

O/0346/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3927632

BY TAMARIS (GIBRALTAR) LIMITED

TO REGISTER THE TRADE MARK:



IN CLASSES 9, 28 AND 41

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 443531

BY PLAY'N GO MARKS LTD

BACKGROUND AND PLEADINGS

1. On 28 June 2023, Tamaris (Gibraltar) Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision (“the contested mark”) in the UK. The application was accepted and published for opposition purposes on 14 July 2023, in respect of goods and services in classes 9, 28 and 41.¹

2. On 10 October 2023, the application was opposed by Play'n GO Marks Ltd (“the opponent”), based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the goods and services in the application. The opponent relies upon the following UK trade marks (“UKTM”):



i)

UKTM no. 918222785²

Filing date: 7 April 2020; registration date: 5 August 2020

Relying upon all the goods and services for which the mark is registered.³

(“the first earlier mark”)

ii) MOON PRINCESS 100

UKTM no. 3888297

Filing date: 13 March 2023; registration date: 2 June 2023

Relying upon all the goods and services for which the mark is registered.⁴

(“the second earlier mark”)

3. The above marks qualify as earlier marks under section 6(1) of the Act. As they had not completed their registration procedure more than five years before the application date for the contested mark, they are not subject to the use provisions contained in

¹ See goods and services comparison.

² Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks (“EUTM”) registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (EU)’ retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

³ See goods and services comparison.

⁴ See goods and services comparison.

section 6A of the Act. Consequently, the opponent may rely upon all the goods and services for which the earlier marks are registered without having to establish genuine use.

4. In its notice of opposition, the opponent claims that the respective marks are highly similar and that the respective goods and services are identical or highly similar, resulting in a likelihood of confusion on the part of the relevant public. The applicant filed a counterstatement denying the grounds of opposition.

5. The opponent is represented by Appleyard Lees IP LLP; the applicant is represented by Mishcon de Reya LLP. Both parties filed evidence. Neither party requested a hearing but both parties chose to file written submissions in lieu of a hearing. This decision is taken following a careful review of the papers before me, keeping all submissions in mind.

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

7. The opponent's representative, Beverley Robinson, a Senior Associate and Chartered Trade Mark Attorney at Appleyard Lees IP LLP, filed evidence, on behalf of the applicant in the form of a witness statement, dated 13 February 2024, along with one exhibit (BR1). It is noted that the exhibit contains screenshots taken from the Cambridge Dictionary (online), providing dictionary definitions for the words 'moon' and 'starlight'. Whilst this evidence is of little relevance to my overall assessment, I will make an assessment later in this decision regarding the distinctiveness of the words in question.

8. The applicant's representative, Stuart Donald Lester, a solicitor of the Senior Courts of England & Wales and a managing associate in the law firm Mishcon de Reya LLP, under the supervision of Sally Britton (partner), filed evidence, on behalf of the applicant in the form of a witness statement, dated 7 May 2024, along with eight exhibits (SDL1-SDL8). The evidence appears to have been adduced in order to demonstrate the coexistence of closely similar marks and similar themed marks in the relevant marketplace, and to show that the words 'moon' and 'princess' contained in the opponent's mark are commonly used in relation to the goods and services at issue, both on the register and in the marketplace. The evidence will be referred to where necessary during this decision.

PRELIMINARY ISSUES

9. The applicant has raised points in their submissions that I intend to address as preliminary issues. Before going any further into the merits of this opposition it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

State of the register

10. The evidence filed on behalf of the applicant includes tables containing a reasonable number of marks, in Classes 9, 28 and 41 which feature the term 'PRINCESS'⁵ and the term 'MOON'.⁶ This information was retrieved following a search on the United Kingdom Intellectual Property Office register. In addition, the evidence also includes screenshots showing use of a selection of these marks in the UK market including screenshots from internet archive Wayback Machine.⁷ Whilst the relevance of this information has not been made clear in the witness statement, it is noted that in its submissions in lieu,⁸ the applicant submits the following regarding its evidence:

⁵ Exhibit SDL1

⁶ Exhibit SDL3

⁷ Exhibits SDL2 and SDL4

⁸ Dated 2 August 202

“Its (the opponent’s) submissions dated 13 February 2024 suggests that the word ‘Princess’ is highly distinctive for goods in Classes 9, 28 and 41. That is not true: there are many marks in these classes using the word 'Princess' as shown in the Applicant's evidence. Indeed, the evidence provided in the Witness Statement of Stuart Donald Lester dated 7 May 2024 ("WS of SDL") demonstrates the reality of the register and the market, which are replete with marks containing the term 'PRINCESS'. This context ensures that consumers are accustomed to distinguishing between different games and would not confuse the games in question.

By the time the Earlier Device Mark was applied for, the UKIPO register already contained numerous registrations featuring 'PRINCESS', covering betting and gaming goods and services.

[...]

The number of registrations incorporating 'PRINCESS' increased even further by the time the Earlier Word Mark was filed, as evidenced by the Applicant.

The WS of SDL also demonstrates unregistered marks being used in the UK betting and gaming market.

[...]

It is in this context that the similarity of the marks must be assessed. Given the multitude of existing marks that combine [word + PRINCESS], the Opponent's claim to monopolise the term 'PRINCESS' is untenable.

[...]

The WS of SDL explains very clearly the results of an objective search of the trade marks register. The picture from the evidence is that PRINCESS is a very common component of marks in classes 9, 28 and 41.”

