

o/0594/25

TRADE MARKS ACT 1994

Consolidated Proceedings

IN THE MATTER OF REGISTRATION NOs. UK916072514, UK914873624 &
UK914554026

BY

DREAMWORKS ANIMATION L.L.C.

IN RESPECT OF THE TRADE MARKS



TROLLS

IN CLASSES 9, 28 & 41

AND THE APPLICATION FOR THE REVOCATION THEREOF

UNDER NOs. 505972, 505973 & 505974

BY PLAY'N GO MARKS LTD

BACKGROUND AND PLEADINGS

1. The trade marks shown on the cover page of this decision (“the Contested Marks”) stand in the name of DreamWorks Animation L.L.C. (“the Registered Proprietor”). The details of the marks are as follows:

Mark	Trademark Number	Filing date	Registration date
 (“the 514 mark”)	UK916072514	22 April 2016	22 November 2016
 (“the 624 mark”)	UK914873624	3 December 2015	22 April 2016
TROLLS (“the 026 mark”)	UK914554026	11 September 2015	5 April 2016

2. On 5 April 2023, Play’n GO Marks Ltd (“the Cancellation Applicant”) filed an application for revocation under sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 (the Act) against the following goods and services for each of the marks:

The 514 mark:

Class 28: Games; pinball machines; hand-held unit for playing electronic games adapted for use with an external display screen or monitor; hand-held unit for playing electronic games other than those adapted for use with an external display screen or monitor.

The 624 mark:

Class 9: Data processing equipment, computers; computer software; prerecorded video discs and dvds featuring [...] other entertainment programs; prerecorded optical and magneto-optical discs featuring other entertainment programs, interactive multi-media software for playing games; downloadable software in the nature of a mobile application for playing games for use with computers, portable handheld digital electronic communication devices, mobile device and wired and wireless communication devices; computer game software for wireless and electronic mobile devices, mobile phones and handheld electronic devices; computer game discs; video game discs; computer game cartridges.

Class 28: Games; pinball machines; hand held unit for playing electronic games adapted for use with an external display screen or monitor; hand-held unit for playing electronic games other than those adapted for use with an external display screen or monitor.

Class 41: Entertainment; production and distribution of multi-media entertainment programs.

The 026 mark

Class 9: Data processing equipment, computers; computer software; prerecorded video discs and dvds featuring [...] other entertainment programs; prerecorded optical and magneto-optical discs featuring other entertainment programs, interactive multi-media software for playing games; downloadable software in the nature of a mobile application for playing games for use with computers, portable handheld digital electronic communication devices, mobile device and wired and wireless communication devices; computer game software for wireless and electronic mobile devices, mobile phones and handheld electronic devices; computer game discs; video game discs; computer game cartridges.

Class 28: Games; pinball machines; hand held unit for playing electronic games adapted for use with an external display screen or monitor; hand-held unit for playing electronic games other than those adapted for use with an external display screen or monitor.

3. In the applications for revocation, the Cancellation Applicant claims that the IRs were not put to genuine use within five years of the date on which protection was granted in the UK (section 46(1)(a)) and, under section 46(1)(b), that use has been suspended for an uninterrupted period of five years between the following two periods:

21 December 2017 – 20 December 2022

4 April 2018 – 3 April 2023

4. The Registered Proprietor denied the Cancellation Applicant's claims within their counterstatements and stated that the marks were in use for all goods and services for the periods stated.

5. The Registered Proprietor provided evidence in these proceedings. A hearing was requested by the Cancellation Applicant and took place on 30 June 2024. Ms Beverley Robinson of Appleyard Lees represented the Cancellation Applicant and Mr David Stone of A&O Shearman represented the Registered Proprietor. This decision is taken following a careful consideration of the papers before me. I note that since the hearing, the Registered Proprietor has changed representatives and is now represented by White & Case.

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

Evidence

7. The Registered Proprietor provided evidence in the form of a witness statement by Christina S. Monteiro, the Vice President of Intellectual Property for NBCUniversal including its DreamWorks Animation LLC subsidiary, dated 14 August 2023 and accompanied by 15 Exhibits. The main purpose of this evidence was to show that the Registered Proprietor had made use of its marks.

8. The Cancellation Applicant did not file evidence but did file submissions in response to the Registered Proprietor's evidence.

DECISION

Sections 46(1)(a) and 46(1)(b)

9. Section 46 of the Act states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

10. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

11. Given that the proprietor’s marks are comparable marks, paragraph 8 of part 1, schedule 2A is relevant. It reads:

“8.— Non-use as defence in infringement proceedings and revocation of registration of a comparable trade mark (EU)

(1) Sections 11A and 46 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 11A(3)(a) and 46(1)(a) or (b) (the "five-year period") has expired before [IP completion day]—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before [IP completion day]—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark, are to be treated as references to the corresponding EUTM ; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union”.

12. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

13. I remind myself that there are three periods of use requested by the Cancellation Applicant. The first is the five years following the date of the completion of the registration being:

The 514 mark: 23 November 2016 to 22 November 2021

The 624 mark: 23 April 2016 to 22 April 2021

The 026 mark: 6 April 2016 to 5 April 2021

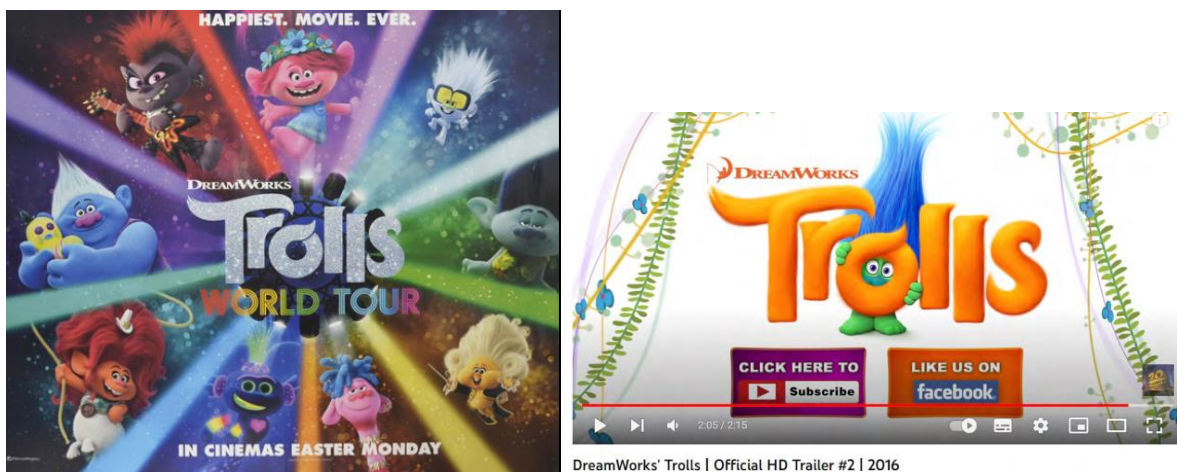
14. There are also the two periods that the Cancellation Application has noted within its three Form TM26Ns as follows: 21 December 2017 to 20 December 2022 and 4 April 2018 to 3 April 2023 which apply to all three marks. I note that there is a significant overlap in all of the above use periods. Further, in the hearing Mr Stone clarified that the Registered Proprietor had focused the evidence on the most recent use period as section 46(3) means that use within this period negates the need to show use in the earlier periods.

Evidence

15. The witness statement from Christina Monteiro states that the Registered Proprietor was founded in 1994 and is “one of the most prominent entertainment and media companies in the entertainment industry”. Further, it is stated that the

Registered Proprietor is the owner of intellectual property rights and of a family of TROLLS properties including the registrations relied on which have been “used extensively by the Registered Proprietor in connection with a wide variety of products”.

16. The Registered Proprietor provided sales figures in relation to the DreamWorks Trolls film released in 2016 as over 30.2 million US Dollars in the UK and over 100.1 million US Dollars in the EU at the date of the witness statement. She explains that the marks are used in relation to the movies in Exhibit CSM1 and 2 as follows:



17. Ms Monteiro then goes on to mention subsequent television series being ‘Trolls: Holiday’ released in 2017 and ‘Trolls: The beat goes on!’ released in 2018 which she stated was available on Netflix to over 13 million subscribers in the UK in 2019, over 14 million in 2020 and over 12 million in 2021. I note that these numbers refer to subscribers of Netflix itself and is not the number of viewers of the TV series itself.

18. The witness statement goes on to say that the contested marks “feature prominently on a broad variety of merchandise [...] including, but not limited to, action figures, plush toys, games, books, clothing, stationery, food and personal care products”. It then references Exhibit CSM5 as showing these goods available in the UK. Exhibit CSM5 shows the following:

- An article in ‘Retail Times’ published on 9 August 2016 relating to a promotional partnership between Vosene Kids and Dreamworks (running from August 2016

to February 2017) which “centres around an on-pack promotion” on haircare products.

- An article from ‘The Grocer’ dated 11 October 2016 titled ‘Hovis rolls our Trolls movie promotion across 8m Best of Both loaves’ which again refers to an on-pack promotion on the packs of bread.
- An extract from amazon.co.uk. There is a small date at the top of the page (being 10/1/2020) but I cannot tell where that or the extract has come from. Aside from the videos/blue-ray, I can see listings for a jigsaw puzzle, plush doll, a play-doh toy, tie-dye kit, matching pairs game, pyjamas, and a playhouse.

19. Exhibit CSM6 contains copied of select redacted licences entered into by the Registered Proprietor in relation to merchandise.

20. Mr Stone referred to two articles in Exhibit CSM7. The first is a news item from March 2022 from ‘Toy World Mag’ which states that DreamWorks has entered an agreement with Mattel regarding the Trolls franchise and giving Mattel the rights to develop a “full line of toys [...] including dolls, vehicles, plush, games and more” and expected to be launched in autumn 2023 (which I note is outside of all of the use periods). Secondly, is an article from ‘Licensing Source’ dated 31 May 2017 which states that in reference to 2016 “...DreamWorks’ Trolls which sold £12million of toys...”.

21. Moving on to Exhibit CSM8 which contains amazon.co.uk listings for various ‘Trolls’ DVDs and includes the ‘review’ section of the listings with reviews dating through 2020 to 2022. I note on the first page there is a note in red saying ‘This DVD will not play on most DVD players sold in the UK’ and it goes on to say that ‘Region 1 DVDs are dispatched to the USA and Canada’ so I do not believe this DVD is relevant to the EU or UK and is of little assistance. However, Mr Stone did draw my attention to the UK based reviews later on within the exhibit as follows:

suzi h
Great little film
 Reviewed in the United Kingdom on 2 March 2022
Verified Purchase
 Arrived timely well packed. Present for my young granddaughter who loves the Troll films.

Helpful Report

Sally
Trolls Holiday is great, Amazon description not so.
 Reviewed in the United Kingdom on 3 December 2017
Verified Purchase
 Trolls fans will love the film, it's a great short movie. Kids love a sing a long with the Trolls and it meets expectations.

It's a shame Amazons description is very misleading, because that is leading to negative reviews which is not a true reflection on the film, but Amazon. It states that it is one hour 11 minutes long, when the trolls feature is less than 30 minutes. The streaming time is then filled with some animation that I haven't watched for long enough to find out what it is.

Amazon need to change their description so people know what they are buying and Trolls Holiday can get the reviews it deserves.

7 people found this helpful

Helpful Report

Amazon Customer
Trolls
 Reviewed in the United Kingdom on 25 January 2021
Verified Purchase
 Really enjoyed the film with the grand children, very entertaining, colourful and great music.
 Really enjoyed the first Film to. Think were hooked!

