

BLO/0414/25

CONSOLIDATED PROCEEDINGS UNDER THE TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3604863  
IN THE NAME OF WAI LEONG WONG TO REGISTER THE TRADE MARK

## **GT OMEGA RACING**

IN CLASS 20  
AND THE OPPOSITION THERETO UNDER NO 425925  
BY SONY INTERACTIVE ENTERTAINMENT EUROPE LIMITED

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AND IN THE MATTER OF APPLICATION NO. 3690941  
IN THE NAME OF WAI LEONG WONG TO REGISTER THE TRADE MARK

## **GTSEAT**

IN CLASS 20  
AND THE OPPOSITION THERETO UNDER NO 431777  
BY SONY INTERACTIVE ENTERTAINMENT EUROPE LIMITED

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AND IN THE MATTER OF APPLICATION NO. 3724728  
IN THE NAME OF WAI LEONG WONG TO REGISTER THE TRADE MARK



IN CLASSES 9, 20 AND 28  
AND THE OPPOSITION THERETO UNDER NO 432815  
BY SONY INTERACTIVE ENTERTAINMENT EUROPE LIMITED

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AND IN THE MATTER OF APPLICATION NO. 3788952  
IN THE NAME OF WAI LEONG WONG TO REGISTER THE TRADE MARK

**GTGAMER**

IN CLASSES 9, 20 AND 28  
AND THE OPPOSITION THERETO UNDER NO 436065  
BY SONY INTERACTIVE ENTERTAINMENT EUROPE LIMITED

## BACKGROUND AND PLEADINGS

1. Wai Leong Wong (“the applicant”) has applied to register four trade marks that have been opposed by Sony Interactive Entertainment Europe Limited (“the opponent”). The applied for marks, their filing dates and the goods that have been opposed are as follows:

Mark applied for:	Filing date:	Goods opposed:
<u>3604863</u> <b>GT OMEGA RACING</b>	4 March 2021	<u>Class 20</u> Furniture; office furniture; office chairs; electronic equipment stands and mounts [furniture]; computer equipment stands [furniture]; tables; chairs; cushions; metallic and non-metallic furniture including garden furniture and office furniture; pillows; head rests [furniture]; neck, head and lumbar supporting pillows and cushions.
<u>3690941</u> <b>GTSEAT</b>	6 September 2021	<u>Class 20</u> Furniture; office furniture; office chairs; electronic equipment stands, frames and mounts [furniture]; computer equipment stands, frames and mounts [furniture]; computer and electronic gaming equipment stands, frames and mounts [furniture]; chairs; seats; seating furniture; gaming chairs [furniture]; seating apparatus; tables; cushions; metallic and non-metallic furniture including garden furniture and office furniture; pillows; head rests [furniture]; neck, head and lumbar supporting pillows and cushions.
<u>3724728</u> 	23 November 2021	<u>Class 9</u> Stands, frames, mounts and mounting brackets adapted for use with computer equipment, namely, computer monitor stands and computer speaker stands; stands, frames, mounts and

		<p>mounting brackets adapted for television monitors and computer monitors.</p> <p><u>Class 20</u> Furniture; office furniture; office chairs; electronic equipment stands, frames and mounts [furniture]; computer equipment stands, frames and mounts [furniture]; computer and electronic gaming equipment stands, frames and mounts [furniture]; chairs; seats; seating furniture; tables; cushions; metallic and non-metallic furniture including garden furniture and office furniture; pillows; head rests [furniture]; neck, head and lumbar supporting pillows and cushions.</p> <p><u>Class 28</u> Games console parts, fittings and accessories; apparatus for games adapted for use with television receivers; parts, fittings and accessories specially adapted for playing video games; parts, fittings and accessories specially adapted for video game controllers, for racing or steering wheel shaped controllers, for accelerator and brake controllers and pedals, for gaming headsets, for gaming mice and for gear shifting controllers; gaming chairs [furniture].</p>
<p><u>3788952</u> <b>GTGAMER</b></p>	<p>17 May 2022</p>	<p><u>Class 9</u> Stands, frames, mounts and mounting brackets adapted for use with computer equipment, namely, computer monitor stands and computer speaker stands; stands, frames, mounts and mounting brackets adapted for television monitors and computer monitors.</p> <p><u>Class 20</u></p>

		<p>Furniture; office furniture; office chairs; electronic equipment stands, frames and mounts [furniture]; computer equipment stands, frames and mounts [furniture]; computer and electronic gaming equipment stands, frames and mounts [furniture]; chairs; seats; seating furniture; tables; cushions; metallic and non-metallic furniture including garden furniture and office furniture; pillows; head rests [furniture]; neck, head and lumbar supporting pillows and cushions.</p> <p><u>Class 28</u></p> <p>Games console parts, fittings and accessories; apparatus for games adapted for use with television receivers; parts, fittings and accessories specially adapted for playing video games; parts, fittings and accessories specially adapted for video game controllers, for racing or steering wheel shaped controllers, for accelerator and brake controllers and pedals, for gaming headsets, for gaming mice and for gear shifting controllers; gaming chairs [furniture].</p>
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2. The opponent bases its case on sections 5(2)(b) and 5(3)<sup>1</sup> of the Trade Marks Act 1994 (“the Act”).

3. The marks and goods relied on by the opponent for the claims under sections 5(2)(b) and 5(3) are as follows:<sup>2</sup>

<p><b>First mark details:</b></p>
<p><b>UKTM:</b> 3499904</p>

<sup>1</sup> The 5(4)(a) ground was dropped in the opponent’s skeleton argument, see paragraph 7.

<sup>2</sup> The number of earlier marks relied on by the opponent was reduced in paragraph 8 of its skeleton argument. The number of goods relied on was also reduced at paragraph 9 of the same document.

# GT

**Filed:** 12 June 2020

**Registered:** 2 October 2020

**Goods relied on for 5(2)(b):**

**Class 9**

Computer game software; video games software; interactive entertainment software; computer software for video games or for games machines; video games; discs, CD-ROMs, DVDs and other magnetic, electronic or optical media, all bearing interactive games software and computer game software; video games racing simulators.

**Goods relied on for 5(3):**

**Class 9**

Computer game software; video games software; video games; CD-ROMs, DVDs, all bearing interactive games software and computer game software; video games racing simulators.

**Class 41**

Organising and hosting virtual-to-reality competitions.

**Second mark details:**

**UKTM:** 917944264



**Filed:** 16 August 2018

**Registered:** 22 December 2018

**Goods relied on for 5(2)(b):**

**Class 9**

Computer game software; video games software; interactive entertainment software; downloadable electronic publications; sound and video recordings featuring music, entertainment and games; cinematographic films; discs, tapes, cartridges, CD-ROMs, DVDs and other magnetic, electronic or optical media, all bearing computer games software and/or video games software; films; software applications; website applications; downloadable application software; downloadable audio and video recordings and media; controllers and peripherals for computer games and computer and video games consoles; wearable activity trackers; sensors for scientific use to be worn by a human to gather human biometric data; wearable digital electronic devices to allow players to record, collect, collate, analyse, review and transmit data related to in game performance; gaming headsets for use in playing video games; virtual reality software; virtual reality games software; virtual reality headsets; virtual reality games controllers; bags and cases adapted for the aforementioned goods; all the aforesaid goods being for or in relation to computer games and video games for racing.

**Goods relied on for 5(3):**

**Class 9**

Computer game software; video games software; CD-ROMS, DVDs, all bearing computer games software and/or video games software; controllers and peripherals for computer games and computer and video games consoles; all the aforesaid goods being for or in relation to computer games and video games for racing.

**Third mark details:**

UKTM: 917944265



**Filed:** 16 August 2018

**Registered:** 22 December 2018

**Goods relied on for 5(2)(b):**

**Class 28**

Toys, games, playthings; handheld electronic games; video games consoles; video game machines; racing steering wheels, pedals and gear sticks for use in relation to video games; video games racing simulators; racing seats for use in relation to video games; controllers for game consoles, video game peripherals for storing, relaying, tracking, measuring and displaying biometric data and body movement of players.

**Goods relied on for 5(3):**

**Class 28**

Video games consoles; video game machines; racing steering wheels, pedals and gear sticks for use in relation to video games; video games racing simulators; racing seats for use in relation to video games; controllers for game consoles.

**Fourth mark details:**

UKTM: 3499920



**Filed:** 12 June 2020

**Registered:** 2 October 2020

**Goods relied on for 5(2)(b):**

**Class 9**

Computer game software; video games software; interactive entertainment software; computer software for video games or for games machines; video games; downloadable electronic publications; sound and video recordings featuring music, entertainment and games; cinematographic films; discs, tapes, cartridges, CD-ROMS, DVDs and other magnetic, electronic or optical media, all bearing computer games, software and/or audio visual content; films; software applications; website applications; electronic game software for mobile phones; application development tool programs for personal and handheld computers; downloadable application software; downloadable audio and video recordings and media; computer hardware; video games racing simulators; bags and cases adapted for the aforementioned goods.

**Class 28**

Toys, games, playthings; handheld electronic games; video games consoles; video game machines; racing steering wheels, pedals and gear sticks for use in relation to video games; racing seats for use in relation to video games; controllers for game consoles; peripherals for computer games and computer and video game consoles being video game apparatus, keyboards specially adapted for playing video games, gaming mice and gaming headsets specially adapted for playing video games; gaming headsets for use in playing video games.

