

O/922/22

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 03671295 BY
SHANGHAI ZHENGLANG TECHNOLOGY CO., LTD.
TO REGISTER THE TRADE MARK:**

Bubble Pop Origin

IN CLASSES 9 & 41

AND

**OPPOSITION THERETO
UNDER NO. 428462
BY
GAMEDUELL GMBH**

BACKGROUND & PLEADINGS

1. Shanghai Zhenglang Technology Co., Ltd. (“**the applicant**”), applied to register the trade mark shown on the front page of this decision in the United Kingdom on 21 July 2021. It was accepted and published in the Trade Marks Journal on 10 September 2021 for the following goods and services:

Class 9: Computer game software downloadable from a global computer network; Computer game software, downloadable; Computer games programmes downloaded via the internet; Computer games programmes downloaded via the internet [software]; Computer game programs; Computer game software; Computer game software for use on mobile and cellular phones; Electronic game programs; Electronic game software; Electronic game software for handheld electronic devices; Game software; Recorded computer game programs; Computer application software for mobile phones; Computer programs for pre-recorded games; Downloadable computer game programs; Audio visual recordings.

Class 41: Coaching [training]; organization of competitions [education or entertainment]; providing online electronic publications, not downloadable; entertainment services; zoological garden services; modelling for artists; teaching; on-line game services; providing amusement arcade services; video editing services for events; audio and video recording services; providing online videos, not downloadable; audio, film, video and television recording services; Entertainment; Musical entertainment; Interactive entertainment; Radio entertainment; Television entertainment; Online entertainment services; Post-production editing services in the field of music, videos and film; Operation of video and audio equipment for the production of radio and television programs; Music recording; Recording services; Sound recording studios; Video recording services;

Production of sound recordings; Production of videos; production of sound and video recordings.

2. GameDuell GmbH (“**the opponent**”) opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opponent is the proprietor of the following mark:

Trade Mark no.	UK00801073863 ¹
Trade Mark	Bubble Popp
Goods & Services	Classes 9, 28, 38 & 41
Relevant Dates	Filing date: 15 February 2011
	Date of entry in register: 13 March 2012

3. For the purpose of this opposition, the opponent relies on all goods in Classes 9 and 28 and all services in Class 41, as shown later in this decision. The opposition concerns all of the applicant’s goods in Class 9 and only part of the applicant’s services in Class 41, as follows:

Class 41: Organization of competitions [education or entertainment]; providing online electronic publications, not downloadable; entertainment services; on-line game services; providing amusement arcade services; video editing services for events; audio and video recording services; providing online videos, not downloadable; audio, film, video and television recording services; Entertainment; Interactive entertainment; Television entertainment; Online entertainment services; Post-production editing services in the field of music, videos and film; Production of sound recordings; Production of videos; production of sound and video recordings.

¹ The trade mark relied upon by the opponent is a UK ‘comparable’ trade mark. It is based on the opponent’s earlier International Registration which has designated the EU (“IR(EU)”). On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with an existing IR.

4. In its notice of opposition, the opponent argues that the competing marks are visually, phonetically, and conceptually, highly similar, stating “[b]oth marks are "bubble pop" marks and the addition of a second letter "p" (a silent letter) to one mark or the secondary word "Origin" to the other, does not detract from the fact that both would be seen by the relevant consumer as "bubble pop" marks as this is the dominant and distinctive element of both marks”. Further, it claims that the contested goods and services are the same or similar to the opponent’s.
5. In response, the applicant filed a counterstatement, denying any similarity between the marks. I will return to some of the contentions of the applicant later in my decision. The applicant concedes that part of the goods and services are similar and part dissimilar. I will reproduce these contentions later in my decision. The applicant requests that the opponent provides proof of use of its earlier mark relied upon.
6. I note that the applicant, together with its counterstatement, incorrectly filed evidence. However, with an official letter, dated 2 March 2022, the Registry informed the parties that the documents provided by the applicant could not be admitted into the proceedings as evidence as they had not been filed in the correct format. Consequently, these documents will not be taken into consideration in the decision at hand.
7. Only the opponent filed evidence in these proceedings, which will be summarised to the extent that I consider necessary. Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision.
8. No hearing was requested and so this decision is taken following a careful perusal of the papers.
9. In these proceedings, the opponent is represented by MW Trade Marks Limited and the applicant by Akos Suele, LL.M.

10. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Relevant Date/Period

11. An “earlier trade mark” is defined in Section 6(1) of the Act:

“(1) In this Act an “earlier trade mark” means –

- (a) a registered trade mark, international trade mark (UK) or European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

[...]

- (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered. [...]

12. As the earlier mark relied upon had been registered for more than five years on the date on which the contested application was filed, Section 6A of the Act applies, which states:

“(1) This Section applies where–

- (a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

13. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union”.

14. In accordance with Section 6(1) of the Act, the opponent’s trade mark clearly qualifies as an earlier mark. The relevant period for proof of use of the opponent’s mark is **22 July 2016 to 21 July 2021**. In the present proceedings, the opponent relies on a UK comparable mark, i.e. IR (EU), and, thus, it is possible for the opponent to rely on evidence of use in the EU as set out in Tribunal Practice Notice 2/2020.² In accordance with paragraph 7(3) of Part 1 of Schedule 2A of the Act, the assessment of use shall take into account any use of the corresponding EUTM prior to IP Completion Day, being 31 December 2020. Therefore, for the portion of the relevant five year period between **22 July 2016 and 31 December 2020**, evidence of use of the mark in the EU may be taken into account.
15. The relevant date for the assessment of likelihood of confusion as per Section 5(2)(b) is the date on which the contested application was filed, namely **21 July 2021**.

EVIDENCE

Opponent’s Evidence

16. The opponent’s evidence consists of a witness statement by Kai Bolik and Boris Wasmuth, who are the Managing Directors of GameDuell GmbH (the opponent), a position they have held for 19 years. The main purpose of the evidence is to demonstrate that the earlier mark has been genuinely used in the UK for the relevant period.
17. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

² See ‘Tribunal Practice Notice (2/2020) End of Transition Period – impact on tribunal proceedings’.

DECISION

Proof of Use

18. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114. [...]The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C 416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I 4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d)

the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus, there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

19. As the earlier mark is a comparable mark, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 are also relevant. The court noted that:

“36.It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use. [...]

50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark. [...]

55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)."

20. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance

with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

21. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since *Leno* and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute

genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted Leno as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]- [40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of Leno persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multifactorial one which includes the geographical extent of the use."

22. The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even

where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

23. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the IR(EU), in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I must consider all relevant factors, including:

- i. The scale and frequency of the use shown
- ii. The nature of the use shown
- iii. The goods and services for which use has been shown
- iv. The nature of those goods/services and the market(s) for them
- v. The geographical extent of the use shown

24. The onus is on the proprietor of the earlier mark to show use. This is in accordance with Section 100 of the Act, which states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

25. Proven use of a mark which fails to establish that “the commercial exploitation of the marks is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

Form of the Mark

26. In Case C-12/12 *Colloiseum Holdings AG v Levi Strauss & Co.*, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.”

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the

purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)." (Emphasis added)

27. Where the issue is whether the use of a mark in a different form, rather than with, or as part of, another mark, constitutes genuine use of the mark as registered, the decision of Mr Richard Arnold KC (as he then was), sitting as the Appointed Person, in *Nirvana Trade Mark*, BL O/262/06, is relevant. He said:

"33. [...] The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period. [...]"

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

28. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of

the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

a.



30. The opponent’s mark is a word mark capitalised and in standard typeface. The use of the word element “BUBBLE POPP”, as shown in ‘b’, is presented in upper case and slightly stylised in white font with blue outline. Such variations in colour, case, and font are within the confines of fair and notional use, and, thus, I am not of the view that the colour has been used in a complex colour arrangement. As a result, and in accordance with *Colloseum*, I consider the mark shown above is an example of use of the opponent’s mark as registered. The same applies in ‘a’ as the word retains its independent use as an indicator of origin, even though it appears slightly more stylised than in ‘b’. If I am wrong on this finding, I find that the overall presentation of the mark does not in my view alter the distinctiveness of the mark as registered. Consequently, I find that this is an acceptable variant of the “Bubble Popp” mark as per *Lactalis*.

