

O-403-11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2507731

BY

PLAYFACE LIMITED

TO REGISTER THE TRADE MARK:

PLAYFACE

IN CLASSES 35, 38, 41, 42 AND 45

AND

THE OPPOSITION THERETO

UNDER NO 99277

BY

CRYTEK ENTERTAINMENT GMBH

1) On 2 February 2009, Playface Limited (PL) filed an application to register the trade mark PLAYFACE (the trade mark). The application was published on 3 April 2009 with the following specification:

advertising; business management; business administration; office functions; advertising and information distribution services, namely, providing classified advertising space via the global computer network; promoting the goods and services of others over the Internet; compilation and management of on-line computer databases and on-line searchable databases; providing on-line computer databases featuring classified listings of goods and services, real estate, personals, want ads and employment opportunities; on-line retail store services in relation to the sale of downloadable pre-recorded music, video and computer games, books and printed materials, clothing, footwear, headgear, sporting and gymnastic apparatus and equipment, toys and games; promoting the goods of others by means of operating an on-line shopping mall with links to the websites of others; dissemination of advertising for others via the Internet; providing and rental of advertising space on the Internet; on-line advertising and marketing services; advice, information and consultancy services relating to the aforesaid services;

telecommunications services; chat room services; portal services; e-mail services; providing user access to the Internet; radio and television broadcasting; computer aided transmission of messages and images; providing on-line chat rooms and electronic bulletin boards for transmission of messages; providing email and instant messaging services; communication services, namely, transmission of voice, audio, visual images and data by telecommunications networks, wireless communications networks and the Internet; video-on-demand services; providing voice communication over the Internet; providing on-line facilities for real-time interaction with other computer users; data transmission and instant messaging services; advice, information and consultancy services relating to the aforesaid services;

education; providing of training; entertainment; on-line entertainment; sporting and cultural activities; lottery services; electronic games services provided by means of the Internet; the provision of on-line electronic publications; providing an on-line directory information service featuring information regarding, and in the nature of, collegiate life, general interest, classifieds, virtual community, social networking, photo sharing, and transmission of photographic images; entertainment services, namely, providing a web site featuring audio, video, graphics, text and other multimedia content; on-line journals, namely, blogs featuring personal information and opinions, organisation of entertainment, cultural and sporting events; entertainment in the nature of contests, competitions and games; advice, information and consultancy services relating to the aforesaid services;

scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services; computer services, namely, hosting on-line web facilities for others for organizing and conducting on-line meetings, gatherings, and interactive discussions; and computer services in the nature of customized web pages featuring user-defined information, personal profiles and information; providing use of software applications through a website; computer services in the nature of customised web pages featuring user-defined information, personal profiles and information; computer services, namely, hosting on-line web facilities for others for organising and conducting on-line meetings, gatherings, and interactive discussions; hosting of digital content on the Internet, namely, on-line journals and blogs; providing temporary use of non-downloadable computer software for use in the creation and publication of on-line journals and blogs; advice, information and consultancy services in relation to the aforesaid services;

Internet based dating, introduction and social networking services; advice, information and consultancy services relating to the aforesaid services.

The above services are in classes 35, 38, 41, 42 and 45 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 3 July 2009 Crytek Entertainment GmbH (Crytek) filed a notice of opposition to the registration of the trade mark. Crytek relies upon section 5(2)(b) of the Trade Marks Act 1994 (the Act). Under section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

Crytek relies on international registration no 999915, designating the European Community, for the trade mark GAME FACE. The date of designation of the European Community is 26 September 2008; the registration has an international priority date of 27 March 2008. The international registration has been granted protection. Crytek relies upon the following goods and services of the registration:

software, namely computer software for the management, transmission, storage and sharing of computer game programs and electronically stored information across computer networks to users, and for downloading and use of games by users; computer games (software); games for game consoles (software); software for game consoles; magnetic or optical data carriers pre-recorded with software for computers, game consoles, games, video games or other electronic publications; computer game software and game software for game consoles, hand-held game consoles and mobile phones provided by multimedia electronic broadcast or online network transmission; video game cassettes and video tapes; integrated circuits with software for computers, game consoles, video players and game automata recorded thereon;

books; periodically published publications; booklets; pamphlets; information leaflets; packaging made of paper, cardboard or plastics (included in this class); printed matter; instructional and teaching material (except apparatus); posters and placards; brochures for video games; manuals;

