

O/0707/25

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NUMBER 1780799

DESIGNATING THE UK

IN THE NAME OF GEOBRA BRANDSTÄTTER STIFTUNG & CO. KG  
FOR THE FOLLOWING TRADE MARK:

***ACTION*HEROES**

IN CLASS 9, 16, 28 AND 38

AND

IN THE MATTER OF FAST TRACK OPPOSITION

THERE TO UNDER NUMBER 600003385

BY FABRICAS AGRUPADAS DE MUÑECAS DE ONIL, S.A.

## **BACKGROUND & PLEADINGS**

1. Geobra Brandstätter Stiftung & Co. KG (“the holder”) is the holder of the International Registration shown on the cover page of this decision (“the IR”). The IR was registered on 18 December 2023 and, with effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement (“the relevant date”). The IR was accepted and published in the Trade Marks Journal for opposition purposes on 14 June 2024. The holder seeks protection in the UK for the goods and services listed in Annex 1 of this decision.
2. On 29 July 2024, the application was partially opposed under the fast-track opposition scheme by Fabricas Agrupadas De Muñecas De Onil, S.A. (“the opponent”). The opposition is brought under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed at the class 28 goods in respect of which the IR has been applied for.
3. The opponent relies upon the following mark (“the earlier mark”):



Trade mark number: UK00003712829

Filing date: 21 October 2021

Registration date: 21 January 2022

4. The opponent relies upon the following goods for which its earlier mark is registered:

**Class 28:** Trading cards for games; Toy furniture; Playhouses for children; Toy model hobbycraft kits; Toy environments for use with action figures; Playsets for action figures; Cases for play accessories; Cases for action figures; Toy plants; Toy vehicles; Animal replicas as playthings; Toy animals; Collectable toy figures; Toy action figurines; Toy figures; Dolls; Toy models.

5. The opponent claims that the marks are similar, and the goods are identical or similar, with the result that there is a likelihood of confusion.
6. The holder filed a counterstatement denying the claims made against it. Whilst the holder acknowledged a similarity between some of its class 28 goods and the earlier mark's class 28 goods, the holder denied that "there would be any likelihood of confusion or association in the minds of the public for the purposes of Section 5(2)(b)".
7. Rule 6 of the Trade Marks (Fast Track Opposition (Amendment) Rules 2013, S.I. 2013 2235 disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but it provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:  
  
“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”
8. The effect of the above is to require parties to seek leave in order to file evidence in fast track oppositions. Further, Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it, or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.
9. The opponent is represented by Haseltine Lake Kempner LLP. The holder is represented by Marks & Clerk LLP. In this case, neither party sought leave to file evidence. No hearing was requested, and only the holder filed written submissions in lieu of a hearing. This decision is therefore taken following a

careful consideration of the papers that have been filed by the parties, which will not be summarised but will be referred to as and where appropriate during this decision.

10. 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.

## **DECISION**

### Section 5(2)(b)

11. The opposition is based upon section 5(2)(b) of the Act which stipulates the following:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

12. Section 5A of the Act stipulates that 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.”
13. Given its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years prior to the designation date of the IR, it is not subject to the use provisions in section 6A of

the Act. Consequently, the opponent can rely upon the full breadth of its specification.

14. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*,<sup>1</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (“Canon”),<sup>2</sup> *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*,<sup>3</sup> *Marca Mode CV v Adidas AG & Adidas Benelux BV*,<sup>4</sup> *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (“OHIM”),<sup>5</sup> *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,<sup>6</sup> *Shaker di L. Laudato & C. Sas v OHIM*<sup>7</sup> and *Bimbo SA v OHIM*<sup>8</sup>:
- 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 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 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

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<sup>1</sup> Case C-251/95

<sup>2</sup> Case C-39/97

<sup>3</sup> Case C-342/97

<sup>4</sup> Case C425/98

<sup>5</sup> Case C-3/03

<sup>6</sup> Case C-120/04

<sup>7</sup> Case C-334/05P

<sup>8</sup> Case C-591/12P

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 may be offset by a greater degree of similarity between the marks, and vice versa;
- h. there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- i. mere association, in the strict sense that the later mark brings 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 services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of Goods**