**Goods relied on for 5(3):**

**Class 9**

Computer game software; video games software; computer software for video games or for games machines; video games; CD-OMs, DVDs, all bearing computer games, software and/or audio visual content; video games racing simulators.

**Class 28**

Video games consoles; video game machines; racing steering wheels, pedals and gear sticks for use in relation to video games; racing seats for use in relation to video games; controllers for game consoles; peripherals for computer games and computer and video game consoles being video game apparatus.

**Class 41**

Organising and hosting virtual-to-reality competitions.

**Fifth mark details:**

**UKTM:** 3499916

# GT SPORT

**Filed:** 12 June 2020

**Registered:** 18 September 2020

**Goods relied on for 5(2)(b):****Class 9**

Computer game software; video games software; interactive entertainment software; computer software for video games or for games machines; video games; downloadable electronic publications; sound and video recordings featuring music, entertainment and games; cinematographic films; discs, tapes, cartridges, CD-

ROMs, DVDs and other magnetic, electronic or optical media, all bearing computer games, software and/or audio visual content; films; software applications; website applications; electronic game software for mobile phones; application development tool programs for personal and handheld computers; downloadable application software; downloadable audio and video recordings and media; computer hardware; video games racing simulators; bags and cases adapted for the aforementioned goods.

### **Class 28**

Toys, games, playthings; handheld electronic games; video games consoles; video game machines; racing steering wheels, pedals and gear sticks for use in relation to video games; racing seats for use in relation to video games; controllers for game consoles; peripherals for computer games and computer and video game consoles being video game apparatus, keyboards specially adapted for playing video games, gaming mice and gaming headsets specially adapted for playing video games; gaming headsets for use in playing video games.

### **The opponent's case under the section 5(2)(b) ground**

4. Section 5(2)(b) of the Act prevents registration of a mark that is similar to the opponent's earlier marks, for goods and/or services that are the same or similar to those of the opponent, such that there will be a likelihood of confusion.

5. In its statement of grounds the opponent submits:

*"24. In light of the similarities between the Later Mark and the Earlier Marks, and, the identity, strong similarity and complementary nature of the Later Goods with the Opponent's Goods and Services, there exists a likelihood of confusion on the part of the public. The likelihood of confusion includes the likelihood of association with the Opponent's Earlier Marks."*

6. In addition, the opponent relies on a family of GT marks, it submits:

*“25. As set out above, the Opponent has a Family of GT Marks and it will be shown in evidence that the Applicant is applying his sign to goods that are directly aimed at the Opponent's consumers. It will be shown in evidence that these goods are being sold on the premise that they are specifically compatible with the Opponent's Goods and Services. Consumers would therefore be led to believe that the Later Mark is a member of the GT Family and that the Later Goods have been sold with the Opponent's approval.”*

### **The opponent's case under the section 5(3) ground**

7. The 5(3) ground of opposition requires the opponent to show its earlier mark(s) have a reputation in the UK such that the registration of the contested mark(s), without due cause, would allow them to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the opponent's earlier trade mark(s).

8. The opponent submits that its GT family of marks has a strong reputation in the UK, due to extensive use for more than two decades and its *'significant commercial success'*. It further claims that its evidence shows it has a business in merchandising, which makes use of the opponent's *'considerable reputation'* in its GT family of marks.

9. It claims the later marks are highly similar to the earlier marks, which, coupled with the opponent's strong reputation would result in use of the later marks bringing the opponent's GT family of marks to mind.

10. With regard to damage, the opponent submits:

*“31. Use of the Later Mark for the Opposed Goods will take unfair advantage of the distinctive character and repute of the Earlier Marks by attempting to ride on their coat-tails in order to benefit from its power of attraction, reputation and prestige, and to exploit, without being required to make efforts of its own in that regard, the marketing effort expended by the Opponent in order to create and maintain the image of its GT Family...”*

11. With regard to dilution, the opponent submits:

*“32. Use of the Later Mark for the Later Goods will also dilute the distinctive character of the Earlier Marks and weaken their ability to identify the goods and services of the Opponent. Therefore, use of the Later Mark will be detrimental to the distinctive character of the Earlier Marks in the GT Family.”*

12. The opponent also claims that use of the contested marks would result in “detriment to the repute of the Earlier Marks in the GT Family”. This is because:

*“33...[The] Opponent's goods are of a high quality and benefit from significant marketing and quality control by the Opponent. If the Applicant's goods are not of a similar quality they will taint the reputation of the Earlier Marks and render these less attractive to consumers, thereby changing their economic behaviour as they will choose not to purchase the Opponent's goods and services. In this regard, it is not necessary to show consumers' actual change in behaviour: a serious risk that it will change suffices. Therefore, use of the Later Mark will be detrimental to the reputation of the Earlier Marks.”*

13. The applicant filed a counterstatement in which it denied all the grounds of opposition. No other material was filed by the applicant.

14. The opponent filed evidence and a skeleton argument. A hearing took place before me at which the opponent was represented by Tony Pluckrose of Boulton Wade Tennant LLP. The applicant did not attend.

15. I make this decision having taken full account of all the papers before me and the submissions made at the hearing.

16. Although the United Kingdom (UK) has left the European Union (EU), section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition

period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

### **The opponent's evidence**

17. The opponent's five earlier marks are not subject to proof of use because none of them had been registered for five years at the application date of each of the four contested applications.<sup>3</sup>

18. The opponent's evidence relates to its claim to a family of GT marks and its claim to enhanced distinctive character under section 5(2)(b) of the Act and its claim to reputation for the purposes of the section 5(3) ground of opposition.

19. The evidence is provided in a witness statement by Hogarth Andall, dated 24 February 2022. Mr Andall is the senior director of intellectual property and technology for Sony Interactive Entertainment Europe Limited (the opponent).

20. I take the following from Mr Andall's evidence:

#### Company background

21. The opponent is a member of the Sony Interactive Entertainment group of companies and is responsible for the sale, marketing and distribution of the PlayStation family of products in Europe, including the UK.

22. The opponent is a multinational video game and digital entertainment company and has been operational since 1997.

23. The PlayStation series of game consoles was launched in 1995. There have also been handheld units, namely the PlayStation Portable system and the PlayStation Vita system.

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<sup>3</sup> See section 6A of the Act.

24. The Gran Turismo (GT) game was created in 1997 by Polyphony Digital,<sup>4</sup> a development studio wholly owned by Sony Interactive Entertainment Inc (based in Tokyo) and part of the SIE World Wide Studios group. It is designed to be a realistic driving simulator, offering realistic driving physics.

25. The original game has given rise to a series of GT games that has had seven primary releases, I include the Worldwide sales and UK release dates for each of the products, shown in the table below, as they appear in the evidence:<sup>5</sup>

<b>Game</b>	<b>Release date (UK)</b>	<b>Platform</b>	<b>Worldwide sales</b>
Gran Turismo	8 May 1998	PlayStation	10.85m
Gran Turismo 2	28 January 2000	PlayStation	9.37m
Gran Turismo 3: A-Spec	20 July 2001	PlayStation 2, PlayStation 3	14.89m
Gran Turismo Concept	17 July 2002	PlayStation 2	1.56m
Gran Turismo 4 Prologue	4 December 2003	PlayStation 2	1.4m
Gran Turismo 4	9 March 2005	PlayStation 2, PlayStation 3, PSP	11.6m
Gran Turismo 4 Online	1 June 2006	PlayStation 2	
Gran Turismo HD Concept	23 March 2007	PlayStation 3	
Gran Turismo 5 Prologue	28 March 2008	PlayStation 3	5.35m
Gran Turismo	1 October 2009	PSP	3.86m
Gran Turismo 5	24 November 2010	PlayStation 3	Approx 12m
Gran Turismo 6 and Gran Turismo	6 December 2013	PlayStation 3	4.71m

<sup>4</sup> Kazunori Yamanashi is credited as the designer.

<sup>5</sup> See paragraphs 14 – 17 of Mr Andall's statement.

6 Anniversary Edition			
Gran Turismo Sport	18 October 2017	PlayStation 4	
Gran Turismo 7	Due March 2022	PlayStation 5	

26. Worldwide game rankings are provided from GameRankings and Metacritic. Mr Andall submits that both review sites aggregate reviews of other parties.<sup>6</sup>

Game	GameRankings	Metacritic
<a href="#">Gran Turismo</a>	94.95%	96
<a href="#">Gran Turismo 2</a>	92.42%	93
<a href="#">Gran Turismo 3: A-Spec</a>	94.54%	95
<a href="#">Gran Turismo Concept: 2001 Tokyo</a>	77.00%	–
<a href="#">Gran Turismo Concept: 2002 Tokyo-Geneva</a>	75.71%	–
<a href="#">Gran Turismo 4 Prologue</a>	68.83%	–
<a href="#">Gran Turismo 4</a>	89.53%	89
<a href="#">Gran Turismo HD Concept</a>	85.00%	82
<a href="#">Gran Turismo 5 Prologue</a>	79.79%	80
<a href="#">Gran Turismo (2009 video game)</a>	74.63%	74
<a href="#">Gran Turismo 5</a>	84.33%	84
<a href="#">Gran Turismo 6</a>	81.73%	81
<a href="#">Gran Turismo Sport</a>	74.96%	75

27. Worldwide sales of games within the GT franchise have exceeded 80 million since the launch in 1997.

28. Sales of hard copies of the GT games are provided<sup>7</sup> from 2011-2016:<sup>8</sup>

Year	Sales in Europe	Sales in the UK
2011	1,008,849	184,167
2012	1,667,046	243,264
2013	2,486,234	292,212
2014	139,419	62,544

<sup>6</sup> See paragraph 34 of Mr Andall's statement and exhibit 5.1.