news agency services for collecting and supplying news and transmission of press releases; providing access to information on the Internet; providing access to platforms and portals on the Internet; providing online chatlines, chat rooms and electronic bulletin boards; providing online discussion forums and electronic mailboxes for the transmission of news between users in fields of common interest, also including interactive survey pages relating to entertainment and various topics, in particular video and computer games; electronic transmission of news in the form of emails and instant messaging services via the Internet and other global computer networks; text based and numeric wireless digital transmission of messages; providing multiple-user access to a global computer information network for the transfer and dissemination of a wide range of information and services, and for accessing third party and proprietary websites; communication services, namely, transmission of voice, audio, visual images and data by telecommunications networks, wireless communication networks, the Internet, information services networks and data networks; streaming audio and video material on the Internet; video-on-demand transmission services via the Internet and other global computer networks; providing voice communication services over the Internet; providing online facilities for real-time interaction with other computer users concerning topics of general interest and for playing games (in this class); data transmission services, namely providing media data files via the Internet and other global computer networks (podcasting), transmission of audio-visual data via an IP-based network (webcasting) and instant messaging services; providing access to software applications via a website;

organization of contests (entertainment) relating to video games, education and/or entertainment; organization of exhibitions in the field of entertainment; publication of texts (excluding advertising texts) in the field of entertainment, education and training; publishing of press magazines, newspapers, magazines and books; providing information relating to online computer games and other

kinds of online entertainment services; providing online games (via a computer network); providing games by means of communication via mobile phones; providing games via or for mobile phones; providing of online information via the Internet in the fields of movies, television entertainment and video entertainment, music, news, games, art and contemporary arts; providing information and content in the fields of computer games, online games, movies, television, sports, comedy and cultural activities via an online computer database, production and distribution of audio-visual entertainment transmitted via mobile communication devices; production and rental of movies.

The above goods and services are in classes 9, 16, 38 and 41 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3) Crytek claims that the respective trade marks are similar and that all of the services of the application are identical or similar to the goods and services of the international registration.

4) PL filed a counterstatement denying that the respective trade marks are similar and requesting the rejection of the opposition.

5) Only PL filed evidence. It also filed written submissions.

6) A hearing was held on 11 November 2011. Crytek was represented by Ms Linda Harland of Reddie & Grose LLP. PL was represented by Mr Mark Chadwick of the company.

Evidence of PL

7) PL's evidence shows what it has done in business. This is not pertinent to the decision to be made in this case; which relates to comparing the respective trade marks and the respective goods and services. In written submissions, PL refers to what Crytek does. Again this is not pertinent to the decision to be made, which relates to comparing the respective trade marks and the respective goods and services. PL has also claimed that it has examined the trade marks register of the United Kingdom and that there are over 400 different trade marks "in the relevant classes that contain the word FACE". No details of these trade marks have been furnished and so it is neither possible to see the nature of the goods and services nor the nature of the trade marks. State of the register evidence does not indicate whether there will not be confusion in the market place in relation to the respective trade marks. Jacob J in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 and the General Court (GC)¹ in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and*

¹ All of the judgments of the General Court and the Court of Justice of the European Union can be found at the url: <http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=en>

Designs) (OHIM) Case T-400/06 and *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-135/04 have both rejected arguments based upon state of the register evidence. In the last judgment the General Court (GC) stated:

“68. As regards the search of the Cedexlex database, the mere fact that a number of trade marks relating to Class 35 contain the word ‘bus’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks actually used in relation to the services concerned. Secondly, it includes a number of trade marks in which the word ‘bus’ is used descriptively by public transport businesses.”

The issues have to be judged on the particular trade marks in question, a claimed common use of the word FACE says nothing about the trade marks of the parties in these proceedings.

Average consumer and nature of purchasing decision

8) The average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant”ⁱ. The specifications of the two trade marks cover a wide spectrum of goods and services. Some of these will be bought after a careful and educated decision, eg business management. Others may well be purchased without a good deal of consideration, eg books. The average consumers will also vary widely; business management services will be bought by businesses whilst books are bought by the public at large.

Comparison of goods and services

9) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade”ⁱⁱ. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning”ⁱⁱⁱ. Consideration should be given as to how the average consumer would view the services”^{iv}. The class in which goods and services are placed may be relevant in determining the nature of the goods or services”^v. In assessing the similarity of services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary”^{vi}. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 GC explained when goods were to be considered to be complementary:

“82 It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed^{vii}. Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

Services can be considered as identical when the services designated by the earlier trade mark are included in a more general category, designated by the trade mark application^{viii}.

