O/0181/25

TRADE MARKS ACT 1994

IN THE MATTER OF

APPLICATION NO. 3906446

IN THE NAME OF CARLO JOSEPH FRANCESCO MASI

TO REGISTER

AS A TRADE MARK IN CLASS 9

AND

OPPOSITION THERETO UNDER NO. 441888

BY

WELL DONE STK LTD

Background and pleadings

1. On 28 April 2023, Carlo Joseph Francesco Masi ("***the Applicant***") applied to register in the UK the trade mark shown on the cover page of this decision, under number UK00003906446 ("***the Contested Mark***"). Details of the application were published for opposition purposes on 19 May 2023. Registration is sought for the following goods:

   Class 9 Game software; Video game software; Games software for use with video game consoles; Computer video game software; Video games software.

2. Well Done STK Ltd ("***the Opponent***") opposes the application in full under section 5(2)(b) of the Trade Marks Act 1994 (***"the Act"***).[1] The Opponent relies upon the following trade mark registration ("***the Earlier Mark***"):

Earlier Mark: MASSIVE

Registration number: UK00003821448

Filing date: 18 August 2022

Registration date: 30 December 2022

Goods relied upon for the opposition:

Class 9 Recorded and downloadable media, computer software, blank digital or analogue recording and storage media; Downloadable games (software); Interactive electronic games (software); Computer software, including downloadable computer software; Computer software for use in playing games; Betting software; Games software; Gaming software, including interactive gaming; Computer application software featuring games and gaming; Interactive casino games provided through a computer or mobile platform; Downloadable games applications; Interactive electronic games applications; Interactive casino games provided through a computer or mobile platform.

[1] Statement of grounds filed on 11 July 2023.

3. By virtue of its earlier filing date, the Opponent's registration constitutes an earlier mark within the meaning of section 6 of the Act. As the Earlier Mark had not completed its registration process more than five years before the filing date of the application in issue, it is not subject to the use conditions under section 6A of the Act. The Opponent can, therefore, rely upon all of the goods it has identified without having to demonstrate use.

4. In its statement of grounds, the Opponent contends that the Contested Mark is highly similar to the Opponent's Earlier Mark on the basis of phonetic, visual and conceptual comparisons and that the contested goods are identical or highly similar to the Opponent's goods relied upon, giving rise to a likelihood of confusion under section 5(2)(b) of the Act, including a likelihood of association. The Opponent requests that the contested application be refused in its entirety and requests an award of costs in its favour.

5. On 17 July 2023,[2] the Applicant filed his defence and counterstatement, denying the grounds of opposition (i.e., the similarity between the competing marks and the goods at hand). More specifically, the Applicant submitted that the marks differ visually, given the Contested Mark's stylisation, and conceptually due to the addition of "GAMES" in the Contested Mark.

Relevance of EU law

6. 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.

Evidence and submissions

7. Neither party filed evidence. Neither party requested a hearing, but, in lieu of a hearing, the Opponent filed written submissions, dated 14 June 2024. The submissions will not be summarised here but will be referred to as and where

[2] The counterstatement was originally filed on 17 July 2023, it was further amended and finally accepted on the re-filing of 23 July 2023.

appropriate during this decision. This decision is taken following a careful perusal of the papers.

8. The Applicant is not professionally represented. The Opponent is represented by Stobbs IP.

Preliminary matters

9. In his counterstatement, the Applicant argued that the competing marks are not similar or identical because there are other trade marks that are "much more similar or identical" to the Earlier Mark. The Applicant provided a list of five third-party "MASSIVE" trade marks. The Applicant did not submit any evidence that such trade marks have genuinely been used. Whilst I acknowledge these comments, I find that the existence of few registered third-party marks consisting of the word "MASSIVE" does not provide much assistance in relation to the assessment of similarity between the marks at hand. In accordance with the comments of the General Court ("GC") in *Zero Industry Srl v OHIM*,[3] the presence on the UK register of marks containing the same or shared elements is not evidence of how many of such trade marks are in fact used in the market, nor does it clarify whether consumers have or have not been confused by the presence of such marks. The decision I am required to make is based on a notional assessment of the likelihood of confusion; whether there has already been confusion in the marketplace or not is irrelevant to my assessment. For the sake of completeness, I am unable to rely on this submission even to assess the Earlier Mark's inherent distinctive character (or lack thereof) because none of the third-party marks submitted by the Applicant relate to the goods at issue. Hence, the Applicant's submission has no apparent relevance for the proceedings at hand.

