

O/1172/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 4180329
IN THE NAME OF SOFT SONIC INFORMATION TECHNOLOGY LLC
TO REGISTER THE FOLLOWING TRADE MARK:

Circus Delight

IN CLASSES 9 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600003673
BY CIRCUS BELGIUM S.A.

Background and pleadings

1. Soft Sonic Information Technology LLC (“the applicant”) applied to register the trade mark **Circus Delight** (“the applicant’s mark”) in the UK on 27 March 2025, under number 4180329. It was accepted and published in the Trade Marks Journal on 4 April 2025 in respect of the following goods and services:

Class 9: Downloadable computer software; Computer game software; Downloadable mobile applications; Downloadable applications for use with mobile devices; Interactive entertainment software; Gambling software; Betting software; Downloadable software, namely virtual currency; Downloadable computer software for managing cryptocurrency transactions using blockchain technology; Computer game software for use on mobile devices; Payment software; Apparatus for processing electronic payments; Software for arranging online transactions; Software for the processing of business transactions.

Class 42: Design and development of computer software; Software as a service [SaaS] featuring software platforms for electronic gaming; Platforms for gaming as software as a service [SaaS]; Hosting of websites; Hosting of platforms on the Internet; Maintenance of computer software; Updating of software; Development of computer platforms; Development of software for secure network operations; User authentication services using blockchain technology; Data authentication via blockchain; Blockchain as a Service [BaaS]; Certification of data via blockchain; Data storage via blockchain; Computer programming of smart contracts on a blockchain; Customized design of computer software; Design and development of computer game software and virtual reality software; Information technology [IT] consulting services.

2. On 29 April 2025, CIRCUS BELGIUM S.A. (“the opponent”) opposed the application by way of the fast-track procedure. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all the goods and services of the application.

3. The opponent relies upon his UK trade mark number 3849721, which consists of a series of two marks: **Circus** and **CIRCUS**. Since the marks in the series only differ in the use of title case and uppercase, for ease of reference I will refer to them as “the

opponent's mark" unless it becomes necessary for me to distinguish between them. The opponent's mark was filed on 15 November 2022 and became registered on 24 February 2023. It stands registered for goods and services in classes 9, 28, 41, 42, and 43. However, for opposition purposes, the opponent relies only on the goods in class 9 and the services in class 42, which are as follows:

Class 9: Games software; Computer programs for games, gaming, betting and lottery; Computer game development software; computer databases for games, gaming, betting and lottery; computer programming software for games, gaming, betting and lottery; computer software platforms for games, gaming, betting and lottery; computer software for accessing computer networks in the field of games, gaming, betting and lottery; programming units (computer-) of games, gaming, betting and lottery; downloadable computer software of games, gaming, betting and lottery; Computer game software, recorded; Computer programs for remote connection via hand-held electronic devices, portable video players, portable music players, smartphones, laptop computers, portable computers, tablet computers, mobile phones, pagers, personal digital assistants, digital television set-top boxes, interactive digital television controllers and programmable recorders; Electronic publications, downloadable; platform software of games, gaming, betting and lottery; porting platforms for games, gaming, betting and lottery; Computer software for the administration of on-line games and gaming; management and control systems of games, gaming, betting and lottery; Electronic publications, downloadable in relation to the following fields Games, games of chance, Wagering games, Gambling addiction, entertainment in the field of games; Electronic terminals for generating lottery tickets; computer terminals used in operation of lotteries, gaming activities; Software and hardware for enabling interactive gaming solutions; computer hardware for games, gaming, betting and lottery; data communications hardware for games, gaming, betting and lottery; hardware testing software for games, gaming, betting and lottery; computer network attached storage (NAS) hardware for games, gaming, betting and lottery; Hardware for processing electronic payments to and from others; electronic device software drivers that allow computer hardware and electronic devices to communicate with each other for games, gaming, betting and lottery; Lottery

ticket dispensing apparatus; Point of sale apparatus; Electronic payment terminals; Betting terminals; computer programming software; Computer software programs; Computer programmes; downloadable computer software for blockchain technology; downloadable computer software for managing cryptocurrency transactions using blockchain technology; Animated or still images and/or sounds (audio tape) for computer games authenticated by NFT (non fungible token) for computer games; Downloadable digital files authenticated by non-fungible tokens [NFTs].

