o/0423/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATIONS TO PROTECT INTERNATIONAL REGISTRATION NOS. WO0000001727235 AND WO0000001727237 IN THE UNITED KINGDOM

SoftGamings

AND

SoftGamings
BUILD YOUR OWN CASINO

IN THE NAME OF BROMSTON ASSOCIATES LTD

AND

IN THE MATTER OF AN OPPOSITION THERETO UNDER NOS. 442578 AND 442595

BY SOFTGAMES - MOBILE ENTERTAINMENT SERVICES GMBH

BACKGROUND AND PLEADINGS

1. On 2 February 2023, BROMSTON ASSOCIATED LTD ("the holder") requested protection in the United Kingdom ("UK") of international trade mark registration 1727235 for "SoftGamings". On the same date, the holder requested protection in the UK for international trade mark registration 1727237 for the figurative mark shown on the cover page to this decision. The holder's '235 mark was published for opposition purposes on 21 July 2023 and its '237 mark on 4 August 2023.

2. On 18 August 2023, SOFTGAMES - Mobile Entertainment Services GmbH ("the opponent") filed a Notice of Opposition in respect of both applications. The opponent claims that the protection of the marks should be refused in the UK, in part, under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The goods and services which it opposes are set out below, with the same goods and services opposed in both proceedings:

Audiovisual apparatus and instruments; recorded and downloadable media, computer software; computers and computer peripheral devices (class 9)
Telecommunications services (class 38)
Entertainment (class 41)
Design and development of computer hardware and software (class 42)

3. For the purpose of both oppositions, the opponent relies upon the following mark and all goods and services for which it is registered, as set out below:

United Kingdom Trade Mark ("UKTM") 914370522

Softgames

Computer games programs; Programs (Computer -) [downloadable software]; Computer games for mobile phones (mobile games) (class 9)
Providing a computer game that may be accessed by users on a global network and/or the Internet; Providing interactive multiplayer computer games via the Internet and electronic communication networks; Internet games (non-downloadable); Electronic

game services provided by means of the internet; Provision of online computer games (class 41)
Computer programming of video and computer games (class 42)

Filing date: 16 July 2015

Registration date: 26 November 2015

4. The opponent claims that the high degree of similarity between the respective marks and the identity and/or similarity between the terms in the parties' specifications gives rise to a likelihood of confusion, which includes a likelihood of association.

5. The holder, in turn, denies that there exists a likelihood of confusion, highlighting in its counterstatements various differences between the parties' marks and the goods and services in which they trade.

6. On 13 November 2023, by way of official letter, the parties were notified of the oppositions' consolidation. The opponent is represented by MW Trade Marks Limited and the holder by Simon Mercouris. Throughout the course of the proceedings, the opponent filed written submissions, the holder filed submissions and evidence and the opponent filed submissions in reply. Neither party requested a hearing nor did they file submissions in lieu. This decision is taken following a careful perusal of the papers.

RELEVANCE OF EU LAW

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

EVIDENCE

8. The holder's evidence comprises a witness statement from Ms Christiana Georgiou, dated 13 March 2024, and four supporting exhibits CG1 – CG4. Ms Georgiou has been the holder's director since 2019. I take the following from her evidence:

> The holder has promoted its marks at various ICE exhibitions[1] in London seeking to reinforce its "position as a leading aggregator and platform provider in the casino solutions space."
>
> Ms Georgiou encloses photographs taken at the exhibition and press articles and screenshots of videos pertaining to the exhibition and some to the holder specifically. An online article in European Gaming, for example, is headed "SoftGamings to Present its Platform and Solutions at ICE London"[2].
>
> The holder displays exhibition-related content on its website, www.softgamings.com. It also utilizes LinkedIn to promote its SoftGamings products.

9. That concludes my summary of the evidence, insofar as I consider it necessary.

DECISION

Section 5(2)(b)

10 Section 5(2)(b) of the Act reads as follows:

> "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

[1] 5-7 February 2019, 4-6 February 2020, 12-14 April 2022, 7-9 February 2023 and 6-8 February 2024.
[2] It is difficult to make out the date in the exhibit but it appears to have been published in 2020.