<sup>7</sup> See paragraph 19 of Mr Andall's statement.

<sup>8</sup> Sales data for 2016 are incomplete.

2015	237,818	11,078
2016 (incomplete)	51,093	816

29. In addition to these hard copy sales, Mr Andall states it is possible to download the complete game as well as special content related to the game, namely music, trailers, videos and add-on content such as virtual automobiles or tracks. These downloads are made from the consumer's online platform PlayStation Network. Some of the downloads are free and some are paid for.

30. Mr Andall provides total figures for the UK that include both hard copies of the GT game and downloads of the GT games. See the table below:<sup>9</sup>

<b>UK sales of GT games (hard copy and online downloads)</b>	
<b>Year</b>	<b>Total</b>
2016	1,679
2017	525,826
2018	71,439
2019	32,968
2020	57,767
2021	21,960

31. Mr Andall has provided a breakdown of the games sold for each of these years. For the years 2017 to 2021, Gran Turismo Sport makes up by far the largest proportion of sales. The evidence shows that the Gran Turismo games retail at approximately £40-£50.

32. A GT Sport app is also made available by the opponent. It was released in May 2018 as a companion to Gran Turismo Sport and enables the user to monitor their activity on the game and that of their friends. Mr Andall states that iOS and Android downloads of the app in Europe have exceeded 70,000.<sup>10</sup> The app image seen on the

<sup>9</sup> Data for 2016 is incomplete.

<sup>10</sup> See paragraph 60 of Mr Andall's witness statement.

Play and iOS stores is the stylised GT mark in white on a red background. A press release concerning its launch includes the following:<sup>11</sup>

*“...The official ‘Gran Turismo Companion’ app has been released, allowing all our players to enjoy the ‘GT Sport’ community features on the go.”*

33. The App Store description reads:<sup>12</sup>

*“The official Gran Turismo Sport Companion keeps you connected to your GT Sport experience wherever you go...”*

### Peripherals and merchandising

34. Mr Andall states:

*“23. In addition to the game itself and the downloadable add-ons as detailed below, there is a range of authorised, licensed merchandise and peripherals bearing the GT mark. There are also special editions which are not authorised or licensed products but are first party products. By ‘peripherals’ I mean products directly used with the console as part of the gaming experience while playing and by “merchandise” I mean products which are not used for game play but are purchased by the consumers because of their loyalty and attraction to the GT mark.”*

35. A list of authorised game peripherals launched in the UK is provided.<sup>13</sup> It shows the following:<sup>14</sup>

- GT PlayStation, Portable Special Edition – launched October 2009 (the GT logo with the words Gran Turismo below can be seen on the top and side of the box).

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<sup>11</sup> See annex 8.1 to Mr Andall’s witness statement.

<sup>12</sup> See annex 8.2 to Mr Andall’s witness statement.

<sup>13</sup> See annex 3.1 to Mr Andall’s witness statement.

<sup>14</sup> Some of the links to the goods are from French and Italian versions of Amazon. However, Mr Andall has provided launch dates for the UK.



- GT 5 Signature Edition - includes a GT keyring, a GT 4Go USB key, a GT leather purse, a GT metallic box, a GT miniature car and a GT pilot book – launched 24 November 2010. It appears as follows:



- Logitech Driving Force GT Steering Wheel – launched 15 May 2013 (the stylised GT logo can be seen in the centre of the steering wheel).



- Thrustmaster T500 RS Force Wheel with feedback (PS3/PC) – launched 6 December 2013 (the stylised GT logo with the words Gran Turismo 6 can be seen on the box. The GT logo is shown in the centre of the steering wheel).



- Thrustmaster T300RS GT Edition – launched 18 November 2016 (the stylised GT logo with the words Gran Turismo can be seen on the box) the product is shown as follows (the stylised GT logo can be seen in the centre of the steering wheel):



- Thrustmaster T-GT PS4 and PC – launched 1 January 2017 (the stylised GT logo can be seen in the centre of the steering wheel):



- GT Sport PS4 Console Limited Edition, including sticker packs and a GT Controller – launched 18 October 2017 (the stylised GT logo can be seen in the centre of the console and at the top of the controller):



- Play Seat Gran Turismo (PS4, PS3, Xbox 360, Xbox One, PC DVD) – launched 18 October 2017 in the UK (on sale in Europe from 2013) (the stylised GT logo can be seen on the back of the seat):



- Sport Collector's Edition - includes a Gold SteelBook, an APEX book and a GT miniature car – launched 18 October 2017 (the stylised GT logo with the words GRAN TURISMO underneath can be seen of the box on the left):



- Controller GT Sport Edition – launched 18 October 2017 (the stylised GT logo can be seen in the centre at the top of the controller):



36. Mr Andall states that the Logitech driving wheel sold 160,000 units in Europe between 2008 and 2014. Thrustmaster still sell three licensed products in the UK, T-GT II wheel, T-GT II pack and T300RS GT Edition. He confirms that all licensed products have the GT logo displayed in the centre of the wheel.<sup>15</sup>

## Marketing

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<sup>15</sup> See paragraphs 25 and 26 of Mr Andall's witness statement.

37. With regard to marketing spend, Mr Andall states:

*“29. I confirm that the marketing spend has been extensive. The highest marketing spend has occurred in the years when a new title in the GT series was launched: hence, in the year ending 2014 when GT6 was launched, the combined marketing spend for the territories Belgium, Germany, Austria, Spain, France, Ireland, Italy, Poland, and the United Kingdom was in excess of EUR 8 million. For the same territories in the year ending June 2012, the combined spend was in excess of EUR 1.1 (one point one) million. In each and every year from the financial year ending mid-2012 to the one ending mid-2016, the combined marketing spend for these territories has been at least EUR 100K (one hundred thousand Euros).”*

38. An internal marketing document is provided, dated 29 May 2013 and titled ‘GT and GT6 in Social Media’.<sup>16</sup> The Gran Turismo 6 launch was announced on 15 May 2013. By 29 May the launch had received 6471 mentions on social media, two thirds of those on Twitter. Mr Andall states that the announcement was made in 20 countries with more than 50 media outlets attending the announcement event.<sup>17</sup>

39. The following is an example of the UK press release for Gran Turismo 6:<sup>18</sup>



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<sup>16</sup> Annex 4.3.4

<sup>17</sup> Paragraph 31(d) of his witness statement.

<sup>18</sup> See annex 4.3.5 to Mr Andall’s witness statement.

40. Mr Andall states that the stylised GT mark has been used on hard copies of the games, since at least 2020. The following examples are taken from the evidence:<sup>19</sup>



41. As well as the stylised logo, several game covers refer to the game by the letters GT, for example:

- Gran Turismo 4 back cover, “Memory Card 8MB for PlayStation 2 required to play GT mode.”
- Gran Turismo 5 - Prologue, back cover, “Up to 16 player races – compete online against other GT fans for the first time.”
- Gran Turismo 5, back cover, “Whoever you are, there’s always something at stake in GT.”

### Press coverage

42. Mr Andall provides examples of press coverage relating to the GT games:

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<sup>19</sup> Annex 4.2, examples taken from the covers of Gran Turismo 4, Gran Turismo 5 – Prologue, Gran Turismo 5 and Gran Turismo Sport.

- Observer – Madrid event coverage – “GT5 was not to be merely about the brute simplicities of gaming...”<sup>20</sup>
- Press association – Madrid launch and press pack responses – “...It speaks volumes of the game’s realism that, as well as gaming experts, car journalists were also present to sample the GT5’s ultra-realistic simulation experience.”<sup>21</sup>
- EVO – Madrid launch – “Whether you are after pure escapism or obsessive realism, GT5 is an epic you should really experience for yourself...”

43. Articles from the UK press include the following:<sup>22</sup>

- Auto Car, “Gran Turismo 5: it’s game on, the creator of the iconic racing game explains why we’ve had to wait so long for GT5 to arrive,” 1 December 2010

*“Launched in 1997, the original Gran Turismo featured 178 cars and 11 circuits and went on to sell 10.85 million copies. The fourth iteration arrived as long ago as 2005, but it was to be another 2000 days until GT5 was ready to launch.”*

- From the same article:

*“McLaren gave Yamauchi’s team access to the MP4-12C well ahead of its official launch and Mercedes has invested heavily to ensure the SLS AMG features on the front cover.”*

- Guardian online: “Gran Turismo 5 – review, Years in the making, GT5 gives petrolheads the truest taste yet of a racing driver’s experience behind the wheel,” 1 December 2010

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<sup>20</sup> Annex 4.3.1

<sup>21</sup> As above at 14

<sup>22</sup> Annex 4.3.2

- Press Association, “World’s Best-Selling Driving Game on Sale Again,” 25 November 2010

*“...Previous editions have sold in excess of 56 million copies worldwide, and GT5 is set to add further millions with huge amounts of interest ahead of the on-sale date. GT5 uses the full processing power of the PS3 to deliver stunning graphics – even in 3D when hooked up to a 3D-ready television – and its renowned realistic driving experience...GT5 also offers a choice of 70 circuits such as the world-famous Nurburgring and Le Sarthe tracks, as well as off-road rally stages and the option to create your own custom tracks. The on-line playing experience has been enhanced too, with the capability to now race against 15 other drivers from around the world...”*

*GT5 is on sale now with the standard version priced at £39.99, a collector’s edition at £59.99 and an elite Signature Edition at £149.99 from all good electronics retailers.”*

- PistonHeads, “Gran Turismo 5: The Launch – Cars and pixels merge at the GT5 launch in Madrid,” 25 November 2010
- Car Magazine UK, “Mr Gran Turismo speaks on the eve of GT5’s launch,” 21 October 2010.<sup>23</sup>
- Car Magazine UK, “Gran Turismo 6 confirmed for launch: full details here,” 16 May 2013.<sup>24</sup>

“Sony has announced that its latest racing simulator game, Gran Turismo 6, will go sale in this November with more cars, expandability and even more impressive realism than before. Gran Turismo, which

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<sup>23</sup> See annex 5.2

<sup>24</sup> See annex 5.3

launched in 1998, is the most successful Sony franchise with sales of more than 70 million games sold in its 15-year history.”