11. I deduce that the main purpose of Mr Lester's witness statement and exhibits, is to try and demonstrate that: the opponent's mark is of low/weak distinctiveness due to the existence of other marks made up of or incorporating the words MOON and PRINCESS both on the register and in the marketplace; to demonstrate the relevant consumer's knowledge of the relevant marketplace; and to show the successful coexistence of often closely similar marks and similar themed marks in the relevant marketplace. However, in regard to the level of distinctiveness of the earlier marks, by virtue of the fact that they are registered means that it is assumed that they have at least some distinctive character.⁹

12. Furthermore, it is important to recall that the state of the register is not evidence of how many of such trade marks are effectively used in the market, nor does it establish that the distinctive character of the elements in question has been weakened because of their frequent use in the field concerned.

13. In considering this issue, I refer to the case of *Zero Industry Srl v OHIM*, Case T-400/06, wherein the General Court ("GC") stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71)."

⁹ *Formula One Licensing BV v OHIM*, Case C-196/11P

DECISION

Section 5(2)(b): legislation and case law

14. Section 5(2)(b) of the Act states that:

“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.”

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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

16. Section 60A of the Act provides:

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

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

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

17. When considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account.

Those factors include, *inter alia*:¹⁰

- the physical nature of the goods or acts of service;
- their intended purpose;
- their method of use / uses;
- who the users of the goods and services are;
- the trade channels through which the goods or services reach the market;
- in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and

¹⁰ See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “Treat” case

- whether they are in competition with each other (taking into account how those in trade classify goods and services, for instance whether market research companies put them in the same or different sectors)
or
- whether they are complementary to each other. Complementary means *“there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”*.¹¹ I note that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.¹²

18. When interpreting the terms in a specification I bear in mind:

- (i) that it is *“necessary to focus on the core of what is described..”* and that *“... trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise”*, although *“where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”*.¹³

19. The competing goods and services are as follows:

The applicant’s specification

Class 9

Computer gaming software; Computer software for the administration of on-line games and gaming; Computer hardware for games and gaming; Computer application software featuring games and gaming; Gaming software that generates or displays wager outcomes of gaming machines; Interactive game software; Downloadable computer games; Downloadable video game software; Interactive computer game

¹¹ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82

¹² *Kurt Hesse v OHIM*, Case C-50/15

¹³ *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

programs; Computer games programs [software]; Interactive multimedia computer game programs.

Class 28

Gaming machines; Slot machines [gaming machines]; Gaming machines for gambling; Slot machines (gaming devices); Gaming machines namely devices which accept a wager; Portable gaming devices; Machines for playing games of skill or chance.

Class 41

Providing on-line information in the field of computer gaming entertainment; Information relating to computer gaming entertainment provided online from a computer database or a global communication network; Online gaming services; Providing online games; Providing online video games; Provision of online computer games; Provision of online information in the field of computer games entertainment; Provision of an online magazine featuring information in the field of computer games; Gaming machine entertainment services; Conducting multiple player games of chance; Video game entertainment services; Providing an online computer game; On-line gambling services.

The opponent's specifications

The first earlier mark (UKTM no. 918222785)

Cass 9

Computer games and video games (software), hereunder software for slot machine games, betting and wagering games, video slot games, casino games and bingo games provided online and via computer networks and playable on any type of computing device including arcade games, personal computers, handheld devices and mobile phones; software for slot machine games, betting and wagering games, video slot games, casino games and bingo games provided online and via computer networks and playable on any type of computing device including arcade games, personal computers and handheld devices.

Class 28

Videogaming apparatus, hereunder slot machines for gambling, gaming machines, poker machines and other video based casino gaming machines; arcade games; gaming machines, namely, devices that accept a wager; reconfigurable casino and lottery gaming equipment, hereunder gaming machines including computer games and software therefor sold as a unit.

Class 41

Games services provided online (via computer networks), hereunder providing slot machine games, betting and wagering games, video slot games, casino games and bingo games, playable via local or global computer networks; on-line gaming services; entertainment services, namely, conducting a game of chance simultaneously at multiple, independent gaming establishments; entertainment services, hereunder providing on-line computer games; prize draws [lotteries]; organising and conducting lotteries; Services for the operation of computerised bingo.

The second earlier mark (UKTM no. 3888297)

Class 9

Computer games and video games (apps and software), hereunder apps and software for slot machine games, betting and wagering games, video slot games, casino games, games of chance and bingo games provided online and via computer networks and playable on any type of computing device including arcade games, personal computers, handheld devices and mobile phones; apps and software for games with monetary or non-monetary prizes; software for slot machine games, betting and wagering games, video slot games, casino games, games of chance and bingo games provided online and via computer networks and playable on any type of computing device including arcade games, personal computers, handheld devices and mobile phones.

Class 41

Games services provided online (via computer networks), hereunder providing slot machine games, betting and wagering games, video slot games, casino games, games of chance, games with monetary or non-monetary prizes and bingo games,

playable via local or global computer networks; online gaming services; entertainment services, namely, conducting a game of chance simultaneously at multiple, independent gaming establishments; entertainment services, hereunder providing online computer games; prize draws [lotteries]; organising and conducting lotteries; Services for the operation of computerised bingo.

20. With regard to the similarity of the goods and services, in its written submissions in lieu,¹⁴ the opponent states the following:

“Both the Applicant and the Opponent are developers and providers of online gaming products. The Applicant's goods and services are in direct competition with the Opponent's goods and services, being sold alongside them as alternative options available to consumers visiting online gaming outlets. The goods and services are of the exact same nature, have the same end users, and have identical distribution channels. Any goods and services that are not strictly identical are highly similar.