15. The competing goods are as follows:

The opponent's goods	The holder's goods
<p><u>Class 28:</u> Trading cards for games; Toy furniture; Playhouses for children; Toy model hobbycraft kits; Toy environments for use with action figures; Playsets for action figures; Cases for play accessories; Cases for action figures; Toy plants; Toy vehicles; Animal replicas as playthings; Toy animals; Collectable toy figures; Toy action figurines; Toy figures; Dolls; Toy models.</p>	<p><u>Class 28:</u> Games; toys; playthings, in particular toy figures, accessories for toy figures, sets of toy figures and accessories, in particular the aforesaid goods of plastic; card games; playing cards; knee and elbow guards (sporting articles); kites; scooters [toys]; bags adapted for use with sporting equipment, namely golf bags, cricket bags, tennis bags; balloons (toys); streamers; roller skates; inline roller skates; decorations for Christmas trees; computer games being auxiliary devices for television sets; video game consoles being auxiliary devices for television sets; confetti; mobiles.</p>

16. As a preliminary point, it should be noted that section 60A of the Act provides that goods are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification<sup>9</sup>, or dissimilar on the ground that they appear in different classes under the Nice Classification.”
17. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated (at paragraph 23) that, when making the comparison, “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”.

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<sup>9</sup> “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957.

18. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case<sup>10</sup>, for assessing similarity were:
- a. The uses of the respective goods;
  - b. The users of the respective goods;
  - c. The physical nature of the goods;
  - d. The respective trade channels through which the goods 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 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 in the same or different sectors.
19. As per the case of *Separode*,<sup>11</sup> I also bear in mind that it is permissible to group the goods together, for the purpose of comparison, where they are sufficiently comparable to be assessable in essentially the same way for the same reasons.
20. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*,<sup>12</sup> that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

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<sup>10</sup> [1996] R.P.C. 281

<sup>11</sup> BL O/399/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person

<sup>12</sup> Case T- 133/05

“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”.

#### Games; Card games; Playing cards

21. It is noted that the holder has admitted that there is similarity between the holder’s “Games”, “card games” and “playing cards” and the opponent’s goods, but the holder fails to identify which of the opponent’s goods it considers are similar. In any event, I am of the view that these terms are identical on the principle outlined in *Meric* to “trading cards for games” from the opponent’s specification.

#### Toys

22. It is also noted that the holder has admitted that there is similarity between the holder’s “toys” and the opponent’s goods, but the holder has failed to identify which of the opponent’s goods it considers to be similar. In any event, I am of the view that the opponent’s “toy furniture”, “toy vehicles”, “toy animals”, “toy actions figurines”, “toy figures” and “toy models” would all fall within the holder’s wider term of “toys”. Consequently, I consider all of the aforementioned goods to be identical in line with the *Meric* principle.

#### Playthings, in particular toy figures, accessories for toy figures, sets of toy figures and accessories, in particular with the aforesaid goods of plastic

23. It is noted that the holder has admitted that there is similarity between the above referenced goods and the opponent’s goods, but, once again, the holder has failed to identify which of the opponent’s goods it considers to be similar. In any event, I note that the opponent’s specification includes “toy figures”, and I am of the view that toy figures would fall within the holder’s wider term “Playthings, in particular toy figures, accessories for toy figures, sets of toy figures and

accessories, in particular with the aforesaid goods of plastic.” Consequently, I consider the aforementioned goods to be identical in line with the *Meric* principle.

