marks and I consider this is at a medium level".

19. Therefore, the Hearing Officer took into account the very point raised on appeal by the Appellant. Whereas the Appellant puts the degree of similarity at a higher level than the Hearing Officer, I remind myself of the cautionary advice provided by Iain Purvis QC (as he then was) in §23 of *GREYBOX* O/106/20:

> "I do not consider there is any great value in debating differences between '*fairly low*' and '*medium*' degrees of similarity in the context of the overall assessment of likelihood of confusion. Certainly, I do not consider that such fine distinctions can properly be characterized as errors of principle. They are at best simply disagreements about the precise 'weight' to be given to a factor in the overall assessment, something which the Courts have consistently rejected as a proper ground of Appeal. Furthermore, given the lack of clarity and subjectivity of the terms in question, it is impossible to have any sensible debate on Appeal about whether the Hearing Officer was right".

20. The outcome of the Hearing Officer's analysis of the degree of conceptual similarity, which took into account all the points raised by the Appellant, cannot therefore be characterised as an error of principle.

21. Thirdly, the Appellant contends that greater emphasis should have been placed on the word BURNING in the Application and Earlier Marks because "consumers generally tend to focus on the beginning of a sign when they encounter a trade mark. This is because the public reads from left to right, which makes the part placed at the left of the sign (the initial part) the one that first catches the attention of the reader".

22. It is true that this argument was advanced before the Hearing Officer, who does not deal with it in her Decision. There is case law, including *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, to the effect that the beginnings of words usually have greater visual and aural impacts than the ends. However, that principle is not a rule of law – it is a practical rule of thumb, based on experience and observation. It amounts to no more than "All else being equal, the average consumer will tend to pay more attention to the beginnings of marks than other parts of marks". Where, as here, the Hearing Officer has determined that the distinctive character lies in the combination of words, the principle is likely to have little or no impact. I accordingly do not consider that the fact that the common word – BURNING – is at the beginning of each of the marks, makes any material difference to the Hearing Officer's assessment of similarity.

23. I dismiss this first ground of appeal.

(2) Errors in the global assessment of the likelihood of confusion

24. During the hearing, the Appellant's representative confirmed that it is only the Hearing Officer's decision in relation to likelihood of indirect confusion that is challenged on appeal. The

Appellant contends that the Hearing Officer failed to take into account the marketplace and nature of the average consumer, and incorrectly applied *L.A. Sugar* in her dismissal of a likelihood of indirect confusion.

25. The Hearing Officer set out the law relating to indirect confusion at §45-47. At §50, having dismissed a likelihood of direct confusion, she said:

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

26. The relevant law was explained by Iain Purvis QC (as he then was) in *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.'
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
>
> (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

27. The above was approved by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, who said (at §12):

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

28. Arnold LJ added at §13:

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

29. Specifically, the Appellant contends:

- Branding is very important in the gambling sector. Service providers in the sector invest significant resources in establishing a recognisable brand. The trade marks in question would be marketed and sold to the same consumers and viewed in the same places;
- The evidence filed and submissions show that the Appellant is the owner of many "BURNING" marks;
- Brand extensions and sub-branding arrangements are often logical in the online game / gambling / casino marketplace;
- BURNING STARS might call to mind the earlier marks relied on, such that the relevant public could believe that the goods or services marketed under the earlier mark and those marketed under the later mark come from the same undertaking or from economically-linked undertakings.

30. Addressing each contention in turn, my analysis is as follows. For the first and third contentions, whereas I do not doubt that this is true, the same can be said for many other sectors. The fact that service providers invest heavily in branding, that competitors' brands are exposed to consumers in the same places, and that brand extensions and sub-brands are common and often follow a logical pattern does not of itself establish "a proper basis for concluding that there is a likelihood of indirect confusion". It is clear that the Hearing Officer took all these factors into account in her analysis.

31. The second contention is relied upon to support the argument that the average consumer is used to seeing products, bearing marks containing the word BURNING, emanating from the Appellant, and is therefore more likely to associate any mark containing that word with the Appellant.

32. The authors of Kerly's Law of Trade Marks and Trade Names summarise the position in relation to families of marks at 11-092:

"Use of a family of marks may support the contention that a mark or particular element of a mark is distinctive. However, evidence of entries in the register of trade marks will not be of assistance. Such entries do not necessarily reflect the position in the marketplace or affect the way in which marks are perceived and remembered. Not all of the family of marks relied upon must be registered, but they must be in use. Where the common feature of an alleged family of marks alludes to the nature of the goods or

services in issue and might be viewed as allusive, that will militate against the finding that a collection of marks would be viewed as a family".

33. The Appellant filed evidence of use of its marks, but this was dismissed by the Hearing Officer at §43:

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

34. That finding is therefore fatal to the Appellant's "family of marks" argument in support of a likelihood of indirect confusion.

35. Finally, with regard to the fourth contention, a mere calling to mind is insufficient to establish indirect confusion. The Appellant's skeleton argument includes references to a number of instances in the case law where a likelihood of indirect confusion was found in relation to marks/signs sharing an identical first word, including *32Red Plc v WHG (International) Ltd and others* [2011] EWHC 62 (Ch), *GEO vs GEOLOTTO* and *GEO WIN* O-219-15, *Circus v Royal Circus & Royal Circus Games* O-462-17 and others. However, I am not persuaded that pointing to other decided cases in which a likelihood of indirect confusion was found is necessarily helpful. As Arnold LJ made clear in *Liverpool Gin*, there must be a "proper basis" for that finding, which means that the precise circumstances need to be carefully considered, and a finding of likelihood of indirect confusion in one set of circumstances is of weak precedent value in relation to another, different set of circumstances.