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

11 Section 5A of the Act reads as follows:

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

12. The opponent's mark is a comparable mark[3] and clearly qualifies as an earlier trade mark pursuant to section 6 of the Act. Given that it had been registered for more than five years prior to the application date of the opposed marks, it is, in theory, subject to the proof of use provisions laid out in section 6A of the Act. However, in its counterstatement, the holder declined to request that the opponent provide proof of use.[4] As a consequence, the opponent may rely upon its mark and all goods and services it has identified without providing evidence of use.

Preliminary matters

Target audience

13. The holder relies upon a number of points in its defence which I intend to address briefly to explain why they are unlikely to have any bearing on the outcome of the present proceedings. Firstly, the holder makes the following submission regarding the parties' respective target audience:

"It is crucial to consider market segmentation and target audience within the relevant industry. Our analysis indicates that Softgames primarily operates within

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

[4] See question 7 of the Form TM8 filed in both oppositions

a specific segment of the gaming industry, while our platform caters to a different segment with distinct customer preferences and behavior.

…

The stark differentiation between our platform and Softgames' offerings becomes apparent when considering the nature of our respective target audiences. Our trademark applications cover goods and services that are tailored to the online casino industry, whereas Softgames operates within a distinct market segment with arcade games targeting a different audience, i.e., Softgames offerings may be designed to appeal to a broader consumer base seeking casual entertainment rather than catering to the specific needs of the online casino industry. This fundamental difference further supports the notion that the visual distinctions between our trademarks and those of Softgames are essential in preventing confusion among consumers in our specific market niche."

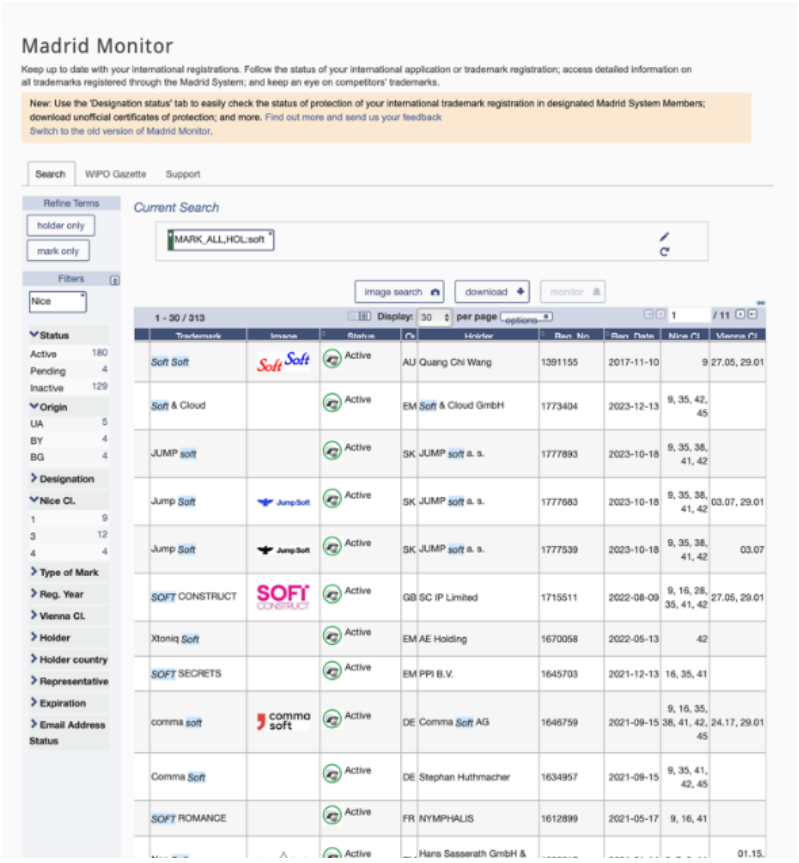
14. When assessing a likelihood of confusion, it is necessary to consider the potential for conflict between the applied for mark and the earlier trade mark in light of all relevant circumstances. In the context of registering or protecting a new mark it is necessary to consider all of the circumstances in which the mark applied for might be used, should it be registered.[5] Differences between parties' *current* offerings are therefore irrelevant to the assessment I am required to make, except to the extent that those differences are apparent from the lists of goods or services they have tendered for the purpose of registration. Furthermore, consideration of a likelihood of confusion is prospective and should not be restricted to the current marketing or trading patterns of the parties.[6] As parties' marketing strategies are transitional and can change with the passage of time, it would be inappropriate to take such factors into account when approaching the prospective analysis of a likelihood of confusion.[7] In short, I am required to make an assessment of the likelihood of confusion notionally and objectively, on the basis of the respective specifications (and marks) as they appear before me.