Bags adapted for use with sporting equipment, namely golf bags, cricket bags, tennis bags

24. It is noted that the opponent’s specification contains “Cases for play accessories” and that the holder’s specification contains “bags adapted for use with sporting equipment, namely golf bags, cricket bags, tennis bags”. I consider that “play” would incorporate sporting activities and, consequently, “play accessories” would include accessories for sporting activities such as cricket bats, tennis rackets and golf clubs. In light of the above, I do consider that the holder’s term “bags adapted for use with sporting equipment, namely golf bags, cricket bags, tennis bags” would fall within the opponent’s wider term “cases for play accessories”, and that these terms are therefore identical in line with the *Meric* principle.
25. However, if I am wrong in the above determination, and golf bags, cricket bags and tennis bags are not found to be identical to “cases for play accessories”, I find these goods to be similar to a high degree. This is because I consider these goods to have the same purpose (i.e., to transport accessories for activities for entertainment purposes). I also consider there to be an overlap in the users of these goods, i.e., members of the general public partaking in physical activities for entertainment purposes. Whilst I am conscious that the opponent’s term “cases for play accessories” could incorporate a diverse range of goods, I also consider there to be an overlap in trade channels as “cases for play accessories” and, for example, cricket bags and tennis bags would all be available to purchase from toy shops (particularly where they are sporting goods aimed at children). The goods are also likely to overlap in nature and method of use, all being bags that are used for storing items and likely to be made from the same materials.

Balloon (toys)

26. I note that the term “balloon” in the holder’s specification is qualified as a toy balloon, as opposed to a decorative balloon. On this basis, I consider there to be

an overlap in purpose (i.e., for entertainment) and user (i.e., members of the general public) between toy balloons and the goods in the opponent's specification. I also note that toy balloons would be available to purchase in toy retailers, and therefore that there is an overlap in trade channels with the goods in the opponent's specification. Further, I consider there to be a level of competition between toy balloons and the goods in the opponent's specification as a purchaser may opt to purchase a toy balloon over some of the other types of toys contained in the opponent's specification (for example, if they are purchased by a parent looking to entertain their child for a period of time). However, I recognise that any competition is limited, as it is more likely to be between different toys within the same category (e.g. different action figures). However, the nature of balloon toys is entirely different to that of the goods in the opponent's specification, and I also do not consider there to be any complementarity between these goods as these goods are neither important nor indispensable from one another.<sup>13</sup>

27. Considering all of the above, I find the holder's toy balloons to be similar to a medium degree to the goods in the opponent's specification.

### Mobiles

28. I note that the parties have failed to provide any submissions regarding the similarity, or lack thereof, between mobiles, which I understand to be cot mobiles, and the goods in the opponent's specification. I note that there is an overlap in users and general purpose between "mobiles" and some of the goods in the opponent's specification (specifically "toy animals", which I consider could include soft toy animals) on the basis that these may all be purchased for the entertainment of infants, albeit I acknowledge that these goods are purchased to entertain infants in different settings (i.e., either inside or outside of the infants cot). I also acknowledge that mobiles and the goods in the opponent's

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<sup>13</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

specification may both be purchased from toy retailers, albeit I consider that these would be available in separate sections of those retailers.

29. However, there is a clear difference in nature and method of use between mobiles and the opponent's goods, and I do not consider there to be any competition between the goods. This is because cot mobiles are used to entertain/soothe infants whilst they are in their cot and the opponent's goods are toys which would be used solely for the purpose of entertaining infants whilst they are outside of the cot. Consequently, I do not consider that you would purchase one as an alternative to the others, and I also do not consider there to be any complementarity between these goods as they are not indispensable or important for one another.
30. Considering all of the above, I find the holder's "mobiles" to be similar to a low to medium degree to the opponent's goods.

Computer games being auxiliary devices for television sets; video games consoles being auxiliary devices for television sets

31. I note that the parties have failed to provide any submissions regarding the similarity, or lack thereof, between the above referenced goods and the opponent's goods. Having said that, I note that the above referenced goods and the opponents' class 28 goods (such as trading cards for games and toy model hobbycraft kits) would be purchased for entertainment purposes. However, the specific purposes differ (being different types of entertainment). I also consider that there would be an overlap in the users of the above referenced goods and the opponent's goods (i.e., members of the general public looking for entertainment). I also note that the above referenced goods and the opponent's goods would be available from toy retailers, and therefore that there is an overlap in trade channels. However, I recognise that they are likely to be sold in different sections of such retailers.
32. I am also conscious that the above referenced goods differ in nature to the opponent's goods because they are electrical goods, and I therefore do not

consider there to be any real competition between these goods. I also do not consider that there is any complementarity between the goods as I do not consider the goods to be important or indispensable for the other. Having considered all of the above, I find the above referenced goods to be similar to a low degree to the opponent's goods.

