

O/1197/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003762213

BY JACKIE BEDFORD

TO REGISTER THE TRADE MARK:



IN CLASSES 9 AND 28

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 434248

BY NACON

## BACKGROUND AND PLEADINGS

1. On 5 March 2022, Jackie Bedford (“the applicant”) applied for the trade mark shown on the cover page of this decision, in the UK. The trade mark was published for opposition purposes on 18 March 2022 and registration is sought for the following goods:

Class 9 Games software; Game software; Computer games; Gaming software; Video game programs; Downloadable computer games; Interactive game software; Downloadable electronic games; Computer game programs; Computer game programmes; Computer gaming software; Video games software; Video game software; Computer games software; Downloadable game software; Programs (Computer game -); Electronic game programs; Electronic game software; Computer games programs; Computer game software.

Class 28 Games; Electronic games.

2. On 15 June 2022, the application was opposed by NACON (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).<sup>1</sup> The opponent relies upon the following trade mark:



UKTM no. 917989987

Filing date 23 November 2018; registration date 30 March 2019

Relying on all goods for which the mark is registered, namely:

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<sup>1</sup> The opposition was also originally based upon sections 5(3) and 5(4)(a) of the Act, but these grounds were not pursued (see paragraph 3 of Mr Harris’ skeleton argument).

Class 28 Control apparatus and joysticks for video games; Controllers for game consoles or arcade cabinets; Video game joysticks; accessories, parts and fittings for all the aforesaid goods allowed in this class; None of the aforesaid related to games of chance and/or equipment for casinos and/or bingo halls.

3. The opponent claims the marks are similar and the goods are similar, with the result that there is a likelihood of confusion.

4. The applicant filed a counterstatement denying the claims made.

5. Both parties filed evidence in chief. The opponent did not file evidence in reply. A hearing took place before me on 28 September 2023, by video conference. Both parties were in attendance. The applicant was self-represented and the opponent was represented by Mr Philip Harris of Lane IP Limited. Mr Harris filed a skeleton argument in advance of the hearing.

## **EVIDENCE**

6. The opponent filed evidence in the form of the witness statement of Caroline Phillips dated 5 December 2022, which is accompanied by 3 exhibits. Ms Phillips is one of the opponent's representatives in these proceedings. The opponent's evidence relates to the similarity of the goods in issue.

7. The applicant filed a witness statement in her own name dated 13 March 2022, which is accompanied by 2 exhibits.

8. I have taken the evidence into account in reaching my decision and will refer to it below where necessary.

## **RELEVANCE OF EU LAW**

9. 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 Act relied upon 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.

## **PRELIMINARY ISSUE**

10. In her evidence, the applicant referred to six trade marks that are all registered for the text 'Revolution' in class 28. Although registered in class 28, the majority of these marks are registered for goods that are quite distinct from those in the opponent's specification (such as "shinguards" and "tennis racket strings"). In any event, there may be any number of reasons why the opponent is not in dispute with the owners of these marks. I note that the majority of those marks pre-date the opponent's mark and so the opponent would not have been in a position to oppose them. Further, there may be co-existence agreements in place between the parties. Consequently, I do not consider that this evidence is of assistance to the applicant.

## **DECISION**

10. Section 5(2)(b) of the Act reads as follows:

"5(2) A trade mark shall not be registered if because –

(a)...

(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."

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

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

12. The trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years before the filing date of the mark in issue, it is not subject to the use provisions in section 6A of the Act.

13. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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**

14. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p><u>Class 28</u></p> <p>Control apparatus and joysticks for video games; Controllers for game consoles or arcade cabinets; Video game joysticks; accessories, parts and fittings for all the aforesaid goods allowed in this class; None of the aforesaid related to games of chance and/or equipment for casinos and/or bingo halls.</p>	<p><u>Class 9</u></p> <p>Games software; Game software; Computer games; Gaming software; Video game programs; Downloadable computer games; Interactive game software; Downloadable electronic games; Computer game programs; Computer game programmes; Computer gaming software; Video games software; Video game software; Computer games software; Downloadable game software; Programs (Computer game -); Electronic game programs; Electronic game software; Computer games programs; Computer game software.</p> <p><u>Class 28</u></p> <p>Games; Electronic games.</p>

15. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 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.”

16. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

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

18. Ms Bedford made submissions at the hearing regarding the fact that her software is currently used on mobile phones and that the opponent’s goods would not,

therefore, be compatible with her product. Submissions of this kind, whilst entirely understandable, do not assist the applicant. This is because the assessment that I must undertake is a notional one based upon the full breadth of the parties' respective specifications. The applicant's specification is not limited in any way to goods for use on mobile phones and so I must consider both goods for use with mobile phones and other types of software (such as software used on game consoles). Similarly, Ms Bedford discussed the specific ways in which the parties' goods are sold and their customer bases. This is reflected in her evidence.<sup>2</sup> However, this is not reflected in the parties' respective specifications and so this is not a matter that I am able to take into account in making my assessment.