- TopGear.com, “Gran Turismo Sport review: collection’s out, racing’s in,” 18 October 2017.<sup>25</sup>

“Gaming: new GT emphasises heated multiplayer competition.”

- Daily Express, “GT Sport release REVEALED: Sony makes HUGE Gran Turismo announcement,” 21 April 2017.<sup>26</sup>

44. Mr Andall provides prints from the Guinness book of records that relate to the Gran Turismo games.<sup>27</sup> Some examples are:

- Best-selling PlayStation video game – sales of 10.95 million units make the original Gran Turismo (Sony, 1997) the highest selling game on PlayStation.
- Best-selling Gran Turismo videogame – as of March 2018, Gran Turismo 3 A-Spec, the 2001 title for PlayStation 2 had racked up 14.98 million sales.
- First racing videogame to win a ‘Game of the Year’ BAFTA – Gran Turismo 3: A Spec (PS2, 2001) was the first racing videogame to win a top gaming BAFTA.
- Longest running PlayStation franchise – Gran Turismo
- Most branded steering-wheel controllers for a videogame
- Fastest selling racing videogame for PlayStation 3 – Gran Turismo 5 Prologue became the fastest selling PlayStation 3 game in a single week following its release.

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<sup>25</sup> As above at 19

<sup>26</sup> As above at 19

<sup>27</sup> Annex 5.5

## GT Academy

45. Mr Andall also draws my attention to the Nissan PlayStation GT Academy, which he describes as follows:

*41. GT Academy is an international virtual-to-reality contest by Nissan and [the opponent], launched in 2008 and running continuously ever since. It allows the best GT game players to compete for the once-in-a-lifetime opportunity to become a real-life professional race car driver.*

*42. Any player who proves his or her skill in the virtual world has a chance to go wheel-to-wheel in a real race car on a real circuit to achieve the grand prize - a spot on the Nissan racing team, and all the training and licensing needed to race in international events.*

46. Players begin with virtual racing on PlayStation's GT racing game, and progress to National Finals before the winners of each region compete in Nissan cars at 'Race Camp'. Since 2008, Race Camp has been based at Silverstone Circuit, UK, where the title of GT Academy Winner is awarded to whoever demonstrates the greatest potential to make the switch from GT gamer to real racer.

47. Competition winners are rewarded with a place in Nissan's Driver Development Programme as well as entry into an international race or series with Nissan. GT Academy Winners who qualify to compete in the international race or series are also considered for a potential future racing career with Nissan as a Nissan Motorsport International Athlete.

48. Mr Andall submits that entry numbers for the academy have been enormous. As an example, in 2013, according to Nissan's data shown in Annex 6.0, there were over 756,000 entrants from the 18 participating EU countries. The UK had the highest number of entries with 148,984.

49. An article from TopGear.com, dated 20 May 2016, reads,

*“Gran Turismo Sport wants to turn everyone into a racing driver.*

*With the Nissan GT Academy program, the PlayStation-exclusive Gran Turismo series has been converting video game players into real life racers for the better part of a decade now.”*

## Vision GT

50. The Vision GT project is described by Mr Andall in the following terms:

*“55. The Vision GT project started with a single question from the game founder Kazunori Yamauchi to car companies: ‘Would you design your rendition of the ideal GT for us?’*

*56. Many car manufacturers agreed to take part, and now there are many ‘ideal’ cars represented in the game. Vision GT, which began as a project to celebrate the GT game’s 15th anniversary, continues to bring together the automotive passions of the gamer and the car companies. The cars have been introduced one at a time throughout the GT game series.”*

51. Mr Andall states that as well as game versions of the cars, real-life full-size models of the Vision GT cars have been built by the companies and shown at motor shows in Japan, Germany, England, the USA and Switzerland.

52. He concludes:

*“58. Again, this link between real world motor vehicle manufacturers, the virtual vehicles they design for use by players of the GT game, and the fact that some of those virtual vehicles have been transformed into real life models all mean that the awareness of the GT game goes far beyond those who own and play the GT game.”*

## **My conclusions from the evidence**

53. I accept, on judicial notice, that PlayStation is a successful video game console. The Gran Turismo games are its longest running and most successful game franchise, having begun in 1997. Its games are hotly anticipated by fans and press alike and have given rise to the 'most branded steering-wheel controllers for a videogame', as well as GT branded controllers, branded consoles, and so on. According to the Guinness book of records. Gran Turismo 3 was the first racing game to win a 'Game of the Year' BAFTA. Its reputation is such that Mercedes gave the game designers an advance preview of one of its cars and invested to ensure that one of its cars was on the front cover of the game. In addition to games and accessories, the opponent's GT goods have given rise to a real driving championship with Nissan (GT Academy) and racing car manufacturers designing and building their own take on the cars in the GT games (Vision GT), some of which have been unveiled at motor shows.

54. It is clear the opponent's GT marks have a considerable reputation and benefit from enhanced distinctive character through the use made of them.

55. I also accept that the opponent had a family of GT marks present on the UK market at the relevant dates. This family consisted of the stylised GT logo, the same mark with the words GRAN TURISMO below it, the GT solus mark and to a slightly lesser extent, the GT SPORT mark.

56. I will return to the effect of these findings in the relevant parts of this decision.

## **DECISION**

57. I will begin by assessing the opponent's case under section 5(2)(b).

58. 5(2)(b) of the Act reads:

"5. - (2) A trade mark shall not be registered if because -

(a)...

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

59. I bear in mind the following principles gleaned from the judgments 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 Office for Harmonisation in the Internal Markets (OHIM)*, Case C3/03, *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 the 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 greater 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 to mind the earlier mark, is not sufficient;

(j) The reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) If the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

60. I will start by making a prima facie assessment of the opposition case based on fair and notional use of its GT SPORT mark. This is because GT SPORT is a word mark with the broadest specification. If the opponent fails in relation to this mark, the others put it in no better position, being 'prima facie' less similar and/or having narrower specifications.

**The opponent's goods are:**

**Class 9**

Computer game software; video games software; interactive entertainment software; computer software for video games or for games machines; video games; downloadable electronic publications; sound and video recordings featuring music, entertainment and games; cinematographic films; discs, tapes, cartridges, CD-ROMs, DVDs and other magnetic, electronic or optical media, all bearing computer games, software and/or audio visual content; films; software applications; website applications; electronic game software for mobile phones; application development tool programs for personal and handheld computers; downloadable application software; downloadable audio and video recordings and media; computer hardware; video games racing simulators; bags and cases adapted for the aforementioned goods.

**Class 28**

Toys, games, playthings; handheld electronic games; video games consoles; video game machines; racing steering wheels, pedals and gear sticks for use in relation to video games; racing seats for use in relation to video games; controllers for game consoles; peripherals for computer games and computer and video game consoles being video game apparatus, keyboards specially adapted for playing video games, gaming mice and gaming headsets specially adapted for playing video games; gaming headsets for use in playing video games.

61. The applicant's goods are as follows:

<b>Applicant's goods ('863)</b>	<b>Applicant's goods ('941)</b>	<b>Applicant's goods ('728 and '952)</b>
		<b>Class 9</b>
		Stands, frames, mounts and mounting brackets adapted

		for use with computer equipment, namely, computer monitor stands and computer speaker stands; stands, frames, mounts and mounting brackets adapted for television monitors and computer monitors.
<b>Class 20</b>	<b>Class 20</b>	<b>Class 20</b>
Furniture; office furniture; office chairs; electronic equipment stands and mounts [furniture]; computer equipment stands [furniture]; tables; chairs; cushions; metallic and non-metallic furniture including garden furniture and office furniture; pillows; head rests [furniture]; neck, head and lumbar supporting pillows and cushions.	Furniture; office furniture; office chairs; electronic equipment stands, frames and mounts [furniture]; computer equipment stands, frames and mounts [furniture]; computer and electronic gaming equipment stands,-frames and mounts [furniture]; chairs; seats; seating furniture; gaming chairs [furniture]; seating apparatus; tables; cushions; metallic and non-metallic furniture including garden furniture and office furniture; pillows; head rests [furniture]; neck, head and lumbar supporting pillows and cushions.	Furniture; office furniture; office chairs; electronic equipment stands, frames and mounts [furniture]; computer equipment stands, frames and mounts [furniture]; computer and electronic gaming equipment stands, frames and mounts [furniture]; chairs; seats; seating furniture; tables; cushions; metallic and non-metallic furniture including garden furniture and office furniture; pillows; head rests [furniture]; neck, head and lumbar supporting pillows and cushions.
<b>Class 28</b>	<b>Class 28</b>	<b>Class 28</b>
		Games console parts, fittings and accessories; apparatus for games adapted for use with

		television receivers; parts, fittings and accessories specially adapted for playing video games; parts, fittings and accessories specially adapted for video game controllers, for racing or steering wheel shaped controllers, for accelerator and brake controllers and pedals, for gaming headsets, for gaming mice and for gear shifting controllers; gaming chairs [furniture].
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62. In comparing the goods, I bear in mind the decision in *Gérard Meric v OHIM*,<sup>28</sup> (Meric) in which the General Court stated that:

“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”.