10) In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97 the Court of Justice of the European Union (CJEU) stated:

“22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.”

The court required evidence of similarity to be adduced. This finding has been reiterated by the CJEU and GC, eg in *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-316/07:

“43 Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

The above part of the Canon judgment has been more recognised in the breach than in the observance in this jurisdiction (and before OHIM). It may not always

be practical to adduce evidence of similarity; it may be that the nature of the goods is so well-known that it would be a waste of effort and resources to do so. However, the onus is upon an opponent at least to make submissions as to why goods and services are similar.

11) Prior to the hearing, Crytek was specifically required to produce detailed submissions as to how the respective goods and services were similar or identical; it having made no indication as to the basis of the claims in its statement of grounds. Crytek has, at the very minimum, to identify which goods and services of its registration it considers similar to the services of the application. It cannot expect the decision maker to permutate each item in its registration with the services of the application to ascertain whether there might or might not be similarity. Crytek filed the opposition, it made the claim re similarity and identity; it can be expected that it knows on what basis it made the claim. It has had a considerable length of time since the filing of the opposition to consider the basis of its claims. In its skeleton argument, the basis of its analysis is the argument considered in paragraph 15 and comparative lists of where it considers the respective goods and services are similar. In certain cases there are clear links between the respective goods and services. (Crytek makes reference to *software for graphics data processing* and *virtual reality game software*, which are included in its registration; however, it did not rely upon these goods in its grounds of opposition and so they cannot be taken into account.

12) At the hearing, Ms Harland conceded that the following services of the application are neither similar nor identical to the goods and services of the earlier registration:

business management; business administration; office functions;

sporting and cultural activities; lottery services;

scientific and technological services and research and design relating thereto; industrial analysis and research services.

13) Crytek has identified services that it considers identical as follows:

communication services, namely, telecommunications services; transmission of voice, audio, visual communication services, namely, images and data by transmission of voice, audio, visual telecommunications networks, wireless images and data by communication networks, the Internet, telecommunications networks, wireless information services networks and data communications networks and the Internet; providing voice networks communication over the Internet

providing online chatlines, chat rooms chat room services; providing on-line

and electronic bulletin boards; chat rooms and electronic bulletin boards for transmission of messages providing online discussion forums and electronic mailboxes for the transmission of news between users in fields of common interest, also including interactive survey pages relating to entertainment and various topics, in particular video and computer games

providing access to platforms and portals on the Internet

electronic transmission of news in the form of emails and instant messaging services via the Internet and other global computer networks; text based and numeric wireless digital transmission of messages

providing multiple-user access to a global computer information network for the transfer and dissemination of a wide range of information and services, and for accessing third party and proprietary websites

streaming audio and video material on the Internet; video-on-demand transmission services via the Internet and other global computer networks

providing voice communication services over the Internet; providing online facilities for real-time interaction with other computer users concerning topics of general interest and for playing games (in this class)

data transmission services, namely providing media data files via the Internet and other global computer networks (podcasting), transmission of audio-visual data via an IP-based network (webcasting) and instant messaging services

production and distribution of audio-visual entertainment transmitted via mobile communication devices; production and rental of movies *entertainment; on-line entertainment*

providing online games (via a computer network); providing games by means of communication via mobile phones; providing games via or for mobile phones *electronic games services provided by means of the Internet*

publication of texts (excluding advertising texts) in the field of entertainment, education and training; publishing of press magazines, newspapers, magazines and books; providing information relating to online computer games and other kinds of online entertainment services *the provision of on-line electronic publications; on-line journals, namely, blogs featuring personal information and opinions*

providing of online information via the Internet in the fields of movies, television entertainment and video entertainment, music, news, games, art and contemporary arts; providing information and content in the fields of computer games, online games, movies, television, sports, comedy and cultural activities via an online computer database *providing an on-line directory information service featuring information regarding, and in the nature of, collegiate life, general interest, classifieds, virtual community, social networking, photo sharing, and transmission of photographic images; entertainment services, namely, providing a web site featuring audio, video, graphics, text and other multimedia content*

organization of contests (entertainment) relating to video games, education and/or entertainment; organization of exhibitions in the field of entertainment *entertainment in the nature of contests, competitions and games*

14) The respective class 38 and 41 services are identical, as identified by Crytek.