The Earlier Registrations collectively cover gaming, betting and casino related goods and services in classes 9, 28 and 41. The Application covers identical and highly similar goods and services in identical classes.”

21. In its written submissions in lieu,¹⁵ the applicant states the following:

“The scope of the goods and services protected by the Earlier Registrations are notably specific and narrow, almost exclusively relating to online betting and gaming. In contrast, the Mark covers several broad terms such as 'Computer gaming software' in Class 9, 'Gaming machines' in Class 28, and 'Providing online games' in Class 41. These categories are not inherently tied to the betting and gambling sector and encompass a wider range of gaming activities that do not involve wagering.

¹⁴ Filed on 2 August 2024 [paragraph 20].

¹⁵ Dated 2 August 2024.

The use of goods and services within these broad categories does not necessarily overlap. A consumer interested in 'Computer gaming software' may not have any inclination towards gambling machines or devices that accept wagers. Similarly, the provision of computer software for general gaming purposes does not imply a provider's involvement in the gambling sector, such as offering software for slot machine games or video slot games. The same logic applies to providers of online games, where the provision of such games does not automatically extend to the provision of wagering games or similar gambling activities.

Beyond these terms, the Applicant recognises that there is a degree of similarity in the goods and services when considering the broader category of betting and gaming. However, this similarity does not compromise the distinctiveness of the Mark.”

22. I note the applicant's claim that some of its goods and services do not directly relate to betting/gambling. However, having carefully reviewed the contested specification, it is clear that some of the goods and services do directly relate to betting/gambling. Moreover, I acknowledge that not all the opponent's goods and services relate to betting/gambling.

Class 9 of the contested application

Computer gaming software; Computer software for the administration of on-line games and gaming; Computer application software featuring games and gaming; Gaming software that generates or displays wager outcomes of gaming machines; Interactive game software; Downloadable computer games; Downloadable video game software; Interactive computer game programs; Computer games programs [software]; Interactive multimedia computer game programs

23. The above contested terms all cover different types of software for computer games. I note that the opponent's earlier marks include the term *computer games (software)*, and that the opponent's second earlier mark includes the term *computer games (apps)*. Therefore, it is clear that these goods are all computer game software

and apps. In my view, 'computer games' will not be read as being games exclusively reserved for use on computers. Instead, I consider that the term 'computer games' is commonly used when referring to games played on any electronic device or system, regardless of whether they are technically computers or not. As a result, I consider that the opponent's terms cover games that are played on video games consoles, virtual reality devices, mobile phones, gaming machines or any other electronic device. As a result, I find that the contested terms all fall within the opponent's terms and, therefore, I find they are identical under the principle outlined in *Meric*.

Computer hardware for games and gaming

24. The contested goods are physical devices, such as computers, upon which games and gaming software is downloaded or computer games are played. The opponent's earlier marks include *computer games (software)* and therefore whilst not identical to the above contested goods I find that they are similar to a degree. Whilst differing in nature and purpose, the respective goods overlap in end users, they reach the market through the same trade channels and are complementary on the basis that one is important for the use of the other in such a way that consumers may think that the responsibility of the goods lies with the same undertaking, for example, computer software cannot be used without computer hardware and vice versa. Accordingly, I find the contested goods and the opponent's *computer games (software)* are similar to a medium degree.

Class 28 of the contested application

Gaming machines; Slot machines [gaming machines]; Gaming machines for gambling; Slot machines (gaming devices); Gaming machines namely devices which accept a wager; Portable gaming devices; Machines for playing games of skill or chance

25. The above contested goods all have direct equivalents in the opponent's Class 28 specification (first earlier mark), namely *videogaming apparatus, hereunder slot machines for gambling, gaming machines, poker machines and other video based casino gaming machines; arcade games; gaming machines, namely, devices that*

accept a wager; reconfigurable casino and lottery gaming equipment, hereunder gaming machines including computer games and software therefor sold as a unit. I am therefore of the view that the competing goods are identical either due to their identical/near-identical wording or based on the *Meric* principle.

Class 41 of the contested application

Online gaming services; Providing online games; Providing online video games; Provision of online computer games; Providing an online computer game; On-line gambling services

26. The above contested services have direct equivalents in the opponent's Class 41 specification (first and second earlier marks), namely *on-line gaming services; games services provided online (via computer networks), hereunder providing slot machine games, betting and wagering games, video slot games, casino games and bingo games, playable via local or global computer networks; entertainment services, hereunder providing on-line computer games.* I am therefore of the view that the competing services are identical either due to their identical/near-identical wording or based on the *Meric* principle.

Conducting multiple player games of chance

27. The above contested services directly coincide with the opponent's *entertainment services, namely, conducting a game of chance simultaneously at multiple, independent gaming establishments* (first and second earlier marks). Therefore, the competing services are identical.

Gaming machine entertainment services; Video game entertainment services

28. The above broad services overlap with the opponent's *games services provided online (via computer networks), hereunder providing slot machine games, betting and wagering games, video slot games, casino games and bingo games, playable via local or global computer networks; entertainment services, hereunder providing on-line*

computer games (first and second earlier marks). Therefore, the competing goods are identical based on the *Meric* principle.