State of the register

[5] *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66
[6] *Oakley v OHIM*, Case T-116/06
[7] *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P

15. The holder also directs me to third party trade marks incorporating the word “Soft”. It submits as follows:

> “35. We maintain that it is common in the IT and gaming industry for trademarks to share similarities, such as incorporating terms like “soft”. The observation is based on industry analysis.
>
> 36. …Below is a screenshot from the WIPO Madrid Monitor, illustrating the number of registered trademarks containing the word “soft” (arising from “software”). As shown, there are at least 180 active trade marks registered within Classes 9, 41 and 42 in which the term “soft” is used, highlighting the widespread use of such terms in various industries.



> 37. …While the primary focus of the opposition is indeed the comparison between the Applicant’s mark and the Opponent’s mark, the assertion regarding the prevalence of similar names in the industry serves to provide context and

understanding of common practices within the IT and gaming sector… While the names of unrelated companies may not directly impact the proceedings, understanding broader industry practices can inform the assessment of trademark similarity and consumer perception. Thus, the Applicant maintains its position that the statement regarding industry trends is relevant in providing necessary context for the opposition proceedings."

16. As the opponent identifies in its own submissions, this line of defence is not relevant. Whilst the holder's comments are noted, I should make clear that the existence of such marks will not have any bearing on the present case. In *Zero Industry Srl v OHIM*, the General Court ("GC") stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '…there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II 4865, paragraph 68, and 6 Case T-400/06 Case T 29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II 5309, paragraph 71)."

17. In light of the above, and given that I have no evidence showing the use of the listed trade marks in the marketplace, this line of reasoning will play no part in my considerations as to whether there exists a likelihood of confusion, or indeed in my consideration of the earlier mark's inherent distinctiveness.

The marks at issue

18. Finally, in the holder's counterstatement, it appears to have approached a likelihood of confusion in respect of the following representation of the earlier mark:

19. For clarification, the opponent relies upon a word-only trade mark for "Softgames" and has not been required to file evidence exhibiting its use. The matter of a likelihood of confusion will be considered in regard to the respective marks as they appear before me on the register.

Section 5(2)(b) - case law

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

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

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

Comparison of goods and services

21. The competing goods and services are laid out at paragraphs 2 and 3 to this decision.

22. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

23. In addition to cases of *literal* identity, the General Court set out a further provision as to when goods (though it equally applies to services) can be considered identical in *Gérard Meric v Office for Harmonisation in the Internal Market*[8]. It stated:

> "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 für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

24. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

> (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;

[8] Case T-133/05

(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.

Audiovisual apparatus and instruments (class 9)

25. The opponent contends that the above term "is identical or highly similar to all of the Opponent's goods and services. Examples of audiovisual apparatus and instruments include speakers, microphones, screens and monitors. These are all examples of equipment which are used with computer software and games."

26. The holder submits that its term "encompasses a wide range of equipment used in conjunction with computer software and games. However, the Applicant's goods and services extend beyond mere equipment to include comprehensive solutions for audiovisual content creation and consumption, specifically designed for the online casino industry which forms a specific target market."

27. For the reasons already explained, I must assess the term as it appears before me, irrespective of the intended target market. When considered against the opponent's class 9 goods, to my mind, there is a distinction in the respective goods' immediate use though, as the parties appear to agree, the goods may be used alongside one another, which suggests that there may be some degree of shared purpose overall. The users of the respective goods are likely to be the same and, particularly in the circumstances alluded to by the parties, there may be an opportunity for coincidence in the respective trade channels. The goods' physical nature is distinct, the goods are not competitive

and, whilst they may be used in conjunction with one another, I do not consider them necessarily indispensable; the holder's goods may enhance the user's operation of the opponent's goods, for example, but, to my mind, they are not a necessary component in all cases. On balance, I find there is a medium degree of similarity.