Class 42: Software as a service [SaaS]; Platform as a service [PaaS]; IT services; Providing a website featuring non-downloadable software; Platform as a service [PaaS] featuring gaming software platforms; computer services relating to the conversion of data, document or information; Design and development of computer hardware and software for gaming, betting, games of chance for others; design, installation, provision, maintenance and updating of computer programs and software; Research and development services; Conducting technical project studies in relation to the following fields games, betting activities, Gambling addiction, services relating to gaming and betting activities; maintaining security and providing controlled access to electronically stored files, data, and documents; electronic storage of files, data, and documents for others; Services for updating computer software; creation of software for wagering on competitive video game matches; providing artificial intelligence computer programs on data networks; Software as a service [SaaS] for the creation of customized bet slips; hosting of e-commerce platforms on the Internet; software as a service [SaaS] for providing deposit and withdrawal support for customers to add funds to accounts; Design of computer game software; Design and development of computer game software; Design and development of computer game software and virtual reality software; design and development services in relation to interactive entertainment products; design services relating to the production of computer games and interactive entertainment products; design of graphics, visuals, virtual and/or interactive images, and of special effects for games, audiovisual, multimedia productions and for Internet website pages; creation, hosting, updating and/or maintenance of sites such as Internet sites; software as a service [SaaS] for the production

of graphics, visuals, virtual and/or interactive images, and of special effects for games audio-visual, multimedia productions and for Internet website pages; Providing software on a global computer network; design and development of website; design and development of web solution in relation with blockchain services; data authentication via blockchain; data storage via blockchain; data storage; certification of data via blockchain; blockchain as a service (Baas); consulting services relating to blockchain technology.

4. As the filing date of the opponent's mark is earlier than the filing date of the applicant's mark, the opponent's mark constitutes an earlier mark in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods and services identified without having to establish genuine use.

5. In his statement of grounds, the opponent contends that the applicant's mark is similar to the opponent's mark as it contains the same distinctive word "CIRCUS", and that the goods and services are either identical or similar. On this basis, it argues that there exists a likelihood of confusion, including a likelihood of association.

6. The applicant filed a counterstatement denying the ground of opposition.

7. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1 to 3 of rule 20 of the Trade Mark Rules 2008 but provides that rule 20(4) shall continue to apply. Rule 20(4) stipulates that "the Registrar may, at any time, give leave to either party to file evidence upon such terms as the Registrar thinks fit". The net effect of these changes is to require the parties to seek leave in order to file evidence in fast-track oppositions. No leave was sought in respect of these proceedings.

8. The opponent is professionally represented by Trademark Tonic Limited and the applicant is represented by Greg Sach.

9. Rule 62(5) (as amended) states that arguments in fast-track proceedings shall be heard 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. A hearing was neither requested nor considered necessary. Only the opponent filed written submissions. This decision is taken following a careful perusal of the papers, keeping all submissions in mind.

Relevance of EU law

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.

Section 5(2)(b)

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

“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 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.”

13. 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 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.

The principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

14. In *Canon*¹, the Court of Justice of the European Union (“CJEU”) stated, at paragraph 23 of its judgment, that when considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account. The CJEU stated that those factors include their nature, intended purpose, method of use and whether they are in competition with each other or are complementary.

15. The relevant factors identified by Jacob J. (as he then was) in the *Treat*² case, for assessing similarity were

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

¹ Case C-39/97

² [1996] R.P.C. 281

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16. In *Kurt Hesse v OHIM*³, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods and services. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*⁴, the General Court (“GC”) stated that “complementary” means:

“...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.”

17. In *G rard Meric v OHIM*⁵, the GC confirmed that even if goods and services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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 fur 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.”

18. The goods and services to be compared are shown in the table below:

The opponent’s goods and services	The applicant’s goods and services
<u>Class 9</u> : Games software; Computer programs for games, gaming, betting	<u>Class 9</u> : Downloadable computer software; Computer game software;