Providing on-line information in the field of computer gaming entertainment; Information relating to computer gaming entertainment provided online from a computer database or a global communication network; Provision of online information in the field of computer games entertainment; Provision of an online magazine featuring information in the field of computer games

29. Whilst it is noted that neither of the opponent's Class 41 specifications contained in its earlier marks include the above contested services, I consider there to be a degree of similarity between these services and the opponent's *entertainment services, hereunder providing on-line computer games; on-line gaming services; Games services provided online (via computer networks), hereunder providing slot machine games, betting and wagering games, video slot games, casino games and bingo games, playable via local or global computer networks* (first and second earlier marks). I acknowledge that their natures and method of use differ, as do their purpose for that matter as the contested services aim to provide information, whereas the opponent's services do not, however, as for their points of similarity, I am of the view that the user of the opponent's services may also seek the provision of entertainment information. Therefore, I find that the respective services are likely to overlap in user. Further, it is also likely that providers of the opponent's computer gaming services will also provide information relating to those computer gaming services via online sources such as magazines, FAQs or walkthroughs provided on websites. As a result, there is also likely to be an overlap in trade channels between these services. Accordingly, I find that the services are similar to a medium degree.

The average consumer and the nature of the purchasing act

30. It is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose 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 or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

31. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

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

32. With regard to the average consumer of the goods and services at issue, in its written submissions in lieu,¹⁶ the opponent states the following:

“[...] the relevant public is the average consumer of everyday online gaming products, which is the public at large. The goods are everyday items with a low purchase value, and the average consumer is accustomed to encountering a high number of available products to select from. As such, the average consumer’s level of attention will be relatively low when purchasing the relevant goods and services and encountering any associated trade marks.

In this case, the Applicant and the Opponent operate in the exact same field and the goods and services are largely identical. Any differences between the marks are therefore more likely to go unnoticed and only a relatively low degree of similarity between the marks is required for a likelihood of confusion to arise. This is particularly true because the average consumer’s level of attention when purchasing the goods and services in question will be relatively low.”

¹⁶ Filed on 2 August 2024 [paras 32-33].

33. In its written submissions in lieu,¹⁷ the applicant states:

“The Opponent's characterisation of the average consumer as a general member of the public who may engage with computer games or online games is an oversimplification that fails to consider the specific nature of the goods and services at issue. The Applicant contends that the average consumer in this context is more accurately defined as an adult who engages with gambling computer games or accesses gambling games online. The regulatory framework governing gambling in the UK mandates stringent age verification and account creation processes for consumers to access these services. This regulatory environment inherently narrows the field to a more discerning adult consumer base, which in turn has a significant impact on their level of attention and perceptiveness when selecting games.

The average consumer of gambling games is exposed to a plethora of similar products, each requiring a financial stake. The inherent risks and the potential for financial gain or loss in such a volatile environment heighten the consumer's attentiveness beyond that of a typical computer game user. This heightened level of attention is further amplified by the consumer's familiarity with the games' volatility, gameplay, and promotional features, particularly if they have prior experience with the game. As a result, the consumer is more attuned to the nuances of different games and more likely to discern between them.

The process of selecting gambling games is predominantly visual, with consumers typically encountering these games on websites of gambling operators or their mobile applications. While recommendations through word of mouth may introduce consumers to new games, it is ultimately the visual presentation of the trade mark that informs the consumer's purchasing decision. The visual encounter with the trade mark is a critical step that precedes any financial commitment to play.

¹⁷ Dated 2 August 2024 [paras 2.2-2.5].

For the above reasons, the Applicant submits that the average consumer's level of attention is relatively high when engaging with the relevant goods and services. The choice of game is influenced by a multitude of factors, including but not limited to visual appeal, familiarity, and the potential for financial outcomes. This heightened level of attention ensures that the average consumer is capable of distinguishing between different marks and games, thereby reducing the likelihood of confusion.”

34. With regards to the goods in Class 9, I consider that the average consumer will include both the general and professional public. For the goods at issue that relate specifically to gambling, the general public will be over the age of 18. For the general public, the goods will likely be sought out primarily by eye via websites or app stores on a consumer's device, for example. However, I bear in mind that the goods may sometimes be the subject of word-of-mouth recommendations and therefore aural considerations are also borne in mind. I am of the view that the general consumer will pay no more than a medium level of attention. Conversely, a professional purchaser seeking software for their gaming machines, for example, might pay a slightly higher than medium level of attention as their purchasing decision might include, amongst other things, the compatibility of the software with the gaming equipment, etc. The price and frequency of purchase of the goods will vary. For example, goods such as video games and gaming software for use on mobile phones may be relatively inexpensive or even free and will likely be purchased frequently, whereas software for gaming machines and terminals etc., is likely to be expensive and purchased less frequently.

35. With regards to the goods in Class 28, in my view the goods will almost always be purchased by a professional, who is in the business of providing gaming, casino or gambling services, etc. The purchasing act will likely be primarily visual with the goods being viewed either in a catalogue or online. However, I acknowledge that there may also be an aural aspect to the purchasing process where the purchaser consults the seller before concluding a purchase. The goods are likely to be relatively expensive and I find that the average consumer will likely pay an above average degree of attention (though not at the highest level), during the purchasing act as they are likely to consider a number of factors regarding the goods, such as the mathematical

algorithms of the gaming machines in order to determine the percentage and frequency of winnings, etc. Furthermore, as the goods will be used in the context of the business, the success of the business will also likely depend upon the right choice of goods.