Kites; Scooters [toys]; roller skates; inline roller skates;

33. I also note that the parties have failed to provide any submissions regarding the similarity, or lack thereof, between the above referenced goods and the goods in the opponent's specification. I once again consider that the above referenced goods have the same purpose as the opponent's goods (i.e., entertainment), and that there may be an overlap in user and trade channels (i.e., members of the public looking for entertainment and toy retailers, albeit I consider that these goods would be sold in different sections of the same retailers). However, once again, the specific purposes differ, particularly as the holder's goods are (at least in part) for transportation, as do the methods of use, and I do not consider there to be a complementary relationship between the goods as the goods are neither important nor indispensable for the other. I also note that the goods differ in nature, and I do not consider there to be any competition between the goods as I do not believe the average consumer would purchase any of the above referenced goods in the place of the opponent's goods. Consequently, I consider the goods to be similar to a low degree.

Knee and elbow guards (sporting articles);

34. I cannot see any basis for a finding of similarity between the above referenced goods and the goods in the opponent's specification, nor have I been provided with any submissions from the parties on this point.

35. The goods in the opponent's specification are all purchased for the purpose of entertainment, whereas the purpose of knee and elbow guards is to provide support/safety to users during physical activity. As a consequence, I do not consider there to be any competition between the goods. However, I accept that

there may be some very general overlap in users (i.e., members of the general public). Whilst I note this overlap, I am conscious of the judgment of Iain Purvis KC in *Unicorn Studio Inc v Veronese*<sup>14</sup> in which he stipulated that “any finding of similarity in the end requires the exercise of common sense and requires the hearing officer to stand back and consider the overall question” rather than by engaging “in a box-ticking exercise, asking how many of the factors identified in *TREAT* or in *Canon* could be said to have been satisfied”.

36. Further, I consider that knee and elbow guards would generally be purchased from sports retailers, whereas the opponent’s goods would be purchased from toy retailers. The respective trade channels and method of use for these goods therefore differ. I also do not consider there to be a complementary relationship between the goods as none of these goods are important or indispensable for the other.
37. In the light of the above, I find the above reference goods to be dissimilar to the opponent’s class 28 goods.

Decorations for Christmas trees; streamers; confetti

38. I also cannot see any basis for a finding of similarity between the above referenced goods and the opponent’s goods, and I note that I have not been provided with any submissions that would support such a finding.
39. I note that there is a clear difference in purpose between the opponent’s goods, which are purchased purely for entertainment purposes, and the above referenced goods, which are purchased for decorating purposes. Whilst there would be an overlap in the user of these goods, I am again conscious of the judgment of Iain Purvis KC in *Unicorn Studio Inc v Veronese*<sup>15</sup> referenced in paragraph 35 above, and consider any overlap in user to be at a very general level. There is also no level of competition between these goods and the

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<sup>14</sup> [2024] EWHC 1098 (Ch) - paragraph 24

<sup>15</sup> [2024] EWHC 1098 (Ch) - paragraph 24

opponent's goods, given the differing purpose. Plainly, the method of use and nature of the goods would also differ, and there is no complementarity between the goods as they are not important or indispensable for each other.

40. In the light of the above, I do not find any similarity between the above referenced goods and the goods in the opponent's specification.
41. As some degree of similarity between the goods is required for a successful claim under section 5(2)(b) of the Act, the opposition must fail in respect of those goods in paragraphs 34 to 40 that I have found to be dissimilar.<sup>16</sup>

### **Average consumer and the purchasing act**

42. 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. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question (see *Lloyd Schuhfabrik Meyer*<sup>17</sup>).
43. 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*,<sup>18</sup> Birss J. held:

“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.