Helpful Report

T E.
NOWHERE NEAR 71 MINUTES LONG, but kids love it
 Reviewed in the United Kingdom on 9 April 2020
Verified Purchase
 Advertised as over an hour long, so thought £6 wasn't bad value to watch it. 23 minutes later it's finished. Unfortunately it would seem refunds aren't available on these either. If I had bought a metre long ruler and it was only 30cm long I'd be entitled to a refund!

The kids enjoyed it but it shouldn't have been that expensive and the description is VERY misleading. If we had seen the reviews on here then we would have known better but on the FireTV app you only get the stars.

I have changed this to 3 stars as despite being very disappointed with the time the kids ask to watch it every day!

22. Next, is an undated extract from 'WB The Shop' showing 11 results for 'DreamWorks' Trolls' DVDs and Blu-ray and another undated extract from HMV showing a Trolls DVD. In her witness statement, Ms Monteiro states that consumer spending for the first feature film in 2016-2018 on Blu-ray and DVD is in excess of 5 million US Dollars in the UK. Further, the 'Trolls: holiday' and TV series sold 34,860 units in the UK for the years 2019-2020.

23. Exhibit CSM9 starts with an article from 'Entertainment Focus' website dated 21 December 2016 which discusses the release of "Trolls: Crazy Party Forest!" which is a mobile game. There is a further page from the "Trolls Trollpedia" site which stated that the game was available for approximately a year and closed on 30 October 2017.

24. Turning to Exhibit CSM10, there are further undated screenshots of apps featuring Trolls. Although the screenshots are undated, there are dated reviews within these extracts such as:

Mcbrides|b, 18/03/2020
Amazing!!!!!! 🤩
 I love this game so much!. It's really fun and brilliant so try it out today!

ICREAM LOVER 33467, 13/04/2021
Really good but..... SCARY
 This is an awesome thing but there are not many stickers. Also satin and chenille look a bit creepy and you don't want to scare people there eyes look like aliens 🙄

Mellkeyllkey, 11/06/2017
Full access ???
Why does this App require full keyboard?

Developer Response,
 Thank you for downloading the Emoji **Trolls**




25. There are references to the following apps: Emoji Trolls and Trolls Holiday Stickers. Further, there is an article from The Toy Insider dated 17 August 2021 in relation to the release of Trolls Music Stars App and states the app is 'now available'.

26. The witness statement at paragraph 23 states that the Registered Proprietor offers games cartridges which are shown (together with a user manual) in Exhibit CSM11 which are extracts from a website named 'toymonster.co.uk':

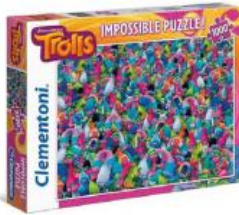









27. Ms Monteiro states in her witness statement that Exhibit CSM12 shows website extracts showing various games offered under the marks in the UK and EU within the relevant period. Ms Monteiro states that the exhibit shows games including card games, board games, puzzles, an arcade game, a DJ turntable, toy microphone and sing along electronic book. I have extracted the following information from the amazon listings:

Product	Image	Date first available
eKids TR-625 Trolls World Tour DJ Trollex Party Mixer		5 Dec 2019

<p>Turntable Toy for Kids</p>												
<p>DreamWorks Trolls – Get Back Up Again Little Music Note Sound Book</p>	<p>Children's Books › Literature & Fiction › Growing Up & Facts of Life</p> <p>DreamWorks Trolls - Get Back Up Again Little Music Note Sound Book - Play-a-Song - PI Kids Hardcover – Sound Book, 15 Feb. 2017</p> <p>by Veronica Wagner (Author)</p> <p>4.8 ★★★★★ 2,774 ratings</p> <p>Book 5 of 8: Little Music Note Sound Book See all formats and editions</p> <p>Join Poppy, Branch, and more trolls on a musical adventure! Your little one can press 6 sound buttons to play "Get Back Up Again," and other Trolls related sounds, and sing along to the lyrics printed in the book. They can also participate in activities designed to get little readers involved in the action on each page.</p> <p>This sound book is special because:</p> <ul style="list-style-type: none"> • Hands on interaction engages young readers • Singing and music build language and literacy skills • Includes popular Trolls characters: Poppy, Branch, DJ Suki, Cooper, Biggie, Mr. Dinkles, and Chef 	<p>No information available.</p>										
<p>Tonies Trolls Audio Character- Trolls Toy, Dreamworks Audiobooks for children</p>	 <p>tonies Trolls Audio Character - Trolls Toy, for Children</p> <p>Visit the tonies Store</p> <p>4.7 ★★★★★ 223 ratings</p> <p>Amazon's Choice for "trolls audio character audiobooks"</p> <p>100+ bought in past month</p> <p>£14.99</p> <p>FREE Returns</p> <p>Promotion Message Promotion Available 1 promotion</p> <table border="1"> <tr> <td>Brand</td> <td>tonies</td> </tr> <tr> <td>Age range (description)</td> <td>Children</td> </tr> <tr> <td>Theme</td> <td>Music</td> </tr> <tr> <td>Material</td> <td>Fabric</td> </tr> <tr> <td>Colour</td> <td>Trolls</td> </tr> </table> <p>About this item</p>	Brand	tonies	Age range (description)	Children	Theme	Music	Material	Fabric	Colour	Trolls	<p>24 June 2021</p>
Brand	tonies											
Age range (description)	Children											
Theme	Music											
Material	Fabric											
Colour	Trolls											
<p>Hasbro B9885100 Trolls Bug DJ Console</p>	 <p>Hasbro B9885100 Trolls Bug DJ Console Set</p> <p>Brand: Hasbro</p> <p>3.2 ★★★★★ 2 ratings</p> <p>£10.99</p> <table border="1"> <tr> <td>Brand</td> <td>Hasbro</td> </tr> <tr> <td>Theme</td> <td>Cartoon</td> </tr> <tr> <td>Sub brand</td> <td>Trolls</td> </tr> <tr> <td>Item dimensions L x W x H</td> <td>6.4 x 29.2 x 20.3 centimetres</td> </tr> <tr> <td>Controller type</td> <td>Push Button</td> </tr> </table> <p>About this item</p> <ul style="list-style-type: none"> • As seen in the Trolls film! • At the touch of a button, the music from the film is heard. • Includes 10 cm Poppy figure. • 3 x 1.5 V A76 (LR44) batteries included. • Suitable for 4 year olds and over. <p>See more product details</p>	Brand	Hasbro	Theme	Cartoon	Sub brand	Trolls	Item dimensions L x W x H	6.4 x 29.2 x 20.3 centimetres	Controller type	Push Button	<p>28 Jan 2018</p>
Brand	Hasbro											
Theme	Cartoon											
Sub brand	Trolls											
Item dimensions L x W x H	6.4 x 29.2 x 20.3 centimetres											
Controller type	Push Button											
<p>Dreamworks Trolls – Me Reader Electronic Reader 8 Book Library Box set</p>	 <p>Dreamworks Trolls - Me Reader Library Box Set - PI Kids: 1 Hardcover</p> <p>by Erin Rose Wage (Author)</p> <p>4.7 ★★★★★ 1,289 ratings</p> <p>Part of: Me Reader and 8-Book Library (19 books)</p> <p>Hardcover</p> <p>£19.01</p> <p>4 Used from £19.01</p> <p>8 New from £20.55</p> <p>Shake your hair! Get ready for a sparkling adventure full of scr books featuring Poppy, Branch, and their colorful Trolls friends each book aloud. Choose a book, press the matching book and with fun and surprising sounds! Follow along in the book for a beginning readers. Story sounds and expressive narration enh</p> <p>This Electronic Reader Library is special because:</p> <ul style="list-style-type: none"> • Hands on interaction engages young readers • Connecting words with pictures builds vocabulary 	<p>Not available</p>										