Computers and computer peripheral devices (class 9)

28. I apply much of the same reasoning when considering the above term. Whilst the goods' immediate purpose may not be the same, when used in conjunction with, for example, the opponent's *computer games programs*, they may share a more general purpose. The users are likely to be shared and there may be an opportunity for coincidence in trade channels. Although they may incorporate a degree of compatibility, the goods' physical nature is not the same and they are not competitive. That being said, particularly in the case of the holder's computers, there is somewhat of an indispensable relationship between the goods at hand, to an extent which may lead the average consumer to presume a relationship between the respective undertakings. I find at least a medium degree of similarity between the parties' goods.

Recorded and downloadable media (class 9)

29. The holder contends that "The term "recorded and downloadable media" is indeed relevant to both parties' goods and services. However, …the Applicant's marks are associated with a broader range of media content, including but not limited to computer games. The Applicant's offerings encompass various forms of recorded and downloadable media, tailored specifically for the online casino industry, thereby distinguishing them from the Opponent's specific focus on computer games."

30. Of the same term, the opponent submits that it is identical to "all of the Opponent's goods and services" given that "Computer games can be provided as recorded media on game discs" and "Computer games can also be provided as downloadable media."

31. To my mind, when considering the above term against the opponent's *programs (Computer -) [downloadable software],* there may be some opportunity for the parties' goods to coincide in use, and certainly in their respective user. There may also be some

element of similarity in the goods' nature and in the trade channels through which they reach the market. The goods may be competitive and, even where they are not indispensable to one another, it would not seem unreasonable for the average consumer to presume that they would originate from a single undertaking. Weighing all factors, I find a high degree of similarity between the goods.

Computer software (class 9)

32. I find the above term is encompassing of the opponent's *programs (computer -) [downloadable software]* and is therefore to be considered identical.

Telecommunications services (class 38)

33. The opponent submits that the above services are "identical or at the very least highly similar to the Opponent's Class 41 services. All of the Opponent's Class 41 services are provided via/examples of telecommunications services." The holder, in turn, contends that its class 38 services "encompass a broader range of telecommunications solutions beyond gaming, including but not limited to telecommunication infrastructure and networking services specifically designed for online casinos… it is pertinent to highlight that the Opponent cannot rely on the Applicant's registration in Class 38 or present arguments regarding this class, as the Opponent themselves have not registered this class… Therefore, any arguments concerning this class from the Opponent are not relevant."

34. The holder's latter point holds little weight; simply because the opponent does not have any services registered in class 38 does not mean that no similarity can be shown in respect of its remaining goods and services which are registered in different classes.[9] I compare the applied-for services against the opponent's class 41 services which, as the terms make clear, are provided via the internet or other electronic communication networks. It seems likely that the opponent's services will rely fairly heavily on telecommunications services to fully engage their use, though I accept that the respective services do not share an immediate use. Still, the users of the respective

[9] As per section 60A of the Act, goods and services may still be considered similar even if they do not appear in the same classes of the Nice Classification.

services are likely to be shared, broadly speaking. The nature of the services is unlikely to be similar to any meaningful degree and I see little likelihood of coincidence in the services' respective trade channels. The services are not competitive although, as I have already indicated, there may be an indispensable dynamic between them whereby the average consumer takes the view that the services may originate from a single or related undertaking. Applying due weight to these considerations, I find there is a low degree of similarity between the parties' services.

Entertainment (class 41)

35. I consider the above against the opponent's class 41 services which, broadly speaking, concern the provision of various games. To my mind, *entertainment* is a broad enough term to encompass such activities, given that games are generally undertaken as a form of entertainment. If that is too generous a finding, I nonetheless find coincidence in the services' use on the same basis. The users are, for the most part, likely to be shared and, in some circumstances the services may reach the market via the same channels. The holder's term will naturally cover a wide range of activities which are intended to 'entertain' the consumer, including those which are provided by online or electronic means, for example, which may give rise to some overlap in the services' respective nature. The services may, at times, be competitive, where the average consumer is considering which medium of entertainment best fulfils its requirements. The services are not necessarily indispensable to one another. Having regard to all factors, I find the services share at least a high degree of similarity.