Genuine Use

31. As indicated in the case law cited earlier in this decision, use does not need to be quantitatively significant to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.
32. In their witness statement, Kai Bolik and Boris Wasmuth state that the opponent is “one of the big worldwide cross-platform games communities. GameDuell has about 54 million of registered players overall and offers more than 40 multiplayer games accessible to customers, one of which is our Bubble Popp game.” The witness statement provides undated screenshots from the online website *gameduel.co.uk*, which demonstrates the game platform bearing the registered mark.³ In addition, Kai Bolik and Boris Wasmuth explain in their witness statement that the app version was available on the UK App Store⁴ until at least June 2018, which, subsequently, remained available for existing users to re-download it. In this regard, the opponent adduced undated screenshots depicting the downloading of the Bubble Popp app from the Apple App Store on a mobile device.⁵
33. With its witness statement, the opponent also provides a Sales Report from the Apple App Store Connect,⁶ which contains app analytics in relation to the iOS version of the Bubble Popp app. It is said that it includes a “non generating revenue activity in GBP Currency region” as follows:

³ Exhibit A.

⁴ Although it is not indicated, it appears that the witnesses refer to the UK Apple App Store.

⁵ Exhibit B.

⁶ Exhibit C.

36. Further, an unchallenged annual breakdown of the UK sales figures from 2017 to 2022 relating to goods sold under the earlier mark is provided with the witness statement, which is as follows:

2022 (until and including April 2022):	211,000 €
2021:	574,000 €
2020:	616,000 €
2019:	576,000 €
2018:	565,000 €
2017:	645,000 €

37. The figures covering the relevant period begin at over €645,000 in 2017, fluctuating over the years to approximately £574,000 in 2021. Whilst the 2021 figures include turnover falling outside (post-dating) the relevant time period, it is reasonable to assume from the previous annual figures that at least a portion of the turnover will fall within the relevant time period. Admittedly, the UK computer/video games market is a significant one, and even though the opponent did not provide any evidence as to the market share it possesses, I am satisfied that this evidence supports that the opponent has operated in a way aimed at real commercial exploitation and has done so for a number of years.

38. In addition to the above figures, the witness statement provides an annual breakdown of the UK customer figures as follows:

10. The number of our UK customers are as follows:

2022 (until and including April 2022):	9,000
2021:	17,500
2020:	17,700
2019:	16,000

39. Although the evidence could have been better and more comprehensive in parts, such as demonstration of market share and marketing expenditure, an assessment of genuine use is a global assessment, which requires looking at the evidential picture as a whole and not whether each

individual piece of evidence shows use by itself.¹⁰ Bearing in mind the forms of the mark I have said may be considered, I am satisfied that the evidence supports genuine use in the UK of the mark during the relevant period. As such, the opponent can rely upon the registered mark for the purpose of these proceedings.

Fair specification

40. I must now consider what a fair specification would be for the use shown.

41. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs K.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose, the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

42. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

¹⁰ See *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09.

iv) In cases of partial revocation, pursuant to Section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("*Asos*") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

43. The opponent has submitted that the earlier mark has been used in relation to all the goods in Classes 9 and 28 and all services in Class 41 relied

upon in this opposition. One of the areas in which the opponent's evidence could have been more helpful is to illustrate the link between what it has used the mark on and how that relates to the specification they have registered. This is particularly so given the technical nature of the use in the case at hand. From my perspective, the evidence only really shows use of the mark on goods and services in relation to mobile/online video games. The specification in Classes 9 and 28 and services in Class 41 reads as follows:

Class 9: Computer programs (downloadable software); computer programmes (programs), recorded; stored and downloadable computer programs, in particular computer and video games; stored and downloadable computer programs, especially for computer and video games; electronic publications, downloadable; computer and apparatus for video games adapted for use with an external display screen or monitor; data processing apparatus; recorded data carriers for recording computer, in particular recorded ROM; compact discs, especially CD- and DVD-ROMs; recorded compact discs, sound and image, especially with computer and video games; recorded image, sound and data carriers; video recordings on digital media, in particular with computer and video games; hardware for computer games and online computer games, included in this class.

Class 28: Apparatus for Games other than those adapted for use with an external display screen or monitor; games; games other than those adapted for use with an external display screen or monitor; board games.

Class 41: Game services provided on-line from a computer network; organization of competitions (education or entertainment), in particular on the Internet; providing on-line electronic publications, not downloadable; electronic desktop publishing; entertainment services offered via the Internet, in particular in relation with computer and video games; entertainment services offered via other wireless media or over cable connections; online entertainment in the range of video

and computer games; entertainment, in particular holding of information and game shows via the Internet; organisation of gaming events and games, in particular on the Internet; offering of entertainment services to organize gaming tournaments, in particular on the Internet; organization of competitive computer and video games.