36. In respect of the services in Class 41, I consider that the average consumer will be predominantly members of the general public who play computer games or access games online. With regards to those services that relate to gambling, the general public will be over the age of 18. I consider that the purchasing act will likely be primarily visual on the basis that the purchaser will encounter the service provider either online or upon seeing the physical premises on the street, for example, a betting shop, casino or arcade. That said, there may be an aural aspect as a result of word-of-mouth recommendations, etc. I find that the relevant member of the general public, engaging in, for example, gambling, betting and wagering services, will include regular gamblers, namely those who gamble frequently with the aim of making money. It is my view that this average consumer will, generally speaking, pay a medium degree of attention when gambling, including those that gamble infrequently, for fun and for low stakes. However, I acknowledge that for some average consumers who are looking to potentially risk a significant amount of their own money when gambling, the attention paid will be higher, although not considerably so. In this regard, it is important to acknowledge that where there is more than one category of average consumers who pay different degrees of attention, it is the lowest degree of attention that will be considered in the assessment of likelihood of confusion.

Comparison of the marks

37. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

“34. [...] 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.”

38. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components 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.

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

Opponent's marks		Applicant's mark
<u>First earlier mark</u>		
<u>Second earlier mark</u>	MOON PRINCESS 100	

40. Both parties have filed lengthy submissions regarding the similarity of the marks. Whilst I do not propose to reproduce those here, I have taken them all into consideration in reaching my decision.

Overall impression

The opponent's first earlier mark

41. The mark is a composite mark consisting of words and figurative device elements. The words 'Moon' and 'Princess' are placed in order, one on top of the other. Both words are presented in a large, pink upper and lowercase stylised font. The words are

placed upon a large figurative crescent moon device which is bluey-white in colour. A blue haze and a number of very small white stars surround the crescent moon. Additionally, there are a number of very small yellow/gold figurative elements resembling stars and crescent moons, which are sporadically placed around the words. Due to their size and colour, I find that the eye is naturally drawn to the words 'Moon Princess', keeping in mind *MigrosGenossenschafts-Bund v EUIPO*, T-68/17, where it was stated that:

“...in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements...”

42. With regards to the words, I find that the word 'Moon' qualifies the word 'Princess', however, I acknowledge that this combination is slightly unusual in that the first word is not obviously descriptive when combined with the word 'Princess'. With regards to the figurative elements, for reasons I will come to discuss in the conceptual comparison, I find that these elements, whilst not negligible, play a lesser role in the overall impression. On balance, I find that the words 'Moon Princess' make an equal contribution when considered as a whole, and it is the combination of these two words that dominate the overall impression.

The opponent's second earlier mark

43. This mark comprises the word elements 'MOON' and 'PRINCESS' and a numerical element '100', all presented in a plain font and all characters being of uniform size with the word elements presented in uppercase. I find that the overall impression of the mark resides in its entirety.

The application

44. The mark is a composite mark consisting of words and figurative device elements. The words 'Starlight' and 'Princess' are placed in order, one on top of the other. The

word 'Starlight' is presented in a large, red upper and lowercase standard font; the word 'Princess' is marginally larger than the word 'Starlight' and is presented in a blue, upper and lowercase standard font. The words are placed upon a multi-coloured decorative device element, featuring 10 fanned-out feathers. Placed directly above the words and device element is a centrally placed decorative element comprising a fanciful golden crown. Due to their size and colour, I find that the eye is initially naturally drawn to the words 'Starlight Princess', keeping in mind *MigrosGenossenschafts-Bund v EUIPO*, T-68/17.

45. With regards to the words, I find that the word 'Starlight' qualifies the word 'Princess', however, I acknowledge that this combination is slightly unusual in that the first word is not obviously descriptive when combined with the word 'Princess'. With regards to the figurative elements, for reasons I will come to discuss in the conceptual comparison, I find that these elements, whilst not negligible, play a lesser role in the overall impression. On balance, despite the word 'princess' being presented in slightly larger text to that of the word 'Starlight', the difference is so minimal that this is likely to go unnoticed and as such I find that the words 'Starlight Princess' will make an equal contribution when considered as a whole, and it is the combination of these words that will dominate the overall impression.

Visual comparison

The first earlier mark  *and the application* 

46. Visually, the marks coincide insofar as they identically share the same word 'Princess'. However, the marks differ in that the opponent's mark contains the additional word 'Moon' and figurative elements depicting a moon and stars, not replicated in the applicant's mark; whereas the applicant's mark contains the additional word 'Starlight' and figurative elements depicting feathers and a crown, neither of which are replicated in the opponent's mark. As for the differences between the fonts and colours used in the words contained in the respective marks, I do not consider these elements to be points of significant difference. Whilst I note that both trade marks

contain the word 'Princess', I bear in mind that it is settled caselaw that the beginning of marks tend to have more visual impact than their endings being where consumers tend to focus.¹⁸ Therefore, weighing up the similarities with the differences, I find the competing marks to be visually similar to a low degree.



The second earlier mark 'MOON PRINCESS 100' and the application

47. Visually, the marks coincide insofar as they identically share the same word 'PRINCESS / Princess'. However, they differ in that the applicant's mark contains the additional word 'Starlight' and figurative device elements, which are not replicated in the opponent's mark; whereas the opponent's mark contains the additional word 'MOON' and the numeral '100'. As for the differences between the fonts and letter case used in the respective marks, I do not consider these to be points of significant difference, given that notional and fair use of word only marks allow them to be presented in any font or case.¹⁹ Furthermore, I keep in mind that the beginning of marks tend to have more visual impact than their endings being where consumers tend to focus. Accordingly, weighing up the similarities with the differences, keeping in mind that both trade marks contain the word 'PRINCESS / Princess', I find the competing marks to be visually similar to a low degree.