³ Case C-50/15 P

⁴ Case T-325/06

⁵ Case T-33/05

<p>and lottery; Computer game development software; computer databases for games, gaming, betting and lottery; computer programming software for games, gaming, betting and lottery; computer software platforms for games, gaming, betting and lottery; computer software for accessing computer networks in the field of games, gaming, betting and lottery; programming units (computer-) of games, gaming, betting and lottery; downloadable computer software of games, gaming, betting and lottery; Computer game software, recorded; Computer programs for remote connection via hand-held electronic devices, portable video players, portable music players, smartphones, laptop computers, portable computers, tablet computers, mobile phones, pagers, personal digital assistants, digital television set-top boxes, interactive digital television controllers and programmable recorders; Electronic publications, downloadable; platform software of games, gaming, betting and lottery; porting platforms for games, gaming, betting and lottery; Computer software for the administration of on-line games and gaming; management and control systems of games, gaming, betting and lottery; Electronic</p>	<p>Downloadable mobile applications; Downloadable applications for use with mobile devices; Interactive entertainment software; Gambling software; Betting software; Downloadable software, namely virtual currency; Downloadable computer software for managing cryptocurrency transactions using blockchain technology; Computer game software for use on mobile devices; Payment software; Apparatus for processing electronic payments; Software for arranging online transactions; Software for the processing of business transactions.</p> <p><u>Class 42:</u> Design and development of computer software; Software as a service [SaaS] featuring software platforms for electronic gaming; Platforms for gaming as software as a service [SaaS]; Hosting of websites; Hosting of platforms on the Internet; Maintenance of computer software; Updating of software; Development of computer platforms; Development of software for secure network operations; User authentication services using blockchain technology; Data authentication via blockchain; Blockchain as a Service [BaaS]; Certification of data via blockchain; Data storage via blockchain; Computer</p>
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<p><i>publications, downloadable in relation to the following fields Games, games of change, Wagering games, Gambling addiction, entertainment in the field of games; Electronic terminals for generating lottery tickets; computer terminals used in operation of lotteries, gaming activities; Software and hardware for enabling interactive gaming solutions; computer hardware for games, gaming, betting and lottery; data communications hardware for games, gaming, betting and lottery; hardware testing software for games, gaming, betting and lottery; computer network attached storage (NAS) hardware for games, gaming, betting and lottery; Hardware for processing electronic payments to and from others; electronic device software drivers that allow computer hardware and electronic devices to communicate with each other for games, gaming, betting and lottery; Lottery ticket dispensing apparatus; Point of sale apparatus; Electronic payment terminals; Betting terminals; computer programming software; Computer software programs; Computer programmes; downloadable computer software for blockchain technology; downloadable computer software for managing cryptocurrency transactions using blockchain technology; Animated</i></p>	<p><i>programming of smart contracts on a blockchain; Customized design of computer software; Design and development of computer game software and virtual reality software; Information technology [IT] consulting services.</i></p>
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or still images and/or sounds (audio tape) for computer games authenticated by NFT (non fungible token) for computer games; Downloadable digital files authenticated by non-fungible tokens [NFTs].

Class 42: Software as a service [SaaS]; Platform as a service [PaaS]; IT services; Providing a website featuring non-downloadable software; Platform as a service [PaaS] featuring gaming software platforms; computer services relating to the conversion of data, document or information; Design and development of computer hardware and software for gaming, betting, games of chance for others; design, installation, provision, maintenance and updating of computer programs and software; Research and development services; Conducting technical project studies in relation to the following fields games, betting activities, Gambling addiction, services relating to gaming and betting activities; maintaining security and providing controlled access to electronically stored files, data, and documents; electronic storage of files, data, and documents for others; Services for updating computer software; creation of software for wagering on competitive video game matches; providing artificial intelligence

computer programs on data networks; Software as a service [SaaS] for the creation of customized bet slips; hosting of e-commerce platforms on the Internet; software as a service [SaaS] for providing deposit and withdrawal support for customers to add funds to accounts; Design of computer game software; Design and development of computer game software; Design and development of computer game software and virtual reality software; design and development services in relation to interactive entertainment products; design services relating to the production of computer games and interactive entertainment products; design of graphics, visuals, virtual and/or interactive images, and of special effects for games, audiovisual, multimedia productions and for Internet website pages; creation, hosting, updating and/or maintenance of sites such as Internet sites; software as a service [SaaS] for the production of graphics, visuals, virtual and/or interactive images, and of special effects for games audio-visual, multimedia productions and for Internet website pages; Providing software on a global computer network; design and development of website; design and development of web solution in relation with blockchain services; data

<p><i>authentication via blockchain; data storage via blockchain; data storage; certification of data via blockchain; blockchain as a service (Baas); consulting services relating to blockchain technology.</i></p>	
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19. In the statement of grounds, the opponent submits that the goods and services are either identical or similar. In the counterstatement, the applicant argues that, whilst it acknowledges some overlap in the parties' class 9 goods and class 42 services, it lists the following goods and services as not identical or similar to the opponent's terms:

Class 9: Downloadable mobile applications; Downloadable applications for use with mobile devices; Interactive entertainment software; Downloadable software, namely virtual currency; Computer game software for use on mobile devices; Payment software; Apparatus for processing electronic payments; Software for arranging online transactions; Software for the processing of business transactions.