<p>Trolls Poppy's Microphone</p>	 <p>Trolls Poppy's Microphone Brand: Hasbro 4.4 ★★★★★ 550 ratings Amazon's Choice for "trolls poppy microphone" 100+ viewed in past month</p> <p>£13.95</p> <p>FREE Returns Available at a lower price from other sellers that may not have this option.</p> <p>Brand: Hasbro Age range (description): Kids Theme: Movie Material: Plastic Colour: Multicolor</p> <p>About this item</p>	<p>1 Jan 2020</p>
<p>DreamWorks Trolls World Tour- Troll Lotta Love! Sound Book</p>	 <p>DreamWorks Trolls World Tour - PI Kids (Play-A-Sound): 1 Board Book by Editors of Phoenix International Publications (Author) 4.8 ★★★★★ 766 ratings Part of: Play-A-Song (17 books)</p> <p>Join Poppy and friends in a new adventure! This movie-inspired story to life while you read!</p> <p>This sound book is special because:</p> <ul style="list-style-type: none"> Hands on interaction engages young readers Reading books with your little one strengthens your bond Multisensory reading experiences stimulate the imagination <p>Reading age: 3 - 6 years Part of series: Play-A-Song Print length: 12 pages</p>	<p>Not available</p>
<p>LeapFrog LeapStart Trolls Solve It All with Poppy and Branch Activity Book</p>	 <p>Poppy and Branch Activity Book Visit the LeapFrog Store 4.7 ★★★★★ 17,345 ratings 197 answered questions</p> <p>Currently unavailable. We don't know when or if this item will be back in stock.</p> <p>Color: Trolls Solve It All With Poppy and Branch</p> <p>Size: Level 3 Level 1 Level 2 Level 3</p> <p>Style: 3D 3D Non-3D</p>	<p>5 April 2017</p>
<p>Shuffle Trolls Card Games for Kids</p>	 <p>Shuffle Trolls Card Games For Kids - 4 in 1 Snap, Pairs, Happy Families and Action Game, Great Gift For Kids Aged 4+ Visit the Shuffle Store 4.5 1,531 ratings</p> <p>Style Name: Trolls</p> <p>Avengers Batman Frozen 2 Justice League Lion King Onward Paw Patrol Princess Raya Scooby Doo Toy Story 4 Trolls</p>	<p>9 June 2020</p>

<p>Clementoni 39369.5 "Trolls" Impossible Puzzle</p>	 <p>Clementoni 39369.5 "Trolls" Impossible Puzzle (1000-Piece) Visit the Clementoni Store 4.6 139 ratings</p> <p>£14⁹⁹ FREE Returns Only 1 left in stock</p> <p>Brand Clementoni Manufacturer 108.0 Minimum Age (MONTHS) Number of pieces 1000 Item 38 x 18 x 6 centimetres</p> <p>Roll over image to zoom in</p> <p>See more</p>	<p>1 Sep 2016</p>
<p>Trolls 2 Top Trumps Match Board Games</p>	 <p>Trolls 2 Top Trumps Match Board Game Visit the Top Trumps Store 4.4 78 ratings</p> <p>£18²⁹</p> <p>Age range (description) 4+ Brand Top Trumps Theme Movies Material Plastic Colour Trolls 2 World Tour</p> <p>Roll over image to zoom in</p> <p>About this item</p>	<p>29 Jan 2020</p>
<p>Ravensburger Trolls 2 World Tour Mini Memory Matching Picture Snap Pairs Game</p>	 <p>Ravensburger Trolls 2 World Tour Mini Memory Matching Picture Snap Pairs Game for Kids Age 3 Years Up Visit the Ravensburger Store 4.7 876 ratings</p> <p>£6⁷⁴ FREE Returns</p> <p>Age range (description) 3 Years + Number of players 2 to 6 Brand Ravensburger Theme Movies Material Cardstock</p> <p>Roll over image to zoom in</p>	<p>27 Jan 2020</p>
<p>Ravensburger Trolls 2 World Tour – Let's Save Music Board Game</p>	 <p>Ravensburger Trolls 2 World Tour - Let's Save Music Board Game Kids Age 3 Years and Up Visit the Ravensburger Store 4.3 99 ratings Amazon's Choice for "trolls game"</p> <p>£9²⁴ FREE Returns</p> <p>Age range (description) Kid Number of players 2 to 4 Brand Ravensburger Theme Music, Adventure Material Plastic</p> <p>Roll over image to zoom in</p>	<p>10 Feb 2020</p>