Aural comparison



The first earlier mark



and the application

48. Aurally, as both marks contain well-known English dictionary words ('Starlight Princess' / 'Moon Princess'), they will likely be pronounced in the ordinary way. Therefore, the shared word element 'Princess' will be pronounced identically. The additional word element 'Starlight' (pronounced 'Stahr-lite') in the applicant's mark, and the additional word element 'Moon' (pronounced 'moon') in the opponent's mark will act as points of aural difference. The device components in the respective marks

¹⁸ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

¹⁹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, GC

will not be articulated. Overall, I find the competing marks to be aurally similar to a medium degree.



The second earlier mark 'MOON PRINCESS 100' and the application

49. Aurally, the marks contain well-known dictionary words which will likely be given their ordinary English pronunciation. Therefore, the shared word element 'Princess' will be pronounced identically. The additional word element 'Starlight' (pronounced 'Stahr-lite') in the applicant's mark, and the additional word and numeral element 'Moon' (pronounced 'moon') and '100' (pronounced 'won hun-dred'), in the opponent's mark will act as points of aural difference. The device elements in the applicant's mark will not be articulated. Overall, I find the competing marks to be aurally similar to a low degree.

Conceptual comparison

50. 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] E.C.R.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

51. With regards to the conceptual comparison, in its written submissions in lieu,²⁰ the opponent states the following:

“Conceptually, the marks are similar to a high degree as a result of the common element PRINCESS, and the words MOON and STARLIGHT being semantically related.

As demonstrated in the witness statement of Beverley Robinson, both the words MOON and STARLIGHT essentially refer to a celestial object or form of light in the sky. The word MOON is, of course, immediately understood to be the large round object that circles the Earth and shines at night by reflecting

²⁰ Dated 2 August 2024 [paragraphs 16-18].

light from the sun, and the word STARLIGHT is immediately understood as referring to the light emitted by stars.

The combination of both MOON with PRINCESS and STARLIGHT with PRINCESS, immediately portrays a celestial mythical, fictitious, or imaginary princess. Consequently, the marks MOON PRINCESS and STARLIGHT PRINCESS are conceptually indistinguishable.”

52. In its written submissions in lieu,²¹ the applicant submits:

“Conceptually, the marks are also dissimilar. The Opponent's simplistic comparison of 'Starlight' and 'Moon' fails to capture the nuanced conceptual differences that arise when considering the marks as a whole.

The term 'Starlight' evokes notions of fantasy and the ethereal, potentially suggesting a sci-fi theme which is brought to life by the colourful feathers reminiscent of wings, while 'Moon' conveys a sense of nighttime and tranquillity also brought to life by the darker colours. These distinct themes influence the consumer's perception of the games' narratives or characters.

The inclusion of the number '100' in the Earlier Word Mark introduces an additional conceptual layer that is particularly resonant in the context of betting and gaming. Numbers are frequently employed in slot games to denote features such as the number of paylines, ways to win, or, notably, the number of free spins available - a significant and attractive feature for players. This numerical element adds a conceptual dimension that suggests a specific gaming feature, which is absent from the Mark.

The conceptual overlap implied by the shared term 'Princess' is substantially altered by the differing connotations of 'Starlight' and 'Moon', as well as by the presence of '100' in the Earlier Word Mark. The result is that each mark conveys a different narrative and gaming experience.”

²¹ Dated 2 August 2024 [paragraphs 4.13-4.16].

The opponent's earlier marks



and 'MOON PRINCESS 100' and the

application



53. Conceptually, the ordinary English dictionary word 'Princess' present in all the respective marks will be attributed the identical meaning, i.e. the female member of a royal family, usually the daughter of the king or queen. Accordingly, this element in the marks share the same concept. The fact that this word is stylised in the applicant's mark and the opponents first earlier mark does not detract from this concept.

54. Furthermore, consumers will likely attribute the ordinary meaning to the dictionary word 'Starlight' present in the applicant's mark, namely as the light that comes from the stars; and the ordinary dictionary meaning of the word 'Moon' in the opponent's marks, namely as a bright object in the night sky that moves around the earth. It is noted that the opponent is of the view that these elements are semantically related. However, I am of the view that they clearly have different independent meanings. Whilst there may be a tenuous link between the words, in that they have a celestial theme on the basis that they are both typically visible in the night sky, the word 'starlight' refers to the emission of light from a star (not the star itself), whereas 'moon' is not a reference to light emission, (as this would be 'moonlight'), but rather it refers to the object itself, that can often be seen at night as it moves through the sky, etc. Accordingly, as these words have different independent meanings with different concepts, I find that they are conceptually dissimilar.

55. The '100' element present in the second earlier mark will likely be understood by the average consumer as simply referring to the number 100. However, as mentioned by the applicant, I acknowledge that when used in relation to some of the goods and services at issue, namely those relating to betting and gaming, the '100' element may be perceived by some consumers as a reference to a specific gaming feature, for example, the number of paylines, ways to win, or the number of free spins available,

etc. Either way, as the '100' element is absent from the application, the second earlier mark 'MOON PRINCESS 100', contains an additional concept emanating from the number.

56. Accordingly, in combination, the applicant's mark will likely be perceived as meaning a princess associated with *starlight*; the first and second earlier marks will be regarded as meaning a princess associated with the *moon*. As for the '100' element present at the end of the second earlier mark, bearing in mind the goods and services at issue, I am of the view that this may be perceived as denoting a particular 'Moon Princess' model, version, series number, etc.

57. With regards to the device elements present in the applicant's mark, I am of the view that the fanned-out feathers will merely be seen as decoration, whereas the crown element reinforces the 'princess' (royal) concept. With regards the device elements present in the opponent's first earlier mark, I am of the view that the very small stars present in the mark will merely be perceived as decorative elements associated with the large moon device, which reinforces the 'moon' concept in the mark.