44. Some of the terms in Class 9, for example, “*Computer programs (downloadable software)*”, are far too broad to properly reflect the use shown and would not represent a fair description. Also, other terms do not really represent the use shown, for example, “*Apparatus for Games other than those adapted for use with an external display screen or monitor; games; board games*” in Class 28 and “*compact discs, especially CD- and DVD-ROMs; recorded compact discs, sound and image, especially with computer and video games; recorded image, sound and data carriers; video recordings on digital media, in particular with computer and video games; hardware for computer games and online computer games, included in this class*” goods in Class 9. Consequently, I consider a fair specification to be:

Class 9: Computer **game** programs (downloadable software); stored and downloadable computer programs, **namely** computer and video games.

Class 41: **Computer and video game** services provided on-line from a computer network; **computer and video games** services offered via the Internet; **computer and video games** services offered via other wireless media or over cable connections; **online video and computer games**; **computer and video games** entertainment services offered via the Internet; **computer and video games entertainment** services offered via other wireless media or over cable connections; online **computer and video games** entertainment.

Section 5(2)(b)

45. The relevant statutory provisions are as follows:

Section 5(2)(b) of the Act states:

“A trade mark shall not be registered if because-

[...]

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

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

46. The principles, considered in this opposition, stem from the decisions of the European Courts in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose

attention varies according to the category of goods or services in question;

- c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of Goods and Services

47. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

48. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. 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 complementary.”

49. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281. At [296], he identified the following relevant factors:

- “(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.”

50. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

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

51. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment, he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“[...] the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

52. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

53. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] 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.”

54. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“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.”

55. Taking into account the fair specification I indicated earlier, the competing goods and services to be compared are shown in the following table:

Opponent's Goods & Services	Applicants' Goods & Services
Class 9: Computer game programs (downloadable software); stored and downloadable computer programs, namely computer and video games.	Class 9: Computer game software downloadable from a global computer network; Computer game software, downloadable; Computer games programmes downloaded via the internet; Computer games programmes downloaded via the internet [software]; Computer game programs; Computer game software; Computer game software for use on mobile and cellular phones; Electronic game programs; Electronic game software; Electronic game software for handheld electronic devices; Game software; Recorded computer game programs; Computer application software for mobile phones; Computer programs for pre-recorded games; Downloadable computer game programs; Audio visual recordings.
Class 41: Computer and video game services provided on-line from a computer network;	Class 41: Organization of competitions [education or entertainment]; providing online electronic publications, not downloadable; entertainment services;

computer and video games services offered via the Internet; computer and video games services offered via other wireless media or over cable connections; online video and computer games; computer and video games entertainment services offered via the Internet; computer and video games entertainment services offered via other wireless media or over cable connections; online computer and video games entertainment.	on-line game services; providing amusement arcade services; video editing services for events; audio and video recording services; providing online videos, not downloadable; audio, film, video and television recording services; Entertainment; Interactive entertainment; Television entertainment; Online entertainment services; Post-production editing services in the field of music, videos and film; Production of sound recordings; Production of videos; production of sound and video recordings.
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56. In its counterstatement, the applicant laid down a list of terms which it considers similar between the respective goods and services as follows:

On the contrary, the Applicant has applied for registration of its mark under classes 9 and 41. We consider the goods and services in *italics* to be similar and the ones in **bold** to be entirely dissimilar to the earlier marks' list of goods and services. Details are as under:

Class 9 – “*Computer game software downloadable from a global computer network; Computer game software, downloadable; Computer games programmes downloaded via the internet; Computer games programmes downloaded via the internet [software]; Computer game programs; Computer game software; Computer game software for use on mobile and cellular phones; Electronic game programs; Electronic game software; Electronic game software for handheld electronic devices; Game software;*

Recorded computer game programs; Computer application software for mobile phones; Computer programs for pre-recorded games; Downloadable computer game programs; Audio visual recordings.”

Class 41 – “Coaching [training]; organization of competitions [education or entertainment]; providing online electronic publications, not downloadable; entertainment services; zoological garden services; modelling for artists; teaching; on-line game services; providing amusement arcade services; video editing services for events; audio and video recording services; providing online videos, not downloadable; audio, film, video and television recording services; Entertainment; Musical entertainment; Interactive entertainment; Radio entertainment; Television entertainment; Online entertainment services; Post-production editing services in the field of music, videos and film; Operation of video and audio equipment for the production of radio and television programs; Music recording; Recording services; Sound recording studios; Video recording services; Production of sound recordings; Production of videos; production of sound and video recordings.”