63. Also, the decision in *Canon*, where the Court of Justice of the European Union (“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

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<sup>28</sup> Case T- 133/05.

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”.

64. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the Treat case),<sup>29</sup> where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

65. I bear in mind *Kurt Hesse v OHIM*,<sup>30</sup> in which the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*,<sup>31</sup> the General Court stated that ‘complementary’ means:

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<sup>29</sup> [1996] R.P.C. 281

<sup>30</sup> Case C-50/15 P

<sup>31</sup> Case T-325/06

“...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”.

66. And *Sanco SA v OHIM*,<sup>32</sup> in which the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public is liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*:<sup>33</sup>

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

67. I will group goods together for the purposes of assessment, where it is appropriate to do so,<sup>34</sup> and I bear in mind that the goods must be given their ordinary and natural meanings. In *YouView Ltd v Total Ltd*,<sup>35</sup> Floyd J stated:

“...Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the

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<sup>32</sup> Case T-249/11

<sup>33</sup> BL-0-255-13

<sup>34</sup> See *Separode Trade Mark*, BL O-399-10 (AP).

<sup>35</sup> [2012] EWHC 3158 (Ch) at [12].

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

68. The opponent has filed evidence specifically in respect of the goods comparison to show the way in video game-related goods are sold. This evidence is contained in two witness statements by Henry Schlaefli, a trade mark attorney at the opponent’s representative.<sup>36</sup> The first statement has eleven exhibits attached and the second statement has eight. The exhibits are dated a few months after the filing dates of the applications, though there is nothing to suggest that they do not represent the position at the time the contested applications were filed. The applicant has made no comment to indicate otherwise.

#### Class 9

69. The applicant has goods in class 9 for applications ‘728 and ‘952. The specifications for both marks are the same. They stand as follows:

*Stands, frames, mounts and mounting brackets adapted for use with computer equipment, namely, computer monitor stands and computer speaker stands*

*stands, frames, mounts and mounting brackets adapted for television monitors and computer monitors*

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<sup>36</sup> Witness statements are dated 1 April 2022 and 22 August 2022.

70. The opponent's specification in class 9 is primarily for software goods but also includes 'video games racing simulators'. Mr Schlaefli submits that screenshots from the applicant's own website show:<sup>37</sup>

*"...the Applicant offers the following categories of goods: furniture, including chairs and desks, cockpits for racing simulators, mounting frames for computer and video game peripherals and accessories, wheel stands, computer game accessories including controllers in the form of steering wheels, pedals and gear sticks and further accessories for their mounting and for the creation of a racing simulator."*

71. It is my understanding, supported by the opponent's evidence, that a video game racing simulator creates an environment where a video game player can feel as though they are racing in a vehicle, usually a car. The simulator needs to include a stand, frame or platform to hold the game console and steering controller, somewhere for pedals and a seat for the player. The applicant's frames and mounts for computer equipment, shown in the opponent's evidence certainly can play a part in video game racing simulators and to that extent, the users, uses and nature of the goods may coincide. The evidence indicates that a consumer may buy elements of a simulator, such as the frames and mounts, a steering wheel, pedals and seat to use with a console, or they may purchase an entire ready-made system, with all of the elements, including the seat. The first two items shown in the exhibit are complete 'cockpits'. Consequently, I find these goods may share users, uses, trade channels and may be in competition. I find them similar to at least a medium degree.

## Class 20

72. The opponent points out that the term 'gaming chairs [furniture]' is classified in class 20 of the applicant's '941 mark and class 28 of the applicant's '728 mark.

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<sup>37</sup> See exhibit HS6 attached to the second witness statement of Mr Schlaefli.

73. In *Proctor & Gamble Company v Simon Grogan*,<sup>38</sup> Anna Carboni, sitting as the Appointed person, referred to *Caremix*<sup>39</sup> and, having considered the Regulation on Community trade marks, said:

“34. There is no similarly plain provision in the Act or the Directive. The Court of Appeal has held that, although the purpose of classifying goods and services is primarily administrative, that does not mean that the class numbers in an application have to be totally ignored in deciding, as a matter of construction, what is covered by the specification: *Altecnic Ltd's Trade Mark Application (CAREMIX)*. But neither the Court of Appeal, nor the ECJ, nor any other court or tribunal in the United Kingdom, has gone so far as to state that class numbers are determinative of the question of similarity of goods in the case of national trade marks. On the contrary, they are frequently ignored.”

74. In this case, it is clear to see how goods such as gaming chairs can be classified in class 20, which includes furniture goods or class 28, which includes gaming goods. In my view, nothing turns on this, a gaming chair is a gaming chair, wherever it is classified.

#### *Gaming chairs*

75. The applicant has ‘gaming chairs [furniture]’ (as I have outlined above, this term appears in classes 20 and 28 of its specifications), the opponent has ‘racing seats for use in relation to video games’ in class 28. These are clearly identical goods.

#### *Chairs; seats; seating furniture; seating apparatus*

76. These are all terms that can include gaming chairs and are identical in accordance with *Meric*.

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<sup>38</sup> BL O/176/08.

<sup>39</sup> *Altecnic Ltd's Trade Mark Application (CAREMIX)* [2002] R.P.C. 639

## *Office chairs*

77. At the hearing Mr Pluckrose submitted that gaming chairs are a subcategory of office chairs. I disagree. Both gaming chairs and office chairs are subcategories of chairs.

78. Mr Schlaefli provides evidence taken from the applicant's website showing 'gaming office chairs'<sup>40</sup> and an exhibit taken from GAME,<sup>41</sup> showing chairs for sale under the heading 'GAMING AND OFFICE CHAIRS'. The text below includes: "*GAME has the perfect gaming or office chair for you*". There is no separate category of office chairs in the exhibit. All of the similar chairs are displayed below the one heading shown above. In each case the chairs shown are swivel chairs with high backs. They are padded and have arm rests.

79. The applicant has 'office chairs'. These are typically comfortable, adjustable chairs with padding and may include arm rests and head rests. The nature of these chairs is similar to the opponent's gaming chairs in that they are also usually padded and comfortable as both types of chairs are designed for long periods of sitting. There may be an overlap in users and uses. The evidence shows that in some cases gaming and office chairs are provided in the same areas of online retail stores and are actually the same goods that can be used for either or both purposes. There are also websites and stores directed at gamers who will provide gaming chairs and there are retailers specialising in office chairs, though there may also be an overlap in general retail outlets, such as department stores, where the same chair could be used for gaming or office work, or the goods could be sold in close proximity. There is a degree of competition between the goods but they are not complementary. I find these goods similar to at least a medium degree.

*Cushions; pillows; head rests [furniture]; neck, head and lumbar supporting pillows and cushions*

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<sup>40</sup> See exhibit HGS1.

<sup>41</sup> Dated 26 November 2021.

80. Mr Pluckrose submits that these goods are ‘parts of gaming chairs [furniture]’ He concludes, *“Insofar, as these components are sold as parts or fitting[s] of gaming chairs and racing simulators, then consumers would expect them to be sold by the same manufacturer...”*.

81. These are goods that can be accessories, used with chairs to make the user more comfortable, or they may be offered as replacement parts. There may be an overlap in users, uses and trade channels between these goods of the applicant and the opponent’s gaming chairs. The nature of the goods is different, one being a seat and the others being padding and cushions that can be used with seats or alone. I do find the goods complementary in the way suggested by the opponent. This is because, it is clear from the evidence that racing chairs are padded and have a number of cushioned and supportive parts, which may be added to or replaced. The goods are not in competition. Overall, I find these goods similar to a low degree to medium degree.

*Computer and electronic gaming equipment stands, frames and mounts [furniture]*

82. For the reasons already outlined above, these goods are used to support electronic gaming equipment and can be used as part of the opponent’s ‘video games racing simulators’ in class 9 and its ‘racing seats for use in relation to video games’ in class 28. I find these goods complementary to the opponent’s goods and similar to at least a medium degree.

*Electronic equipment stands, frames and mounts [furniture]; computer equipment stands, frames and mounts [furniture]*

83. These goods are similar to those I have considered above, simply being the broader terms. To the extent that they include the gaming equipment stands, my finding is the same, namely that there is at least a medium degree of similarity between these goods.

## *Tables*

84. Mr Schlaefli provides evidence of tables being sold in a gaming context. This can be as bolt-on parts for racing seats<sup>42</sup> or as ‘gaming desks’ for use with a gaming chair, shown on BOX THE ONLINE TECHNOLOGY STORE, that has a heading ‘Gaming Furniture’, underneath which are pictures of two chairs and a table with the words, “*Game in comfort with our range of ergonomic Gaming Chairs and Desks*”.<sup>43</sup> The users and uses of the goods may overlap. The natures of the opponent’s racing seats and tables are different though they may coincide in trade channels and may be complementary in the sense they can be used together. They are not in competition. I find these goods similar to a low to medium degree.