10. In his counterstatement, the Applicant continued contending that "*[…] the opposition mainly does betting and casino games. While MASSIVE GAMES does top-down, 2D, pixel art games. There's no similarities what so ever*". It appears to me the Applicant intends to bring forward the argument that the competing goods are dissimilar (i.e., the Opponent offers betting and casino games and the Applicant provides pixel-art games). I am reminded of the findings of Dr. Brian Whitehead in

[3] Case T-400/06.

City Storage Systems LLC v Kenmark Kitchen Limited,[4] where, sitting as the Appointed Person, he stated (my emphasis):

> "18. The authors of Kerly state at 11-055: "It is the goods or services covered by the specifications of the marks at issue that must be considered when making this assessment, and not the goods or services actually marketed under those marks", referring to *Present-Service Ullrich GmbH & Co KG v OHIM* (T-66/11) [2013] E.T.M.R. 29. In that case, the General Court said at 45:
>
> > "Secondly, the applicant's claim that it operates in a completely different commercial sector from the intervener is also irrelevant. In order to assess the similarity of the goods or services at issue for the purposes of art.8(1)(b) of Regulation 207/2009, the group of goods or services protected by the marks at issue must be taken into account, and not the goods or services actually marketed under those marks".

11. It follows that in my assessment I must look at the goods' similarity solely on the basis of those registered and it is impermissible for me to take into account the goods actually provided by the parties (i.e., the different types of games the parties provide). I, thus, disregard this submission by the Applicant.

Decision

The law

12. The relevant parts of section 5 of the Act are as follows:

> "5(2) 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."

13. Section 5A reads:

[4] Decision BL O/0065/24.

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

Case law

14. The leading authorities which guide me are from the Court of Justice of the European Union (CJEU): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The Principles

(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

15. When making the comparison, all relevant factors relating to the goods (and services) in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

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

a) The respective users of the respective goods or services;

b) The physical nature of the goods or acts of services;

c) The respective trade channels through which the goods or services reach the market;

d) 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;

e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

17. The General Court ("GC") confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, 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):

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur 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".

18. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

19. The competing goods are as follows:

Opponent's goods	Applicant's goods
Class 9	**Class 9**

Recorded and downloadable media, computer software, blank digital or analogue recording and storage media; Downloadable games (software); Interactive electronic games (software); Computer software, including downloadable computer software; Computer software for use in playing games; Betting software; Games software; Gaming software, including interactive gaming; Computer application software featuring games and gaming; Interactive casino games provided through a computer or mobile platform; Downloadable games applications; Interactive electronic games applications; Interactive casino games provided through a computer or mobile platform.	Game software; Video game software; Games software for use with video game consoles; Computer video game software; Video games software.

- "*Game software; Video game software; Games software for use with video game consoles; Computer video game software; Video games software"*

20. In his counterstatement the Applicant lists some of the Opponent's goods in class 9 that he argues to be different from the Contested Mark's specification. I notice most of the goods identified are not relied upon by the Opponent for the opposition at hand. The Applicant did not provide further submissions on the goods' similarity (or lack thereof).

21. In its submissions in lieu, the Opponent contended that the Earlier Mark's specification covers both "computer software" at large as well as variations of "computer software" (e.g., "games software", "gaming software", "downloadable games") arguing that the competing goods must be considered identical on the

basis of the principle outlined in *Meric*. I agree with the Opponent. The Applicant's goods all consist of video game software (both for consoles and computers), thus, they fall within the broad category of the Opponent's "*Computer software, including downloadable computer software*" and "*Games software*". Hence, they are identical.

The average consumer and the nature of the purchasing act

22. It is necessary to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited*, *The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

23. The average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96, *Gut Springenheideand Tusky* [1998] ECR I-4657, paragraph 31).

24. 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 in question.[5]

25. The Opponent submitted that:

"*All the goods covered by the Application are everyday products offered to the general public at large. There is no specialist or professional public here. These*

[5] *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, (Case C-342/97, para 26).

are not expensive purchases and so the level of attention may be relatively low. These video and computer games can be very low-level purchases or even available or played for free online or on a mobile app. They can be done easily and quickly online through a bowser or through a mobile app. A game or purchase can take mere seconds. A high degree of attention is not necessary to choose or use these goods."[6]

26. The average consumer for the goods in class 9 (video game software) will be a member of the general public (end users who play video games). The cost of the goods in question is likely to vary according to the type of game; on balance, I find it to be relatively low (but not the lowest). Contrary to the Opponent's submissions, I do not find that the goods are "everyday products", nonetheless, I find the goods to be purchased relatively frequently. When purchasing the goods, the average consumer will take various factors into consideration such as the cost, graphic definition, gameplay, compatibility with their devices (e.g., gaming console, computer, mobile phone) and the game's suitability for their specific preference and needs. Consequently, I consider that the degree of attention when selecting the goods will be medium.