15) Crytek claims that the remaining respective goods and services are similar as both parties provide information through the same kinds of channel; via a website accessible by means of the Internet and offering chat room and social networking facilities. The use of the Internet and social networking facilities are used by all sorts of businesses for all sorts of goods and services. This cannot

be considered as being a basis for establishing similarity. Crytek submits that the respective goods and services are aimed at the same customer grouping; it claims that teenage boys and younger men are the main consumers of sports information and electronic and on-line games. There is no evidence to substantiate this claim; an interest in sport is hardly limited by age and gender. There is a claim that those who are interested in real sports may enjoy sports related computer games and may use computer and video simulations for the purposes of analysis of gameplay and sports training. This may be the case, but the users of computer tools for the analysis of sporting performance are likely to be highly sophisticated purchasers. Crytek in its consideration of the similarities of the goods and services is following the line of PL, in looking at what the two undertakings do, rather than the specifications.

16) The attack on the various advertising related services in class 35 is based on the class 9 and 16 goods of the earlier registration. Advertising services may use the Internet, they may use publications; the means of dissemination does not make the means similar to the service. Crytek considers that the similarity is particularly evident where it relates to the goods of its registration. On this logic advertising services are similar to any goods that they advertise; such an argument is unsustainable. There is no meaningful coincidence, within the parameters of the case law, between advertising services and the class 9 and 16 goods of the earlier registration. The claim that the former services are similar to the latter goods is dismissed. This rejection encompasses the following services of the application:

advertising; advertising and information distribution services, namely, providing classified advertising space via the global computer network; promoting the goods and services of others over the Internet; providing on-line computer databases featuring classified listings of goods and services, real estate, personals, want ads and employment opportunities; dissemination of advertising for others via the Internet; providing and rental of advertising space on the Internet; on-line advertising and marketing services;

17) *On-line retail store services in relation to the sale of downloadable pre-recorded music, video and computer games, books and printed materials, clothing, footwear, headgear, sporting and gymnastic apparatus and equipment, toys and games; promoting the goods of others by means of operating an on-line shopping mall with links to the websites of others all fall within the parameters of retailing. (The last part of the specification goes beyond the parameters of advertising and crosses into the retail area as it is, effectively, a virtual mall.)*

18) The attack on the retailing related services of class 35 is based on the class 9 and 16 goods of the earlier registration. In *Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-116/06* the GC considered the similarity between retail services and the goods that are sold by the retailer:

“42 According to settled case-law, in assessing the similarity between goods or services, all the relevant factors which characterise the relationship which may exist between them should be taken into account. Those factors include their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary (*Canon*, paragraph 23; Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237, paragraph 85; Case T-99/01 *Mystery Drinks v OHIM – Karlsberg Brauerei (MYSTERY)* [2003] ECR II-43, paragraph 39, and case-law cited; and Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gómez Frías (euroMASTER)*, not published in the ECR, paragraph 31).

43 With regard, in particular, to the registration of a trade mark covering retail services, the Court held, in paragraph 34 of the judgment in *Praktiker Bau- und Heimwerkermärkte*, that the objective of retail trade is the sale of goods to consumers, which includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction, and that that activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question rather than with a competitor. The Court stated, in paragraph 35 of that judgment, that no overriding reason based on First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1) or on general principles of Community law precludes those services from being covered by the concept of ‘services’ within the meaning of the directive or, therefore, the trader from having the right to obtain, through the registration of his trade mark, protection of that mark as an indication of the origin of the services provided by him.

44 The Court stated furthermore in *Praktiker Bau- und Heimwerkermärkte*, paragraph 17 above (paragraphs 49 and 50), that, for the purposes of registration of a trade mark covering services provided in connection with retail trade, it is not necessary to specify in detail the service(s) for which that registration is sought. However, the applicant must be required to specify the goods or types of goods to which those services relate.

45 In the first place, with regard to the assessment of the similarity of services consisting of ‘retail and wholesale of clothing, headwear, footwear, athletic bags, backpacks and knapsacks and wallets’ covered by the contested Community trade mark, on the one hand, and goods covered by the earlier trade mark, that is ‘clothing, headwear, footwear, rucksacks, all-purpose sports bags, travelling bags, wallets’, on the other, the Board of Appeal found, in paragraphs 18 to 23 of the contested

decision, that there was a strong similarity between those services and goods on account of their nature, their purpose, their method of use, their distribution channels and their complementary nature.