Design and development of computer hardware and software (class 42)

36. The opponent relies upon *computer programming of… computer games*, proper to the same class. Given the nature of the holder's term, these services will naturally encompass hardware and software associated with computer games. This creates an opportunity for some similarity in use, though there is a likely distinction between the 'design and development' and 'programming' process. That said, the services are likely to be accessed by the same users and may utilise the same trade channels. There may be some degree of overlap in the nature of the services though this is likely to be fairly limited, given the difference in the respective processes. The services are unlikely to be

competitive, though there may be a complementary relationship between them. To my mind, there may be circumstances in which the services are important to one another and it would not seem unreasonable for the average consumer to expect that they would be offered by a shared or related undertaking. Weighing all factors, I find at least a medium degree of similarity between the parties' services.

The average consumer and the nature of the purchasing act

37. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

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

38. The average consumer of the goods and services at issue is likely to comprise, for the most part, members of the general public. To my knowledge, neither the goods or services are likely to carry a significant cost and they will be engaged fairly frequently. The goods are likely to be self-selected from a traditional retail outlet or online equivalent and the services from an online resource or advertisement. This suggests that the marks' visual impression is likely to carry the greatest weight in the selection process, though I do not discount the significance of the marks' aural impression as consumers may rely in part on word-of-mouth recommendations or guidance from retailers, for example. The consumer is likely to be alive to considerations such as quality and compatibility. Weighing all considerations, I find the average consumer is likely to apply a medium degree of attention to its selection of the relevant goods and services.

Comparison of trade marks

39. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in *Bimbo SA v OHIM*,[10] that:

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

40. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

41. The parties' marks are laid out in the table below:

Opponent's trade mark	Holder's trade marks
Softgames	**SoftGamings** **('235 mark)** SoftGamings BUILD YOUR OWN CASINO **('237 mark)**

[10] Case C-591/12P

42. The opponent's mark comprises a single word of nine letters, though the average consumer may be inclined to view it as a merging of two ordinary dictionary words (*Soft* and *games*)[11]. There are no additional elements within the mark to contribute to its overall impression.

43. The holder's mark ending '235 comprises a single word of eleven letters. The consumer may, however, naturally dissect the mark into two readily identifiable words; Soft and Gamings (particularly so given that the mark incorporates irregular upper case letters which will encourage the consumer to dissect it as such). There are no additional elements to contribute to the mark's overall impression.

44. The holder's mark ending '237 is a figurative mark incorporating a number of elements. "SoftGamings" is presented in black, in an ordinary, bold font. Beneath it, in upper case, are the words "BUILD YOUR OWN CASINO". The font is proportionately smaller and the words are presented in a turquoise colour. Positioned to the left of the mark's word elements is a device, also in turquoise, depicting a three-dimensional swirl shape. To my mind, the mark's "SoftGamings" element is likely to play the dominant role in the mark's overall impression, with the decorative device playing a lesser role, and the wording presented beneath "SoftGamings" a lesser role still.

45. Visually, the opponent's mark and the holder's '235 mark coincide in the sequential letters S-O-F-T-G-A-M, which are identical and appear at the beginning of each mark. There are a further two letters in the opponent's mark (E-S) and a further four in the holder's (I-N-G-S). Given that registration of a word mark typically allows for its presentation in a combination of upper and/or lower case letters, little hangs on the marks' differences in that respect. Having kept in mind that the beginnings of trade marks generally have a greater impact on the consumer[12], I find the visual similarity between the marks to be fairly high.

[11] See, for example, Case T-356/02 *Vitakraft-Werke Wührmann* v *OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 51, and Case T-256/04 *Mundipharma* v *OHIM – Altana Pharma (RESPICUR)* [2007] ECR II-0000, paragraph 57

[12] *El Corte Ingles, SA v OHIM* (Cases T-183/02)

46. When it comes to the holder's '237 mark, the respective word elements coincide again in their first seven letters (S-O-F-T-G-A-M) and final letter (S). However, the additional elements within the holder's mark have no counterparts in the opponent's mark. Having regard to my earlier findings concerning the marks' overall impressions, I find the visual similarity to be of a medium degree.

47. The opponent's mark is likely to be articulated in two syllables; SOFT-GAMES. The holder's '235 mark is likely to be pronounced in three syllables; SOFT-GAY-MINGS. The marks' first syllables are identical, there is an element of similarity in the sound created by the marks' second syllables and both marks end in a soft percussive sound on account of the final letter 'S'. The marks differ in their totality by one syllable. On that basis, and having kept in mind what I have already said regarding the beginnings of marks, I find the marks' aural similarity to be fairly high.