Class 42: Software as a service [SaaS] featuring software platforms for electronic gaming; Platforms for gaming as software as a service [SaaS]; Hosting of websites; Hosting of platforms on the Internet; Development of software for secure network operations; User authentication services using blockchain technology; Computer programming of smart contracts on a blockchain; Information technology [IT] consulting services.

20. The applicant argues this on the basis that these goods and services are "clearly distinct from those of the opponent's mark in terms of their nature, function, and intended purpose". It also argues that "there are further material distinctions in the respective trade channels through which the Applicant and the Opponent offer their goods and services, with each party operating through independent and unrelated commercial platforms". In its submissions, the opponent reiterates its stance that all of the goods and services are either identical or similar. I will address its individual arguments where necessary below.

21. So far as the applicant's claimed use of independent and unrelated commercial platforms is concerned, as per the CJEU judgement in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*⁶ (particularly paragraph 66), it is necessary to consider all the circumstances in which the applicant's mark might be used. As a result, even though the applicant has suggested that they use independent and unrelated platforms to sell their goods and services, my assessment must take into account only the opponent's mark and any potential conflict with the applicant's mark. Any differences between the actual goods and/or services provided by the parties, or differences in their commercial platforms, are not relevant unless those differences are apparent from the competing marks and their specifications.

22. For the purposes of comparing goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons.⁷ I have therefore assessed the applicant's goods and services by dividing the terms into groups as per below.

Class 9:

Downloadable computer software; computer game software; computer game software for use on mobile devices; interactive entertainment software; gambling software; betting software; payment software; downloadable software, namely virtual currency; software for arranging online transactions; software for the processing of business transactions.

23. I note that the Cambridge Dictionary defines the term "software" as "computer programs", and as such, I consider the term "software programs" to be interchangeable with the term "software". These narrower terms relating to specific types of software are therefore incorporated within the opponent's wider term *computer software programs*. As such, the goods listed above are identical under the principle set out in *Meric*.

Downloadable mobile applications; Downloadable applications for use with mobile devices.

⁶ Case C-533/06

⁷ *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38

24. The Cambridge Dictionary defines a “mobile application” as “a software program that runs on a mobile phone”. The opponent’s software terms such as *games software* (which do not specify that the software is computer software) may be provided in the form of mobile applications. These goods may be included within the applicant’s terms. I therefore disagree with the applicant and find that the goods are identical under the principle within *Meric*.

Downloadable computer software for managing cryptocurrency transactions using blockchain technology.

25. As well as being included within the opponent’s *computer software programs*, this term is also identical to the opponent’s term *downloadable computer software for managing cryptocurrency transactions using blockchain technology* on a literal basis.

Apparatus for processing electronic payments.

26. It is my view that these goods are identical to the opponent’s terms *electronic payment terminals* and *hardware for processing electronic payments to and from others*, which can both be fairly described as apparatus for processing electronic payments. However, if I am wrong in my understanding of this, I find in the alternative that these goods are included within the opponent’s wider term *point of sale apparatus* and are therefore identical under the principle within *Meric*.

Class 42:

Design and development of computer software.

27. This term includes the opponent’s term *design and development of computer game software*, and therefore they are identical under the principle in *Meric*.

*Software as a service [SaaS] featuring software platforms for electronic gaming;
Platforms for gaming as software as a service [SaaS].*

28. These terms are included within the opponent’s wider term *software as a service [SaaS]* and therefore the goods are identical under the principle within *Meric*.

Maintenance of computer software; updating of software.

29. These terms are both included in the opponent's *design, installation, provision, maintenance and updating of computer programs and software*. The terms are therefore identical under the principle within *Meric*.

Data storage via blockchain.