46 With regard, first, to the nature, purpose and method of use of the services and products in question, it cannot be held that those services and products are similar.

47 Indeed – as also pointed out by the Cancellation Division in paragraphs 21 and 22 of the decision of 18 June 2004 – the nature of the goods and services in question is different, because the former are fungible and the latter are not. Their purpose is also different, since the retail service precedes the purpose served by the product and concerns the activity carried out by the trader for the purpose of encouraging the conclusion of the sales transaction for the product in question. So, for example, an item of clothing is intended in particular to clothe the person who purchases it, whereas a service linked to the sale of clothes is intended, *inter alia*, to offer assistance to the person interested in the purchase of that clothing. The same applies to their method of use, which for clothes means the fact of wearing them, whereas the use of a service linked to the sale of the clothes consists, *inter alia*, in obtaining information about the clothes before proceeding to buy them.

48 With regard, second, to the distribution channels of the services and the goods in question, it is correct, as rightly pointed out by the Board of Appeal in paragraph 22 of the contested decision, that retail services can be offered in the same places as those in which the goods in question are sold, as the applicant has also recognised. The Board of Appeal's finding that retail services are rarely offered in places other than those where the goods are retailed and that consumers need not go to different places to obtain the retail service and the product they buy, must therefore be upheld.

49 Contrary to what is claimed by the applicant, the fact that the retail services are provided at the same sales points as the goods is a relevant criterion for the purposes of the examination of the similarity between the services and goods concerned. In that regard, it should be pointed out that the Court has held, in paragraph 23 of *Canon*, paragraph 16 above, that, in assessing the similarity of the goods and services in question, all the relevant factors characterising the relationship between the goods or services should be taken into account. It stated that those factors include their nature, purpose, method of use, and whether they are in competition with each other or are complementary, meaning that it did not in any way regard those factors are the only ones which may be taken into account, their enumeration being merely illustrative. The Court of First Instance therefore concluded from this that other factors relevant to the

characterisation of the relationship which may exist between the goods or services in question may also be taken into account, such as the channels of distribution of the goods concerned (Case T-443/05 *El Corte Inglés v OHIM– Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR II-0000, paragraph 37; see also, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 65, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; and Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 95).

50 Furthermore, contrary to the applicant's assertion, which is moreover unsubstantiated, that, as the majority of the goods are sold in supermarkets, consumers do not attach too much importance to the point of sale when making up their mind whether goods share a common origin, it must be held that, as contended by OHIM, the manufacturers of the goods in question often have their own sales outlets for their goods or resort to distribution agreements which authorise the provider of the retail services to use the same mark as that affixed to the goods sold.

51 It was therefore correct, in paragraph 22 of the contested decision, to take into account, when comparing the goods and the services covered by the trade marks in dispute, the fact that those goods and services are generally sold in the same sales outlets (see, in that regard, *SISSI ROSSI*, paragraph 49 above, paragraph 68, and *PiraÑAM diseño original Juan Bolaños*, paragraph 49 above, paragraph 37).

52 Regarding, third, the complementary nature of the services and goods in question, found to exist by the Board of Appeal in paragraph 23 of the contested decision, it should be pointed out that, according to settled case-law, complementary goods are those which are closely connected in the sense that one is indispensable or important for the use of the other, so that consumers may think that the same undertaking is responsible for both (see, to that effect, *SISSI ROSSI*, paragraph 49 above, paragraph 60; *PAM PLUVIAL*, paragraph 49 above, paragraph 94; and *PiraÑAM diseño original Juan Bolaños*, paragraph 49 above, paragraph 48).

53 In that regard, it must be pointed out that the goods covered by the earlier mark, that is, clothing, headwear, footwear, rucksacks, all-purpose sports bags, travelling bags and wallets, are identical to those to which the applicant's services relate.

54 Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of *Praktiker Bau- und*

Heimwerkermärkte, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.

55 Furthermore, the relationship between the goods covered by the earlier trade mark and the services provided in connection with retail trade in respect of goods identical to those covered by the earlier trade mark is also characterised by the fact that those services play, from the point of view of the relevant consumer, an important role when he comes to buy the goods offered for sale.

56 It follows that, because the services provided in connection with retail trade, which concern, as in the present case, goods identical to those covered by the earlier mark, are closely connected to those goods, the relationship between those services and those goods is complementary within the meaning of paragraphs 54 and 55 above. Those services cannot therefore be regarded, as the applicant claims, as being auxiliary or ancillary to the goods in question.