58. Given the nature of the goods and services, I am of the view that the average consumer will likely perceive the respective trade marks as alluding to the theme or storyline of the games at issue or, relating to particular characters within the game. Accordingly, given that each mark refers to a *princess*, these concepts overlap, however, the concepts differ as to the type of princess ('Starlight/Moon'). Furthermore, the '100' element present in the opponent's second earlier mark, creates an additional concept, as previously discussed. Therefore, on balance, I find the marks to be conceptually similar to a low degree.

Distinctive character of the earlier marks

59. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-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 originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

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

61. I note that the opponent has not pleaded that its marks have acquired enhanced distinctive character through use, nor have they provided evidence to support such a claim. I have, therefore, only the inherent position to consider.



The first earlier mark

62. The mark is a composite mark, comprising the words 'Moon Princess' along with figurative device elements. Individually, the word 'Princess' and 'Moon' will likely be attributed their ordinary dictionary meaning, i.e. *princess* - the female member of a royal family, usually the daughter of the king or queen; *moon* - a bright object in the night sky that moves around the earth. Perceived individually, the words are ordinary dictionary words with no connection to the goods and services at issue. In terms of the mark, I am of the view that the word 'Princess' does not have distinctive significance independently of the 'Moon' given that 'Moon' qualifies 'Princess'.²² Accordingly, in my view, the distinctiveness of the mark lies in the words 'Moon' and 'Princess' in combination, and therefore to an extent they form a unit. However, I acknowledge that this combination of words is slightly strange on the basis that the word 'Moon' would not ordinarily be used to describe or qualify the word 'Princess'. When combined, whilst the words 'Moon Princess' are not clearly descriptive, they may be perceived as alluding to a fictional character or the theme/subject matter of the products on offer (where those products relate to a 'princess' theme). Accordingly, taking into account the added figurative elements, as a whole, I find that the mark is inherently distinctive to a medium degree.

The second earlier mark - 'MOON PRINCESS 100'

63. This mark comprises the word elements 'MOON' and 'PRINCESS' and a numerical element '100'. As stated above, the word 'Princess' and 'Moon' will likely be attributed their ordinary dictionary meanings, however these words, whether taken individually or combined, have no obvious connection to the goods and services at issue. Likewise, in terms of the numerical element, I am of the view that this neither describes or alludes to the goods and services at issue. However, when perceived as a whole, in combination with the respective goods and services, i.e. MOON PRINCESS 100', the combination may allude to a fictional character or the theme/subject matter of the

²² *Medion v Thomson* Case C-120/04 [2005] ECR I-8551

products on offer, (where those products relate to a princess theme). As for the '100' element, bearing in mind the goods and services at issue, I am of the view that this may be perceived as denoting a particular 'Moon Princess' model, version or series number, for example. Accordingly, taking the mark as a whole, I find it to be inherently distinctive to a medium degree.

Likelihood of confusion

64. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services, and the nature of the purchasing process. In doing so, I must be mindful to the fact 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 that they have retained in their mind.

65. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

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

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

later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

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

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

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

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

67. Earlier in the decision I found that:

- The first earlier mark and the applicant's mark are visually and conceptually similar to a low degree and aurally similar to a medium degree;
- The second earlier mark and the applicant's mark are visually, aurally and conceptually similar to a low degree;

- I have found the parties' goods and services to range between identical and similar to a medium degree;
- The earlier marks have a medium degree of inherent distinctive character for the goods and services at issue;
- The average consumer for the goods and services will be members of the public (be that members of the public at large or those over the age of 18 for gambling related goods and services) and professional users, who will select the goods and services primarily by visual means, although I do not discount an aural component. The average consumer will generally pay a medium degree of attention, but this may be higher depending on the goods and services at issue and where professional users are concerned.



68. Whilst I note that the marks identically share the word 'Princess', I bear in mind that the marks begin with different words ('Moon/Starlight'), and that the beginning of marks tend to have more visual and aural impact than the ends,²³ though I accept that this is not always the case. Additionally, the opponent's mark contains figurative moon and star elements, not replicated in the applicant's mark, and the applicant's mark contains figurative feather and crown elements, not replicated in the opponent's mark. Accordingly, taking all of the above factors into account and the principle of imperfect recollection, I consider that the visual, aural and conceptual differences between the marks are sufficient to ensure that they will not be misremembered or mistakenly recalled as each other. Therefore, I do not consider there to be a likelihood of direct confusion. I say this even when factoring in that the goods and services are identical and similar to a medium degree.

²³ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.



The second earlier mark 'MOON PRINCESS 100' and the application

69. Whilst the marks identically share the word 'Princess', they begin with different words ('Moon/Starlight') and as previously stated, I bear in mind that as a general rule, the beginning of marks have more impact. Furthermore, the application contains figurative elements not replicated in the opponent's mark, and the opponent's mark contains the number '100' at the end of the mark, not replicated in the application. Accordingly, I do not believe that the stated differences will go unnoticed by the relevant consumer. Consequently, despite the identity/similarity between the goods and services, consumers are unlikely to mistake or imperfectly recall one mark for the other. Therefore, there is no likelihood of direct confusion.

70. Moving on to indirect confusion, for this to arise the average consumer must consider that as a result of the common element, there is an economic connection between the respective marks, such that the goods and services provided under one, is regarded as a brand extension or sub brand of the other, for example.

71. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. (as he then was) as the Appointed Person pointed out, 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.”

