

O/1092/24

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3871767
IN THE NAME OF BOVIVE LTD
TO REGISTER AS A TRADE MARK**

WINSPIRIT

IN CLASSES 9, 41 AND 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 440149
BY STROPUS LTD.**

BACKGROUND AND PLEADINGS

1. On 26 January 2023, BOVIVE LTD (“the applicant”) applied to register the trade mark “**WINSPIRIT**” in the United Kingdom. The application was accepted and published for opposition purposes on 10 February 2023, in respect of goods and services in classes 9, 41 and 42, as listed in the table under paragraph 16 of this decision.

2. The application is opposed by Stropus Ltd. (“the opponent”). The opposition was filed on 11 April 2023 and is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods and services in the application. The opponent relies upon its UK designation of the following International Registration (“IR”):

WINSPIRIT

International Registration No.: WO1745586

International Registration date: 28 November 2022

Priority claimed from UA (Ukraine) No. m202210573, with a priority date of 5 September 2022

UK Date of Designation: 28 November 2022

Date protection conferred in the UK: 9 November 2023

Protected for goods and services in classes 9, 38, 41 and 42

Relying on all goods and services, as listed in the table under paragraph 16 of this decision.

3. The above mark qualifies as an earlier mark under section 6(1) of the Act. As it had not been protected for more than five years at the date the application was filed, it is not subject to the use provisions contained in section 6A of the Act.

4. The opponent submits that as a result of the strong similarity between the marks and the identity and similarity of the goods/services covered by the applicant’s mark and the opponent’s earlier mark, there exists a likelihood of confusion on the part of the public which includes a likelihood of association. It therefore submits that the

applied for mark should be refused under section 5(2)(b) and an award of costs be made in favour of the opponent.

5. The applicant filed a counterstatement denying the claims. It submits that there is no likelihood of confusion under section 5(2)(b) and that the opposition should be dismissed.

6. Both parties filed written submissions during the evidence rounds which will be referred to as and where appropriate during this decision. Neither party elected to file evidence and neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

7. In these proceedings, the opponent is represented by Sipara Limited and the applicant is represented by Regimark SIA.

Preliminary issues

8. At point 7 of its written submissions, the opponent states that the applicant has admitted there are visual and aural similarities between the marks, and as such “it should carry significant weight when considering the similarities in the respective marks”. The opponent claims that these admissions were made after a preliminary indication (“PI”) on the likelihood of success was issued by the Tribunal.¹

9. The applicant has brought my attention to this point in its own written submissions,² stating that the opponent “is trying to rely on a wrong interpretation of facts” and that the “Opponent’s submission must be denied”. Although the applicant had admitted in its counterstatement that there are some visual and aural similarities between the marks, the counterstatement was filed on 7 August 2023, which was prior to the PI being issued, rather than subsequent to it. I further note that in the counterstatement,

¹ The PI, issued on 24 August 2023 in accordance with Rule 19 of the Trade Mark Rules 2008, indicated that, notwithstanding any identity/similarity between the parties’ goods and services, there was insufficient similarity between the marks to support a finding of a likelihood of confusion. To clarify, the PI, given by a different Hearing Officer, is not binding upon me and will have no bearing upon my decision, which I make based on consideration of the facts before me.

² At points 6 -8.

following the admission of similarity, the applicant continues that it “considers the semantic dissimilarities prevent the finding of a likelihood of confusion”.

10. While I take into account that the applicant has conceded that there are similarities between the marks, it has further submitted that this in itself is insufficient for a finding of a likelihood of confusion. I will proceed to make my own assessment on the degree of similarity between the marks at the appropriate juncture within this decision. In doing so I will fully consider the written submissions made in this regard as provided by each of the parties, making reference to those submissions to the extent I consider necessary.

DECISION

11. 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.

Section 5(2)(b)

12. Section 5(2)(b) is relied on and reads as follows:

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

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

13. Section 5A states:

“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.”

14. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods and services

15. Pursuant to section 60A of the Act, goods and services are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes.

16. The goods and services to be compared are:

Applicant's goods and services
<u>Class 9</u> <i>Application software; Mobile application software; Downloadable mobile applications; Programs (Computer -) [downloadable software]; Software development programs; Software development programmes; Software development tools; Computer software programs.</i>
<u>Class 41</u> <i>Game services provided online from a computer network; organization of electronic sports competitions; organization of lotteries; organization of sports competitions; providing amusement arcade services; e-sports services; gambling services.</i>
<u>Class 42</u> <i>Software development; IT consultancy, advisory and information services; IT security, protection and restoration.</i>
Opponent's goods and services
<u>Class 9</u> <i>Recorded and downloadable media files, software; computers and computer peripheral device; recorded and downloadable media files, namely, video files, audio files, image files and text files in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; electronic publications, downloadable; downloadable e-wallets; downloadable emoticons for mobile phones; interfaces for computers; memory cards for video game machines; integrated circuit cards (smart cards); computer hardware; computer hardware in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; computer game software, downloadable; computer game software, recorded; joysticks for use with computers, other than for video games; computer keyboards; computer programs, downloadable; computer programs, downloadable in the field of gambling, betting, wagering, lotteries, casinos,</i>

educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; computer programs, recorded; computer programs, recorded in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; computer operating programs, recorded; computer operating programs, recorded in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; computer software applications, downloadable; computer software applications, downloadable in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; computer software platforms, recorded or downloadable; computer software platforms, recorded or downloadable in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; mouse (computer peripheral); processors (central processing units); downloadable ring tones for mobile phones; computer software, recorded; computer software, recorded in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; downloadable video game software; downloadable interactive video game software; downloadable computer programs for playing electronic games and computer software platforms downloaded via the Internet, electronic mail or via portable, mobile, handheld or tablet devices, for use in accessing social networks; electronic downloadable publications in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; electronic downloadable publications in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events, distributed via the Internet, electronic mail or portable, mobile, handheld and tablet devices; recorded or downloadable applications for electronic games; computer software downloadable and recorded for a game engine for developing and using video games; downloadable and recorded computer game software for

generating and displaying slot machine betting results; downloadable or recorded computer software for casino games, slot machines and online electronic games; downloadable game software for electronic devices; downloadable sports betting game software; downloadable graphical user interface software; interactive software; interactive computer systems; interactive entertainment software for computers; downloadable computer software used in the provision of entertainment services, namely, in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance; entertainment systems consisting of computer hardware and downloadable game software; computer software and computers with multimedia and interactive functions; apparatus and devices for recording, transmission, reproduction of sound, data and images; downloadable computer software and downloadable computer software platform, incorporating a single or multiple computer applications featuring functional and graphical elements for creating, operating, managing, monitoring and supervising on-line gaming, betting and gambling portals, contests and tournaments, and for management of customer relationship and customer accounts; downloadable computer game software and computer software for gambling used for slot machines; downloadable computer game programs and computer programs for gambling, betting, wagering, lotteries, casinos, card games, educational games, games, where the result depends on mastery, skill of the player and other games of chance, for electronic mobile devices and cell phones; downloadable computer game software applications and computer software applications for gambling; downloadable computer software, in particular, for gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, for playing via telecommunications networks and the Internet, with or without prizes; electronic virtual reality motion simulators; virtual reality headsets; virtual reality game headsets; downloadable virtual reality software for simulation while playing video games; downloadable virtual and augmented reality software for playing video games; downloadable virtual reality software for telecommunications; downloadable virtual reality game software; computer virtual reality game hardware; electronic number generators; electronic number generators in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; downloadable computer operating systems software; recorded computer game programs with sports elements; 3D spectacles; connected bracelets (measuring instruments); downloadable graphics for mobile phones; computer screen saver software, recorded or downloadable; downloadable image files;

downloadable music files; encoded magnetic cards; protected encoded identity cards; identity cards with encoded protective features; magnetic encoded identity cards with holograms; photographic and cinematographic apparatus and instruments for use in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; downloadable computer game programs for pocket devices.

