O/0138/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3871762 BY VILARDO LTD TO REGISTER THE TRADE MARK:

ROCKETPLAY

IN CLASSES 9 & 41

AND

OPPOSITION THERETO UNDER NO. 440955 BY DACS LABORATORIES GMBH

BACKGROUND & PLEADINGS

1. VILARDO LTD ("**the applicant**"), applied to register the trade mark shown on the front page of this decision in the United Kingdom on 26 January 2023. It was accepted and published in the Trade Marks Journal on 24 February 2023. I note that on 8 August 2023 the applicant filed a Form TM21B, which was published on 13 September 2023, amending its specification to read as follows:

   Class 9: Gambling software; Sports betting software.

   Class 41: Gambling services.

2. On 23 May 2023, DACS Laboratories GmbH ("**the opponent**") opposed the application on the basis of Sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("**the Act**") [1]. Under section 5(2)(b), the opponent relies upon the following mark:

Trade Mark no.	UK00918263705[2]
Trade Mark	ROCKITPLAY
Goods and services for which the mark is registered	Classes 9, 38, 41, 42 and 45
Filing date	1 July 2020
Date of entry in register	15 October 2020

[1] The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

[2] Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM. As a result, the opponent's earlier EUTM was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

3. For the purpose of this opposition, the opponent relies on all of its goods and services as follows:

> **Class 9:** Software for searching and retrieving information across a computer network; Computer software, recorded; Computer software applications, downloadable; Games software; Cloud computing software; Downloadable cloud computing software; Application software for cloud computing services; Downloadable software; Downloadable applications for use with mobile devices; Software and applications for mobile devices; Software programs for video games; Computer programs for video and computer games.
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> **Class 38:** Streaming of data; Streaming of audio, visual and audiovisual material via a global computer network; Streaming audio and video material on the Internet; Transmission and distribution of data or audiovisual images via a global computer network or the Internet; Transmission of data, audio, video and multimedia files; Packet transmission of data and images; Electronic transmission of data.
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> **Class 41:** Provision of on-line computer games; Providing on-line interactive computer games; Interactive entertainment services; Interactive computer game services.
>
> **Class 42:** Software development; Software design and development; Software as a service [SaaS]; Development of computer game software; Development of software for processing and distribution of multimedia contents.
>
> **Class 45:** Licensing of computer software [legal services]; Licensing of computer games.

4. The opponent asserts that the competing marks are highly similar, and visually, aurally, and conceptually identical. Also, it claims that the competing goods and services are the same and/or similar, and there exists a likelihood of confusion.

5. Under Section 5(4)(a), the opponent contends continuous use of the earlier mark for the past approximately three years, while acquiring significant reputation and goodwill in relation to the registered goods and services. It also claims that use of the contested mark would be contrary to the law of passing off.

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

Papers Filed and Representation

7. The opponent filed evidence in these proceedings. This comes in the form of a witness statement from Frank Schwarz, the CEO of the opponent in these proceedings. His witness statement is dated 20 October 2023 and is accompanied by 18 Exbibits (FS1-18).

8. The applicant filed evidence in these proceedings. This comes in the form of a witness statement from Mr Valerii Polinskyi. His witness statement is dated 22 December 2023 and is accompanied by one Exhibit (EXH1).

9. In addition, the opponent filed evidence in reply which also comes in the form of a witness statement from Frank Schwarz and is accompanied by 9 Exbibits (FS1-9).

10. The applicant filed written submissions on 26 December 2023 and the opponent on 20 February 2024.

11. I have taken the evidence and submissions into account in reaching my decision and will refer to them below, where necessary.