## *Furniture; metallic and non-metallic furniture*

85. The terms ‘furniture’ at large and ‘metallic and non-metallic furniture’ will include gaming chairs [furniture] and are identical in accordance with Meric.

86. I note it is unusual to have a finding of identity where goods are in different classes but as I have outlined above, gaming chairs are classified in classes 20 and 28 in these proceedings and are the same goods.<sup>44</sup>

## *Office furniture*

87. This will include office chairs, which I have already found to be similar to the opponent’s goods to a medium degree.

## *Garden furniture*

88. This is different from the opponent’s ‘racing seats for use in relation to video games’ in nature, the applicant’s furniture being used outside to enjoy the garden and the opponent’s used indoors for playing video games. The goods are likely to be made

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<sup>42</sup> See exhibit HGS6.

<sup>43</sup> See exhibit HGS8.

<sup>44</sup> See also, Allan James in O/347/18 – Repronle.

from different materials and have different users. The trade channels are different, the goods are not in competition, nor are they complementary. I find these to be dissimilar goods.

## Class 28

### *Gaming chairs [furniture]*

89. The applicant's gaming chairs [furniture] is identical to the opponent's racing chairs for video games. If I am wrong in this assessment on the basis that gaming chairs includes racing chairs, then they are identical on the basis that the applicant's term is a broader term that includes racing chairs for video games and they are still identical goods in accordance with *Meric*.

### *Apparatus for games adapted for use with television receivers*

90. These are video game machines or consoles that attach to a television or similar. They are identical to the opponent's broad term 'video game consoles' and 'video game machines', being included within each.

### *Accessories for games consoles and accessories specially adapted for playing video games; parts and fittings specially adapted for playing video games*

91. This part of the applicant's specification will include all of the opponent's peripherals and accessory goods, such as steering wheels, keyboards, mice, pedals and so on. These are identical goods.

### *Parts and fittings for games consoles; parts, fittings and accessories specially adapted for video game controllers, racing or steering wheel shaped controllers, accelerator and brake controllers and pedals, gaming headsets, gaming mice and gear shifting controllers*

92. Parts and fittings for the opponent's goods will have the same users, being game players and use, being the playing of games. The natures will be slightly different, one

being the good itself and the other being the part or fitting for that good. The goods are not in competition but have a strong complementary relationship, meaning that the consumer would expect them to be provided by the same undertaking. These goods are highly similar.

93. I have made the following findings regarding the similarity between competing goods:

**Identical**

Class 20

*Gaming chairs; Chairs; seats; seating furniture; seating apparatus; Furniture; metallic and non-metallic furniture.*

Class 28

*Gaming chairs [furniture]; apparatus for games adapted for use with television receivers; accessories for games consoles and accessories specially adapted for playing video games; parts and fittings specially adapted for playing video games.*

**Highly similar**

Class 28

*Parts and fittings for games consoles; parts, fittings and accessories specially adapted for video game controllers, racing or steering wheel shaped controllers, accelerator and brake controllers and pedals, gaming headsets, gaming mice and gear shifting controllers.*

**Similar to at least a medium degree**

Class 9

*Stands, frames, mounts and mounting brackets adapted for use with computer equipment, namely, computer monitor stands and computer speaker stands stands, frames, mounts and mounting brackets adapted for television monitors and computer monitors.*

**Class 20**

*Office chairs; office furniture; Computer and electronic gaming equipment stands, frames and mounts [furniture]; Electronic equipment stands, frames and mounts [furniture]; computer equipment stands, frames and mounts [furniture].*

**Low to medium degree of similarity**

**Class 20**

*Cushions; pillows; head rests [furniture]; neck, head and lumbar supporting pillows and cushions; tables.*

**Dissimilar**

**Class 20**

*Garden furniture.*

94. In *eSure Insurance Limited v Direct Line Insurance Plc*,<sup>45</sup> Lady Justice Arden stated that:

“49... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion

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<sup>45</sup> [2008] EWCA Civ 842 CA

has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

95. Therefore, the oppositions under 5(2)(b) to all of the applications fails with respect to garden furniture in class 20, as there is no similarity between these goods and those of the opponent.

### **Average consumer**

96. 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”.


97. The opponent submits that the average consumer is someone who plays computer games. I disagree. The average consumer of the goods will be members of the general public for the most part, though goods such as office furniture could also be bought by businesses. The goods will vary greatly in price. Furniture goods in particular cover a very wide range of prices. The goods are likely to be sold in physical stores as well as online. The selection of the goods is primarily visual, although I do not discount that aural considerations may be relevant where word-of-mouth recommendations play a part. Furniture goods such as office furniture and chairs may require aesthetic consideration as well as account being taken of size, suitability and so on. Purchasers of video games and related goods will need to consider compatibility, technology and so on. Consequently, the level of attention to be paid will vary but will be at least medium.

## Comparison of marks

98. I note that the opponent compares only the stylised GT marks to the contested applications as it concludes that the evidence shows those marks will be seen as GT marks by its customers. I will return to the matter of reputation and families of marks later in this decision, but for now it is sufficient to note that reputation is not to be taken into account when assessing the similarity between marks. In *Ravensburger AG v OHIM*,<sup>46</sup> the General Court (GC) held that:

“27. It is appropriate at the outset to reject that complaint as unfounded. The reputation of an earlier mark or its particular distinctive character must be taken into consideration for the purposes of assessing the likelihood of confusion, and not for the purposes of assessing the similarity of the marks in question, which is an assessment made prior to that of the likelihood of confusion (see, to that effect, judgment of 27 November 2007 in Case T-434/05 *Gateway v OHIM – Fujitsu Siemens Computers (ACTIVY Media Gateway)*, not published in the ECR, paragraphs 50 and 51).”

99. As already outlined, I intend to compare the opponent’s GT SPORT mark to the contested applications:

Opponent’s mark	Applicant’s marks
<b>GT SPORT</b>	GT OMEGA RACING GTSEAT  GTGAMER

100. In comparing the parties’ marks the opponent relies on a case decided in this tribunal under O/1052/22, in which the hearing officer compared GTPLAYER and

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<sup>46</sup> Case T-243/08

GTCHAIR. Whilst there are some similarities between the marks at issue, in that they contain the GT element at the beginning, the rest of the marks differ from the ones before me here. I will, as I must, make the necessary comparisons based on the marks before me.

#### Overall impression of the earlier GT SPORT mark

101. The opponent's mark is a plain word mark in block capitals. For some of the goods, namely those that concern racing games and racing accessories, the SPORT part of the mark has a descriptive meaning and plays a lesser role in the overall impression of the mark. GT may give the average consumer a message relating to cars, in particular, sporty cars, or it may be seen as an acronym with no clear meaning. It is the first element in the mark and plays the slightly larger role in the overall impression.

#### GT SPORT v GT OMEGA RACING

102. The applicant's GT OMEGA RACING mark is also presented in plain block capital letters. I note the opponent compares its earlier marks to the applicant's mark as it appears on the applicant's website. This is not the correct approach as the mark used on the website is stylised and differs from the mark applied for. I will consider the plain text version of the mark, GT OMEGA RACING, which is the one opposed in this case.

103. If the average consumer gives GT a meaning, it will be as above, a message relating to cars, in particular, sporty cars. If not, then it will be a two-letter acronym. RACING will, for goods relating to racing games, have a lesser role to play in the overall impression of the mark, as it is descriptive for those goods. Though RACING is perfectly distinctive for, for example, office furniture. With regard to OMEGA, the opponent submits:

*"28. OMEGA is often used to denote a new variant of a product, as with other Greek letters - "this is my OMEGA variant of my produce, the ultimate variant of the product".*

104. There is no evidence of this use of the word OMEGA and it is not, as far as I am aware, common use of the word. Taking account of the whole mark, I find the GT OMEGA part of the applied for mark to play the slightly larger role in the overall impression of the mark.

105. Visually, the marks share the first two letter element, GT. The rest of the marks differ, being the word SPORT in the earlier mark and OMEGA RACING in the application. Overall, I find the marks visually similar to a low to medium degree.

106. Aurally, the marks coincide in the first two syllables, GEE TEE. The rest of the marks differ, being a single syllable, SPORT in the earlier mark and an additional five syllables, O-ME-GA RA-CING in the application. They are aurally similar to a low to medium degree.

107. Conceptually, the high point of similarity occurs where the average consumer sees GT as having a meaning that relates to cars. This, when coupled with the SPORT and OMEGA RACING elements of the competing marks, would give the average consumer a motorsport-flavoured message. In these circumstances, the marks are conceptually similar to a fairly high degree. Where the average consumer does not see GT as having a particular meaning, the message it conveys will be the same in both marks. There is also still a shared SPORT/RACING message, which gives rise to a low to medium degree of conceptual similarity overall.

#### GT SPORT v GTSEAT and GTGAMER

108. The marks GTSEAT and GTGAMER are both plain word applications in block capitals. There is no space between GT and the word element in each of those marks, but the average consumer will identify the marks as being made up of two elements. GT and SEAT and GT and GAMER.

109. SEAT is descriptive for chairs and furniture goods and will play a lesser role in the overall impression of the mark, which is dominated by the GT part.

110. For computer/video games and related goods GAMER is descriptive and it is the GT part that plays the greater role in the overall impression of this mark.

111. In both marks there will be goods for which the SEAT and GAMER parts of the marks applied for are more distinctive. However, in both cases, it is the GT part of each mark that plays the larger role in the overall impression of the marks, being placed at the beginning.

