

O/0890/25

**SUPPLEMENTARY DECISION**

**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**

1. On 31 July 2025, a decision in the above opposition proceedings was published under reference number BL O/0707/25 (“my decision”). The outcome of my decision was to dismiss the opposition filed by Fabricas Agrupadas De Muñecas De Onil, S.A. (“the opponent”). As a result, subject to any successful appeal, I determined that the International Registration (“IR”) shown on the cover page of this decision may proceed to registration in its entirety.
2. Following the issuance of my decision, it has been brought to my attention that I did not have all the papers filed in these proceedings before me when reaching that decision. Whilst I reference at paragraph 9 of my decision that only the holder filed written submissions in lieu of a hearing in these proceedings, it transpires that the opponent also filed final written submission in lieu of a hearing on 15 January 2025, which, by way of a procedural irregularity, did not make it onto the relevant file. These submissions were therefore not considered within my decision. The opponent has therefore requested that my decision be reconsidered based on all of the papers filed, and I agree that it is reasonable and proper in the circumstances to review my decision, having regard to the full complement of papers filed. Whilst I do not consider it appropriate to set aside my decision in its entirety, I issue this supplementary decision in accordance with Rule 74 of the Trade Mark Rules 2008 in order to rectify the procedural irregularity that has occurred.
3. For ease of reference, unless indicated otherwise, I will adopt the same defined terms specified in my decision in this supplementary decision.

## **SUPPLEMENTARY DECISION**

4. The opponent’s final submissions are 7 pages long and are broken down into consideration of the following subheadings:
  - (i) Comparison of Marks;
  - (ii) Comparison of Goods;
  - (iii) Distinctive Character of the Earlier Mark; and
  - (iv) Likelihood of Confusion.

5. For ease of reference, I will adopt the same subheadings in this supplementary decision.

### **Comparison of Marks:**

6. It is noted that the opponent submits that the respective marks are similar to a high degree overall. Specifically, the opponent is of the view that the average consumer would identify both the earlier mark and IR as containing the words “Action Heroes”. On this basis, the opponent submits that “the respective marks overlap entirely in their dominant and distinctive elements, namely the words “ACTION HEROES”. In support of this assertion, the opponent submits that there is an “accepted principle derived from case law that the relevant consumer’s eye is naturally drawn to the element of trade marks that can be read, i.e., the verbal elements” and that, “Applying the principle that the average consumer takes note primarily of the verbal elements of the mark, the dominant and distinctive parts of both respective marks must therefore be the words “ACTION HEROES””, as these “are the only elements in the respective marks which are capable of being verbalised and would therefore be remembered.”
7. If I had reviewed the opponent’s submissions prior to reaching my decision, I would, of course, have accepted the general principle that the average consumer’s attention is drawn to the word element of a mark and that this may result in the word being the dominant element. However, I am also conscious of the finding of the Court of Justice of the European Union in *L&D SA v OHIM*,<sup>1</sup> that “case-law does not in any way show that, in the case of mixed trade marks comprising both graphic and word elements, the word elements must systematically be regarded as dominant.”
8. The general principle does not apply in every case and, for the reasons given in my decision at paragraphs 50 to 53, I consider the words “action heroes” to be descriptive of the opponent’s goods and some of the goods in the holder’s

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<sup>1</sup> [2008] E.T.M.R. 62

specification (namely, the toy figures, playing cards and computer games). As a consequence, I found that the stylisation/presentation of the mark is the dominant and distinctive element for some of the goods (whilst, for others, it would be the words that play the greater role). Nothing in the opponent's submissions has changed my determination on the distinctive/dominant element of the marks in issue.

9. With regard to any visual similarity, the opponent submits that the marks are visually similar to a medium degree. Whilst I note that the opponent has sought to identify some commonality between the stylisation of the marks in issue (namely the approximate size and style of block capital letters, and the positioning of the word "HEROES" at a lower level than "ACTION"), I note that the marks differ in terms of stylisation quite considerably (i.e., in respect of the devices they incorporate and their respective colour), and I do not accept that the positioning of the words "ACTION" and "HEROES" in the relevant marks is similar. As outlined in paragraphs 49 and 51 of my decision, in the earlier mark the word action is stacked immediately above the word heroes, and in the IR the words are positioned side by side, albeit the word "Action" is positioned very slightly higher than the word "Heroes". Whilst I have reviewed the opponent's submissions in this regard, there is nothing in the submissions that change my view on visual similarity of the marks.
10. The opponent submits that the marks in issue are aurally and conceptually identical. I found the marks to be aurally and conceptually identical in my decision. As such, I need say no more about the submissions on aural/conceptual similarity.
11. For all of the reasons outlined above, despite giving due consideration to it, nothing in the opponent's submissions changes my determination on the similarity, or lack thereof, of the respective marks.