36. Turning to the facts of this case, the finding of the Hearing Officer which was critical to her conclusion was "Neither do I find that the common element "BURNING" is so distinctive that only the opponent would be using it". The Respondent, in its evidence and submissions, relied on a number of third party marks comprising the word BURNING, in an attempt to show that the word is commonly used in the gambling sector and is hence non-distinctive. That argument was dismissed in its entirety by the Hearing Officer at §40. However, as stated above she went on at §43 to dismiss the Appellant's evidence of acquired distinctive character.

37. Bearing in mind that the Hearing Officer found that each of the Earlier Marks had a medium (but no higher) degree of inherent distinctive character, the failure of the Appellant to establish enhanced distinctive character through use means that the Hearing Officer's rejection of a likelihood of indirect confusion on grounds of insufficient distinctive character cannot be faulted.

38. I accordingly dismiss this second ground of appeal.

Conclusion

39. There is no likelihood of direct or indirect confusion between the Application and the Earlier Marks. The Opposition is unsuccessful, and the Application can proceed to registration.

Costs

40. Clearly, the Respondent has been the successful party in this appeal. The Respondent filed a Respondent's Notice, but played no further part in the appeal. I order that the Appellant should pay the Respondent £500 by way of costs of the Respondent's Notice.

41. The above is in addition to the £800 ordered by the Hearing Officer to be paid by the Appellant to the Respondent.

Dr. Brian Whitehead

17 December 2023

Representation

Ms Dale Campbell of IK-IP Limited for the Opponent / Appellant

Tierney IP for the Applicant / Respondent, who did not participate in the hearing

Annex – Opponent/Appellant's Goods and Services

IR No. 1486143

Class 9
Electronic components for gambling, gambling machines, gambling games on the internet and via telecommunication network; electronic components for gambling machines; computer operating system software; software drivers; operating computer software for main frame computers; computer programs for network management; computer hardware; monitors (computer hardware); communications servers [computer hardware]; apparatus for recording images; monitors (computer programs); apparatus for recording, transmission or reproduction of sound or images.

Class 28
Parlor games; boxes for coin-operated machines, slot machines and gaming machines; housings for coin-operated machines, gaming equipment, gaming machines, machines for gambling; Chips for gambling; gaming chips; gaming tables; roulette chips; poker chips; chips and dice [gaming equipment]; roulette tables; gaming roulette wheels; mah-jong; arcade games.

Class 41
Gambling; gaming services for entertainment purposes; casino, gaming and gambling services; training in the development of software systems; provision of equipment for gambling halls; providing casino equipment [gambling]; gaming machine entertainment services; providing casino facilities [gambling]; gaming hall services; amusement arcade services; games equipment rental; rental of gaming machines; providing amusement arcade services; rental of gaming machines with images of fruits; editing or recording of sounds and images; sound recording and video entertainment services; hire of sound reproducing apparatus; provision of gaming equipment for casinos; providing of casino facilities; casino, gaming and gambling services; provision of gaming establishments, gaming halls, internet casinos.

IR Nos. 1487417, 1488604 and 1491750

Class 9
Software; computer gaming software; computer software packages; computer operating system software; computer software, recorded; software drivers; virtual reality software; games software; entertainment software for computer games; computer programs for network management; operating computer software for main frame computers; monitors (computer hardware); computer hardware; apparatus for recording images; monitors (computer programs); computer game programs; computer programs for recorded games; apparatus for recording, transmission or reproduction of sound or images; communications servers [computer hardware]; electronic components for gambling machines; computer application software featuring games and gambling; computer software for the administration of on-line games and gaming; computer hardware for games and gaming; electronic components and computer software for gambling, gambling machines, gambling games on the internet and via telecommunication network.

Class 28
Gaming machines for gambling; chips for gambling; mah-jong; arcade games; gambling machines operating with coins, notes and cards; games; electronic games; parlor games; gaming chips; gaming tables; slot machines [gaming machines]; LCD game machines; slot machines and gaming devices; coin-operated amusement machines; roulette chips; poker chips; chips and dice [gaming equipment]; equipment for casinos; roulette tables; gaming roulette wheels; casino games; gambling machines and amusement machines, automatic and coin-operated; coin-operated amusement

machines and/or electronic coin-operated amusement machines with or without the possibility of gain; boxes for coin-operated machines, slot machines and gaming machines; electronic or electrotechnical amusement machines and apparatus, gaming machines, coin-operated entertainment machines; housings for coin-operated machines, gaming equipment, gaming machines, machines for gambling; electropneumatic and electrical gaming machines (slot machines).

Class 41
Gambling; services related to gambling; gaming services for entertainment purposes; casino, gaming and gambling services; training in the development of software systems; provision of equipment for gambling halls; providing casino equipment [gambling]; gaming hall services; amusement arcade services; games equipment rental; rental of gaming machines; providing amusement arcade services; rental of gaming machines with images of fruits; editing or recording of sounds and images; sound recording and video entertainment services; hire of sound reproducing apparatus; provision of gaming equipment for casinos; providing of casino facilities; online gambling services; casino, gaming and gambling services; provision of gaming establishments, gaming halls, internet casinos, online gaming services.