<p>Trolls 2 Top Trumps Card Game</p>	 <p>Roll over image to zoom in</p> <p>Trolls 2 Top Trumps Card Game Visit the Top Trumps Store 4.7 811 ratings</p> <p>-13% £4³⁵ RRP: £4.99 @</p> <p>FREE Returns Available at a lower price from other sellers that may not offer free Prime delivery.</p> <p>Age range (description) 3+ Number of players 2 Brand Top Trumps Theme Cartoons Material Cardboard</p>	<p>29 Jan 2020</p>
<p>Mattel Games GRC65 Dreamworks Trolls World Tour Uno</p>	 <p>Roll over image to zoom in</p> <p>Mattel Games GRC65 DREAMWORKS TROLLS WORLD TOUR UNO Visit the Mattel Games Store 4.5 89 ratings</p> <p>-45% £4⁹⁰ RRP: £8.99 @</p> <p>FREE Returns</p> <p>Age range (description) Adult Number of players 2-10 Brand Mattel Games Theme Movie,Race Material Cardstock</p> <p>About this item</p>	<p>17 Jan 2020</p>
<p>Hasbro Gaming - Trolls Operation</p>	 <p>Roll over image to zoom in</p> <p>Hasbro Gaming - Trolls Operation Brand: Hasbro Gaming 4.5 454 ratings</p> <p>£11⁹⁹</p> <p>FREE Returns Only 1 left in stock</p> <p>Brand Hasbro Gaming Genre Party Number of players 1 Item dimensions L x W x H 40 x 25.1 x 4.1 centimetres Batteries required? Yes</p>	<p>1 Aug 2016</p>
<p>Monopoly Junior; DreamWorks Trolls World Tour Edition Board Game</p>	 <p>Roll over image to zoom in</p> <p>Monopoly Junior: DreamWorks Trolls World Tour Edition Board Game for Children Aged 5 and Up Brand: Monopoly 4.7 1,004 ratings</p> <p>£14⁷⁵</p> <p>FREE Returns Only 1 left in stock</p> <p>Brand Monopoly Material Plastic Theme Fantasy Genre Family, Mystery Number of players 1</p> <p>About this item</p>	<p>29 Nov 2019</p>

28. Next is a list of awards for the Trolls film franchise with IMDB extracts in Exhibit CSM13 showing some of these also:

Title	Award Recognition
DREAMWORKS TROLLS	<ul style="list-style-type: none"> • Academy Award Nominee for Artistic Merit in Film by the Academy of Motion Picture Arts and Sciences • Golden Globe Nominee for Outstanding Achievement in Film by the Hollywood Foreign Press Association • Grammy Awards Winner for Excellence in Music Industry by the Recording Academy • Annie Awards Nominee for Excellence in Animation by the International Animated Film Association • World Soundtrack Awards Nominee to Recognize the Art of Film Music • ASCAP Film and Television Music Awards Winner
TROLLS: THE BEAT GOES ON!	Emmy Award Nominee for Excellence in the Television Industry
TROLLS 2: WORLD TOUR	Annie Awards Nominee for Excellence in Animation by the International Animated Film Association (multiple categories)
	Visual Effects Society Awards Nominee for Excellence in visual effects (multiple categories)

29. Exhibit CSM14 shows some extracts from the website 'www.dreamworks.com/trolls' which she states regularly attracts visitors from the UK and EU. From the screenshots I can see references to the films and where to watch them, and various images of characters.

30. The same exhibit also has screenshots from Facebook, Instagram and Twitter accounts belonging to Dreamworks' Trolls, the details of which are as stated in the witness statement:

- (a) Screenshots from the Registrant's Facebook page entitled 'Trolls', which features extremely prominent use of the Trolls Marks. As of 1 October 2020, this Facebook page had 911,227 'likes' and 972,614 followers from all around the world. Posts on this Facebook page date back to at least May 2016.
- (b) Screenshots from the Registrant's Instagram page entitled 'Trolls', which features prominent use of the Earlier Mark. As of 1 October 2020, this Instagram page had 207,000 followers from all around the world. Posts on this Instagram page date back to at least April 2016.
- (c) Screenshots from the Twitter account the Registrant operates using the handle ©Trolls, which is accessible from, and has followers in, the UK and EU. It can be seen that the account was created on December 2015 and has been active throughout the Relevant Periods.

31. Finally, Exhibit CSM15 is noted in the witness statement as showing press coverage from third party publications such as the Evening Standard and Metro and all refer to the film.

Analysis

Form of the mark

32. Firstly, I must consider whether the mark has been used as registered or in an acceptable variant form. Ms Robinson stated at the hearing that this was one of the key considerations in dispute.

33. In relation to the 514 mark there were no specific submissions from Ms Robinson on the form of this mark being used and I consider that it is clear from the evidence that this mark can be seen throughout, as registered (and with slight colour variations which do nothing to alter the distinctiveness of the mark). Therefore, there is acceptable use of this mark.

34. Regarding the 624 mark, Ms Robinson mentioned that the only reference to this mark was within Exhibit CSM2 which relates to the film only and is outside of the most recent relevant periods. Further, she claimed that none of the other references to 'Trolls' uses the "distinctive lower case lettering in the orange font, nor do they have

the troll figure behind the letter 'o'. Mr Stone contended that any use of the 514 mark is also use of the 624 mark. He said that, as pointed out by Ms Robinson, there are four elements to the 624 mark, two of which are not present in the 514 mark but that must then follow that two elements are included within the 514 mark.