## Comparison of Goods:

12. I note that the opponent has submitted that all of the goods in the holder's specification are either identical, or similar to between a low and high degree to the goods in the opponent's specification. Within its submissions the opponent grouped together the goods it deemed identical, the goods it deemed highly similar and the goods it considered to be similar to a low/medium degree. I have now given due consideration to these submissions and those consideration are outlined below. For ease of reference, I have addressed all of the goods in the same groups adopted by the opponent in its submissions.

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; scooters [toys]; balloons (toys)

13. The opponent has submitted that the above goods are either self-evidently identical to the holder's goods, or are identical to the goods in the holder's specification under the principle of *Meric*<sup>2</sup> on the basis that they are either explicitly qualified as being "[toys]" or are broader terms within which the protected goods in the holder's specification are contained.
14. As a preliminary point, it is noted that the opponent's specification does not contain the general category of "toys". Whilst I accept that the "scooters" and "balloons" in the holder's specification are qualified as toys, I do not accept that any of the goods in the opponent's specification could be considered a wider category of the goods that the holder's "scooters" and "balloons" could genuinely be seen to fall within, or vice versa. The holder's "scooters" and "balloons" cannot therefore be identical in line with the principle set out in *Meric* to any of the goods in the opponent's specification. There is nothing in the opponent's submissions that changes my determination on the similarity between the holder's "scooters" and "balloons" and the goods in the opponent's specification.

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<sup>2</sup> Gérard Meric v Office for Harmonisation in the Internal Market, Case T- 133/05, the principle of which is outlined in paragraph 20 of my decision dated 31 July 2025

15. It is noted that my findings in respect of the other goods referenced above are consistent with the submissions of the opponent. Consequently, I need say no more about it.
16. I also note that I made a primary finding that the opponent's "Cases for play accessories" were identical under the principles of *Meric* to the opponent's "Bags adapted for use with sporting equipment, namely golf bags, cricket bags, tennis bags" or, should I be wrong in that determination, highly similar.

Kites; mobiles; computer games being auxiliary devices for television sets; video games consoles being auxiliary devices for television sets

17. The opponent submits that the above referenced goods are similar to a high degree to "toys" in the holder's specification. The reason provided for this submission is that the opponent considers there to be an "overlap in their nature (playthings for entertainment), intended purpose (for entertainment and play) and users (children)". I found there to be an overlap in general purpose and users between the above referenced goods and the goods in the opponent's specification. There is nothing in the opponent's submissions that persuades me that the nature of these goods is similar.
18. Whilst I have taken the opponent's submissions into account, my findings remain unchanged.

Knee and elbow guards (sporting articles); bags adapted for use with sporting equipment, namely golf bags, cricket bags, tennis bags; roller skates; inline roller skates

19. The opponent submits that the above referenced goods are similar to at least a medium degree to the goods in the opponent's specification because they overlap in intended purpose and end user to the opponent's "playthings" and "toys". The opponent makes this submission on the basis that they consider that

goods “facilitating the playing of sports are designed for exercise as well as amusement purposes”. In particular, the opponent submits that roller skates “are a great example of how consumers goods can serve a dual purpose in facilitating exercise and amusement for children and adults”. The opponent also submits that the above referenced goods “can be purchased in sporting articles retailers as well as toy stores” and therefore overlap in trade channels, as well as target audience.

20. As a preliminary point, as outlined above, I found “bags adapted for use with sporting equipment, namely golf bags, cricket bags, tennis bags” to be identical in line with the *Merix* principle, or highly similar to the opponent’s “cases for play accessories” in my decision. Nothing in the opponent’s submissions changes my decision in that respect.
21. In respect of the holder’s “knee and elbow guards (sporting articles)”, I do not accept that the purpose of these goods is for amusement. As outlined in paragraph 35 of my decision, I found that the purpose of knee and elbow guards is to provide support/safety to users during physical activity. I also do not accept that these goods are purchased in the same stores as the opponent’s goods. Knee and elbow guards for sporting activities, as we have here, would be purchased from sports retailers, whereas the opponent’s goods will be available to purchase from toy retailers. The opponent did not file any evidence to suggest otherwise. Whilst I accept that there may be some very general overlap in user (on the basis that the user would be members of the general public), in the light of the judgment of Iain Purvis KC in *Unicorn Studio Inc v Veronese*,<sup>3</sup> which is detailed in paragraph 35 of my decision, I remain of the view that the holder’s “knee and elbow guards (sporting articles)” are dissimilar to the goods in the opponent’s specification.
22. In respect of the holder’s “roller skates” and “inline roller skates”, I accept the opponent’s submission that there is an overlap in general purpose, user and trade channels with these goods and the goods in the opponent’s specification.

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<sup>3</sup> [2024] EWHC 1098 (Ch)

However, I remain of the view that the specific use of these goods differs to that of the opponent's goods, that these goods differ in nature and method of use, and that there is no competition between these goods, nor are they complementary to one another, as detailed in paragraph 33 of my decision. There is nothing in the opponent's submissions that persuades me otherwise and I remain of the view that the holder's "roller skates" and "inline roller skates" are similar to a low degree to the goods in the opponent's specification.