### Class 9

*Games software; Game software; Computer games; Gaming software; Video game programs; Downloadable computer games; Interactive game software; Downloadable electronic games; Computer game programs; Computer game programmes; Computer gaming software; Video games software; Video game software; Computer games software; Downloadable game software; Programs (Computer game -); Electronic game programs; Electronic game software; Computer games programs; Computer game software.*

19. These goods differ in nature, purpose and method of use to the opponent's goods. However, they will overlap in user. I have evidence before me of both parties' goods being sold by businesses such as Currys and through specialist retailers such as Game.<sup>3</sup> I note that the evidence filed is undated. However, this evidence does nothing more than reflect my own understanding of the market as at the relevant date. In my view, even in general retailers, these goods are likely to be sold in the same areas of those stores or, at the very least, nearby. There is, plainly, an overlap in trade channels. Mr Harris argued that the goods are also complementary. It seems to me that it is entirely possible to use game software without a video game controller. For example, some video game software would be played on a mobile phone or tablet,

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<sup>2</sup> Exhibit JB2

<sup>3</sup> Exhibit CP3

which would not involve the use of a controller at all. However, I do accept that for some types of game software (such as those used on a console) a controller will be important or indispensable for the use of those goods. However, in order to find complementarity, I must be satisfied that the average consumer would consider that the goods originate from the same undertaking. That is not the same as an overlap in retailers; the average consumer must consider that the undertaking actually responsible for those goods is the same (which would be producer of the goods).

18. Mr Harris suggested that I could take it on judicial notice that these goods are produced by the same undertakings (such as Microsoft, Sony etc.). I am not aware of any such overlap in producers and so, absent that knowledge myself, it would be an odd finding to make that it is a notorious fact of which I am prepared to take judicial notice. In any event, even if I was prepared to take judicial notice of the fact that large undertakings such as Microsoft and Sony produce both types of goods, given the significant scale of those businesses, that is unlikely to be indicative of the position in the market at large. The opponent has filed evidence which shows game consoles, game controllers and game software being sold as part of a bundle.<sup>4</sup> This appears as follows:



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<sup>4</sup> Exhibit CP2



I do not consider that the latter image assists the opponent. This is because it is clear from the information on the box that the PS5 console (and, presumably, controller) is produced by Sony and the FIFA 23 game is produced by EA Games. There is nothing in this image to suggest to me that the average consumer would consider that the controller and the software were produced by the same undertaking. I accept that in the former image there is no way of knowing whether the same undertaking is responsible for the controller and the software (or not). In any event, again, the two examples provided refer to undertakings with enormous reputations in the market. There is certainly nothing in the evidence before me to demonstrate that a coincidence in the undertaking responsible for these goods is commonplace such that the average consumer would expect it to be the same. In my view, there is no complementarity. There is also no competition, given the differing purposes. The goods are similar to between a low and medium degree.

## Class 28

*Games; Electronic games.*

20. Mr Harris submitted that these goods are identical to the opponent's goods on the principle outlined in *Meric*. I disagree. When interpreting specifications, it is necessary to consider the ordinary and core meaning of the terms used.<sup>5</sup> I do not consider that the ordinary and core meaning of these terms would extend to cover the opponent's goods. However, I do accept that there are types of electronic games (such as arcade games), which would be used with the opponent's goods. It would also be reasonable for the average consumer to expect that the same undertaking would produce both the game (such as the arcade cabinet) and the controller to be used with that game, and they are important or indispensable for each other. Consequently, they are complementary. The nature, purpose and method of use of the goods differ. I consider the goods to be similar to a medium degree.

### **The average consumer and the nature of the purchasing act**

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

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

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<sup>5</sup> *Sky v Skykick* [2020] EWHC 990 (Ch)

22. The average consumer for the goods will be a member of the general public. The goods will vary in cost and frequency of purchase but are unlikely to be at the highest end of the scale in terms of cost. However, the average consumer is likely to consider factors such as graphics, gameplay, compatibility and functionality. Consequently, I consider that a medium degree of attention will be paid during the purchasing process for the goods.

23. The goods are likely to be self-selected from the shelves of a retail outlet or their online equivalents. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase given that advice may be sought from retail assistants.



### **Comparison of trade marks**

24. It is clear from *Sabel* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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.”

25. 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.

26. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
	

27. The opponent's mark consists of the word REVOLUTION, presented in a white upper case font on a black background. The second letter "O" has been replaced by a device. The contents of the device is not immediately clear, although upon zooming in it is apparent that it is a snakes head device. It is the word REVOLUTION itself which plays the greater role in the overall impression, with the device, background and font playing a lesser role. The applicant's mark consists of the word RE-EVOLUTION, presented in a green upper case font, on a black background. The first "O" has been replaced by a globe device. It is the word RE-EVOLUTION itself which plays the greater role in the overall impression, with the device, font and background playing a lesser role.