From the above comparison, it is evident that one of the mediums to access the Applicant’s goods under class 09 is via mobile phones which as on date is a big market, however the same is not covered in the Opponent’s list of goods under class 09. Further, list of goods covered under class 28 of the Opponent’s mark is irrelevant as the Applicant has no connection to the said class. Proceeding further, the list of services of both the marks under class 41 are somewhat overlapping but are largely dissimilar.

Hence, since the goods and services at issue are though overlapping but widely dissimilar and not offered on the same platforms, the chances of consumer confusion are quite bleak.

57. The opponent made lengthy submissions which I have taken into account and am not proposing to reproduce here.
58. I must note that the above contentions of the parties were made based on the opponent’s specification before arriving at a fair specification. Therefore, although I have considered these contentions, I will conduct a comparison of the goods and services where I feel it is necessary.
59. Following the fair specification set out previously in this decision, I note that the opponent’s specification contains the word “*namely*”. Guidance on how to treat this word is contained in the addendum to the Trade Mark Registry’s Classification Guide, which reads as follows:

“Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states “namely” to mean “that is to say” and the Cambridge International Dictionary of English which states “which is or are”.” (emphasis added)

60. For the purpose of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.¹¹

Class 9

Computer game software downloadable from a global computer network; Computer game software, downloadable; Computer games programmes downloaded via the internet; Computer games programmes downloaded via the internet [software]; Computer game programs; Computer game software; Computer game software for use on mobile and cellular phones; Electronic game programs; Electronic game software; Electronic game software for handheld electronic devices; Game software; Recorded computer game programs; Computer application software for mobile phones; Computer programs for pre-recorded games; Downloadable computer game programs

61. The contested terms in Class 9 are all variations of software/programs for computer games. In this regard, I consider that the contested terms are encompassed by the broad earlier terms “*Computer game programs (downloadable software); stored and downloadable computer programs,*

¹¹ *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

namely computer and video games". Therefore, I find that the respective goods are identical as per *Meric*.

Audio visual recordings

62. The contested goods in Class 9 are recordings containing audio/video content, whereas the earlier goods "*Computer game programs (downloadable software)*" are computer games. The competing goods could be in digital or analog format, such as CDs or DVDs, sharing the same nature. The competing goods could be provided through the same distribution channels, targeting the same public. In the absence of specific submissions or evidence to assist me, it is my view that the respective goods are neither in competition nor complementary. Taking all the above factors into account, I find that there is a low degree of similarity.

Class 41

On-line game services

63. The contested term is sufficiently broad to cover the earlier services "*Computer and video game services provided on-line from a computer network; computer and video games services offered via the Internet; computer and video games services offered via other wireless media or over cable connections; online video and computer games*". As a result, I find them to be identical based on *Meric*.

Entertainment; Entertainment services; Interactive entertainment; Online entertainment services

64. The contested terms are broad enough to encompass the earlier services "*computer and video games entertainment services offered via the Internet; computer and video games entertainment services offered via other wireless media or over cable connections; online computer and video*

games entertainment". In this respect, I find them to be identical in accordance with *Meric*.

Providing amusement arcade services

65. In terms of these contested services, the opponent's submits that "the entertainment provided in amusement arcades invariably includes gaming machines, and amusement arcade services are therefore identical or highly similar to the services covered by the Opponent's earlier registration." I concur with the opponent's submissions in relation to the fact that video games would, indeed, be expected to be found in an amusement arcade. The opponent's services "*computer and video games entertainment services offered via other wireless media or over cable connections*" are offered over cable connections, which could well be a physical service identical to the applicant's services provided in a physical place, namely an arcade. In this respect, I find that the respective services are identical, or, if I am wrong, highly similar.

Television entertainment

66. The contested services relate to entertainment provided through television. This is a broad term and would also cover electronic sports ('Esports'), which have become particularly popular in recent years, broadcasted via television, enabling viewers to watch Esports and computer game competitions. In this regard, the contested services will sufficiently encompass the opponent's "*computer and video games entertainment services offered via other wireless media or over cable connections; online computer and video games entertainment*" services. Therefore, I find the respective services to be identical as per *Meric*.