12. No hearing was requested and so this decision is taken following a careful perusal of the papers.

13. In these proceedings, the applicant is represented by Regimark SIA and the opponent by Palmer Biggs IP, Solicitors.

Preliminary Issue

14. I note that the opponent filed evidence in reply in the form of a second witness statement from Mr Schwarz challenging various points raised in Mr Polinskyi's witness statement. More specifically Mr Schwarz states that the applicant has failed to provide any evidence to demonstrate that it has been operating in the market since 2016. In this context, Exhibit FS1 indicates that the applicant's website is not accessible from the UK. Given the grounds of this opposition and the facts of the case, the evidence about the trade activity or inactivity are not relevant, particularly bearing in mind that there is no requirement for the applicant to show use of the applied for mark in the UK. Thus this is not relevant to the assessment of this case before me, and I will say no more.

DECISION

Section 5(2)(b)

15. 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."

16. 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 might 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

17. When making the comparison, all relevant factors relating to the goods and services 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 […], 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."

18. 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."

19. 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".

20. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

> "365. […] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the

substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case."

21. 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 of 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."

22. 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."

23. 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."

24. The competing goods and services to be compared are shown in the following table:

Opponent's Goods & Services	**Applicant's Goods & Services**
Class 9: Software for searching and retrieving information across a computer network; Computer software, recorded; Computer software applications, downloadable; Games software; Cloud computing software; Downloadable cloud computing software; Application software for cloud computing services; Downloadable software; Downloadable applications for use with mobile devices; Software and applications for mobile devices; Software programs for video games; Computer programs for video and computer games. **Class 38:** Streaming of data; Streaming of audio, visual and audiovisual material via a global computer network; Streaming audio and video material on the Internet;	**Class 9:** Gambling software; Sports betting software. **Class 41:** Gambling services.

Transmission and distribution of data or audiovisual images via a global computer network or the Internet; Transmission of data, audio, video and multimedia files; Packet transmission of data and images; Electronic transmission of data. **Class 41:** Provision of on-line computer games; Providing on-line interactive computer games; Interactive entertainment services; Interactive computer game services. **Class 42:** Software development; Software design and development; Software as a service [SaaS]; Development of computer game software; Development of software for processing and distribution of multimedia contents. **Class 45:** Licensing of computer software [legal services]; Licensing of computer games.	

25. The opponent made lengthy submissions, which I have considered, but I do not propose to reproduce here. However, I note that the opponent asserts identity or, at very least, a high or medium degree of similarity between the competing specifications.

26. In its counterstatement, the applicant claimed that the Class 41 services are dissimilar due to dissimilarities between "*gambling services*" and "*gaming services*". The applicant has also substantiated this claim with its submissions, which I have considered but will not reproduce here. Also, in his witness statement, Mr Polinskyi provides points as to the business sector in which the parties trade, along with definitions for the competing terms.

27. I bear in mind that the assessment I must make is based on a notional and fair use of the terms as registered against all the potential or intended uses of the goods and services and not necessarily the ones in which a party actually trades. I note that differences between the services currently provided by the applicant, such as particular characteristics of the Class

41 services at issue, are irrelevant, except to the extent that those differences are apparent from each party's specification. Nor is it a relevant consideration that at present the parties are trading in what the applicant regards as discrete business sectors.

28. It is noted that the applicant, without putting forward a blanket denial for the competing specifications, is deemed to have accepted the opponent's contentions in relation to Class 9 goods.[3] That said, I will assess below the degree of similarity between the competing goods.

29. The contested goods "*Gambling software; Sports betting software*" in Class 9 are software in relation to gambling and sports betting. The opponent's specification contains the broad term "*computer software*" which will readily cover the contested goods. Therefore, I find them to be identical as per *Meric*.

30. Both parties have made submissions regarding the competing services in Class 41, primarily focusing on whether "*online computer games*" services will be captured by "*gambling services*" or not. When conducting the analysis that follows, I will bear in mind that terms for services should not be interpreted too liberally but confined to the core meaning of those terms, guided by the case law I have already quoted previously.