57 Thus, notwithstanding the incorrect finding of the Board of Appeal to the effect that the services and goods in question have the same nature, purpose and method of use, it is indisputable that those services and goods display similarities, having regard to the fact that they are complementary and that those services are generally offered in the same places as those where the goods are offered for sale.

58 It therefore follows from all of the foregoing that the goods and services in question resemble each other to a certain degree, with the result that the finding in paragraph 24 of the contested decision that such a similarity exists must be upheld.

It is taken from this judgment, and that of the GC in *Yorma's AG c Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI)* Case T-213/09, that goods can be considered similar to retail services, being complementary, where the retail services relate, or could relate, to the goods of an earlier registration. In this case this affects the following parts of the class 35 specification:

on-line retail store services in relation to the sale of downloadable pre-recorded music, video and computer games, toys and games; promoting the goods of others by means of operating an on-line shopping mall with links to the websites of others.

The final part of the specification is included as it covers a virtual shopping mall for all goods and services. Consequent upon the above, the following services are not considered to be similar to the goods of the earlier registration:

on-line retail store services in relation to the sale of clothing, footwear, headgear, sporting and gymnastic apparatus and equipment

as they do not relate to goods in Crytek's registration and so are not complementary.

19) Crytek considers that *compilation and management of on-line computer databases and on-line searchable databases* are similar to *providing of online information via the Internet in the fields of movies, television entertainment and video entertainment, music, news, games, art and contemporary arts; providing information and content in the fields of computer games, online games, movies, television, sports, comedy and cultural activities via an online computer database*. The services of the application are in class 35; they relate to the actual compilation and management of the databases, the content is secondary to the service. They are services provided to third parties, compiling and managing the data of the third party, which will invariably be a business. The services upon which Crytek relies are supplied to the public at large. The services have different purposes; those of PL are to manage and compile data, those of Crytek to supply data to the public at large. Consequently, the end consumers will be different and the channels of trade will be completely different. The average consumer of Crytek's services will have no idea and no interest in the undertaking which has compiled or managed the data to make it accessible. The services are not fungible, they are not in competition. The respective services have a mutually dependant relationship in that data compilation is essential to the ability to be able to access the data. However, owing to the fundamental differences in the services and the users of the services it is most unlikely that the average consumers, who will be very different, will believe that the responsibility for the services lay with the same undertaking. Consequently, it is not considered that the services are complementary; as per *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* and are not, therefore, similar.

20) In relation to the class 42 services of the application, in its skeleton argument Crytek did not identify which of the goods and services of its registration that it considered to be similar to *computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; and computer services in the nature of customized web pages featuring user-defined information, personal profiles and information; computer services in the nature of customised web pages featuring user-defined information, personal profiles and information*. At the hearing Ms Harland submitted that the claim of similarity was made on the same basis as for other computer related services. Crytek submits that *software, namely computer software for the management, transmission, storage and*

sharing of computer game programs and electronically stored information across computer networks to users, and for downloading and use of games by users; computer games (software); software for game consoles; providing online chatlines, chat rooms and electronic bulletin boards; providing online discussion forums and electronic mailboxes for the transmission of news between users in fields of common interest; providing access to platforms and portals on the Internet are similar to design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; creating, maintaining and hosting the web sites of others; design services; computer services, namely, hosting on-line web facilities for others for organizing and conducting on-line meetings, gatherings, and interactive discussions; providing use of software applications through a website; providing temporary use of non-downloadable computer software for use in the creation and publication of on-line journals and blogs; computer services, namely, hosting on-line web facilities for others for organising and conducting on-line meetings, gatherings, and interactive discussions; hosting of digital content on the Internet, namely, on-line journals and blogs. The computer software of the earlier registration is not limited to games, it includes software for *storing and sharing electronically stored information across computer networks to users*. The software of the earlier registration can be used to effect the services of the application; consequently, it can be used by the same users and for the same purpose. It is normal for suppliers of software to supply a variety of support services; whether that be on-line, by telephone or in person. There is a clear symbiotic relationship between *providing access to platforms and portals on the Internet* and *creating, maintaining and hosting the web sites of others and namely, hosting on-line web facilities for others for organising and conducting on-line meetings, gatherings, and interactive discussions; hosting of digital content on the Internet, namely, on-line journals and blogs*. The nature of these services of the application is that they can be supplied to one party for onward supply to a third party. Consequently, they are services are complementary and users may believe that the responsibility for the services lays with the same undertaking. *Design services* is a broad term that includes services relating to the design of computer software, websites and the like. In such a context, there is a complementary relationship with the goods of the earlier registration. This complementary relationship may involve the same end users. The users may believe that the responsibility for the services lay with the same undertaking. Consequently, there is a degree of similarity between *design services* and the goods of the earlier registration.