112. Visually and aurally the earlier mark and the applied for marks share the first element, GT. They differ in their second elements, being SPORT in the earlier mark and SEAT and GAMER in the applied for marks. I find the earlier mark to be visually and aurally similar to the applied for marks to a medium degree.

113. Conceptually, the high point of similarity exists where the average consumer gives GT a meaning that relates to cars, there will be a shared concept between the competing trademarks. In the context of goods that relate to video games, the endings of the three marks do nothing to point away from the concept of car-related games and accessories and I find the conceptual similarity to be at least a medium level.

GT SPORT v 

114. The applicant's stylised mark is the letters GT inside a device that looks like wings. The stylised element will not be ignored and plays a role in the mark as a whole, but it is the letters GT that play the greater role in the overall impression of the mark, being the part that will be articulated.

115. Visually, the marks coincide in the GT part of the marks. They differ in the addition of SPORT to the earlier mark and a wing-type device around the GT part. I find these marks visually similar to a medium degree.

116. Aurally, the earlier mark will be pronounced GEE-TEE SPORT. The application will be pronounced GEE-TEE. The figurative part will not be articulated by the average consumer. I find these marks aurally similar to medium to high degree.

117. Conceptually, the marks coincide in the GT element, which will be the same for both marks. Where the consumer sees GT relating to cars, the conceptual similarity is fairly high.

118. In *Lloyd Schuhfabrik Meyer*, 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 Alternberger* [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).”

119. Registered trade marks possess varying degrees of inherent distinctive character. Marks that are suggestive of, or allude to, a characteristic of the goods or services would sit at the lower end of a spectrum of distinctiveness, while those marks that are invented words with no allusive qualities would sit towards the top.

120. The earlier trade mark ‘GT SPORT’ would be recognised by the average consumer as relating to sport. In the context of the opponent’s goods that are computer

games, racing seats, and game peripherals such as steering wheels and pedals, the GT element is likely to be seen as referring to car related games, being racing games. Accordingly, the inherent distinctiveness of the mark is lower than medium.

121. The opponent has filed evidence to support its claim to reputation and claims to have enhanced the distinctive character of its marks through the use made of them. It is clear from the evidence that the GT SPORT mark has been used as a title for one of the opponent's games and is the title of the app that allows players to keep track of their progress in the game and that of their friends. The figures for hard copy and download sales for the period 2017–2021 are heavily dominated by the SPORT version of the opponent's GT series of games. Accordingly, I find the opponent has enhanced the distinctive character of this mark resulting in medium distinctiveness overall.

### **Likelihood of confusion**

122. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services or vice versa. I 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 they have in their mind.

123. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*,<sup>47</sup> Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

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

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<sup>47</sup> BL O/375/10

confusion, on the other hand, only arises where the consumer has actually recognised 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.’”

124. Taking account of the levels of similarity between the opponent’s earlier mark and the contested applications, I find the differences between them sufficient to avoid direct confusion, including through imperfect recollection.

125. There is also the possibility of indirect confusion or ‘association’ as it is described in section 5(2)(b) of the Act. The opponent claims that its GT, GT SPORT, stylised GT logo and Gran Turismo logo marks are a ‘family’ of marks and it is this submission that represents the opponent’s strongest case. I will consider indirect confusion based on the opponent’s family of marks.

126. *Il Ponte Finanziaria SpA v OHIM (“Bainbridge”)*,<sup>48</sup> is the leading case on this point and this case makes clear that marks that are to be considered part of the ‘family’ must be present on the market.<sup>49</sup>

127. I am satisfied that each of the earlier marks was, at the relevant date, present on the market for the suite of racing games offered by *Playstation* known as Gran Turismo, or GT. One of the marks is GT solus, which is used by third parties and the opponent. A good example of the opponent’s use is a press release for the video game Gran Turismo 6 that featured the outline of a racing car with the letters (and number) GT6, with no stylisation.

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<sup>48</sup> case C-234/06 P, EU:C:2007:514

<sup>49</sup> See paragraph 64.



128. The GT SPORT mark is used for several iterations of the game (dominating the hard copy and download sales from 2017–2021) and is the title of the app launched in 2018.



129. The stylised marks are used for games, advertising and feature on special edition consoles, controllers and third-party peripherals (licenced by the opponent), for example steering wheels.

130. The stylised mark with the words GRAN TURISMO below the letters is used for games, advertising and packaging, in particular.

131. The considerable use of these marks made by the opponent since the launch of the first game in 1997, will have created in the mind of the relevant public the belief that these marks are a family of marks indicating a common origin, that being the Gran Turismo franchise of games and associated accessories and events. This use has also resulted in the average consumer having been educated to see the stylised GT marks as representing the letters GT.

132. Based on the evidence before me, the opponent can rely on the following family of marks:

Trade mark	Goods present on the UK market
UKTM: 3499904  	Class 9: Computer game software; video games software; video games; CD-ROMs, DVDs, all bearing interactive games software and computer game software; video games racing simulators.
UKTM:917944264  	Class 9: Computer game software; video games software; CD-ROMS, DVDs, all bearing computer games software and/or video games software; controllers and peripherals for computer games and computer and video games consoles.

<p>UKTM: 917944265</p> 	<p>Class 28: Video games consoles; video game machines; racing steering wheels, pedals and gear sticks for use in relation to video games; video games racing simulators; racing seats for use in relation to video games; controllers for game consoles.</p>
<p>UKTM: 3499920</p> 	<p>Class 9: Computer game software; video games software; computer software for video games or for games machines; video games; CD-OMs, DVDs, all bearing computer games software and/or video games software; video games racing simulators.</p> <p>Class 28: Video games consoles; video game machines; racing steering wheels, pedals and gear sticks for use in relation to video games; racing seats for use in relation to video games; controllers for game consoles; peripherals for computer games and computer and video game consoles being video game apparatus.</p> <p>Class 41: Organising and hosting virtual-to-reality competitions.</p>
<p>UKTM: <b>GT SPORT</b></p>	<p>Class 9: Computer game software; video games software; interactive entertainment software; computer software for video games or for games machines; video games; CD-ROMs, DVDs and other magnetic, electronic or optical media, all bearing computer games software applications; website applications; electronic game software for mobile phones; downloadable application software.</p>

	<p>Class 28: Video games consoles; video game machines; racing steering wheels, pedals and gear sticks for use in relation to video games; racing seats for use in relation to video games; controllers for game consoles; peripherals for computer games and computer and video game consoles being video game apparatus.</p>
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133. Also, in *Il Ponte Finanziaria SpA*, the CJEU stated:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.”

134. I take this to mean that if there is a likelihood of the contested mark being seen by the average consumer as a member of the opponent’s ‘family’ of marks, there will be indirect confusion, because consumers will realise there is a difference between

the marks but because of the shared family trait will believe the marks are used by the same undertaking.

135. The opponent's case is that the 'common characteristic' of its family of marks is GT. I agree. Each of the applied for marks include a GT element.

136. The applicant's GT OMEGA RACING mark begins with the common GT element shared by the opponent's family of marks. The strength of the opponent's family of marks is such that in my view the average consumer will simply see this mark as another from the opponent that relates to its GT franchise of racing games and related goods. The presence of OMEGA, which is distinctive and not contained in the earlier marks, does not alter this conclusion. It will be seen as denoting a different range from the same origin.

137. In the case of GTSEAT I find this mark will be seen as referring to a seat used to play the opponent's GT franchise of games. There is clearly indirect confusion as the average consumer, already familiar with the range of peripherals offered by the opponent, would simply think this was another in the range from the opponent.

138. The applied for mark GTGAMER will be seen by the average consumer as relating to someone who plays the opponent's GT franchise of games. When this mark is applied to any goods that have a degree of similarity to those of the opponent, there will be indirect confusion because the consumer will believe the goods originate from the opponent or a linked undertaking.



139. The applicant's stylised mark consists of the letters GT surrounded by a circular device with what look to be wings either side. The GT element of this mark is sufficient to connect it to the opponent's family of GT marks, with the average consumer likely to believe it originates from the same stable as the opponent's family of marks.

140. In conclusion, I found all of the applicant's goods to have a degree of similarity with the opponent's goods, ranging from low to identical. Taking all factors into account

and in the context of the opponent's family of marks, I find there will be a likelihood of indirect confusion with all of the applicant's marks.

141. If I am found to be wrong in my assessment of the opponent's claim to a family of GT marks, I would, in any case, have found indirect confusion for each of the marks applied for when compared to the opponent's earlier GT SPORT mark. This is because the shared GT element is the primary contributor to the distinctiveness of the applicant's marks and the opponent's GT SPORT mark and the average consumer would simply see the applicant's goods sold under its marks as goods originating from the opponent.

**142. The opposition succeeds under 5(2)(b), except for garden furniture.**

### **The opponent's case under section 5(3)**

143. Section 5(3) of the Act reads:

"5 (3) A trade mark which-

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark".

144. The applicant has not accepted the opponent's claim to have a reputation for any goods and, in its counterstatement, requested proof of the same.

145. The opponent claims a significant reputation in the UK in what it refers to as its 'family of GT marks'.

146. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure*

[2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L’Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation; *Marks and Spencer v Interflora, paragraph 74 and the court’s answer to question 1 in L’Oreal v Bellure*.

147. In *General Motors*,<sup>50</sup> the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

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<sup>50</sup> Case C-375/97.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

148. The conditions of section 5(3) are cumulative. First, the application must be similar to the earlier marks. Secondly, the opponent must satisfy me that its earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must establish that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark(s) being brought to mind by the later mark. Fourthly, assuming that the other conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar although the relative distance between them is one of the factors that must be assessed in deciding whether the public will make a link between the marks.