30. This term is identical to the opponent's *data storage via blockchain* on a literal basis.

Blockchain as a Service [BaaS].

31. This term is identical to the opponent's *blockchain as a service (Baas)* on a literal basis.

Data authentication via blockchain.

32. This term is identical to the opponent's *data authentication via blockchain* on a literal basis.

Certification of data via blockchain.

33. This term is identical to the opponent's *certification of data via blockchain* on a literal basis.

Customized design of computer software.

34. This narrower term specifying "customized" is included within the opponent's wider term *design [...] of computer programs and software*. They are therefore identical under the principle in *Meric*.

Design and development of computer game software and virtual reality software.

35. This term is identical to the opponent's term *design and development of computer game software and virtual reality software*.

Information technology [IT] consulting services.

36. This term is included within the opponent's wider term *IT services*. The services are therefore identical under the principle in *Meric*.

Hosting of websites.

37. This term is included within the opponent's term [...], *hosting [...] of sites such as Internet sites*. The services are therefore identical under the principle in *Meric*.

Hosting of platforms on the Internet.

38. The opponent's narrower term *hosting of e-commerce platforms on the Internet* is included within the applicant's wider term. The services are therefore identical under the principle in *Meric*.

Development of computer platforms; development of software for secure network operations.

39. These narrower development terms fall within the opponent's wider term *research and development services*. The services are therefore identical under the principle in *Meric*.

User authentication services using blockchain technology.

40. In its submissions, the opponent argues that these services "serve the same functional and commercial purpose and are intended for the same or overlapping client groups" with the opponent's services for authentication. These services may have the same users and broad nature as the opponent's *data authentication via blockchain*, given that the services will be used by people seeking to use blockchain technology for authorisation purposes. Whilst their purpose overlaps to a degree, it differs in that the applicant's services are used to authorise users whereas the opponent's services are used in relation to data. They may be offered through the same or similar trade channels. At times they may be listed together given the overlap in nature and purpose. However, the focus of the services is quite distinct so they may not always be, given that some providers of these services may focus on their own specific area of authentication. With no evidence before me relating to how these services work, it is my view that they are unlikely to be complementary. Although data will be involved in authenticating a user, the services themselves are likely to operate separately given

that the focus of the authentication services differs. Given their difference in core purpose, they are unlikely to be in competition with each other. Taking into account these factors, I find that the services are similar to a medium degree.

Computer programming of smart contracts on a blockchain.

41. In its submissions, the opponent argues that these services also “serve the same functional and commercial purpose and are intended for the same or overlapping client groups” with the opponent’s services “for authentication and encryption using blockchain technology”. I cannot see any of the opponent’s terms which specify encryption, so I will assess the similarity with the opponent’s *data authentication via blockchain*. There may be an overlap in users, nature, and purpose between these services and the opponent’s service, as both will be used by people seeking to use the services in conjunction with blockchain technology. However, they differ as the applicant’s services focus on the programming of smart contracts, whereas the opponent’s services are primarily involved in data authentication. They may be offered through similar trade channels in that they are likely to appear in IT-related contexts, but they may differ as to where they appear within those channels due to the difference in purpose. I have no evidence before me to suggest that they are complementary. Given their different purposes, I find that it is unlikely that they are in competition with each other. Taking all of this into account, I find a low degree of similarity between the services.

Average consumer and the purchasing act

42. 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 in question: *Lloyd Schuhfabrik Meyer*⁸.

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*⁹, Birss J (as he then was) described the average consumer in these terms:

⁸ Case C-342/97

⁹ [2014] EWHC 439 (Ch)

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

44. In its submissions, the opponent argues that “taking into account the category of goods and services, the degree of sophistication and level of attention shall be considered to vary from low (for the public at large) to average (for professionals)”. In its counterstatement, the applicant has not commented on the average consumer or level of attention paid when purchasing the goods and services.