31. The contested services "*gambling services*" in Class 41 involve the provision of gambling activities where individuals can place bets or wagers

[3] Prof. Phillip Johnson, sitting as the Appointed Person, in *SKYCLUB*, BL O/044/21, at paragraph 24 states:

> "The position in the Civil Procedure Rules (CPR) is clear; namely, a defendant must state which allegations are denied, which allegations a defendant is unable to admit or deny, and which allegations the defendant admits (CPR, 16.5(1)). Where a defendant fails to deal with an allegation it is taken to be admitted (CPR 16.5(5)). This is subject to the rule that where an allegation is not dealt with, but the defence sets out the nature of his case in relation to the issue to which that allegation is relevant, then the allegation must be proved by the Claimant (CPR 16.5(3)). Thus, the filing of a "blank" defence would lead to the whole of the Claimant's case being admitted."

on the outcome of events or games, such as card or casino games.[4] The closest comparable terms from the earlier specification are "*Provision of on-line computer games; Providing on-line interactive computer games*" in the same Class. To my mind, the earlier terms are broad enough that they could encompass a vast range of different fields, including online games of chance which are a form of gambling. Evidence submitted by the opponent indicates that numerous online gambling games are accessible through various websites.[5] Conversely, the applicant submits that:

> "[14] The services of the earlier mark differ from the contested services by their nature, since playing a computer game (gaming) is not the same as playing casino (gambling). Those services are not complementary, they target different consumers (i.e., computer games are freely available products and are targeted to a wide public, while gambling services are strictly regulated and age-vulnerable in most jurisdictions) and normally are of a different origin. Please see also the Witness Statement attached in that regard."

I note that the applicant in its submissions refers to "casino" to draw a distinction between the competing services. In this present case, though, the applicant seeks to register the broader term "*gambling services*" rather than the narrower term "*casino services*". As a result, I consider that the contested term is broad enough to cover the opponent's terms which will also include online gambling games. Therefore, the competing services are identical based on *Meric*.

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[4] The Online Oxford Dictionary defines gambling as "The action, practice, or pastime of playing games for stakes, as cards, dice, etc., or betting money on the outcome of particular events, e.g. the result of a race or other sporting contest" (emphasis added). See https://www.oed.com/dictionary/gambling_n?tab=meaning_and_use#3430648

[5] See Exhibits FS2, FS3, FS4 and FS5 annexed to Mr Schwarz's second statement.

Average Consumer and the Purchasing Act

32. The opponent in its submissions states the following:

> "39. In the present case, as indicated in the second witness statement of Mr Schwarz, the average consumer for the Opponent's Goods and Services are businesses as well as end users/members of the general public. Businesses may wish to integrate the Opponent's products into their systems in order to enhance the performance of their systems. Similarly, end-users may wish to purchase the Opponent's products to enhance the performance of existing and/or new applications in their computers.
>
> 40. Given the nature of the Opponent's Goods and Services, the average consumer of such goods and services is likely to pay only a medium degree of attention to the purchase of such goods and services, where the level of attention of the end-user is likely to be lower than that of a business. Furthermore, the purchase process is likely to be mostly aural (through word of mouth, presentations and direct communications with sales representatives of the Opponent) but also visual from perusal on websites, presentations, promotional materials and written reviews and recommendations."

33. I also note Mr Polinskyi's contentions in his witness statement:

> "3. According to my knowledge and belief the relevant consumers targeted by our business is an average Internet user interested in online gambling and betting, while the target public of the Opponent is business consumers interested in integrating the Opponent's product into their products."

34. 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 (as he then was) 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."

35. Given the strict gambling laws in the UK, the average consumer for the goods and services will be an adult member of the public with an interest in gaming, betting, and gambling as a regular pastime, or they may be a professional gamer or gambler, or a business providing gambling services and associated goods to the public. The visual element would carry slightly more weight than the aural. When making a selection, the consumer is likely to have seen posters in the street or other advertising material, either in print form, on television, or online. They may also hear the marks spoken, for instance by word-of-mouth recommendations; thus, the aural element cannot be discounted. A member of the general public is likely to pay a higher than a medium degree of attention when selecting such goods/services. This is because of the financial risks and rewards associated with gambling and the added risk of placing bets with online (remote) operators. Because of the substantial financial risks involved, professional users of such goods/services are likely to pay a high degree of attention when selecting such goods/services.