## **Reputation**

149. As stated above, I accept on judicial notice that PlayStation is a successful video game console.

150. Unusually, the opponent has not provided turnover figures. However, it has clearly sold a large number of Gran Turismo games and it is clear from the evidence that the games retail at £40–50. This represents a significant volume of sales and that finding is further supported by entries in the Guinness book of records showing that

the Gran Turismo games are PlayStation's longest running franchise. Those entries also show that Gran Turismo has been the most successful PlayStation game, with Gran Turismo 3 being the first videogame to win a 'Game of the Year' BAFTA.

151. The opponent licenses the GT marks for use on special edition consoles, controllers, steering wheels and so on.

152. In addition to the games and accessories, the GT franchise, (as it's referred to by the opponent, third parties and press), has given rise to real-world driving events, has garnered attention from the car and autosport markets and has resulted in some manufacturers paying undisclosed sums to ensure their cars are on the front covers of the game packaging. Some car manufacturers have also invested large sums of money in designing and building their take on a GT car and then exhibiting those cars at motoring trade shows.

153. The considerable use of these marks made by the opponent since the launch of the first game in 1997, for example on the game packaging, in advertising and in press coverage and product launches, will have created in the mind of the relevant public the belief that the five marks relied on by the opponent in these proceedings are a family of marks, indicating a common origin, that being the Gran Turismo franchise of games and associated accessories and events.

154. Having considered all of the evidence presented to me, I find that the earlier marks have a strong reputation in the UK for, at least, video/computer games, consoles, peripherals, including controllers, steering wheels and pedals.

## **Link**

155. In addition to the earlier marks having a reputation, a link must be made between the mark applied for and the earlier marks. In *Intel Corporation Inc v CPM (UK) Ltd*<sup>51</sup> ("*Intel*") the CJEU provided guidance on the factors to consider when assessing whether a link has been established. It stated:

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<sup>51</sup> C-252-07.

“41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...”

156. Those factors include:

The degree of similarity between the conflicting marks

157. In *Intra-Press SAS v OHIM*,<sup>52</sup> the CJEU stated that:

“72...The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

158. In other words, the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion.

159. I have already found that the earlier marks relied on by the opponent constitute a family of GT marks. I have also identified above that the applied for marks all contain

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<sup>52</sup> Joined cases C-581/13P & C-582/13P.

a GT element, which was sufficient under the 5(2)(b) ground to give rise to a finding of indirect confusion.

The strength of the earlier mark's reputation

160. For the reasons I have already given, the opponent's marks had a strong reputation at the relevant date.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

161. The earlier marks are inherently distinctive to varying degrees. GT and GT SPORT are a little lower than medium. The stylised marks are inherently distinctive to a fairly high degree. However, the opponent has enhanced the distinctiveness of the family of GT marks to the very highest degree by the use made of the marks since 1997, such that the opponent's GT marks are very highly distinctive of the opponent.

The nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

162. For the purposes of detriment and/or unfair advantage under section 5(3) of the Act it is not a requirement that there must be identity or similarity between the respective goods, however, the issue remains relevant to the overall analysis.

163. My findings regarding the similarity between the parties' respective goods are contained in the table at paragraphs 93 of this decision. In short, apart from garden furniture for which the section 5(2)(b) oppositions have failed, I have found similarity ranging from a low to medium degree to identical, for all of the goods applied for.

164. In support of its view that there will be a link made between the parties' goods, the opponent has filed examples of the applicant's use, which includes use of the opponent's marks alongside the applicant's marks.

- The first example is an Amazon UK listing by the applicant for its ‘GT Omega Steering Wheel Stand’. The steering wheel shown in the centre of the stand is the opponent’s product with the stylised GT logo in the centre.<sup>53</sup>
- The second example is a post from the applicant’s Instagram page ‘GT Omega WHEEL STANDS BACK IN STOCK’. It was ‘liked’ on 7 May 2020. It shows two racing set-ups with pedals, gear sticks and steering wheels on stands. The steering wheel in the first image is the opponent’s goods with the stylised GT mark in its centre.<sup>54</sup>
- The third and fourth examples are taken from the applicant’s website, www.gtomega.co.uk. The pages are products provided by the applicant. The ‘CLASSIC WHEEL STAND’ and the ‘APEX Steering Wheels Stand’ include the opponent’s steering wheel with the stylised GT mark in the centre.<sup>55</sup>

#### The existence of the likelihood of confusion on the part of the public

165. I have already found there to be a likelihood of indirect confusion between the opponent’s GT family of marks and the contested applications, except for garden furniture.

#### **Conclusion**

166. Taking all of the competing factors into account, I find that the opponent’s reputation for its family of GT marks is such that when the applicant’s marks are encountered, even for goods at the lower end of similarity, the opponent’s GT marks will be brought to mind. In other words, the relevant public will make a link between the opponent’s family of marks and the application, except in the case of the applicant’s garden furniture.

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<sup>53</sup> See exhibit HS2, dated x, attached to Mr Schlaefli’s first statement.

<sup>54</sup> See HS3, dated x, attached to Mr Schlaefli’s first statement.

<sup>55</sup> See HGS3 and HSG4, dated 18 August 2022, attached to Mr Schlaefli’s second statement.

167. Whilst I am in no doubt about this conclusion, my finding is reinforced by the fact that the applicant clearly uses the opponent's mark to advertise its own goods, strengthening the already inevitable link that would be made between them.

## **Damage**

168. The opponent claims under the three heads of damage available to it under section 5(3) of the Act, those being unfair advantage, dilution and detriment to repute of the earlier marks. I will deal first with unfair advantage.

169. In *L'Oréal*,<sup>56</sup> the CJEU said:

“The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image.”

170. The opponent submits that the applicant's marks ride on the coat tails of the opponent's GT family of marks reducing the need for the applicant to market its own goods.<sup>57</sup>

171. It is fairly unusual in cases before this tribunal that there is evidence of the intended use of marks applied for when one comes to make an assessment regarding the likelihood of damage. However, in this case, the opponent has provided evidence of the way in which the applicant uses its marks, and it clearly shows use alongside the opponent's GT marks. It also shows use of the applicant's applied for marks alongside the opponent's PlayStation marks, though these are not marks relied on in

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<sup>56</sup> *L'Oréal SA & Ors v Bellure & Ors* - Case C-487/07, paragraph 50.

<sup>57</sup> See the opponent's statement of grounds.

this case.<sup>58</sup> In any case, it is clear from the decision of Arnold J. (as he then was) in *Jack Wills v House of Fraser (Stores) Limited*,<sup>59</sup> that the claim to unfair advantage does not require proof of subjective intention on the part of the applicant. Paragraph 80 of that decision reads:

“The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

172. In effect, the opponent's complaint is that the applicant is unfairly exploiting its marketing efforts and investment and is free-riding upon the coat tails of the opponent's considerable reputation in its GT family of marks. I agree. The success of the earlier marks and their standing amongst users of computer/video games will make it easier for the attraction of the earlier marks to be projected on to the applicant's marks. I find that *prima facie* there is a risk, which is not hypothetical, that use of the contested mark will make it easier for the applicant to offer its goods to a section of the relevant public (with the exception of garden furniture). In addition, it is clear from the evidence that the applicant uses the opponent's marks alongside its

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<sup>58</sup> See exhibits HS4, HGS1 and HGS2

<sup>59</sup> [2014] EWHC 110 (Ch)

own, in order to sell its goods to the relevant public. I find that unfair advantage is made out.

173. As I have found for the opponent under the first head of damage, I do not consider it necessary to go on to consider the remaining heads of damage pleaded.

### **Due cause**

174. Having found the 5(3) ground to have succeeded, the only defence left for the applicant is to show that it has due cause to use the mark applied for. In its counterstatement the applicant requested that the opponent show that use by the applicant of the marks applied for would be without due cause.<sup>60</sup>

175. It is for the applicant to prove its case, as is clear from *Leidseplain Beheer BV v Red Bull*<sup>61</sup> in which the CJEU held:

“44. Onus is on the third party using a sign similar to the mark with a reputation, to establish that he has due cause for using such a sign.”

176. The applicant has not engaged in these proceedings, beyond filing a defence and has made no mention of due cause beyond its request for the opponent prove it. I need consider this no further.

### **CONCLUSION**

**177. The opponent succeeds under sections 5(2)(b) and 5(3) for all of the goods in the contested applications, except garden furniture.**

**178. The applicant’s marks may proceed to registration for ‘garden furniture’ in class 20.**

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<sup>60</sup> See paragraph 3.

<sup>61</sup> C-65/12

## Costs

179. Sony Interactive Entertainment Europe Limited has been largely successful and is entitled to a contribution towards its costs. I award costs on the following basis, bearing in mind the applicant did not engage with these proceedings, beyond filing a defence and succeeded in respect of garden furniture:

Official Fee -	£200
Preparing a statement and considering the other side's statement -	£400
Filing evidence and considering the other side's evidence -	£800
Preparing for and attending a hearing -	£800
<b>Total</b>	<b>£2200</b>

180. I order Wai Leong Wong to pay Sony Interactive Entertainment Europe Limited the sum of £2200. 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 this decision is unsuccessful.

**Dated this 8<sup>th</sup> day of May 2024**

**Al Skilton**  
**For the Registrar,**  
**the Comptroller General**