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<sup>16</sup> *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

<sup>17</sup> Case C-342/97

<sup>18</sup> [2014] EWHC 439 (Ch)

The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

44. In respect of the goods at issue, I find that the average consumer will be members of the general public. Most of the goods in issue will be sold in retail outlets through self-selection or from their online equivalents. The purchasing process for all of the goods will therefore be dominated primarily by visual considerations, but I do not discount that aural considerations will also play a part as advice may be sought from sale assistants or through verbal recommendations.
45. The goods in question and the frequency of purchase will vary quite considerably, from card games and toy figures, which will be very low in price and may be purchased more regularly, to the roller skates and games consoles, which will be much more expensive, and are likely to be purchased as a one-off item. However, for all of the goods in issue, I consider that the average consumer will consider factors such as price, quality, longevity and age appropriateness/suitability of the goods during the purchasing process. For the low value goods, I find that the average consumer will pay a medium degree of attention during the purchasing process, and that a higher level of attention will be paid by the average consumer during the purchasing process for the higher value goods.

### **Comparison of marks**

46. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*,<sup>19</sup> that:

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<sup>19</sup> Case C-591/12P

“.....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.”

47. It would be wrong, therefore, to dissect the trade marks artificially, 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.

48. The respective trade marks are shown below:

Earlier mark	IR
	

**Overall Impression**

49. The earlier mark consists of the words “Action Heroes”, with the word “action” in a blue font with a white outline, and the word “heroes” in a slightly larger red font with a white outline. Through the centre of the “O” in “heroes” is an orange lightning bolt, and the word action is stacked immediately above the word heroes.

50. The words “Action Heroes” are positioned on top of what appears to me to be a pentagonal shaped yellow plaque with a blue outline, and what appears to me to

be three mounting holes. I note the holder's submissions that the words "Action Heroes" are "entirely descriptive" for the goods in question, that "action figures" are "referenced explicitly in the Opponent's class 28 specification as a discrete category of products", and that it is "an established practice for the launch of dedicated merchandise to accompany the release of films, shows or books that such protagonists often form the basis, nature and subject matter of associated toy products in class 28, particularly goods such as models, figures and "toy action figurines" designed in the likeness of such protagonists". I agree that the words "action heroes" are descriptive of the opponent's goods for the reasons highlighted above by the holder. Consequently, I consider them to be non-distinctive and that the overall impression is, therefore, dominated by the stylisation of the mark.

51. The IR is also made up of two words which I consider that the average consumer would identify as the words "Action Heroes", although the "I" in "Action" is replaced with an exclamation mark. These words are positioned side by side, albeit the word "Action" is positioned slightly higher than the word "Heroes".
52. Whilst I accept that, for the same reasons outlined above, the words "Action Heroes" could be considered descriptive of some of the goods in the holder's specifications (specifically, the toy figures, playing cards and computer games), I do not consider them to be descriptive of the majority of the goods in the holder's specification.
53. For those goods for which I have found ACTION HEROES to be descriptive, the stylisation/presentation of the mark will be the dominant and distinctive element. For those goods for which the words are not descriptive, it is the words themselves that will play the greater role, with the stylisation/presentation of the mark playing a lesser role.

### **Visual Comparison**

54. Visually, as outlined above, there are presentational differences in the way the words are stylised and positioned. Specifically, the earlier mark also has two

devices (the device reminiscent of a plaque and the lightning bolt) which are not present in the IR.

55. Having said that, whilst I note that the “I” in “Action” is replaced with an exclamation mark, I consider the average consumer would identify both marks as sharing the same two words (“Action Heroes”). For the reason identified in paragraph 50 above, I consider the stylisation of the earlier mark to be the dominant element, and as these stylistic elements are not present in the IR, I consider the marks to be visually similar to a low to medium degree.

### **Aural Comparison**

56. Whilst I acknowledge that the “I” in “Action” in the IR has been replaced with an exclamation mark, I consider that it would still be identified as the words “Action Heroes”. As, I consider the words “Action Heroes” to be the only pronounceable element of both marks, I find the marks to be aurally identical.