27. The goods are likely to be obtained by self-selection from websites, e-commerce platforms, app stores, or the shelves of a physical retail outlet (supermarkets or specialised game stores). The goods may also be purchased following advertisements on social media or other specialised online platforms. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase of the goods through advice sought from a sales assistant or representative, and word-of-mouth recommendations.

Comparison of trade marks

28. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the

[6] Submissions in lieu dated 14 June 2024, paragraph 37.

overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

29. 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".

30. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

31. The trade marks to be compared are as follows:

Earlier trade mark	Contested trade mark
MASSIVE	

Overall impression

32. The overall impression of the Earlier Mark resides in the word "MASSIVE" of which it is composed.

33. The Opponent submitted that: "*the dominant element of the Earlier Mark and the Contested Sign is the word MASSIVE. The additional element GAMES in the Contested Sign is clearly non-distinctive in character in relation to the applied for*

goods, all of which relate to computer/video games".[7] In the Contested Mark the words "MASSIVE GAMES" are placed in a dominant position (centre of the mark) and with identical stylisation. I find the first word ("MASSIVE") qualifies the second ("GAMES"), nonetheless each individual word retains its own meaning within the mark; the distinctive character resides in the mark as a whole without one word dominating, but with "GAMES" being descriptive of the goods.

Visual similarity

34. The Earlier Mark consists of the single word "MASSIVE" represented in standard typeface and all capitalised letters. The Contested Mark features the all-capitalised words "MASSIVE" and "GAMES" disposed on two lines (one on top of the other) and placed at the centre of the mark. In the Applicant's words, the mark's text is represented in a 'pixel art' fashion (i.e., retro blocky aesthetic).[8] A horizontal line separates the words "MASSIVE" and "GAMES". The line becomes dotted at its edges. The mark's text is in black on a white background and contained within a black border. The white background goes beyond the black border to make it visible. The mark's words and the white background are placed on a bigger black background.

35. The Opponent argued that the Earlier Mark is wholly contained within the Contested Mark and that the competing marks overlap in their first word (MASSIVE) to which consumers pay more attention when reading the marks.[9] I agree with the Opponent that "MASSIVE" is fully contained in the Contested Mark (albeit with some stylisation) and that consumers are likely to pay more attention to this word when reading the mark. In this respect it is recalled that words are normally read from left to right and from top to bottom[10] and that the initial part of a mark normally has a greater impact, both visually and aurally, than the following or final parts.[11] The Contested Mark is a longer mark comprising two words and present some level of stylisation. Having considered the parties' arguments and

[7] Submissions in lieu dated 14 June, paragraphs 46 – 47.
[8] Counterstatement dated 17 July 2023, page 8.
[9] Submissions in lieu dated 14 June, paragraph 49.
[10] *New Look Ltd v European Union Intellectual Property Office*, Joined Cases T-117/03 to T-119/03 and T-171/03, [28].
[11] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, [81].

keeping in mind the marks' overall impression, I find, overall, the respective marks have a medium degree of visual similarity.

Aural similarity

36. The Earlier Mark is comprised of the two-syllable word "MASSIVE". The Contested Mark features two words, with the former ("MASSIVE") being identical to the Earlier Mark (also in its enunciation) and the latter ("GAMES") being a shorter one-syllable word. The Contested Mark features English dictionary words that are structured in accordance with the English grammar rules to convey a specific meaning. All words in both the Earlier Mark and Contested Mark are English dictionary words and the relevant consumer will voice them accordingly.

37. In light of the above considerations, I find, overall, the respective marks to be aurally similar to an above medium degree.

Conceptual similarity

38. The Applicant contended that:

"*Massive and Massive Games can be conceptually different in the following ways:*

1. *Size or scale: Massive refers to something that is large, significant or extensive in size or quantity. It describes something of great magnitude or dimensions. On the other hand, Massive Games typically refers to video games that are large in size and in game content.*
2. *General vs Specific Context: Massive is a broader term that can be applied to various contexts, such as describing large objects, events or quantities. It is not exclusive to the gaming industry. In contrast, Massive Games has a more specific context, directly associated with video games that are large in size.*
3. *Adjective vs Noun: Massive is primarily an adjective used to describe the size or quantity of something. It modifies or gives additional information about a noun. On the other hand, Massive Games is a noun phrase that specifically refers to a category or type of video games with a large component.*

While Massive can be used broadly in different domains, Massive Games focuses specifically on a certain genre of video games with large scale game functionality."[12]

39. The Opponent submitted that "*the Earlier Mark and the Contested Sign are clearly conceptually very similar to a high degree"* and that *"both signs share the same understandable concept of size, due the shared word MASSIVE*".[13]

40. I appreciate both marks share the same word "MASSIVE", however I agree with the Applicant that the presence of "GAMES" in the Contested Mark renders "MASSIVE" an adjective referring to "GAMES". This takes it further away from the meaning of the more general adjective constituting the Earlier Mark. Therefore, overall, I find the marks have a low conceptual similarity.