48. Turning to the holder's '237 mark, whilst it may be arguable as to whether consumers will elect to articulate the mark's 'tagline' element ("BUILD YOUR OWN CASINO"), in its entirety the mark will comprise nine syllables; SOFT-GAY-MINGS-BUILD-YOUR-OWN-CAS-EE-NO. This creates a seven-syllable disparity between the parties' marks. Having weighed the marks' identical and/or similar syllables at the beginning of the marks against the remaining differences, I find the aural similarity to be between a low and medium degree.

49. The marks' conceptual impressions must be considered from the perspective of the average consumer. In its submissions, the opponent states that:

> "The Opponent's earlier mark and the dominant SoftGamings element of the Applicant's mark both consist of two words placed together to create a neologism. The first word of the neologism in each case is the identical word "Soft". The second word in the Applicant's mark is "Gamings", whereas in the Opponent's earlier mark it is "games"… These terms have an identical meaning and are therefore conceptually identical."

50. In the holder's submissions, it states:

> “In response to the assertion that both the Opponent's earlier mark and the dominant "SoftGamings" element of the Applicant’s mark consist of two words placed together to form a neologism, with the first word being the identical "Soft," we argue that this shared characteristic does not render the marks indistinguishable. While both marks utilize "Soft" as their initial component, the subsequent words, "games" in the Opponent's mark and "Gamings" in the Applicant’s marks, create distinct neologisms with different meanings and implications. The inclusion of "Gamings" in the Applicant’s mark, SoftGamings, serves to differentiate it from the Opponent's mark, which employs "games." These distinctions underscore the conceptual dissimilarity between the marks.”

52. I agree with the parties that the word elements in each mark will be viewed as portmanteau terms of either “Soft/games” or “Soft/Gamings”. In the earlier mark, *Soft* and *games*, being ordinary dictionary words, will be readily identified and understood by the average consumer, applying their natural meanings. To my knowledge, the words when combined do not create a clear concept, at least nothing beyond the idea of games which are, in some capacity, ‘soft’. In the holder’s ‘235 mark, the words it combines are also likely to be readily interpreted and understood by the average consumer. Again, I am not aware of any meaningful concept likely to be conveyed by their combination. “Soft” is likely to be attributed the same meaning in both marks and any conceptual difference between the marks lies in the difference between the marks’ second words “games” and “Gamings”, with *games* being understood as recreational and possibly competitive activities and *gamings* as a word generally used to describe the action of engaging in such activities (or at least the plural thereof). On this basis, I find the marks share a high degree of conceptual similarity.

53. In the holder’s ‘237 mark, the device element is unlikely to contribute any additional conceptual insight. The marks’ tagline element “BUILD YOUR OWN CASINO” may introduce some conceptual elements which are absent from the earlier mark but I must keep in mind that I have found this element to carry the lesser weight in the mark’s overall impression. In doing so, I find the marks are conceptually similar to at least a medium degree.

Distinctive character of the earlier trade mark

54. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*[13], 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, 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 promotion of 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)."

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

56. In the absence of any evidence showing the use made of the earlier mark, I have only its inherent position to consider. As discussed, the earlier mark is likely to be viewed as a combination of two dictionary words to create, in essence, an invented

[13] Case C-342/97

word. Given what I have said regarding the conceptual impression the mark is likely to leave on the average consumer, when considered against the goods and services relied upon by the opponent, the mark is somewhat descriptive in nature, or at least plays an allusive role. Whilst the mark's 'soft' element may not have any immediate meaning in respect of the goods or services, it is nonetheless an ordinary word. For completeness, I have considered whether 'soft' will be viewed as a shortening of 'software', particularly with reference to the earlier specification, but I find this an unlikely interpretation and I have nothing before me to support such a position. Weighing all factors, I find the earlier mark inherently distinctive to no more than a medium degree.

Likelihood of confusion

57. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and/or services, and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion. Conversely, the less distinctive it is, the lower the likelihood of confusion.