### **Conceptual Comparison**

57. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU, including *Ruiz Picasso v OHIM*.<sup>20</sup> The assessment must, therefore, be made from the point of view of the average consumer.
58. As outlined above, I consider that the average consumer would find that both marks contain the words “Action Heroes”. These are standard English dictionary words; “Heroes” is the plural term for a “Hero”, which is someone that is admired for being exceptionally brave or achieving something great, and an action hero is a reference to a hero in an action story. I consider this to be the conceptual meaning that an average consumer would attribute to both of the marks. Whilst I note that there are other stylisation/device elements in the marks, these will not convey any particular conceptual message over and above the meaning of the

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<sup>20</sup> [2006] ECR I-643; [2006] E.T.M.R

words. Consequently, the marks share an identical conceptual message. However, I bear in mind that this message will not be distinctive for all of the opponent's goods and some of the holder's goods.

### **Distinctive character of the earlier trade mark**

59. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49)

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

60. Distinctiveness is a scale along which marks of various types sit. A mark which is allusive of the goods will have less distinctive character than one that is not; dictionary words will also be less distinctive than words which are entirely fanciful. However, all will turn on the particular facts. For example, there are “invented” words which are really just composites of two allusive words and only distinctive as a result, and dictionary words which are more or less common than others.

61. Whilst the distinctiveness of a mark may be enhanced as a result of it having been used in the market, in this instance the opponent has filed no evidence of use. Consequently, I have only the inherent position to consider.
62. In this instance, the earlier mark is made up of the words “Action Heroes”, which I consider would be given their ordinary dictionary meaning. As noted in paragraph 58 above, “Heroes” is the plural term for a “Hero”, which is someone that is admired for being exceptionally brave or achieving something great, and an action hero is a reference to a hero in an action story. The words are stylised and the earlier mark also features colour and two devices (as discussed above).
63. I note that the opponent has provided no submissions regarding the distinctiveness, or lack thereof of the earlier mark. In any event, for all of the reasons outlined above, I find the words “Action Heroes” to be non-distinctive for the goods in the opponent’s specification. This is important because it is the distinctiveness of the common element which is key: In *Kurt Geiger v A-List Corporate Limited*,<sup>21</sup> Mr Iain Purvis KC as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark

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<sup>21</sup> BL O/075/13

alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

64. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.
65. That being said, I am required to attribute at least some distinctiveness to the earlier mark by virtue of it being registered.<sup>22</sup> Indeed, the presentation of the words is quite striking (with the use of colour, lightning bolt and plaque device all contributing to the distinctiveness of the mark). It is, therefore, in the presentation of the words that the distinctiveness of the earlier mark resides. I find it to be inherently distinctive to between a low and medium degree.

### **Likelihood Of Confusion**

66. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related.
67. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*<sup>23</sup>). 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 vice versa (see *Canon*<sup>24</sup>). It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods, and the nature of the purchasing process. In doing so, I must be alive to the fact that the average

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<sup>22</sup> See section 72 of the Act.

<sup>23</sup> C-251/95, para 22

<sup>24</sup> C-39/97, para 17

consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

68. I have found that the parties' goods vary from being identical to similar to a low degree (except where I have found them to be dissimilar). In addition, I have found that the marks are visually similar to a low to medium degree, and aurally and conceptually identical. Though, I have found the earlier mark to have between a low and medium degree of inherent distinctive character.
69. I have identified that the average consumers of the goods would be members of the general public. I have also found that the average consumer will pay either a medium or high degree of attention during the purchasing process, and that the purchasing process for all of the goods in issue would be primarily visual in nature, although I do not discount aural considerations.
70. Weighing up all of the above and notwithstanding the principle of imperfect recollection, I consider that there are sufficient visual differences between the marks to avoid them being mistakenly recalled as each other, particularly given that I have determined that at least a medium level of attention will be paid by the average consumer during the purchasing process. Whilst the marks are aurally identical, the purchase is mainly visual and I am of the view that the stylisation of the earlier mark (which is not present in the IR, and which I have determined to be the dominant element of the earlier mark) will enable the average consumer to differentiate between them. As the common words ACTION HEROES are descriptive/non-distinctive, the presentational differences between the marks will take on greater significance for the average consumer than they otherwise might.<sup>25</sup> The presentational/stylisation elements of the marks are entirely different.