Providing online videos, not downloadable; providing online electronic publications, not downloadable

67. The contested services are intended to provide streaming media or publications to users. The closest comparable term from the opponent's specification is the "*online video and computer games*" in Class 41. The competing services differ in nature and purpose. The trade channels will be different, and to that extent, there is an overlap in end-users. In the absence of evidence, there is no competition or complementarity between the services. I find the respective services to be dissimilar.

Audio and video recording services; audio, film, video and television recording services

68. The contested services are intended for the provision of sound/music, video or film recording services. Such services are of a technical nature, and as such they are likely to be provided to businesses, such as content creators, and not the end-users. In my view there is no apparent similarity between the applicant's terms and the opponent's services in Class 41 or goods in Class 9. The competing goods and services are therefore different in nature, method of use and purpose, as well as channels of trade, and I consider it unlikely that the average consumer would expect them to be provided by the same undertaking. Consequently, I find these goods and services to be dissimilar.

Post-production editing services in the field of music, videos and film; Production of sound recordings; Production of videos; production of sound and video recordings

69. The applicant's services pertain to music, videos, film production, and post-production. I consider such services to be mainly niche services of technical nature. In the absence of evidence, there is no similarity between the opponent's and the applicant's services in Class 41 or Class 9 goods. There is unlikely to be any overlap in the nature of the services/goods

provided, the users, and trade channels through which they reach the market, given their varying purpose. The services/goods are not competitive, nor are they complementary. In conclusion, I do not find there to be any similarity between the competing services/goods.

Video editing services for events

70. Following the approach of the preceding paragraph, there is no obvious similarity between the contested and the earlier services in Class 41 or Class 9 goods. The purpose, trade channels, and users are different. There is no competition or complementarity between the respective services/goods. Thus, I find them to be dissimilar.

Organization of competitions [education or entertainment]

71. I can see no obvious aspect of similarity between the above contested services in Class 41 and the opponent's goods or services, nor has the opponent made any specific submissions to the contrary. Therefore, I find them to be dissimilar.

Average Consumer and the Purchasing Act

72. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J described the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the

test is to be applied objectively by the court from the point of view of that constructed person. The word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."

73. In relation to the goods, they will be purchased by members of the general public without excluding professionals altogether. Such goods are usually offered for sale in stores, for instance, high street retail stores, brochures, catalogues, and online. The goods will be displayed on shelves and racks in retail premises, where they will be viewed and self-selected by consumers. Similarly, for online stores, consumers will select the goods relying on the images displayed on the relevant web pages. Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be ignored in the assessment, as advice may be sought from a sales assistant or representative. The cost of the goods may vary, but in any case, and irrespective of the cost, the average consumer may examine the products to ensure software/hardware compatibility with other components or systems or that the goods possess the features they require. In this regard, the average consumer is likely to pay a higher than average degree of attention, although not the highest, when selecting the goods at issue.
74. The average consumer of the services at issue will be either a member of the general public or businesses. The consumer will select such services by looking through brochures and websites, so the visual element will be important. However, I do not discount the aural element, as word-of-mouth recommendations may also influence consumers' decisions. These factors suggest that the level of attention of the average consumer will fluctuate from an average to a higher than average level of attention, although heightened slightly for professionals and businesses.

Comparison of Trade Marks

75. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

76. 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.

77. The marks to be compared are:

Opponent's Mark	Applicants' Mark
Bubble Popp	Bubble Pop Origin

Overall Impression

78. The contested mark consists of the word elements “Bubble Pop Origin”, capitalised and in a standard typeface. I note that the words of the

contested mark create a phrase that ‘hangs together’ so they are perceived as a unit, and they together form the dominant and distinctive element of the mark. The overall impression lies in the verbal elements of the mark as a whole.

79. The earlier word mark consists of the words “Bubble Popp” capitalised and in a standard typeface. Registration of a word mark protects the word itself presented in any regular font and irrespective of capitalisation.¹² As delineated above, the words will be perceived as a unit. The overall impression of the respective mark lies in the words themselves.

Visual comparison

80. The competing marks share the common words “Bubble” and “Pop” save for the additional ‘p’ letter at the end of the earlier mark. A point of visual difference is the presence of the additional word “Origin” in the contested mark. I also note that this diverging element appears at the end of the mark, a position which is generally considered to have less impact due to consumers in the UK reading from left to right.¹³ Taking into account the overall impression of the marks and the similarities and differences, I consider there to be a high degree of visual similarity between the marks.