Class 38

Telecommunication services; telecommunication services to provide access to games, gambling and content; providing access to databases; providing information in the field of telecommunications; providing user access to global computer networks; providing internet chatrooms; providing internet chatrooms in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; providing online forums; providing online forums in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; providing telecommunications connections to a global computer network; communications by fibre optic networks / communications by fiber optic networks; communications by computer terminals; video-on-demand transmission; transmission of electronic mail; computer aided transmission of messages and images; computer aided transmission of messages and images i in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; transmission of podcasts; transmission of digital files; transmission of digital files in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; message sending; message sending in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; videoconferencing services; electronic bulletin board services (telecommunications services); telecommunications routing and junction services; news agency services; streaming of data; rental of access time to global computer networks; wireless broadcasting; providing access to databases

featuring information content of websites and portals as communication services; audio, video and multimedia broadcasting via the Internet and other communication networks; broadcasting services; communication services via computer networks; communication services via computer networks in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; data transmission by electronic means; data transmission services; electronic data transmission, including audiovisual data, via a global computer network or the Internet; electronic communication services; data transmission via electronic communication; data transmission via electronic communication in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; electronic data exchange services; electronic messaging services; electronic messaging services in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; electronic messaging services via computers; electronic messaging services via computers in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; rental of access time to computer databases; video and audio material streaming services on the Internet; electronic transmission and dissemination of data, including information, via computer networks and the Internet; electronic transmission and dissemination of data, including information, via computer networks and the Internet in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; electronic transmission of data, audio, video and multimedia files, including transmission of downloadable files and files transmitted over a global computer network; transmission of information in real time; transmission (routing) of audio, images and digital signals

Class 41

Entertainment services; dubbing; language interpretation; providing films, not downloadable, via video-on-demand services; sound engineering services for events; sound engineering services for events in the field of gambling, betting, wagering, lotteries,

casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; organization of shows (impresario services) for entertainment purposes; organization of shows (impresario services) in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; party planning (entertainment); video editing services for events; video editing services for events in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; lighting technician services for events; production of shows; film production, other than advertising films; film production, other than advertising films in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; scriptwriting, other than for advertising purposes; scriptwriting, other than for advertising purposes in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; writing of texts; writing of texts in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; presentation of live performances; rental of audio equipment; rental of audio equipment in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; rental of show scenery; rental of show scenery in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; rental of sound recordings; rental of sound recordings in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; publication of texts, other than publicity texts; electronic desktop publishing; providing user reviews for entertainment purposes; providing information in the field of entertainment; providing online videos, not downloadable; providing online electronic publications, not downloadable; practical training

(demonstration); training services provided via simulators; games equipment rental; rental of training simulators; providing casino facilities (gambling); game services provided online from a computer network; providing amusement arcade services; gambling services; providing information in the field of gambling; organization of competitions in the field of gambling, betting, wagering, lotteries, casinos, card games, educational games, games, where the result depends on mastery, skill of the player and other games of chance, by providing the related content live or via television, or online via computer databases, or via the internet, or via portable, mobile, handheld or tablet devices; organization of lotteries, including live or via television, or online via computer databases, or via the Internet, or via portable, mobile, handheld or tablet devices; organization of sports competitions, including live or via television, or online via computer databases, or via the Internet, or via portable, mobile, handheld or tablet devices; layout services, other than for advertising purposes; online gambling services provided via a computer network; virtual reality gaming services provided online from a computer network; providing online and offline gaming services for accepting bets; providing online and offline game services, where the result depends on the mastery, skill of the player; providing online and offline game services for the control of entertainment games, in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for tournaments, competitions, game shows, events; arranging, conducting and presenting, other than for commercial or advertising purposes, of tournaments, competitions, game shows, and other entertainment events live or via television, or online via computer databases, or via the Internet, or via portable, mobile, handheld or tablet devices; organization and conducting presentations of the aforesaid services, other than for commercial or advertising purposes; providing information in the field of entertainment; providing information in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; organization games, gaming entertainments, namely shows, tournaments, competitions and conducting their presentations, other than for commercial or advertising purposes; providing the aforesaid services online via computer databases, or via the Internet, or via portable, mobile, handheld or tablet devices; providing online game services for electronic games provided via the Internet.