45. The goods are types of software and apparatus for processing payments. Some of the software is broader in its purpose whereas others are more specialised and targeted towards certain professions or interests such as the gaming and/or betting communities, or financial specialists. The average consumer of the goods is likely to be businesses and professional users for the more specialised software but may also include the public at large. The cost of purchase and frequency of purchase will vary depending on the type of software. However, I recognise that some of the goods (such as those relating to mobile applications and some types of software) may be low cost or even free of charge, and consumers may therefore pay less attention when selecting these goods. Several factors may influence the average consumer when purchasing the goods, such as useability, technical function, and the compatibility of the software with existing systems. Based on these factors, I find that the average consumer is likely to pay around a medium degree of attention for the general public, although it may be lower for some types of software such as those relating to mobile apps where there may be more causal selections. The level of attention paid may be higher than medium overall for the goods aimed at businesses and professionals. The goods will be available in specialist retailers and general retailers, both in stores and via their online equivalents. They may also be available from app stores. The customer will self-select the goods from the display shelves, or by selecting the image of their desired product if purchasing online in respect of the goods and services. The visual

component will therefore dominate the purchasing process, but I do not discount aural considerations, such as word-of-mouth recommendations, discussing the suitability of the products with the provider, or placing telephone orders.

46. The services at issue are both broad in nature and aimed at the public at large and also professional users, whereas some are more specialised and aimed at certain types of professions or interests such as the gaming communities. The average consumer of the services is likely to be businesses and professional users for the more specialised software but may also include the public at large. The cost of purchase and frequency of purchase will vary depending on the type of service and the scale of the project to be undertaken, but more specialist services relating to development and programming may come at a higher cost. Several factors may influence the average consumer when purchasing the services, such as, inter alia, the expertise and reputation of the provider of the services, and the time taken to complete the work. Taking all of these factors into account, I find that the average consumer is likely to pay a medium degree of attention when purchasing the services, with professional users paying slightly more. The services are likely to be purchased directly from the provider, after seeing information online or in brochures. The visual component will therefore dominate the selection process. However, I do not discount the role that aural selection may play when purchasing, such as through word-of-mouth recommendations or when consumers discuss the services with the provider or a representative before purchasing them.

Comparison of marks

47. 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*¹⁰, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means

¹⁰ Case C-591/12P

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.”

48. 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.

49. The respective trade marks are shown below:

The opponent’s marks	The applicant’s mark
Circus CIRCUS	Circus Delight

50. In its submissions, the opponent submits the word “Circus” is “the sole, and therefore dominant and distinctive element” of its marks. The opponent also argues that the word “Circus” is the “main and only distinctive term” in the competing marks. In its counterstatement, the applicant argues that ““Circus Delight” forms a unitary expression in which both “Circus” and “Delight” contribute equally to the distinctive character and overall impression of the mark”.

51. The opponent’s marks are plain word marks, with one written in uppercase and the other in title case. As word-only marks with no other elements, the overall impression lies in the word “Circus”/“CIRCUS”.

52. The applicant’s mark is also a plain word mark written in title case. As neither ‘Circus’ nor ‘Delight’ are directly descriptive or non-distinctive in relation to the goods and services, I do not find that either is more dominant within the applicant’s mark. Whilst the applicant argues that the words will be viewed together as a unitary expression, I am of the view that the average consumer will not understand them in this way, and will instead understand the separate words’ meanings rather than as a

unitary phrase. As a word-only mark with no other elements, I am of the view that the overall impression lies equally in the individual words “Circus” and “Delight”.

My approach

53. As the opponent’s marks only differ as to the type of case, for ease of reference, I will focus my assessment on the mark “Circus” in the series of two. However, for the avoidance of doubt, the same findings will also apply to the opponent’s other mark “CIRCUS”. This is because word marks are protected regardless of the case type, as shown in *LA Superquimica v European Union Intellectual Property Office (EUIPO)*¹¹, in which the GC held at [39] that word-only marks protect the word or words contained in the mark in whatever case, colour or typeface. The difference in capitalisation between “Circus” and “CIRCUS” is therefore not significant. I will therefore continue to refer only to the opponent’s mark “Circus”.

Visual comparison

54. In its submissions, the opponent argues that the marks are visually similar on the basis that the applicant’s mark includes the entirety of the opponent’s mark in the initial position within its mark. In its counterstatement, the applicant accepts that the marks share the word “Circus”, but argues that the addition of “Delight” in its mark “creates a clear visual distinction between the two marks”.

55. The competing marks are similar because they both have the identical word “Circus”. The marks differ as the applicant’s mark contains the second word “Delight”, which is not present in the opponent’s mark. The beginnings of words tend to have more visual and aural impact than the ends¹², which, in my view, results in the visual difference created by the additional word ‘Delight’ being slightly less significant. Bearing in mind my analysis of the marks’ overall impressions, I am of the view that the marks are visually similar to a medium degree.