35. He expanded upon this and explained that the 'Dreamworks' element is not particularly obvious but is distinctive when recognised. Then there is the word 'Trolls' which he states is "clearly the key part of the mark". Ms Robinson had said that the 'Trolls' element was very low in distinctiveness as it relates to well known mythological creatures and indicates the subject matter or theme when used in relation to the relevant goods and services. The third element referred to by Mr Stone was the lowercase orange font which he submitted would not alter the distinctive character of the mark should it be changed.

36. Finally, there is the troll device behind the letter 'o' as referred to by Ms Robinson. Mr Stone referred to *Lactalis McLelland Limited v Arla Foods AMBA* BL O/265/22, specifically where Phillip Johnson, sitting as Appointed Person, stated "where a mark contains words and a figurative element, the word element will usually be more distinctive; *T-146/15 Hyphen v EUIPO* EU:T:2016:469, [30]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements". He further stated that the troll device simply emphasises the conceptual meaning of the word element of the mark.

37. Mr Stone went on to reference *Aceitunas Y Encurtidos Artesanos De Navarra S.A. v Olive Line International, S.L.*, O-890-22, specifically where the hearing officer said: "To my mind, these would be perceived by the average consumer as decorative elements which would not detract from the trade mark message itself. In my view, the relevant consumer is more likely to identify and recall the words 'MAESTRO DE OLIVIA' within the banner in the second mark, and which is present in all variants, as being indicative of brand origin".

38. It is clear from the evidence that the actual use of the 624 mark as registered is nominal and therefore, I do need to consider whether any of the variants shown in the

evidence are acceptable variants. I take guidance from the aforementioned *Lactalis* decision:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

39. I agree with Mr Stone’s submissions that the troll device element is likely to be viewed as decorative and a reinforcement of the conceptual message of the ‘Trolls’ word. Further, the font/typeface of the ‘Trolls’ element is not so different that it changes the distinctive character. I appreciate what Ms Robinson submitted in that ‘Trolls’ is likely to be viewed as the subject matter of the goods and services but that does not negate it from being one of the more distinctive elements of the mark. Therefore, as the two elements that I consider to be the most distinctive –‘Dreamworks’ and ‘Trolls’ are found in representations of the 514 mark and the elements that have been removed or changed do not alter the distinctive character, I consider that the use of this mark throughout the evidence amounts to acceptable variant use of the 624 mark.

40. Finally, I turn to the 026 mark which is simply ‘TROLLS’. Ms Robinson submitted at the hearing that the evidence filed demonstrates that any use of ‘TROLLS’ by the Proprietor is in logo stylised form and is always used in conjunction with the word ‘DREAMWORKS’ which she claims is a very distinctive element. Again, Mr Stone argued that use of the 514 mark amounts to use of the 026 mark. I note there are a couple of instances within the evidence where ‘TROLLS’ is used without ‘DREAMWORKS’, for example, from this extract on their own website in Exhibit CSM 14:



41. There are two issues I must address here. Firstly, the 026 mark is a word mark which protects the word regardless of colour, typeface etc. The question is whether the stylisation of the mark as it is used in the evidence affects the distinctive character of the mark. I do not consider that the stylisation of the 'TROLLS' element itself is enough to affect the distinctive character.

42. The second issue is that throughout the evidence the 'TROLLS' mark is largely used with another trademark- 'DreamWorks'. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that:

"31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous

to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)." (emphasis added)

43. As I said above, throughout the evidence the mark is largely shown with 'DreamWorks' and 'TROLLS' together. Given that the 'DreamWorks' element is the more distinctive one (given that 'TROLLS' would have a well known meaning which could be seen as the subject matter, particularly in relation to the films and TV shows) I believe it is indicative of origin and without that in place, 'TROLLS' solus would no longer be viewed as indicative of origin. Therefore, I do not consider that there has been use made of the 026 mark and the revocation against that mark succeeds here.

Sufficient use

44. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the comparable mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period. In making this assessment, I am required to consider all relevant factors, including:

- The scale and frequency of the use shown;
- The nature of the use shown;
- The goods and services for which has been shown;
- The nature of those goods/services and the market(s) for them; and
- The geographical extent of the use shown.

45. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹

46. A matter that was not raised at the hearing but that must be discussed is whether reliance on fictional characters serves as a trade origin function or whether it is rather seen as denoting the subject matter without also serving as an indicator of trade origin. The issue is highly fact-dependent, as observed by Birss J. (as he then was) 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). It depends on what is shown in the evidence.

47. In *Danjaq LLC v OHIM*, Case T-435/05, the GC did not accept that use of 'Dr No' as the title of a film was trade mark use. Dr No distinguished the artistic work but it was 'James Bond' which was the trade mark which distinguished the trade origin of the series of films to which the film Dr No belonged. It was noted in this case that 'James Bond' did indicate that the commercial origin of the DVDs and video cassettes was the company producing the 'James Bond' series and given that there is evidence of two films and a television series (as supported by the WB shop page in Exhibit CSM8) together with 'DreamWorks' being an indicator of origin within the marks it suggests that the marks can be deemed to have been used as a commercial origin, at the very least for the films and television series themselves.

48. The only goods I have been given any sales figures for is the first film. These are clearly substantial, amounting to \$5 million dollars for the first film on Blu-ray and DVD between 2016 and 2018 in the UK. Further, within the witness statement Ms Monteiro states that the television series sold 34,860 units between 2019 and 2020. I consider that the TV and Film market is a very large one and although the TV series units sold are not substantial, there is enough for it to be considered part of the market.

49. I have not been given any sales figures/unit sales within the witness statement for anything other than the films and I have also not been given any information regarding

¹ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

marketing/advertising costs or expenditure by the Registered Proprietor. In the hearing, Mr Stone acknowledged that these figures were not provided and stated the following:

“The way in which Hollywood studios keep records of their licensing arrangements are by region or by licensee or sometimes by both. What that means is that I can get you evidence for sales figures for the whole of Europe but my learned friend will say "that is not specific to the UKIPO so what value is that?" I would agree with that submission. That is why that evidence is not there.