Comparison of Trade Marks

36. 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."

37. 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.

38. The marks to be compared are:

Earlier Mark	Contested Mark
ROCKITPLAY	ROCKETPLAY

Overall Impression

39. The earlier mark, "ROCKITPLAY", is a word mark. Registration of a word mark protects the word itself.[6] The average consumer will see the earlier mark as being coined from three words juxtaposed, namely "ROCK-IT-PLAY". The mark's overall impression lies in the combined words, with neither word component dominating the other.

40. Similarly, the overall impression of the contested mark lies in the conjoined words, namely "ROCKETPLAY", with neither component dominating the other. Again, in this case, the average consumer would also identify that the mark has been coined from two words.

Visual Comparison

41. The competing marks are of the same length and share all the letters apart from the central one in position five (ROCKITPLAY/ ROCKETPLAY). Bearing in mind, as a rule of thumb, that the beginnings of words tend to have more impact than the ends,[7] the beginnings, "ROCK-", and the endings, "-TPLAY", are identical in both marks, with the only difference being the fifth letter. Considering all the factors, including the overall impression of the marks, I find them to be visually similar to a high degree.

Aural Comparison

42. The competing marks are three-syllable marks that the average consumer will likely articulate as "ROCK-IT-PLAY". If I am wrong and the vowel in the second syllable is pronounced differently, the difference will only be slight, and the marks will be aurally similar to a high degree.

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[6] *LA Superquimica v EUIPO*, T-24/17, para 39. See also *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

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

Conceptual Comparison

43. In its submissions the opponent states that:

> "(i) Conceptually, contrary to what is argued by the Applicant, neither mark is a common English word or has any particular meaning with regards to the goods and services in question. When articulated, the marks are likely to evoke the same concept, such as that the goods and services in question will be provided or are able to perform speedily like a rocket, with the word ROCKIT in the Earlier Mark likely to be understood to be a deliberate misspelling of the word ROCKET. The respective marks are accordingly conceptually similar to a high degree. Alternatively, both marks are non-descriptive and have no particular meaning with regards to the goods and services in question such that a conceptual comparison cannot be made."

44. Conversely, the applicant submitted that:

> "[6] Furthermore, as it is known from the case law, an average consumer perceiving a word sign will break it down into elements which suggest a concrete meaning or resemble known words (T-356/02, *Vitakraft-Werke Wührmann & Sohn Gmbh & Co. KG v EUIPO*, para. 51, confirmed by C-512/04 P). Thus, the earlier mark most likely will be read as 'ROCK IT / PLAY' while the contested sign will be read as 'ROCKET / PLAY'.
>
> [7] Consequently, bearing in mind the above-mentioned way of perception of the average consumers the main attention will be paid to the verbal parts 'ROCK IT' of the earlier mark and 'ROCKET' of the contested sign.
>
> [8] The semantic meaning (content) of the relevant verbal elements is different since:
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> a) the word 'rocket' designates a large cylinder-shaped object that moves very fast by forcing out burning gases, used for

space travel or as a weapon, or a type of firework that flies up into the air before exploding, or even extremely quick increasing or making extremely quick progress towards success;

b) the term ‘rock it’ is an expression referring to partying, having fun, or an idiom of using for praise or encouragement meaning that either ‘you are awesome’ or ‘to do what you do in an outrageous and marvellous way’.

[9] Both of the mentioned words/phrases are widely known to average consumers and their meaning will be immediately grasped and understood by the public, and their different semantic meanings will be also well perceived by the audience. Therefore, contrary to the Opponent’s view, the marks are dissimilar from a conceptual aspect and do not evoke the same concept (association with a rocket).”

45. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

46. I bear in mind that in *Usinor SA v OHIM*, Case T-189/05, the GC found that:

“62. In the third place, as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft* (VITAKRAFT) [2004] ECR II-3445, paragraph 51, and Case T-256/04 *Mundipharma v OHIM – Altana Pharma* (RESPICUR) [2007] ECR II-0000, paragraph 57).”