Class 42

Design and development of computer hardware and software; computer system analysis; computer system analysis in the field of gambling, betting, wagering, lotteries, casinos,

educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events and for providing access to the related content; graphic arts design; graphic design of promotional materials; off-site data backup; research and development of new products for others; duplication of computer programs; electronic data storage; electronic monitoring of personally identifying information to detect identity theft via the internet; providing information relating to computer technology and programming via a website; installation of computer software; information technology services provided on an outsourcing basis; computer programming; conversion of computer programs and data, other than physical conversion; computer technology consultancy; Internet security consultancy; data security consultancy; information technology (IT) consultancy; computer software consultancy; computer security consultancy; consultancy in the design and development of computer hardware; website design consultancy; monitoring of computer systems for detecting unauthorized access or data breach; monitoring of computer systems to detect breakdowns; monitoring of computer systems by remote access; maintenance of computer software; updating of computer software; platform as a service (PaaS); user authentication services using technology for e-commerce transactions; user authentication services using single sign-on technology for online software applications; hosting computer websites; data encryption services; software as a service (SaaS); computer system design; rental of web servers; rental of computer software; industrial design; development of computer platforms; software development in the framework of software publishing; creating and maintaining websites for others; creating and designing website-based indexes of information, for others (information technology services); providing virtual computer systems through cloud computing; server hosting; styling (industrial design); computer system administration of user accounts in computer networks; computer-aided videographic design; computer-aided videographic design in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance, including for arranging tournaments, competitions, game shows, events; development of software in accordance with the individual needs of the client; development of interactive multimedia software; development of software for data conversion and conversion of multimedia content into various protocols; design and development of software for computer games and virtual reality; leasing of computer hardware; software development of Internet platforms; development and design of computer software for video games; testing of computer hardware and software; providing temporary use of online non-downloadable software for access and operation in cloud computing environments; software as a service (SaaS), namely, a web platform that

provides software for viewing, detecting, searching, configuring content, managing and exploring content in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance; providing temporary use of non-downloadable computer software for computer games and gambling; providing temporary use of non-downloadable game software; research, development and design of computer software for a computer platform that includes one or more applications that contain functional and graphical elements in the field of gambling, betting, wagering, lotteries, casinos, educational games, games, where the result depends on mastery, skill of the player and other games of chance; application service providers (ASP), namely, hosting computer software applications of others for creating, using, managing, monitoring and supervising online gaming and gambling portals, contests and tournaments, and for managing customer relationships and customer accounts; providing temporary use of non-downloadable software for creating, using, managing, monitoring and supervising on-line gaming, betting and gambling portals, contests and tournaments, and for management of customer relationship and customer accounts.

17. Where the goods or services in the specification of one party are included in a broader term from the other party's specification, those goods or services are considered to be identical: See *Gérard Meric v OHIM*, Case T-133/05 at [29].

18. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated that:

"23. In assessing the similarity of the goods or services concerned, ... 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".

19. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* ("*Treat*") [1996] R.P.C. 281 include an assessment of the users and the channels of trade of the respective goods or services.

20. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“82. ...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

21. For the purposes of considering the issue of similarity of the goods and/or services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.³

22. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

"12. ... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. ... Nevertheless the principle should not be taken too far. ... Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

23. In the case of services, the terms used services should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms: *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), at [56].