28. Visually, the marks coincide in the letters RE\_VOLUTION. They differ in the additional symbol/letter "-E" in the applicant's mark. There is also some visual similarity arising from the common replacement of the letter "O" with a device, albeit the devices themselves are different and in different positions. The common use of a black background is also a point of similarity (albeit one is bigger than the other). The opponent's mark is registered in black and white and so could be used in any colour. In my view, the marks are visually similar to between a medium and high degree.

29. Aurally, the opponent's mark will be pronounced REVO-LOO-SHUN. The applicant's mark will be pronounced REE-EVO-LOO-SHUN. They are aurally highly similar.

30. Conceptually, the opponent's mark will be given its ordinary dictionary meaning i.e. either an attempt to overthrow a regime or a circular turning motion. The word EVOLUTION in the applicant's mark is likely to be understood as referring to a gradual process of change during which species of animal/plant change their physical characteristics. The addition of the letters RE- to the start of that word, in my view, mean that the meaning of the mark as a whole is ambiguous. Evolution is a constant process, and so the addition of the letters RE-, if that is intended to suggest that the process is repeated in some way, does not make sense. Mr Harris submitted that there is a common meaning of change in both marks i.e. change to the regime or change to physical characteristics. In my view, this involves too many mental steps on the part of the average consumer to be a meaning that is immediately graspable. However, I do accept that there will be a significant proportion of average consumers who see the addition of the letters RE- to the applicant's mark to be a play on the words EVOLUTION and REVOLUTION. For those average consumers, there will be at least a moderate degree of conceptual overlap.

### **Distinctive character of the earlier trade mark**

31. 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-2779, 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).”

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

33. The opponent has not filed any evidence to demonstrate how (if at all) it has used its mark in the UK. At the hearing, Mr Harris confirmed that the opponent is not claiming enhanced distinctiveness. Consequently, I have only the inherent position to consider. The word REVOLUTION in the opponent’s mark does not have any connection with the goods in issue. In my view, it is inherently distinctive to a medium degree. The addition of the device and presentational elements raises the distinctiveness of the mark overall to a slightly higher than medium degree.

### **Likelihood of confusion**

34. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertaking being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for

the goods and the nature of the purchasing act. In doing so, I must be alive to the fact that the average consumer rarely has an opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

35. I have found as follows:

- a) The goods are similar to between a low and medium degree and a medium degree.
- b) The average consumer is a member of the general public who will pay a medium degree of attention during the purchasing process.
- c) The purchasing process will be predominantly visual, although I do not discount an aural component to the purchase.
- d) The marks are visually similar to between a medium and high degree and aurally highly similar. For a significant proportion of average consumers, there will be at least a moderate degree of conceptual overlap between the marks.
- e) The earlier mark is inherently distinctive to a slightly higher than medium degree.

36. Bearing in mind the similarities between the marks, I consider it likely that they will be mistakenly recalled or misremembered as each other when used on goods that are similar. The additional symbol/letter “-E” in the applicant’s mark may be overlooked. The average consumer may recall that one of the letter “O”s is replaced with a device, but not recall the exact device or its positioning. In reaching this decision, I have borne in mind Ms Bedford’s submissions that when seen side by side consumers are likely to be able to identify the differences. However, this does not take account of the principle of imperfect recollection. I have also borne in mind that conceptual distinctions may counteract visual and aural similarities.<sup>6</sup> However, in this case, whilst

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<sup>6</sup> *The Picasso Estate v OHIM*, Case C-361/04 P

the word EVOLUTION and the word REVOLUTION plainly have different meanings, the addition of the letters RE- to the beginning of the applicant's mark is likely to be seen, by a significant proportion of average consumers, as a play on the words EVOLUTION and RE-EVOLUTION. For those average consumers, there is at least a moderate degree of conceptual overlap. Even if that is not the case, the ambiguous nature of the word RE-EVOLUTION when taken as a whole, would not convey a strong enough (and distinct) conceptual meaning to overcome the visual and aural similarities between the marks. I consider there to be a likelihood of direct confusion.

## CONCLUSION

37. The opposition is successful, and the application is refused.

## COSTS

38. As the opponent has been successful, it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. Although the opponent paid an official fee of £200, that was due to its reliance upon sections 5(3) and 5(4)(a) of the Act, which were later not pursued. Consequently, I award only the lower official fee in respect of the section 5(2)(b) ground (£100). In the circumstances, I award the opponent the sum of **£1,750**, calculated as follows:

Preparing a Notice of opposition and considering the counterstatement	£250
Preparing evidence and considering the applicant's evidence	£550
Preparing for and attendance at hearing	£850
Official fee	£100
<b>Total</b>	<b>£1,750</b>

39. I therefore order Jackie Bedford to pay NACON the sum of **£1,750**. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 19<sup>th</sup> day of December 2023**

**S WILSON**

**For the Registrar**