47. On this basis, I agree with the applicant that the average consumer will recognise the constituent words in the competing marks.

48. The competing marks both contain the identical word component “-PLAY”, which is a commonplace word, and the UK average consumer will understand immediately. This will also be perceived as highly suggestive of the goods and services in question. Despite the suggestive quality of this word in the competing marks, it still contributes towards the overall impression of the marks and cannot be disregarded completely.

49. On the one hand, the earlier mark consists of the conjoined dictionary word components “ROCK-IT-PLAY”. In the absence of evidence, I am not ready to accept the opponent’s submission that the average consumer will interpret the components “ROCK-IT-” as a misspelled version of “ROCKET”. However, I agree with the applicant that the phrase “rock it” possesses various meanings, and I consider that despite the fact that the individual word components will be understood by the average consumer, when considered as a whole, the earlier mark is unlikely to convey a concrete and clear conceptual message. On the other, the contested mark comprises the conjoined dictionary word components “ROCKET-” and “-PLAY”. While I note that the term ‘rocket’ can have more than one meaning, there appears to be consensus between the parties regarding the interpretation of ‘rocket’, which is generally perceived as something that moves at extreme speed. However, I consider that consumers will not readily derive an immediate concept from the mark as a whole.

50. Even though the common word component “-PLAY” is highly suggestive of the goods and services, there remains a recognisable degree of conceptual similarity given the marks’ composition around this element. Considering all of the above, including the overall impressions, I conclude that the degree of conceptual similarity is low.

Distinctive Character of the Earlier Trade Mark

51. 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)."

52. 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.

53. In its submissions, the opponent states that "as the Earlier Mark has no particular meaning for any of the Opponent's Goods and Services and

consists of an unusual and non-descriptive term with reference to the Opponent's Goods and Services, it must be held to possess a high degree of inherent distinctiveness."

54. I disagree. The earlier mark, "ROCKITPLAY", is an invented word consisting of the conjunction of very commonplace words, conveying the meaning described earlier in this decision. When considered against the goods and services relied upon, the word component "-PLAY", which is the only common element with the contested mark,[8] will be seen as a highly suggestive term. Although the mark as a whole may be considered "invented", awarding some degree of distinctiveness to the mark, the conjoining of those words is not highly fanciful. Weighing all the factors, I find that the earlier mark is inherently distinctive to a medium degree.

Enhanced Distinctiveness

55. I note that in order to consider whether the earlier mark has acquired enhanced distinctive character through use, the opponent must show use for the relevant registered goods and services. I note that the evidence does not contain any evidence of sales but rather it relates to the promotion of the goods and services. In summary, the evidence filed with the first witness statement is as follows:

    a. Exhibits FS1-FS5 consist of various screenshots dated between 2021 and 2023. Some of these were obtained from the WayBack Machine Internet archive and include material from the opponent's websites *dacslabs.com* and *rockitplay.com*, as well as the opponent's social media accounts, namely Facebook, LinkedIn, and YouTube. I also note that that a few screenshots come from Mr Schwarz's personal LinkedIn profile rather than the opponent's official account, which can be inferred from the facts of the case that

[8] *Kurt Geiger v A-List Corporate Limited*, BL O/075/13.

this is use with consent.[9] The Exhibits primarily demonstrate "ROCKITPLAY FastStart for Games", which is described in the witness statement and various social media posts, such as Exhibit FS5, as a gaming solution that allows users to "stream" games without having to download and store them on a local drive, effectively reducing wait times.

b. Exhibits FS6-FS9 contain screenshots from pitch presentations and documents directed at investors and customers, including some based in the UK, such as Green Man Gaming, Accel, London Venture Partners LLP, and The Ingenious Group, all of which are located in London;

c. Exhibits FS10-FS16 screenshots from trade shows held in Germany, France, and the USA between 2018 and 2022, where the opponent promoted its gaming solution;

d. Exhibits FS17-FS18 include screenshots of two online news articles: i) "DACS LABORATORIES UNVEILS ROCKITPLAY, PROMISING NEAR-INSTANTANEOUS ACCESS TO GAMES AS THEY DOWNLOAD", published on 23 April 2021; and ii) "ROCKITPLAY FastStart Brings Netflix-Like Access to PC Games", published on 21 April 2021. Both articles detail announcement of the cloud-based platform and gaming solution ROCKITPLAY, highlighting its promise of "nearly instant access and local play for downloadable software and cloud gaming markets."