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<sup>25</sup> See the decision of Dr Brian Whitehead, sitting as the Appointed Person in *ECO CABLE*, BL O/0564/25

71. In the light of the above, I do not consider there to be a likelihood of direct confusion.
72. Accordingly, I will go on now to consider whether the average consumer, having recognised that the marks are different, considers the common element of both marks (the words “Action Heroes”) and determines, through a mental process, that the marks are related and originate from the same, or an economically linked undertaking.
73. Indirect confusion was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:<sup>26</sup>

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

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.

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<sup>26</sup> BL O/375/10

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).”

74. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,<sup>27</sup> Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria*,<sup>28</sup> where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

75. During the course of this decision, I have explained that the common element “Action Heroes” makes the marks conceptually identical, but that the conceptual message conveyed is descriptive/non-distinctive. Further, I have found that the earlier mark has only between a low and medium degree of inherent distinctive character and that this arises from its presentation, rather than the words themselves. In *Face2FaceHR Partners Limited v Peninsula Business Services Limited*, O/0368/23, Emma Himsworth K.C., sitting as the Appointed Person, reviewed the case law in *Whyte and Mackay v Origin* [2015] EWHC 1271 (Ch) and *Nicoventures Holdings Limited v The London Vape Co Ltd* [2017] EHC 3303 (Ch), as well as guidance in the Common Communication on the Common

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<sup>27</sup> [2021] EWCA Civ 1207

<sup>28</sup> O/219/16

Practice of Relative Grounds of Refusal - Likelihood of Confusion (impact of non-distinctive/weak components) dated 2 October 2014, which is referred to in the case law. Miss Himsworth summarised the correct approach when assessing the likelihood of confusion where the only common element between the marks in issue has no or low distinctiveness as follows, at paragraph 44:

“(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.

(2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.

(3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.

(4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.

(5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.

(6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical.”

76. For the reason outlined above, I consider that the words “Action Heroes” would be understood by the average consumer to hold meaning in relation to the goods at issue. Thus, it is far more likely that it will be seen as a coincidence that two entities incorporate the words “Action Heroes”: it is not so strikingly distinctive that consumers would assume that the IR is a variant of the earlier mark. The overall visual appearances of the marks in terms of the devices/stylisation are different. They do not look like natural brand variants. The differences between the marks are enough, in my view, for the consumer not to be confused, and for the average consumer to determine that the IR is simply another undertaking

using the words “Action Heroes”, unrelated to the opponent. I do not therefore consider that there is a likelihood of indirect confusion.

77. I am fortified in this finding by the words of Lord Simonds in *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39, in which he stated that:

“Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

## **CONCLUSION**

78. The opposition fails in its entirety and, subject to any successful appeal of my decision, the application may proceed to registration for all goods.

## **COSTS**

79. As the holder has been successful it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Note 1/2023. In the circumstances, I award the holder the sum of £600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a Counterstatement and considering the Notice of Opposition:	£250
Preparing submissions-in-lieu of a hearing:	£350
<b><u>Total:</u></b>	<b><u>£600</u></b>

80. I therefore order Fabricas Agrupadas De Muñecas De Onil, S.A. to pay Geobra Brandstätter Stiftung & Co. KG the sum of £600. The above sum should be paid

within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 31<sup>st</sup> day of July 2025**