21) Crytek submits that *providing online chatlines, chat rooms and electronic bulletin boards; providing online discussion forums and electronic mailboxes for the transmission of news between users in fields of common interest, also including interactive survey pages relating to entertainment and various topics, in particular video and computer games* are similar to *Internet based dating, introduction and social networking services; advice, information and consultancy services relating to the aforesaid services*. Crytek is relying upon its services in

class 38. It is to be taken into account that class 38 services furnish the means for content to be accessed and supplied, they do not cover the content. *Dating and introduction services*, whether Internet based or not, are very discrete and well defined services. How the services are provided is not pertinent to the nature of the service; just as insurance is insurance whether it is sold in person, by telephone or via the Internet. There is no coincidence in the services to which Crytek refers in class 38 services and *dating and introduction services* within the parameters of the case law. Indeed there is nothing vaguely similar in the specification of the earlier registration to these services. *Social networking services* provide the means for users to interact using the Internet. They can include *online discussion forums* and *chat rooms*; consequently, the services upon which Crytek relies could be used to supply *social networking services*. The respective services would be used by persons wishing to socialise via the Internet; the users and the means of use would be the same. The respective services are similar.

22) Crytek submits that although not all education and training services are similar to the goods and services of its earlier registration, some are; for example, those which relate to software or computer games. It submits that since PL has not identified which specific services are of interest to it, the broad terms should be refused. This is in conformity with the judgment of the GC in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05*. This is a similar line of argument that to that relating to advertising. On this basis *education and providing of training* would be similar to virtually any goods and services, as they could relate to them. The argument is rejected. However, *magnetic or optical data carriers pre-recorded with software for computers* covers all types of software; this software would include educational software. A person may choose to learn through a service or by means of educational software, or through both. Consequently, the goods and services are in competition with each other and could be for the same user and for the same purpose. *Education and providing of training* are similar to *magnetic or optical data carriers pre-recorded with software for computers*.

23) *Advice, information and consultancy services relating to the aforesaid services* throughout the specification are inextricably linked to the primary services to which they relate; consequently, they stand and fall with the primary services.

24) Therefore, the following services are not similar (and so there cannot be a likelihood of confusion in relation to them):

business management; business administration; office functions;

sporting and cultural activities; lottery services;

scientific and technological services and research and design relating thereto; industrial analysis and research services;

advertising; advertising and information distribution services, namely, providing classified advertising space via the global computer network; promoting the goods and services of others over the Internet; providing on-line computer databases featuring classified listings of goods and services, real estate, personals, want ads and employment opportunities; dissemination of advertising for others via the Internet; providing and rental of advertising space on the Internet; on-line advertising and marketing services;

on-line retail store services in relation to the sale of clothing, footwear, headgear, sporting and gymnastic apparatus and equipment;

compilation and management of on-line computer databases and on-line searchable databases;

dating and introduction services.

25) The services of the application identified in paragraph 16 are identical to the services of the earlier registration. The remaining services are similar to the goods and services of the earlier registration.

Comparison of trade marks

26) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^{ix}. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components^x. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant^{xi}. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{xii}.

27) The trade marks to be compared are: PLAYFACE and GAME FACE. Nothing turns upon the words of the trade mark of PL being conjoined. In relation to services and goods relating to play, games and gaming PLAY and GAME lack distinctiveness. In *Spa Monopole, compagnie fermière de Spa SA/NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-438/07* the GC stated:

“23 Admittedly, the consumer normally attaches more importance to the first part of words (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-965, paragraph 81). However, that argument cannot hold in all cases (see judgment of 16 May 2007 in Case T-158/05 *Trek Bicycle v OHIM – Audi (ALL TREK)*, not published in the ECR, paragraph 70 and the case-law cited) and does not, in any event, cast doubt on the principle that the assessment of the similarity of marks must take account of the overall impression created by them.”