¹¹ Case T-24/17

¹² See paragraph 81 of *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Aural comparison

56. In its submissions, the opponent argues that the marks are similar to a high degree “due to sharing the common distinctive element “Circus””. In its counterstatement, the applicant argues that the “additional word “Delight” materially alters the rhythm, cadence and overall auditory impression” of the applicant’s mark.

57. The competing marks are aurally similar as they both contain the word “Circus”. The competing marks differ as the applicant’s mark contains the second word “Delight”, which is not present in the opponent’s mark. The beginnings of words tend to have more visual and aural impact than the ends as per *El Corte Ingles* cited above, which, in my view, results in the aural difference created by the additional word ‘Delight’ being slightly less significant. Bearing in mind my analysis of the marks’ overall impressions, I am of the view that the marks are aurally similar to a medium degree.

Conceptual comparison

58. In its submissions, the opponent argues that the marks are conceptually similar as they both contain the word “Circus”. Furthermore, it also argues that the word “Circus” in the applicant’s mark is a “separate element and is clearly recognizable and plays an independent role”. It also adds that in the applicant’s mark, “the word “Delight”... only serves to further the amusing and good connotations that the word “Circus” already conveys”. In its counterstatement, the applicant argues that the two words contribute equally to the applicant’s mark overall impression on the basis that “Circus Delight” forms a unitary expression. The applicant also submits that “while the individual words “Circus” and “Delight” each convey a specific and recognisable meaning, the combination “Circus Delight” has no established dictionary definition and is not a commonly used or recognised phrase in the English language” and therefore this “invented combination conveys a new and independent conceptual impression, departing materially from the conventional meaning associated” with the word “Circus”. On this basis, it therefore argues that the competing marks are conceptually dissimilar.

59. The Cambridge Dictionary defines the word “circus” as “a group of travelling performers including acrobats (= people skilled in difficult physical movements) or those who work with trained animals, or a performance by such people usually in a large tent”. It defines the word “delight” as “a feeling of great pleasure, satisfaction, or

happiness”. It is my view that the average consumer in the UK would not recognise “Circus Delight” as a phrase formed by combining the two words to convey a unitary meaning. Instead, as the words “Circus” and “Delight” are both recognisable dictionary-defined words, I am of the view that, when encountering the words “Circus Delight”, the average consumer will extrapolate the two words’ individual meanings and understand them as being independent of each other. I therefore agree with the applicant that the average consumer will derive individual meanings from each verbal component, but I disagree with the applicant that the average consumer would understand the words as a complete unit with its own independent meaning, as there is no obvious conceptual meaning to the combination of the two words “Circus” and “Delight”. As both marks share the identical dictionary-defined word “Circus” but differ due to the inclusion of the additional word “Delight” in the applicant’s mark, it is my view that the marks are conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

60. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*¹³, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 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

¹³ Case C-342/97

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).”

61. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

62. Although the distinctiveness of a mark can be enhanced by virtue of the use made of it, the opponent has not filed any evidence. As such, I have only the inherent position to consider.

63. In its submissions, the opponent submits that the word “Circus” is “highly distinctive” in relation to the goods and services. As stated previously, it is my view that the average consumer will understand the mark as per its dictionary definition, i.e., “a group of travelling performers... or a performance by such people usually in a large tent”. It is my view that the term “Circus” will be viewed by the average consumer as a somewhat fanciful term that is arbitrary in relation to the goods and services. However, whilst I acknowledge that in *Janus International Group LLC v Grosvenor Technology Limited*¹⁴, Phillip Johnson sitting as the Appointed Person highlighted at paragraph 34 that there is no specific reason why arbitrary marks (i.e. existing words used as trade marks) cannot be inherently distinctive to a high degree, I do not consider this to be the case for the opponent’s mark. This is because, in my view, “Circus” is not an obscure or unusual word but, rather, an ordinary word with which the average consumer would be highly familiar. Whilst I am of the view that the word is somewhat fanciful in relation to the goods and services, I do not consider it to be so strikingly distinctive or “out of the ordinary” in relation to the goods and services to be deemed as having a high level of distinctiveness. I therefore disagree with the opponent, and instead find that the opponent’s mark has a medium level of inherent distinctiveness.