**B Hartland**

**For the Registrar**

## **Annex 1**

**Class 9:** Sound, audio, visual and audio-visual recordings and/or content, downloadable or recorded from computers and communications networks, including the internet and the world wide web; exposed cinematographic films; films, recorded; films, exposed; cinematographic films; animated cartoons; interactive entertainment programmes recorded on data carriers; video games recorded on data carriers; recorded DVDs, video cassettes and data carriers containing animated films; recorded audio, video, audio-visual and data carriers of all kinds; magnetic data carriers; apparatus for recording, transmission or reproduction of sound and images; sound recording carriers; sound transmitting apparatus; television apparatus; remote control devices; remote control of signals; cameras; cinematographic apparatus; cameras [photography]; cassette players; radios; laptop computers; computer mouses; monitors; mousepads [mousemats]; loudspeakers; compact disc players; compact discs; chips; encoded chip cards and data storage apparatus with games and films recorded thereon; chip cards and other storage media with embroidery patterns recorded thereon; peripherals adapted for use with computers; software; computer and video games software; games on data carriers; software for video game consoles being auxiliary devices for television sets; computer keyboards; data processors; diskettes; floppy disk drives; videotapes; video game floppy disks; video game cartridges; intercommunication apparatus; electronic notice boards; electronic pens for electronic screen devices; protective helmets; helmets for bicycles; holograms; calculators; pocket calculators; telephones; temperature indicating apparatus; bags to be attached to belts, adapted for mobile telephones or apparatus for reproduction of sound or images; cases especially made for photographic apparatus and instruments; flashlights for photographic apparatus; sandglasses; figures with RFID chips or RFID tags as credentials for downloading of audio, video and audiovisual data.

**Class 16:** Printed matter; paper and cardboard; bookends; jig-saw templates; gift tags; flags and pennants of paper; writing paper; window stickers; photographic albums; photograph boxes; wooden stamps; calendars; postcards; gift wrap paper; bookmarkers; rubber erasers; crayons; pencils; felt pens; ball pens; fountain pens; exercise books; ink pads; collection folders; ring binders; box files; writing pads; art pads; picture books; expanding files; pencil tubs; pencil cups; pencil sharpeners; pen

cases; poetry albums; craft sheets; sharpeners; invitation place cards; wall planners; desk pads; handicraft articles for hobby embroidery, namely embroidery instructions; embroidery kits consisting of embroidery patterns; embroidery template booklets; sealing stamps; bibs of paper; tear-off calendars; rub down transfers; folders for papers; document files [stationery]; scrapbooks; announcement cards (stationery); stickers [stationery]; stickers; desktop cabinets for stationery [office requisites]; paperweights; pictures; paper sheets; pencil holders; pencil sharpeners, electric or non-electric; pads [stationery]; book binders; office requisites (except furniture); paper-clips; comic books; wrappers [stationery]; labels not of textiles; tickets; paint boxes; penholders; paper maché figurines; song books; greeting cards; stands for pens and pencils; manuals [handbooks]; writing or drawing books; binders; envelopes [stationery]; cards; trading cards; containers for stationery (office requisites); catalogues; writing chalk; drafting rulers; paper punchers; notebooks; files; wrapping paper; stationery; paper handtowels; handkerchiefs of paper; paper bags; pastel crayons; paint brushes; desktop planners; prospectuses; indexes; stencil plates; boxes of cardboard or paper; signboards of paper or cardboard; pencil boxes; writing sets; writing instruments; document portfolios; table napkins of paper; table mats [included in this class]; adhesive tape dispensers; cases for stamps; writing slates; tickets; ink pencils; tablecloths of paper; hygienic paper; plastic film for packaging; sheets of reclaimed cellulose for wrapping; packaging materials made of cardboard; packaging material made of starches; handwriting specimens for copying; blackboards; drawing materials; sketch pads; books, in particular children's books, books, ring binders, colouring books, comic books, picture books; magazines.

**Class 28:** Games; toys; playthings, in particular toy figures, accessories for toy figures, sets of toy figures and accessories, in particular the aforesaid goods of plastic; card games; playing cards; knee and elbow guards (sporting articles); kites; scooters [toys]; bags adapted for use with sporting equipment, namely golf bags, cricket bags, tennis bags; balloons (toys); streamers; roller skates; inline roller skates; decorations for Christmas trees; computer games being auxiliary devices for television sets; video game consoles being auxiliary devices for television sets; confetti; mobiles.

**Class 38:** Audiovisual communication services; radio and television broadcasting services; broadcasting of video films; providing access to telecommunication

networks; transmission of data, sound and images by telecommunication; transmission of information via national and international networks; interactive telecommunications services; electronic network communications; streaming of audio, visual and audiovisual material via a global computer network; rental of access time to data, databases, computer networks and central computers; providing access to data processing programs via the internet; providing access to data processing programs via local computer networks; providing access to online games.