Aural comparison

81. The applicant in its counterstatement claims that:

“[...] the opposed mark is phonetically dissimilar to that of the Opponent’s registered mark “Bubble Popp”. Prima facie it is evident that ‘Bubble’ is the only identical and overlapping word in the conflicting marks from a phonetic aspect. Further, the spelling and hence the pronunciation of the word POP is different in both marks,

¹² See *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

¹³ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

in the opposed mark the word 'POP' consists of a single 'P' and also the mark ends with the word 'Origin'. On the contrary, the Opponent has spelled it with double 'P' - "POPP"; laying more emphasis on the sound of the alphabet. Further, the Opponent in its statement claims that the second letter "P" in the word "POPP" is a silent letter, which in our understanding is untrue and fabricated solely for the purpose of the present opposition proceedings.

The significant difference between their pronunciations is evident and hence it can be easily settled that both the marks are phonetically largely (although not entirely) dissimilar at a holistic level."

82. The opponent in its submissions asserts that:

"Both marks begin with the same word 'Bubble', and this element is phonetically identical. The second word in the opposed mark is 'Pop', and the second word in the Opponent's earlier mark is 'Popp'. These elements are phonetically identical. The additional silent letter 'p' in the Opponent's mark does not affect the pronunciation of the word. Contrary to the Applicant's claims, the additional letter 'p' does not lay any additional emphasis on this sound. The difference in spelling certainly does not imply any difference in pronunciation. It is utterly rejected that the Opponent has "fabricated" its claim that the second letter 'p' in the word 'POPP' is a silent letter, and such a desperate argument highlights the weakness in the Applicant's case. The opposed mark contains the additional element 'Origin', but this element is at the end and will therefore attract the least amount of attention from consumers. It is likely that consumers might mistakenly believe that Bubble Pop Origin is an extension of the Opponent's Bubble Popp brand, especially given that the first two words in each mark are phonetically identical."

83. The average consumer will articulate the earlier mark as "BUH-BL-POP".

I agree with the opponent that the additional consonant letter 'p' in the

second word element of the earlier mark will not alter the pronunciation of the word. In this respect, the first two word elements of the contested mark will be identically pronounced as in the earlier mark, namely “BUH-BL-POP”. However, there is a point of aural difference. The contested mark contains the word element “ORIGIN” which will be pronounced as “OR-IJ-IN” which is three syllables longer than the earlier mark. Therefore, I find that the marks are aurally similar to between a medium and a high degree.

Conceptual comparison

84. In terms of the contested mark, the average consumer will immediately understand the dictionary words “Bubble Pop Origin”, which will be considered as a unit and perceive them as the source of popping bubbles. The average consumer will interpret the word “Popp” in the opponent’s mark as a misspelling of “Pop”. Despite the presence of the additional word element “Origin”, introducing a conceptual difference, I consider that the average consumer will discern the same meaning, that of popping bubbles, from both marks. Taking into account the points of conceptual similarity and difference, I find that there is a high degree of conceptual similarity between the marks.

Distinctive Character of The Earlier Trade Mark

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

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

Windsurfing Chiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49).

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

86. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
87. As described above, the earlier mark consists of the word elements "Bubble Popp", which will be understood as popping bubbles, albeit with the misspelling in the word element "Popp". The words used are neither random nor fanciful but allude to a characteristic of the goods and services sold under the mark, i.e. games that involve the popping of bubbles. I find therefore that the earlier mark is inherently distinctive to a low degree.

Enhanced Distinctiveness

88. Taking into account the evidence, which I have referred to earlier in this decision, I will now consider whether the earlier mark has acquired enhanced distinctive character through use, even though the opponent did not plead this. I should stress here that, whilst the mark is a comparable mark, it is the position in the UK that must be considered because the

question is whether the average consumer in the UK will be confused. I find the evidence insufficient to demonstrate that the mark has acquired an enhanced degree of distinctive character through use in the UK for the goods and services that the opponent has been found to have genuinely used the mark on. Although the sales, which have been evidenced, are reasonable, they do not strike me as particularly significant within the context of the UK computer/video games market, which must be considered to be quite substantial. There is no indication of the market share held by the opponent and no marketing expenditure figures as to the amount invested by the opponent in promoting the given mark. Overall, whilst the mark has been genuinely used, the evidence is insufficient to demonstrate enhanced distinctiveness.