72. However, it has to be put forward that a shared common element alone, does not necessarily lead to a likelihood of confusion.²⁴ It is important for me to bear in mind the other elements within the respective marks and the part they play, whilst also recalling the level of distinctiveness of the earlier marks when considered as a whole along with the distinctiveness of the common element.

73. I bear in mind that the examples previously given under paragraphs 17(a) to 17(c) of *L.A. Sugar* are not exhaustive but simply offer helpful guidance as to examples where one may find indirect confusion. Further, on the point of indirect confusion, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

74. Lord Justice Arnold stated in *Liverpool Gin* that “trade mark law was about consumers' unwitting assumptions, not what they could find out if they thought to check.” It is necessary therefore for me to bear this in mind when undertaking the assessment and considering whether the common element ‘PRINCESS’ when viewed within the application is sufficiently powerful when weighed against the differences, that despite these differences the opponent’s marks gives rise to a belief that the two entities are connected, leading to a likelihood of confusion.²⁵

75. Further, I also note in *Duebros Limited v Heirler Cenovis GmbH*,²⁶ Mr James Mellor QC (as he then was), sitting as the Appointed Person, stressed that the finding of

²⁴ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

²⁵ James Mellor as the appointed person on appeal in *Ashish Sutaria v Cheeky Italian Limited* O/219/16

²⁶ BL O/547/17

confusion should not be made merely because two marks share a common element, if a mark merely calls to mind another mark this is insufficient.

76. In their written submissions in lieu, the applicant argues that the opponent does not have a monopoly in the word 'PRINCESS' as the word is commonly used in the market. Further, they add that the average consumer in the gaming sector is accustomed to differentiating between games from various providers that include 'Princess' in their titles, on the basis that these marks are distinguishable due to their different preceding words or distinctive visual elements.

77. In their written submissions in lieu, the opponent argues that even if not directly confused by the marks themselves, it is highly conceivable that consumers would legitimately believe that the applicant's mark is a new line of goods or services provided by the opponent, on the basis that it is common practice in the gaming industry for developers to launch sequels to existing games, commonly launched under variations of an original name, in order to allow consumers to connect and link the subsequent goods and services to the original game. As such, the opponent submits that the relevant consumer will perceive the applicant's mark as a sub-brand or variation of their marks to denote a sequel of its 'MOON PRINCESS' game, if not directly confused between the marks themselves.

78. When assessing whether as a result of the common word 'PRINCESS', consumers will be confused between the respective marks, I remind myself that the opponent has not filed any evidence demonstrating that it has a reputation solely in the word 'PRINCESS', or that the average consumer of the goods and services at issue would consider that any mark including the word 'PRINCESS' will be from the same or economically linked undertaking. Moreover, there is no evidence to suggest that consumers have learned to associate the word 'PRINCESS' as designating the goods and services from one particular source, i.e. the opponent.²⁷

79. As previously discussed, I am of the view that the distinctiveness of the earlier marks lies in the combination of the word elements 'Moon Princess/MOON PRINCESS

²⁷ Il Pont Finanziaria C-2354/06 at 61-64

100'. As such, given that the beginning of the applicant's mark is different ('Starlight Princess') and the evidence filed by the applicant shows that a number of entities use the word 'PRINCESS' to refer to a character or theme of a game, I do not believe that the average consumer would consider that the one mark is a sub brand or brand extension of the other. I am of the view that the word 'PRINCESS' is not so strikingly distinctive of the opponent that the use of this word in combination with a totally different word would lead consumers to consider that it is a brand extension or linked to the opponent. Furthermore, the differing figurative elements in the applicant's mark and the opponent's first earlier mark cannot be overlooked.

80. Bearing in mind my assessment of the overall impression and the role each element plays within the marks as wholes, when coming across the respective marks, I find that the average consumer will not consider that the same provider is responsible for the goods and services at issue.

81. Accordingly, in order to find indirect confusion in this case, it would be necessary to conclude that the average consumer will see in 'Moon Princess / MOON PRINCESS 100' and 'Starlight Princess' respectively, an element common between the marks, leading them to conclude that the presence of 'PRINCESS' in the context of the contested mark means that it is a brand of the owner of the earlier marks. However, keeping in mind the similarities between the marks, I also recognise that there are considerable differences.

82. Accordingly, even for identical goods, I can see no reason why the average consumer would believe that the marks at issue originate from the same or economically linked undertakings. As such, I do not consider there to be a likelihood of indirect confusion. The word 'PRINCESS' is not so distinctive that consumers would assume only one undertaking would use it in their mark, neither is the word 'STARLIGHT' in the applicant's mark non-distinctive or logical for a brand extension. Accordingly, I have found no proper basis for a finding of indirect confusion. The average consumer would simply put the presence of the common element 'PRINCESS' in the marks down to coincidence rather than economic connection.

OUTCOME

83. The opposition under Section 5(2)(b) of the Act has failed in its entirety. Subject to any successful appeal, the application may proceed to registration.

COSTS

84. As the applicant has been successful it is entitled to an award of costs in its favour on a contributory basis. Award of costs in proceedings are based upon the scale as set out in Tribunal Practice Note (TPN) 1/2023. Applying this guidance, I award costs to the applicant on the following basis:

Considering the notice of opposition and preparing a defence and counterstatement	£200
Considering the opponent's submissions and written submissions in lieu of a hearing	£300
Preparing evidence	£200
Preparing written submissions in lieu of a hearing	£200
Total	£900

85. I order Play'n GO Marks Ltd to pay Tamaris (Gibraltar) Limited the sum of £900 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against the decision is unsuccessful.

Dated this 10th day of April 2025

**Sam Congreve
For the Registrar**