24. In its Statement of Grounds the opponent submits that the applicant's goods and services in classes 9, 41 and 42 are identical and/or highly similar to those covered

³ Paragraph 5

by the earlier mark. In its written submissions it has provided a table directly comparing the contested goods and services against some of its own goods and services in classes 9, 41 and 42, although it states that these are examples only and not exhaustive.

25. In its written submissions, the applicant has stated that “for the sake of procedural economy” it would not analyse the goods and services concerned “since even if they are identical or similar, it will not significantly impact the overall assessment due to the claimed (sufficient) dissimilarity of the marks concerned”.⁴ While this may be interpreted as an admission of similarity on the part of the applicant, they have not stated to what degree they consider them to be similar. I will therefore proceed to compare the identity and/or the degree of similarity or otherwise of the goods and services at issue.

The contested goods in class 9

Application software; Mobile application software; Programs (Computer -) [downloadable software].

26. The above goods are all encompassed by the opponent’s wider term “*software*” and are therefore identical as per the principle outlined in *Meric*.

Downloadable mobile applications; Software development programs; Software development programmes; Software development tools; Computer software programs.

27. To my understanding, *Downloadable mobile applications* are a form of software, while software is made up of a set of instructions, data or programs. I also consider that “*software development tools*” are generally software themselves. As such, I consider the applicant’s above terms to be covered by the opponent’s broad terms “*software*” and/or “*computer programs, downloadable*”, rendering them identical as per *Meric*.

⁴ At point 28 of the written submissions dated 15 January 2024.

The contested services in class 41

Game services provided online from a computer network.

28. The applicant's services are self-evidently identical to the opponent's "*game services provided online from a computer network*".

Providing amusement arcade services.

29. The above are self-evidently identical to the opponent's "*providing amusement arcade services*".

Gambling services.

30. The applicant's services are self-evidently identical to the opponent's "*gambling services*".

Organization of lotteries

31. I note that the opponent's "*organization of lotteries*" is qualified as "**including** *live or via television, or online via computer databases, or via the Internet*". However the term "including ..." is considered to merely provide examples of how the service may be delivered and does not limit the services to only those means of employ. The applicant's broad term, above, encompasses the opponent's "*organization of lotteries, including live or via television, or online via computer databases, or via the Internet*" and the services are therefore identical as per the principle outlined in *Meric*.

Organization of electronic sports competitions; organization of sports competitions; e-sports services.

32. The above services encompass or are encompassed by the opponent's "*organization of sports competitions, including live or via television, or online via*

computer databases, or via the Internet, or via portable, mobile, handheld or tablet devices” and as such they are Meric identical.

The contested services in class 42

Software development

33. The applicant’s services are self-evidently identical to the opponent’s “... *development of computer ... software*”.

IT consultancy, advisory and information services.

34. Given that consultancy services would include the provision of advice and information, the applicant’s services are self-evidently identical to the opponent’s “*information technology (IT) consultancy*”, or at the very least identical as per *Meric*.

IT security, protection and restoration.

35. To my mind, the opponent’s “*computer security consultancy*” and its “*monitoring of computer systems for detecting unauthorized access or data breach; monitoring of computer systems to detect breakdowns; monitoring of computer systems by remote access; maintenance of computer software; updating of computer software*” all encompass/are encompassed by the applicant’s “*IT security, protection and restoration*”. If I am wrong in this, I consider that the services will share the same users and that there is an overlap in nature, purpose, method of use and channels of trade. I consider the services to be important to each other and complementary to the extent that it would not be unreasonable for the average consumer to expect them to originate from the same, or related undertakings. Therefore, if the services are not identical as per *Meric*, I find them similar to a high degree.

The average consumer and the nature of the purchasing act

36. The average consumer is a legal construct, deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A.*

Inc & Ors, [2014] EWHC 439 (Ch), paragraph 60. 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 or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97, at [26].