Distinctive character of the Earlier Mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as

[12] Counterstatement dated 11 July 2023, page 8.
[13] Submissions in lieu, dated 14 June, paragraphs 54 – 55.

originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

42. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods, to those with high inherent distinctive character, such as invented words.

43. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the Opponent has filed no evidence of use of its mark. Accordingly, I have only the inherent position to consider.

44. The Opponent submitted that "*whilst made up of ordinary dictionary words, it* [the Earlier Mark] *is a term which makes no allusion to any aspect of the goods and services for which it is registered. It is therefore submitted that the Earlier Mark has at least a medium degree or even a fairly high degree of inherent distinctiveness*".[14] The Opponent also directed me to the decision *Virgin Enterprises Limited v Virginic LLC* [2019] EWHC 672 (Ch) where Mr Justice Arnold (as he then was) found that as the adjective 'VIRGIN' "*[…] is arbitrary in relation to the goods in question, it follows that it has a fairly high degree of inherent distinctive character, albeit not so high as would be the case if it were an invented word*".

45. The Earlier Mark is the English dictionary word "MASSIVE" consisting of an adjective with multiple meanings. I find the mark to be neither descriptive of nor to have any semantic correlation with the goods at hand. Neither party has provided further clarification in this regard. Taking into consideration the Opponent's submissions, I find the Earlier Mark has an above medium degree of inherent distinctive character.

Likelihood of confusion

46. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel*

[14] Submissions in lieu, dated 14 June, paragraph 58.

at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

47. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. The concept of indirect confusion was explained by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10 as follows:

> "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).”

48. I have found the respective goods to be identical. The consumer is likely to pay a medium level of attention in their selection. The distinctiveness of the Earlier Mark is above medium. The marks are visually similar to a medium degree, they have an above-medium aural similarity, and the marks are conceptually similar to a low degree. The purchase of the contested goods is considered to be mainly visual but the potential for aural use is borne in mind.

49. The Contested Mark fully contains the Earlier Mark. Whilst “MASSIVE” will be seen as defining “GAMES” in the Contested Mark, and I have found the two words to contribute to the overall impression of the mark, this does not alter the fact that GAMES is purely descriptive of the goods at issue. The relevant consumers are likely to refer to both the Opponent’s and the Applicant’s goods (i.e., video games) as ‘Massive’ games, thus, leading to the marks being recalled as one another. Weighing all these factors, keeping in mind the Contested Mark’s stylisation, and bearing in mind the effects of imperfect recollection, I find that the relevant average consumer is likely to mistake the Earlier Mark for the Contested Mark, or vice versa. Thus, there is a likelihood of direct confusion.

50. I turn to consider the likelihood of indirect confusion. The concept of indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually 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)".

51. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.[15] I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.[16] The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.[17]

[15] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.
[16] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.
[17] *Liverpool Gin Distillery*.

52. It will be difficult for the relevant consumers to miss that the first word of the Applicant's mark ("MASSIVE") is also the same as the Opponent's mark. Furthermore, whilst I found that "MASSIVE" defines "GAMES" in the Contested Mark it is also true that the relevant consumers, upon encountering the Applicant's mark being used in respect of identical goods (i.e., video games), are likely to perceive it as indicating "games" provided by, or linked to, the Opponent "MASSIVE". Therefore, taking account of the common element in the context of the later mark as a whole, the consumer is likely to conclude that the Contested Mark merely adds a descriptor of the goods to identify 'Massive' games, leading the consumer to perceive the Contested Mark as a sub-brand or rebranding of the owner of the Earlier Mark.

53. Bearing all of the above in mind and taking into consideration the Contested Mark's stylisation, I am of the view that it is likely that a significant proportion of average consumers would, upon being confronted with the parties' marks, believe that they originate from the same or economically linked undertakings. This because the only elements that distinguish the competing marks are the descriptive word 'games' and a small amount of stylisation in the Contested Mark. These do not suffice to avoid indirect confusion.

Conclusion

54. The opposition succeeds and the application will be refused for all the goods.

Costs

55. The Opponent has been successful and is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice ("TPN") 1/2023. Bearing that scale in mind, I award costs to the Opponent as follows:

Official fee	£100
Preparing the notice of opposition and considering the counterstatement	£250
Submissions in lieu	£350
Total:	**£700**

56. I order Carlo Joseph Francesco Masi to pay Well Done STK Ltd the sum of **£700**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of February 2025

Andrea Rossi

For the Registrar