Or I can do it by licensee. I can say Hamleys or Hasbro or Mattel have sold £10 million worth of Trolls related merchandise but I then cannot break it down by product for you because NBC Universal, the parent company of DreamWorks, never gets that information. It just gets from the licensee "we have sold a total of X pounds".

So as an entertainment property, and I can assure you this is the case across entertainment properties, that information just is not available. So when my learned friend says there ought to be better evidence than this, I can assure you madam that the sort of evidence that you could obtain if you were trying to prove use of a soap powder brand by Tesco in the United Kingdom, it will have those data but the Hollywood studios do not.”²

50. Firstly, as all three of the marks subject to these proceedings are comparable marks (as discussed above) then evidence of use within the EU would have been acceptable for the time periods involved in these proceedings as they include time prior to IP Completion Day.

51. Secondly, the law around showing use of a mark in the UK is well established and does not require the Registered Proprietor to access information which would not be within their possession. The onus is on the Registered Proprietor to provide sufficiently

² Hearing transcript page 12

solid evidence to counter the application that it has not used the mark within the periods defined above. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Daniel Alexander Q.C. (as he was then) as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use ... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. **A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive.** By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, **the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken,** having regard to the interests of the proprietor, the opponent and, it should be said, the public”. **(My emphasis).**

52. It is not necessarily fatal to the assertion of genuine use that there is no such evidence, if the other evidence filed by the Registered Proprietor is sufficient to show that there has been a real attempt to exploit the mark in the sector.

53. I shall now assess the evidence that has been provided, grouping the goods and services in the way Mr Stone did in his skeleton argument.

Class 28:

54. Most of the evidence for the class 28 goods is either a licence agreement or amazon listings. I consider games to be another very large market in the UK. I have no sales figures save for a line from ‘Licensing Source’ dated 31 May 2017 which states that “...DreamWorks’ Trolls which sold £12million of toys...” in 2016 as mentioned above. I have no turnover figures/unit sales or marketing expenditure.

Whilst £12 million is not an insignificant figure, I note that firstly, it only relates to one year (some of which falls outside the relevant periods of use that are the focus of these proceedings).

55. Further, it refers simply to 'toys' with no further detail as to what that means. The Registered Proprietor is registered for 'games'. Mr Stone provided the following in his skeleton argument:

"The Oxford English Dictionary defines "game" as "an activity which provides amusement of fun; an amusement, a diversion, a pastime"."

56. I note that the Oxford English Dictionary defines "toy" as "something playful, frivolous, or foolish (principally with reference to abstract or immaterial things" and so, although there may be some overlap in these goods, they are not one and the same and therefore, I do not believe I can attach full weight to the single line of evidence which provides me with the generic figure.

57. I consider that there are an array of items that are referred to as games within the evidence and the only other part which points to sales being made are the 'user reviews' on the listings. The number of user reviews ranges from 89 to 1531 on the goods that might be considered games/toys and total 5294. However, these are not reliable figures as they can include reviews outside the relevant periods and also outside the relevant territory as shown below:





58. As can be seen from the above screengrabs from Exhibit CSM12, the reviews are not solely UK or the EU and include dates up to 2023.

59. I note from Mr Stone's submissions that he contends that in Exhibit CSM9 the references to pinball games would also amount to use for 'pinball machines' in class 28. I am mindful of not construing terms too widely (as per *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch)). The games within the evidence are clearly found in an online or computer game and are not the physical pinball machines which are what I consider is meant by a class 28 'pinball machine' registration.

60. Mr Stone stated that the Trolls DJ mixer, sound book and e-reader were all types of 'hand held unit for playing electronic games adapted for use with an external display screen or monitor; hand held unit for playing electronic games other than those adapted for use with an external display screen or monitor'. I believe this to be a tenuous link at best but even if that were the case, the same criticisms of the evidence apply here. I have no sales figures, no marketing figures and the review numbers are not wholly reliable.

61. Therefore, I find that the Registered Proprietor has not provided me with evidence that is sufficiently solid and specific enough to allow me to make a finding of use for the class 28 goods.

Class 9:

62. Firstly, in class 9, Mr Stone said that the term 'data processing equipment' is "wide and encompasses many items however it is essentially any equipment that accumulates, processes and stores data". He goes on to say that the Trolls electronic readers, Trolls microphones, the V-Tech Games Cartridge and the Tonies range are

all items which process, record and store sound input. I have already mentioned the *Youview* case above and remind myself again not to construe terms too widely. I believe that including microphones and game cartridges would be straining the natural meaning of the term. Even if I consider that electronic readers are a form of data processing equipment the same evidential criticisms apply as per my findings in relation to the class 28 goods.

63. For the terms 'computers; computer software' I have no evidence that the Registered Proprietor has used either the 624 mark or the 026 mark to sell 'computers' as they would be understood by the average consumer. For the software, Mr Stone references the Vtech Game in CSM11, the Trolls Tonie in CSM12, the various apps and the pinball game software. I do not believe this shows use for computer software at large as all goods are focused on children's content and games. Further, I interpret the 'Tonie' element to be indicative of the brand of the licensee. In any event, I have no figures for the number of downloads, and the only geographical information are some copyright notices indicating the UK in the relevant period.

64. The next terms referred to by Mr Stone are the 'pre-recorded video disks and DVDs featuring other entertainment programs, prerecorded optical and magneto-optical discs featuring other entertainment programs'. Firstly, there is nothing showing optical or magneto-optical discs within the evidence filed. With regards to the DVDs and video disks, the evidence does show multiple DVDs and Blue rays for sale. The Cancellation Applicant argues that there is no evidence of these goods being for things other than films and television series. Mr Stone lists various different DVDs in his witness statement and says each DVD also includes additional content such as "dance party mode", "Creating Troll Magic" together with music videos and deleted scenes. All of the examples given though are content that is additional to the movie or tv series also contained on the DVD/video disk. I believe that the average consumer would view the primary purpose (and their ultimate reason for purchasing) would be for the film/tv series itself and those extra features are ancillary. Therefore, I do not believe I can find use for these goods as registered.