[9] It is clear from Section 6A(3)(a) of the Act that genuine use must be made by "[…] the proprietor or with his consent […]". Whilst the witness makes no specific reference to consent, consent may be inferred, in certain circumstances, from the facts and circumstances of the case. Therefore, it can be inferred from the facts of this case that the opponent consented to the use of the registered mark by Mr Schwarz, who is the CEO of the opponent.

56. In addition to the above evidence, the opponent filed evidence in reply with Mr Schwarz's second witness statement where the relevant Exhibits are summarised as follows:

    a. Exhibit FS8 includes screenshots from email correspondence dated 10 July 2020 together with a pitch document that is said to have been sent to the UK team of Makersfund. The email appears to be a follow-up and includes the aforementioned pitch document as an attachment.

    b. Exhibit FS9 contains screenshots from the website *robotcache.com*, where Mr Schwarz describes Robot Cache as "a global online video games provider which specifically also caters to the UK market." I note that the screenshots only bear a print date 31 January 2024. On page 61, one screenshot displays a tile showcasing the earlier trademark under the category "FASTSTART READY." Additionally, there is a response in the FAQ section of the website addressing the question, "WHAT IS ROCKITPLAY FASTSTART TECHNOLOGY?".

57. Mr Schwarz explains in his witness statement that the opponent "has been providing IT products and services including, among other things, gaming technology and cloud gaming." Although various promotion materials are provided with the exhibits, there are no sales or turnover figures broken down based on the product/service type or terms within the registered specification. Also, the above promotional materials do not indicate any extensive media coverage, intensive advertising, or promotional activities in the UK for the relevant goods and services. Even when considering the number of likes and impressions on LinkedIn posts, they do not appear to be significant. Therefore, I do not consider that the use shown establishes enhanced distinctiveness for the average consumer as a whole or even for a significant enough subset of average consumers. Overall, the evidence is insufficient to demonstrate enhanced distinctiveness.

Likelihood of Confusion

58. 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 services may be offset by a greater degree of similarity between the marks, and vice versa.[10] 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.[11]

59. 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 differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

60. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis QC (as he then was), 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,

[10] See *Canon Kabushiki Kaisha*, paragraph 17.

[11] See *Lloyd Schuhfabrik Meyer*, paragraph 27.

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."

61. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis QC (as he then was) 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."

62. Whether a conceptual difference between the marks is sufficient to counteract the visual and aural similarities is liable to depend on the strength of that difference and the degree of visual and aural similarity between the marks. In *Diramode S.A. v. Richard Turnham and Linda Turnham* ("PIMKIE"), BL O/566/19, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, considered an opposition to the mark PIMKIE based upon the earlier mark PINKIES, for identical goods (precious metals and jewellery). Mr Hobbs stated that there was a high

degree of visual and aural similarity between the marks and, following the CJEU's judgement in C-437/16 P *Wolf Oil Corp v EUIPO*, that:

> "28. […] there is no rule to the effect that visual and aural similarities are automatically neutralised by conceptual differences. It [the CJEU] insisted upon the need for two distinct stages in the analysis of the overall likelihood of confusion, with the first being directed to '*a finding of the conceptual differences between the signs at issue*' and second being directed to '*assessment of the degree of conceptual differences'* with a view to determining whether they *'may lead to the neutralisation of visual and phonetic similarities*'."

63. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor QC (as he then was), 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.

64. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

> "13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper

basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

65. Earlier in this decision I have concluded that:

- the competing goods and services at issue are identical;
- the average consumer of the goods and services will be a member of the general public or professional users. The selection process is predominantly visual without discounting aural considerations, and the degree of attention for the general public will be higher than a medium degree, and high for professional users;
- the competing marks are: visually similar to a high degree, aurally identical or highly similar, and conceptually similar to a low degree;
- the earlier mark has a medium degree of inherent distinctive character, and the use is not sufficient to establish enhanced distinctiveness of the mark.

66. Taking all of the above into consideration, the factors persuade me that there is a likelihood of direct confusion. I note that the marks diverge visually by one letter in the middle of the marks, namely ROCKITPLAY/ROCKETPLAY. The goods and services at issue are identical, selected mainly via visual means, which are all points in the opponent's favour. Despite the increased level of attention of the average consumer during the selection process, this will not be sufficient to counteract the visual and aural similarities between the marks as well as militate against imperfect recollection. In this respect, due to the position of the divergent letter, the average consumer may overlook the differences and are likely to mistake one mark for the other. I also find that, notwithstanding the mainly visual purchasing process, there is a material risk of direct aural confusion. Further, whilst the consumer may perceive certain conceptual differences between the competing marks, the conceptual message they convey as a whole is, in my view, unclear and not sufficient in this case to neutralise the visual and aural similarities between the marks. In light of the principle of imperfect recollection and

the fact that consumers rarely have a chance to compare marks side by side, they may be directly confused and mistake the applicant's mark for the opponent's.

67. The opposition under this ground succeeds.

Section 5(4)(a)

68. Section 5(4)(a) of the Act states that:

> "A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -
>
> (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
>
> […]
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of "an earlier right" in relation to the trade mark."

69. Subsection 4(A) is as follows:

> "The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

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

> "55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the *Jif*

Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

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

71. 'Halsbury's Laws of England Vol. 97A' (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

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

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

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

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

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

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

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

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

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

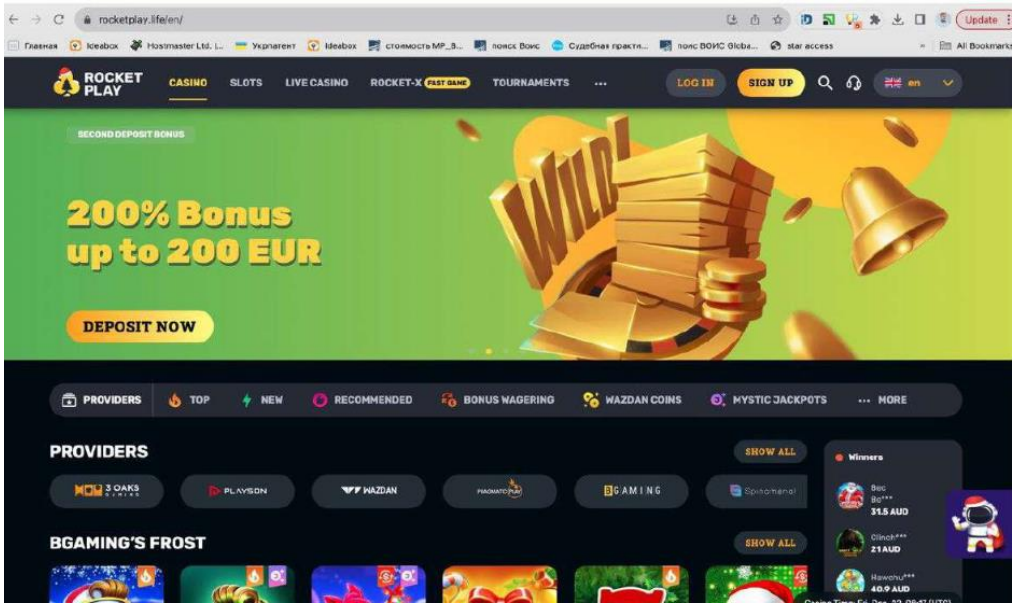
The Relevant Date

72. The relevant date for assessing a claim of passing off is the date of commencement of the conduct complained of.[12] In opposition proceedings, this is the date of the application for registration or, if relevant, a priority date. Where the applicant has used the mark before the application it is also necessary to consider the position at the point of first use. In his witness statement, Mr Polinskyi states that:

"[the applicant] has been established and has been operating on the market since 2016. We are operating in the online casino market, specializing in online gambling services. We are providing online casino services for our clients that may be accessed through the web and via downloadable mobile applications. Exhibit 1 presents the screenshots from the relevant website and mobile application."