¹⁴ BL 0/558/25

Global assessment – conclusions on likelihood of confusion

64. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while 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 and services down to the responsible undertakings being the same or related. There is no set formula for establishing a likelihood of confusion between marks; it is a global assessment where a number of factors need to be borne in mind.

65. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and services, and the nature of the purchasing process. In doing so, I must be mindful 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 that they have retained in their mind.

66. In its submissions, the opponent argues that there is a risk of direct confusion between the competing marks under the principle of imperfect recollection, and a risk of indirect confusion between competing marks due to the shared word "Circus" and the identical or similar nature of the parties' goods and services. In its counterstatement, the applicant argued that the shared use of the word "Circus" does not give rise to a likelihood of confusion and instead, the average consumer would view the use of "Circus" in both marks as coincidental.

67. Earlier in this decision I found that the applicant's goods and services range from being similar to a low to medium degree to being identical to the opponent's goods and services. The average consumer of goods and services will be the general public and professional users. The average consumer is likely to pay a low to medium amount of attention when purchasing the goods, but this may be higher for professional users. The average consumer is likely to pay a medium amount of attention when purchasing the services, although this may be higher for professional users. I have found the

competing marks to be visually, aurally and conceptually similar to a medium degree. The earlier mark has a medium level of inherent distinctive character.

68. The overall impression of the opponent's mark lies exclusively in the word "Circus", whereas the overall impression lies equally in the two words "Circus" and "Delight" in the applicant's mark. The additional word "Delight" within the applicant's mark constitutes a significant difference between the competing marks in respect of their visual, aural and conceptual identities, and it is unlikely that the average consumer would overlook it. It is my view that this additional word is likely to be sufficient to prevent the average consumer from mistaking one mark for the other, even where a lower level of attention is exhibited during the purchasing process. I therefore find that there is no likelihood of direct confusion, even in respect of identical goods.

69. This leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*¹⁵, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a 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

¹⁵ BL O/375/10

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).

70. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*¹⁶, Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

71. It is not sufficient that a mark merely calls to mind another mark (as per *Duebros Limited v Heirler Cenovis GmbH*¹⁷). This is mere association not indirect confusion. A finding of indirect confusion should not be made merely due to a shared element within marks.

72. I do not consider the immediate case to fit neatly into one of the categories set out in *L.A. Sugar* above. However, I remind myself that these are not exhaustive. I also consider the relevance of *Medion v Thomson*¹⁸ and the subsequent case law. In *Whyte*

¹⁶ [2021] EWCA Civ 1207

¹⁷ BL O/547/17

¹⁸ Case C-120/04

*and Mackay Ltd v Origin Wine UK Ltd and Another*¹⁹, Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*²⁰, on the court's earlier judgment in *Medion*. The judge said:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It

¹⁹ [2015] EWHC 1271 (Ch)

²⁰ Case C-591/12P

remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

73. I have previously found that in the applicant’s mark, the first word “Circus” (which is identical to the opponent’s mark “Circus”) has its own conceptual independence from the second word “Delight”. It is my view that the average consumer of the goods would not interpret the two words “Circus” and “Delight” as being a complete unit which has its own meaning separate from the meaning of the two constituent parts. The distinctive significance of “Circus” is therefore independent from the distinctive significance of the whole mark “Circus Delight”. On this basis, the marks may be confused as a result of the moderately distinctive shared element (which has an independent distinctive significance within the applicant’s mark) being identical to the opponent’s mark “Circus”. I am of the view that the average consumer, even when paying a higher than medium level of attention, may believe the mark “Circus Delight” to indicate a commercial connection between the respective undertakings. On this basis, I find that there is a likelihood of indirect confusion, notwithstanding the difference between the competing marks. I find this to be the case even for the services which are similar only to a low degree due to the identical nature of the shared element and the interdependency principle.

Final remarks

74. The opposition under section 5(2)(b) has been successful in its entirety. Subject to any successful appeal, the application will be refused registration.

Costs

75. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. As the opposition was brought under the fast-track procedure, the figures are capped. In the circumstances I award the opponent the sum of £500 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Filing a notice of opposition: £150

Filing written submissions: £250

Official fees: £100

76. I therefore order Soft Sonic Information Technology LLC to pay CIRCUS BELGIUM S.A. the sum of £500. 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 16th day of December 2025

K SERRAVALLE

For the Registrar