Streamers; confetti; decorations for Christmas trees

23. It is noted that the opponent has submitted that certain toy items such as "Playsets for action figures; Cases for play accessories; Cases for action figures; Dolls" can have a secondary purpose of being collectables and that in "toy collectors' communities, particularly prized are those items which remain boxed or in 'mint condition'", and that, in such instances, such goods would have an "ornamental purpose", rather than being purchased for the purpose of play or amusement. Consequently, the opponent submits that there is a degree of overlap in intended purpose between these collectable goods and the holder's "decorations for Christmas trees", "streamers" and "confetti". The opponent further submits that "confetti" and "streamers" are typically also "sold in toy stores resulting in an overlap in trade channels" between these goods and the goods in the opponent's specification.
  
24. Whilst I accept that some of the goods in the opponent's specification may be purchased as collectables, I do not accept that there is an overlap in the purpose between these collectable goods and the holder's streamers, confetti and decorations for Christmas trees. The primary purpose of toys is entertainment, even if they have a collectible element. The primary purpose of the holder's goods is decorative. I also do not accept that streamers and confetti are generally sold in "toy shops" as has been submitted by the opponent and no evidence has been filed to support this claim.

25. I, once again, reiterate the judgment of Iain Purvis KC in *Unicorn Studio Inc v Veronese*<sup>4</sup> referenced in paragraph 35 of my decision 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”. Consequently, I remain of the view that there is no similarity between the above referenced goods and the goods in the opponent’s specification.

**Distinctive Character of the Earlier Mark:**

26. It is noted that the opponent submits that “Given that the Earlier Mark protects goods beyond merely “action figures” toys, it cannot be said that ACTION HEROES is directly descriptive of toys including furniture, playhouses, toy cases, or card games.” The opponent therefore submits that it is “incorrect to deduce that the Earlier Mark is lowly distinctive for such goods, since clearly the mark requires interpretation.” However, it is noted that the opponent accepts that the “verbal elements could be said to be allusive” and submits that the earlier mark has “at least an average level of distinctiveness”.
27. Whilst I give due considerations to the opponent’s submissions, for the reasons outlined in detail in paragraphs 50 and of my decision, I do consider the words “Action Heroes” to be more than merely allusive of the opponent’s goods. In any event, it is noted that the opponent has not submitted that the earlier mark has a high level of distinctive character, it has asserted that it has “at least an average level of distinctiveness”.
28. Nothing in the opponent’s submission changes my interpretation of the words “action heroes” in the earlier mark being two commonly used ordinary dictionary word which, as outlined above, I consider to be descriptive of the opponent’s goods. Whilst I note the opponent’s submission that the applicant did not file any evidence to support its position that these words will be understood descriptively by the average consumer, I do not consider such evidence to be necessary in

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<sup>4</sup> [2024] EWHC 1098 (Ch) - paragraph 24

circumstances where the plain meaning of the words is clear. Consequently, I remain of the view that that the words “action heroes” are non-distinctive for the goods in the opponent’s specification. I note the opponent’s submission that the earlier mark must be attributed at least some distinctiveness to the earlier mark by virtue of it being registered.<sup>5</sup> I acknowledged that at paragraph 65 of my decision. Accordingly, had I considered the opponent’s submissions prior to making my decision, my finding would have remained unchanged.

**Likelihood of Confusion:**

29. It is noted that when considering the likelihood of confusion, the opponent has asserted that the goods in issue “are consumer goods in the toy and entertainment sector aimed at the general public”. This is reflected in my decision, and I need say no more about it.
30. Further, it is noted that the opponent has submitted that “these goods are typically relatively inexpensive and replaceable” and that “the average consumer is likely to pay a fairly low degree of attention when making purchasing decisions”.
31. However, in my view, this does not account for the varied cost point of the goods in issue. As confirmed in my decision, 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. Nothing in the opponent’s submissions alters this determination.
32. For the reasons outlined above, nothing in the opponent’s submissions filed on 15 January 2025 in lieu of a hearing alters my determinations in respect of the similarity of the marks, similarity of the goods, the average consumer and the purchasing act or the distinctive character of the earlier mark.

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<sup>5</sup> See section 72 of the Act

33. I have reviewed the opponent's arguments regarding the likelihood of direct and indirect confusion made within its final submissions. None of what has been said would have changed my view, as expressed in my decision, that there will be no likelihood of direct or indirect confusion between the marks.

### **CONCLUSION**

34. It is my view that the fact that the opponent's written submissions were not before me when drafting my decision was an irregularity in procedure, albeit one that ultimately made no material impact to the outcome of my decision. It is my view that this is an irregularity that can be rectified under Rule 74 of the Trade Mark Rules 2008. Consequently, I give the parties notice that this supplementary decision corrects the irregularity that has occurred.
35. The appeal period in opposition no. 600003385 will therefore be reset and begins from the date of this supplementary decision.

**Dated this 24<sup>th</sup> day of September 2025**

**B Hartland**  
**For the Registrar**