Likelihood of Confusion

89. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.¹⁴ It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.¹⁵
90. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the marks are different, but concludes, due to the

¹⁴ See *Canon Kabushiki Kaisha*, paragraph 17.

¹⁵ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

similarities between them, that the later mark is another brand of the owner of the earlier mark or a related undertaking (or vice versa).

91. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis K.C., sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.)

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

I note that the categories identified above by Mr Purvis K.C. are not exhaustive.¹⁶

92. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor KC, sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

93. With regard to the 'common element', I bear in mind *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis K.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

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

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

¹⁶ *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14 at paragraph 29.

In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

94. Earlier in this decision I have concluded that:

- the goods and services at issue range from identical to dissimilar;
- the average consumer for the goods is a member of the general public without excluding professionals, who will select the goods by predominantly visual means, but without dismissing the aural means. The average consumer will examine the goods to identify suitability, thereby selecting the relevant goods with a higher than average degree of attention, although not the highest. In relation to the services, the average consumer of the services at issue will be either a member of the general public or businesses. Again, they will select the goods by predominantly visual means, but without dismissing the aural means. The level of attention of the average consumer will fluctuate from an average to a higher than average level of attention, although heightened slightly for businesses;
- the competing marks are visually similar to a high degree, aurally similar to between a medium and high degree, and conceptually similar to a high degree;
- the earlier mark is inherently distinctive to a low degree and the use provided by the opponent is not sufficient to establish an enhanced distinctiveness of the mark.

95. The likelihood of confusion does not arise in relation to the application's services which are dissimilar to the earlier mark's services. **The opposition cannot succeed against dissimilar services and, therefore, is dismissed insofar as it concerns the following terms:**

Class 41: Providing online videos, not downloadable; providing online electronic publications, not downloadable; Audio and video recording services; audio, film, video and television recording services; Post-production editing services in the field of music, videos and film; Production of sound recordings; Production of videos; production of sound and video recordings; Video editing services for events; Organization of competitions [education or entertainment].

96. Although I have found earlier in this decision that the inherent distinctiveness of the earlier mark is of a low degree, this does not prevent a likelihood of confusion.¹⁷ However, taking into account the above factors, I am persuaded that there is no likelihood of direct confusion for identical goods and services. Notwithstanding the principle of imperfect recollection, I find that when the marks are considered as a whole, the average consumer would recall the presence/absence of the word "Origin", i.e. Bubble Popp/Bubble Pop Origin, enabling them to distinguish between the marks. Therefore, the average consumer will not mistake the applicant's mark for the opponent's.
97. If I am wrong on direct confusion, the average consumer, having identified that the marks are different, will assume that the respective marks originate from the same or economically linked undertakings. I reiterate the point about imperfect recollection that the consumer rarely has the chance to make direct comparisons between marks but instead relies on an imperfect recollection. I consider that the average consumer, due to the high visual similarity between the competing goods and services and the conceptual hook generated by the concept of popping bubbles, will consider the

¹⁷ See *L'Oréal SA v OHIM*, Case C-235/05 P.

presence/absence of the additional word “Origin” as a brand extension or variation of the earlier mark, or vice versa. Consequently, I find there to be a likelihood of indirect confusion between the marks regarding the goods and services at issue that have been found to be identical. This finding extends to the goods and services that I found to be similar from a high to low degree.

OUTCOME

98. The opposition under Section 5(2)(b) **succeeds, and, subject to an appeal against this decision, the application will be refused for all goods and services except for the following services, for which the application will proceed to registration:**

Class 41: Providing online videos, not downloadable; providing online electronic publications, not downloadable; Audio and video recording services; audio, film, video and television recording services; Post-production editing services in the field of music, videos and film; Production of sound recordings; Production of videos; production of sound and video recordings; Video editing services for events; Organization of competitions [education or entertainment].

COSTS

99. In terms of costs, whilst both parties have achieved a measure of success, proportionately, the opponent has been more successful than the applicant. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. I award costs to the opponent as a contribution towards the cost of the proceedings on the following basis:

Official opposition fee	£100
Preparing a statement and considering the counterstatement	£100
Preparing and filing evidence	£250
Filing written submissions	£200
Total	£650

100. I, therefore, order, Shanghai Zhenglang Technology Co., Ltd. to pay GameDuell GmbH the sum of £650. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 25th day of October 2022

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General