[12] See *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429.

73. Exhibit 1 contains an undated screenshot, reproduced below, from *rocketplay.lige/en*.



As the Exhibit is undated and the applicant has not provided any further evidence as to the use of the applied for mark on the given goods and services, it is not possible to infer that the mark was used before its filing date. Consequently, the only relevant date for assessing this ground of opposition is the filing date of the applicant's mark, namely 26 January 2023.[13]

Goodwill

74. The opponent must show that it had goodwill in a business at the relevant date and that the sign relied upon is associated with, or distinctive of, that business.

[13] See *Advanced Perimeter Systems v Keycorp Limited (MULTISYS)*, BL O-410-11.

75. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217, at paragraph [224]:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates."

76. Earlier in this decision, I concluded that the evidence was not sufficient for the purposes of demonstrating that the distinctive character of the earlier mark had been enhanced though use. Nevertheless, that does not preclude a finding of goodwill since a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill may be small. In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC (as he then was), as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

> "[...] a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."

77. Goodwill arises from trading activities. The evidence, summarised in paragraphs 58-59 above, demonstrates that the opponent's business was in operation for approximately three years by the relevant date. This business and its sign were referred to in two online articles and several social media posts (primarily on LinkedIn) before the relevant date.[14] There is also evidence that the opponent attended various trade shows and games conferences held in countries other than the UK.[15] While evidence has been provided regarding pitch documents and presentations directed towards investors and customers based in the UK, no corroborating information has been provided to ascertain the success of these pitches in leading to any formal agreements between the parties.[16] Although the evidence contains a list of YouTube videos,[17] which bear the sign and were released prior to the relevant date, the evidence does not clarify whether the number of views comes from the UK or global audience.

78. The evidence is deficient on a number of points relating to use and the establishment of goodwill. The opponent has not stated if it has any UK customers, has generated any UK turnover or even if it supplied its goods and services in any location in the UK. Further, it has not provided invoices of any kind to indicate the sale of goods or the provision of services in the UK. Regarding the promotional and advertising materials submitted, while it is true that the majority show use of the relevant sign, there is no information to ascertain whether these promotional materials were

[14] See Exhibit FS5.

[15] See Exhibits FS10-16.

[16] See Exhibits FS6-9 and FS9 from the second witness statement.

[17] See Exhibit FS4.

specifically directed towards the UK market, or whether UK customers purchased the goods and services following engagement with the opponent's advertising and promotional materials. Even when considering the extracts from the opponent's websites and *robotcache.com*, they are all *.com* domains, which do not demonstrate the goods and services are targeted towards the UK market or its consumers. Therefore, it is not possible to infer from the evidence that the opponent offers goods and services within the UK, nor is there any indication of a customer base in the UK attributable to the opponent's trade activities. The necessity to have customers in the UK to prove goodwill was set out in *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others* [2015] UKSC 31 at [47].

79. As the opponent has not been able to prove that it has any goodwill in the UK, then it has failed to clear the first hurdle required under Section 5(4)(a).

OUTCOME

80. The opposition succeeds, and, subject to an appeal against this decision, the application will be refused.

COSTS

81. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. I award costs as follows:

Official fee	**£200**
Preparing a statement and considering the other side's statement	**£250**
Preparing evidence and considering and commenting on the other side's evidence	**£600**
Filing submissions	**£350**
Total	**£1,400**

82. I, therefore, order VILARDO LTD to pay to DACS Laboratories GmbH the sum of £1,400. 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 14th day of February 2025

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General