37. In my view, the average consumer for the overlapping goods in class 9 will be both the general public and business consumers. The software is likely to be sold through a range of channels including physical retail premises, or via the internet, including specialist providers, while the mobile applications are likely to be downloaded and installed from an app store on the internet. The goods will range in price and may be relatively cheap or may be provided free of charge, such as the likes of banking apps, but are likely to be more expensive for more complex software.

38. The average consumer of the overlapping services in class 41 will most likely be the general public, including those with an interest in gaming, gambling and competitions, or they may be a professional gamer or gambler. Meanwhile, the average consumer of the overlapping services in class 42 will be both the general public and businesses. The cost of the services in both classes will vary according to the exact nature, specification and the level of service selected and the services will most likely be sourced from physical premises or via the internet.

39. I consider that the selection process of the goods and services in all classes will be made by primarily visual means, although I do not discount aural considerations such as word of mouth recommendations, or where the consumer receives verbal advice from sales representatives. For the class 9 goods and the class 42 services, considerations such as technical and user reviews, price, quality, ease of use, compatibility and suitability of the product would be taken into account before purchasing the goods or accessing the services. In my view, the level of attention will vary depending on the importance of the goods and services to the consumer: the general public is likely to pay a medium degree of attention to the purchasing process overall, while the business customer whose reputation may be reliant on the choice of the most appropriate goods and/or services will pay a higher than average degree of attention to its selection. In respect of the class 41 services, the level of attention will be commensurate with the size of the stake or prize, or the prestige of the competition,



all of which will range from relatively low to comparatively high. I recognise that the services may attract casual gamers and gamblers who will be less knowledgeable and are likely to pay a lower degree of attention to the selection of the services as well as the regular player or professional gambler paying a higher degree of attention.

Comparison of marks

40. 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 in *Bimbo SA v OHIM* Case C-591/12P, that:

“34. ...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.”

41. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
 The logo for WINPUNITY features the word "WIN" in a bold, sans-serif font, followed by a stylized graphic element consisting of three horizontal bars of varying lengths, and then the word "PUNITY" in a bold, sans-serif font.	 The logo for WINSPIRIT consists of the word "WINSPIRIT" in a bold, sans-serif font.

Overall impression

42. I accept that while it would be wrong to artificially dissect the trade marks, 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.

43. The applicant's mark consists of the word "WINSPIRIT" presented as a single word in capital letters in a standard black typeface. In *Usinor SA v OHIM*, Case T-189/05, the GC found that:

"62. ... it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Lloyd Schuhfabrik Meyer, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT) [2004] ECR II-3445, paragraph 51, and Case T-256/04 Mundipharma v OHIM – Altana Pharma (RESPICUR) [2007] ECR II-0000, paragraph 57)".

I consider that as per *Usinor*, and as submitted by the applicant, that a significant proportion of the average consumer are likely to recognise the two individual, dictionary-defined words which make up the whole, being "WIN" and "SPIRIT". I also accept that to other consumers the applicant's mark is likely to be seen purely as an invented word. I do not consider that even where the mark is recognised as two separate words that either word dominates, given that they are presented as a single unit. The overall impression of the mark lies in its totality.

44. The opponent's mark consists of the letters WIN and PINITY presented in a relatively standard black typeface in capital letters. The two elements are intersected by the letter S and what seems to be the top portion of another letter S positioned directly below, both presented in the same typeface as the other elements but this time in white against a black background. I agree with both parties' submissions that this device element is likely to be seen as a casino reel by a significant proportion of the average consumer. That being said, the letter "S" is still clearly visible and to my mind, the arrangement of the mark as a whole leads to it being perceived as a single, stylised word "WINSPINITY". I do not consider that any one of the combined elements plays

an independent distinctive role and therefore the overall impression of the mark lies in the whole as presented.

45. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginning of words tend to have more visual and aural impact than the ends, although I recognise that this is not always the case.

Visual comparison

46. The applicant's mark consists of nine letters, while the opponent's mark, taking into account the stylised letter "S", consists of ten letters, with the marks sharing the same first six letters, presented in the same order. The presentation of the opponent's mark as a whole, including the letter "S" 'casino reel' element, will not go unnoticed and creates a visual disparity between the marks, as do the different endings to the respective marks. Considering the position of the identical word "WIN" at the start of each mark, I consider the marks to be visually similar to a medium degree.

Aural comparison

47. I consider that to the significant proportion of consumers who view the opponent's mark as a single word, it will be pronounced in its entirety as four syllables, WIN-SPIN-IT-EE or WIN-SPI-NIT-EE. I agree with the opponent that the device element has no bearing on the aural comparison as it will be perceived as the letter "S". The contested mark will be voiced as three syllables, WIN-SPI-RIT. I acknowledge the aural similarities at the beginning of the marks, and considered overall, I find the marks to be aurally similar to a medium degree.

Conceptual comparison

48. With regard to conceptual comparison, in *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)*, Case T-268/18, the GC held:

"8. ... In that regard, it must be borne in mind that the purpose of the conceptual comparison is to compare the 'concepts' that the signs at issue convey. The

term 'concept' means, according to the definition given, for example, by the Larousse dictionary, a 'general and abstract idea used to denote a specific or abstract thought which enables a person to associate with that thought the various perceptions which that person has of it and to organise knowledge about it."

49. The opponent submits that its mark has no recognized meaning and so a conceptual comparison cannot be made. The opponent reminds me that when assessing the conceptual similarity of the marks, this is usually done without reference to the goods and services in question: *Viñedos Emiliana SA v Consorzio Tutela Vini Emilia*, (2) *Chiarli 1860 – Pr.I.V.I Srl And (3) Medici Ermete E Figli Srl* BL O/054/22.

50. The applicant submits that "the verbal part "WIN-" at the beginning of both marks under comparison is of obvious descriptive and non-distinctive nature...", and it disagrees with the opponent that the earlier mark "has no specific meaning ... ".

51. As already mentioned, to my mind, the applicant's mark would be perceived by a significant proportion of the average consumer as the conjoining of two separate, every day, dictionary-defined words, "WIN" and "SPIRIT" and which may lead them to associate the mark with the idea of a winning spirit, being a mindset leading to success in a particular situation. I again acknowledge that there will be other consumers who see the applicant's mark as a wholly invented term without any form of evocative content.

52. As submitted by the applicant, I agree that a significant proportion of average consumers would understand the opponent's mark as including a combination of the words "WIN" and "SPIN". To my mind, regardless of the goods and services to which the mark is applied, and in spite of the random letters "ITY" at the end of the mark, the arrangement "WIN" and "SPIN" together with the casino reel device element, sends an abstract message of winning (something) by spinning the reel and is therefore allusive of gaming or gambling. I also accept that there will be some consumers who find no conceptual content in the opponent's mark as a whole.

53. As the word “WIN” which is positioned at the beginning of each of the marks alludes to the gain of something (or the defeat of someone), the marks share a degree of conceptual similarity by way of this shared element. However, when viewed as a whole, to those consumers who attach no meaning to either mark, the marks are conceptually neutral. To those consumers who extract a meaning from the coalesced terms which make up the competing marks, the marks send out different overall messages: the opponent’s mark conveys the more specific idea of gaming or gambling “WIN, SPIN ...”,⁵ while the applicant’s mark is more general to the concept of a particular (winning) mindset. Consequently, I consider the marks to be conceptually similar to a low degree.

Distinctive character of the earlier mark

54. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. The factors I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97:

“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).”

⁵ Albeit that it would be more logical if the words were transposed as “SPINWINITY”, i.e. “Spin, Win ...”.

55. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not claimed that its mark has enhanced distinctiveness and no evidence of use has been filed. Therefore, I only have the inherent characteristics of the mark to consider.

56. The opponent submits that the earlier mark has no specific meaning and that its length and unusual combination of letters makes it highly distinctive and unusual. Although the mark is presented as a single invented word, bearing in mind the findings of *Usinor* and *Luciano Sandrone*, each cited earlier in this decision, I consider the mark to be allusive of gaming and gambling and as such it is lower in distinctive character for those goods and services which directly relate to such activities. However, in relation to the remaining goods and services, the mark can be said to be higher in distinctiveness, although the idea of winning and spinning (something) still exists. Overall, and factoring in the 'get up' of the mark as registered, I consider it to be inherently distinctive to a medium degree.

Likelihood of confusion

57. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them 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 services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

58. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the

responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“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 recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

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

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

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

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

59. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

60. Earlier in this decision, I found the contested goods and services to be either identical or similar to a high degree to the opponent's goods and services. I considered there to be two groups of average consumers, being the general public and business consumers, with the selection process of the goods and services in all classes being made by primarily visual means, although I did not discount aural considerations. I considered that the level of attention would vary depending on the importance of the class 9 goods and the class 42 services to the consumer, with the general public likely to pay a medium degree of attention to the purchasing process, while the business customer would pay a higher than average degree of attention to its selection. For the class 41 services, I considered that casual gamers and gamblers would be likely to pay a lower degree of attention to the selection of the services while the regular player or professional gambler would pay a higher degree of attention.

61. I found the competing trade marks to be visually and aurally similar to a medium degree. Conceptually, I considered that some consumers would see both marks as invented words with no concept, while other consumers would attach an identical meaning to the "WIN" element present at the start of both marks, although each of the marks in its entirety convey a different overall message. In my view, the earlier mark is inherently distinctive to a medium degree.

62. I have weighed up each of the competing factors in my decision and I come to the conclusion that, while allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, it is unlikely that they would mistake one mark for the other. This is in spite of the identity or similarity of the goods and services in question. To my mind, the differences between the marks stand out and will not be overlooked, even where a lesser degree of attention is paid. Consequently, I do not consider there is any likelihood of direct confusion.

63. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was), in *L.A. Sugar*, I will now consider whether there might be a likelihood of

indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

64. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, Lord Justice Arnold referred to the comments of James Mellor QC (as he then was) sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), 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". Lord Justice Arnold added that there must be "a proper basis" for concluding that there is a likelihood of indirect confusion when there is no likelihood of direct confusion.

65. I acknowledge that the categories listed by Mr Iain Purvis Q.C. (as he then was) are not exhaustive. I have made a multi-factorial assessment of the various considerations in play. The common word "WIN" at the beginning of the respective marks is not so strikingly distinctive that the consumer would assume that only the opponent would be using it as part of its trade mark. While sight of one mark may bring to mind the other mark, and consumers may consider that the marks coincidentally begin with the same six letters, it would be highly unusual for a company to rebrand its mark or launch a sub-brand by adopting a different name, other than some overlap in letters, with a different overall meaning to the original. In my view, there would be no logical reason for consumers (either members of the public or businesses) to believe that there is an economic connection between the undertakings. I therefore find no likelihood of indirect confusion.

66. The opposition under section 5(2)(b) of the Act fails in its entirety.

CONCLUSION

67. The applicant has been successful. Subject to any successful appeal, the application by BOVIVE LTD may proceed to registration.

COSTS

68. The applicant has been successful and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 1/2023. Applying the guidance in the TPN, I consider the following to be fair:

Considering the notice of opposition and filing a counterstatement: £300

Preparing and filing written submissions: £400

Total: £700

69. I therefore order Stropus Ltd. to pay BOVIVE LTD the sum of £700. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 18th day of November 2024

Suzanne Hitchings
For the Registrar,
the Comptroller-General