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

59. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*[14], where he 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

[14] Case BL O/375/10

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

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

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

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

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

60. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,[15] Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of

[15] [2021] EWCA Civ 1207

direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

61. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

62. Throughout the course of my decision, I have found the marks are visually similar to either a fairly high or medium degree; they are aurally similar to either a fairly high or low to medium degree and they are conceptually similar to a high degree or at least a medium degree. The average consumer is likely to be a member of the general public who will apply a medium degree of attention to its purchase. The marks' visual impressions are likely to play the greatest role in the selection process, though I do not discount the relevance of the marks' aural impressions. I have found the earlier mark to enjoy no more than a medium degree of inherent distinctiveness. Finally, I have found the similarity between the parties' respective goods and services ranges from lowly similar to identical.

63. I turn first to consider a likelihood of direct confusion and I will begin with the holder's word only mark ending '235. To my mind, the similarities between the parties' marks are such that the consumer will imperfectly recollect one for the other. The marks share a fairly high degree of both visual and aural similarity and convey a conceptual impression which is so similar that the average consumer, paying a medium degree of attention, is unlikely to successfully identify or recall that the endings of the marks' second words (games/Gamings) are not the same. On a repeat purchase, for example, I could foresee a scenario in which the consumer selects one parties' goods or services, believing it to be the other, failing to recognise the marks' alternate endings. In other words, I find there is a likelihood of direct confusion. Having particular regard to the effects of the interdependency principle, I find this applies even where the goods and services share only a low degree of similarity.

64. Whilst it is not strictly necessary for me to consider a likelihood of indirect confusion, if I were to briefly address the matter, I do not find sufficient reasoning to support such a finding. As above, a finding of indirect confusion requires a proper basis. To my mind, the nature of the marks' differences are such that, were they to be identified by the average consumer, they would be attributed to distinct undertakings which have elected to use a combination of similar words in their respective marks. The differences are not consistent with what the consumer would be inclined to view as a brand extension or sub-brand.

65. Moving now to consider the matter of direct confusion in respect of the holder's '237 mark, I take the view that there are sufficient visual differences between the marks to enable the average consumer to readily identify that the marks are not the same. That being said, I do consider it likely that the average consumer will misremember the respective word elements Soft/Games and Soft/Gamings, with the latter combination being the most dominant of the elements in the holder's mark. The device element it incorporates may be viewed as a decorative embellishment and the mark's tagline element is likely to be seen as just that: a window into the nature of the goods and services the mark is used for. I find it unlikely that the average consumer will rely too heavily on this element for the identification of origin. Given that I have found the marks' word elements will be mistaken for one another, and in light of the nature of (and lesser weight attributed to) the remaining elements in the holder's mark, I find the average consumer will erroneously conclude that the marks originate from the same undertaking. The respective marks will simply be seen as variations of either "Softgames" or "SoftGamings" marks. In short, I find the marks will be indirectly confused.

Conclusion

66. The opposition under section 5(2)(b) succeeds in full. Subject to any successful appeal against my decision, the applications will be refused registration in respect of the following goods and services:

Audiovisual apparatus and instruments; recorded and downloadable media, computer software; computers and computer peripheral devices (class 9)

Telecommunications services (class 38)

Entertainment (class 41)

Design and development of computer hardware and software (class 42)

67. The applications will proceed to registration in respect of the following goods and services, which were unopposed:

Scientific, research, navigation, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, detecting, testing, inspecting, life saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; blank digital or analogue recording and storage media; mechanisms for coin-operated apparatus; cash registers, calculating devices; diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming; fire-extinguishing apparatus (class 9)

Advertising; business management, organization and administration; office functions (class 35)

Financial, monetary and banking services; insurance services; real estate services (class 36)

Education; providing of training; sporting and cultural activities (class 41)

Scientific and technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; quality control and authentication services (class 42)

Costs

68. The opponent has been successful and is entitled to a contribution toward its costs. Awards of costs commenced on or after 1 February 2023 are governed by Annex A of Tribunal Practice Notice ("TPN") 1/2023. In accordance with that TPN, I award the costs to the opponent as follows:

Official fee (x2):	£200
Preparing a Notice of Opposition (x2):	£300
Reviewing the counterstatement and preparing written submissions:	£300
Reviewing the evidence and preparing submissions in reply:	£300
Total:	**£1100**

69. I hereby order BROMSTON ASSOCIATED LTD to pay SOFTGAMES - Mobile Entertainment Services GmbH the sum of £1100. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of May 2025

Laura Stephens
For the Registrar