PLAY and GAME both act as descriptors of FACE; descriptors are subservient to the object that they describe. Consequently, FACE is the more distinctive and dominant component of the two trade marks; regardless of whether the goods and/or services may relate to play, games and gaming.

28) Both trade marks have the same pattern; the word FACE at the end, with a descriptor that refers to the concept of play or games, gaming or playing; these words have a synonymic relationship. Consequently, they have a good deal of conceptual similarity. The trade marks share the word FACE and the letter A; which will be pronounced in the same fashion in both trade marks. The trade marks are similar; primarily because of the similar pattern and conceptual similarity.

Conclusion

29) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{xiii}. In this case certain of the services are identical. There are varying degrees of similarity between the other respective goods and services.

30) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^{xiv}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xv}. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings^{xvi}. GAME in the earlier trade mark is descriptive of certain of the goods and services of the registration. However, it is necessary to consider the trade mark in its entirety. In its entirety the trade mark is neither descriptive nor allusive to the goods and services of the earlier registration. It enjoys a reasonable degree of distinctiveness.

31) At the hearing Mr Chadwick referred to an absence of confusion in the market place. There is a tranche of case law to the effect that lack of confusion in the market place is indicative of very little: *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch), *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 and *Aceites del Sur-Coosur SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-498/07 P*. In *The European Limited v The Economist Newspaper Ltd* Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

This is especially the case here, as there has been no indication of use by Crytek of its trade mark. Consequently, there has been no opportunity for confusion to occur; or not to occur.

32) Mr Chadwick also referred to what PL does and what he considers Crytek does. This is not pertinent as the question in issue relates to the respective specifications, not what the undertakings are actually doing. The current marketing undertaken by the parties is not relevant to the issues to be determined, as the GC stated in *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-414/05*:

“71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant's goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors – whether carried out or not – which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”

33) Mr Chadwick referred to no notification having been issued at examination stage. This not pertinent as Crytek has not opted in for notification and so its registration would not be included in any search by an examiner.

34) In writing the decision it has been necessary to regularly check which trade mark belongs to which party; owing to the conceptual similarities and the similar patterns of the trade mark. This cannot be determinative of the decision but is indicative of the degree of confusion that is likely to arise. It is necessary to bear in mind that the average consumer seldom has the opportunity to compare trade marks directly but must rely on memory and consequently may be prey to imperfect recollection. The effects of the similarities of the trade marks are such that, regardless of the degree of care in choosing the services and regardless of the degree of similarity between the respective goods and services, there is a likelihood of confusion for all services that are identical or similar and the application is to be refused for all of the goods and services with the **exception** of the following services:

advertising, business management; business administration; office functions; advertising and information distribution services, namely, providing classified advertising space via the global computer network; promoting the goods and services of others over the Internet; compilation and management of on-line computer databases and on-line searchable databases; providing on-line computer databases featuring classified listings of goods and services, real estate, personals, want ads and employment opportunities; on-line retail store services in relation to the sale of clothing, footwear, headgear, sporting and gymnastic apparatus and equipment; dissemination of advertising for others via the Internet; providing and rental of advertising space on the Internet; on-line advertising and marketing services; advice, information and consultancy services relating to the aforesaid services;

sporting and cultural activities; lottery services; advice, information and consultancy services relating to the aforesaid services;

scientific and technological services and research and design relating thereto; industrial analysis and research services; advice, information and consultancy services relating to the aforesaid services;

dating and introduction services; advice, information and consultancy services relating to the aforesaid services.

Costs

35) Crytek for the most part having been successful, is entitled to a contribution towards its costs. Costs are awarded upon the following basis:

Opposition fee:	£200
Preparing a statement and considering the statement of PL:	£100
Preparing evidence and considering evidence of PL:	£100
Preparation for and attendance at hearing:	£200
Total:	£600

Playface Limited is ordered to pay Crytek Entertainment GmbH the sum of £600. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18 day of November 2011

**David Landau
For the Registrar
the Comptroller-General**

ⁱ *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* Case C-342/97.

ⁱⁱ *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

ⁱⁱⁱ *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

^{iv} *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

^v *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

^{vi} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{vii} He considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(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.”

^{viii} See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05 paragraph 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

^{ix} *Sabel BV v Puma AG* Case C-251/95.

^x *Sabel BV v Puma AG* Case C-251/95.

^{xi} *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

^{xii} *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

^{xiii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{xiv} *Sabel BV v Puma AG* Case C-251/95.

^{xv} *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

^{xvi} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.