65. "Interactive multi-media software for playing games; downloadable software in the nature of a mobile application for playing games for use with computers, portable

handheld digital electronic communication devices, mobile devices and wired and wireless communication devices; computer game software for wireless and electronic mobile devices, mobile phones and hand-held electronic devices; computer game discs; video game discs; computer game cartridges” is the next set of terms within the skeleton argument. There are 6 downloadable apps within the evidence provided on the face of it, launching multiple apps under the marks could be seen as an attempt to establish a market in these goods. I note that there has been no indications of sales or numbers of downloads for me to ascertain a scale of their use nor geographical spread and I also note that some of these apps were only available for short periods of time and, therefore, these apps could be seen as promotional in nature rather than an attempt to establish a sustained market. I consider that the market for downloadable apps is significant, but I have been provided with no evidence by the Registered Proprietor to assist me in understanding their market share or the level of engagement/exposure of the marks within software applications to consumers. For the term ‘computer game cartridges’ there is evidence of a singular computer game cartridge within the evidence but, as previously stated, I have been given no sales figures or geographical availability in relation to this one cartridge that contains a Trolls game and therefore, I cannot say that this is an attempt to establish a market in these goods.

66. I find that the Registered Proprietor has not provided me with evidence that is sufficiently solid and specific enough to allow me to make a finding of use for the class 9 goods.

Class 41:

67. I consider that tv series and films can both be forms of ‘entertainment’ which the Registered Proprietor has within their specification. The only goods I have been given any sales figures for is the first film which are clearly substantial (30.2 million dollars) and 5 million dollars for the first film on Blue-Ray and DVD between 2016 and 2018. Further, within the witness statement Ms Monteiro states that the television series sold 34,860 units between 2019 and 2020. I consider that the TV and Film market is a very large one and although the TV series units sold are not substantial, there is enough for it to be considered part of the market. They can also be termed as multimedia

entertainment programs which have been produced and distributed under the remaining marks.

Fair Specification

68. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

69. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

70. I have found that the only class where the Registered Proprietor has provided me with sufficient evidence to show use of the mark is Class 41: Entertainment; production and distribution of multimedia entertainment programs. This is only registered for the 624 mark.

71. ‘Entertainment’ is a very wide term and I do not consider that there is sufficient evidence provided from the Registered Proprietor to support such a wide term in its totality. I find ‘Entertainment’ would indeed include television series and films however, it could also include theatre shows, sporting and cookery activities etc. Given the Registered Proprietor has only shown use of its mark in relation to limited sub-categories of such services, the average consumer will view this as use of the mark in relation to “film and television” rather than use in relation to entertainment at large. The evidence I have found to be sufficient to show use is solely related to their films and tv series and although I am mindful not to be too prescriptive in my finding, I do consider a fair term to be ‘television and film entertainment’. I consider that this evidence is also sufficient for the Registered Proprietor to keep the term ‘production and distribution of multimedia entertainment programs’.

Conclusion:

72. The application for partial revocation in relation to mark UK916072514 is successful and the date for revocation will be 23 November 2021 for the following goods:

Class 28: Games; pinball machines; hand-held unit for playing electronic games adapted for use with an external display screen or monitor; hand-held unit for playing electronic games other than those adapted for use with an external display screen or monitor.

73. The application for partial revocation in relation to UK914554026 is successful and the date for revocation will be 6 April 2021 for the following goods:

Class 9: Data processing equipment, computers; computer software; prerecorded video discs and dvds featuring [...] other entertainment programs; prerecorded optical and magneto-optical discs featuring other entertainment programs, interactive multi-media software for playing games; downloadable software in the nature of a mobile application for playing games for use with computers, portable handheld digital electronic communication devices, mobile device and wired and wireless communication devices; computer game software for wireless and electronic mobile devices, mobile phones and hand-held electronic devices; computer game discs; video game discs; computer game cartridges.

Class 28: Games; pinball machines; hand held unit for playing electronic games adapted for use with an external display screen or monitor; hand-held unit for playing electronic games other than those adapted for use with an external display screen or monitor.

74. The application for partial revocation in relation UK914873624 to is successful in relation to the following goods and services only and the date for revocation will be 23 April 2021:

Class 9: Data processing equipment, computers; computer software; prerecorded video discs and dvds featuring [...] other entertainment programs; prerecorded optical and magneto-optical discs featuring other entertainment programs, interactive multi-media software for playing games; downloadable software in the nature of a mobile application for playing games for use with computers, portable handheld digital electronic communication devices, mobile device and wired and wireless communication devices; computer game software for wireless and electronic mobile devices, mobile phones and handheld electronic devices; computer game discs; video game discs; computer game cartridges.

Class 28: Games; pinball machines; hand held unit for playing electronic games adapted for use with an external display screen or monitor; hand held unit for playing electronic games other than those adapted for use with an external display screen or monitor.

75. I consider that the Registered Proprietor has shown genuine use for the following services for UK914873624 and it therefore remains registered for the following, together with the unchallenged goods and services:

Class 41: Television and film entertainment; production and distribution of multimedia entertainment programs.

76. The above findings are subject to any successful appeal.

Costs

77. The Cancellation Applicant has been wholly successful in two of the revocations and largely successful in the third. Therefore, it is entitled to a contribution to its costs based upon the scale published in Tribunal Practice Notice 1/2023 (as the proceedings commenced after 1 February 2023). In the circumstances, I award the Cancellation Applicant the sum of £3100. The sum is calculated as follows:

Official fee x3	£600
Preparing applications for revocation and considering the other side's statements	£500
Considering and commenting on the other side's evidence	£1000
Preparing for and attending a hearing	£1000
Total	£3100

78. I therefore order DREAMWORKS ANIMATION L.L.C.to pay PLAY'N GO MARKS LTD the sum of £900. The above sum should 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 30th day of June 2025

L Nicholas
For the Registrar