

O-261-04

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2272300
BY OUTRAGEOUS GAMES LIMITED
TO REGISTER THE TRADE MARK
BILLIONAIRE OR BUST
IN CLASS 28
AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 90669
BY CROWN & ANDREWS PTY LIMITED

BACKGROUND

1) On 11 June 2001, Outrageous Games Limited of Gun Court, Wapping Lane, London E1 9RL applied under the Trade Marks Act 1994 for registration of the trade mark BILLIONAIRE OR BUST, In respect of the following goods in Class 28: “Board games and parts and fittings therefor”.

2) On 6 June 2002 Crown & Andrews Pty Limited of 19-21 Euston Street, Rydalmere, New South Wales 2116, Australia filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of UK Trade mark 1243791 “Billionaire” registered with effect on 12 June 1985 in respect of “card games (other than ordinary playing cards)” in Class 28. The mark in suit is similar to the opponent’s trade mark, and the goods applied for are identical or similar. The mark applied for therefore offends against Section 5(2)(b) of the Trade Marks Act 1994.

3) The applicant subsequently filed a counterstatement denying the opponent’s claims.

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 11 August 2004 when the applicant was represented by Mr Wilberforce-Ritchie, a Director of the applicant company, and the opponent by Ms Berner of Messrs Urquhart-Dykes & Lord.

OPPONENT’S EVIDENCE

5) The opponent filed a statutory declaration, dated 11 February 2003, by Sarah Berner the opponent’s Trade Mark Attorney. She gives her opinion that the average consumer would, on seeing the mark in suit used on a board game, assume that it emanated from the opponent.

6) Ms Berner claims that there is a link between card games and board games. She carried out a search at Hamleys toy store on 7 September 2002. She claims that board games frequently contain cards and that in her search both card games and board games were found on the same shelves under the sign for “games”. She states that the two parties products would be similar in terms of trade channels, uses and users. She points to compendium packs of examples of board games and cards being in the same package but used separately.

APPLICANT’S EVIDENCE

7) The applicant filed a witness statement, dated 14 November 2003, by Andrew Wilberforce-Ritchie a Director of the applicant company. He points out that his game is a board game which incorporates cards whilst the opponent’s product is a pure card game. He also notes that the packaging is such that whilst his product can be stacked on shelves the opponent’s product is designed to be hung from hooks usually on a carousel. Mr Wilberforce-Ritchie also claims that he visited toy shops and found that

card games were kept on separate displays as they were hung from metal spikes whilst board games such as his company's were displayed on shelves.

OPPONENT'S EVIDENCE IN REPLY

8) The opponent filed another statutory declaration, dated 4 May 2004, by Ms Berner. She accepts that the games are played in a different manner and that the packaging is different. She reiterates her belief that the marks and goods are similar. At exhibit SB2 she provides a definition of the word "game" from the Collins Gem English Dictionary (1994 edition) which defines the word as "amusement or pastime; contest for amusement;" and states that this definition covers both parties products.

9) Ms Berner states that manufacturers of games also produce cards and at exhibit SB3 she provides a copy of the Hasbro internet site which she claims shows that Hasbro, the makers of Monopoly, also manufacture cards bearing the Monopoly trade mark. In fact the exhibit merely shows that Hasbro manufacture a variety of board games, cards games etc under a variety of trade marks. There is no evidence that they produce cards under the Monopoly mark.

10) Whilst accepting that card games are hung from spikes for display purposes Ms Berner provides photographs at exhibit SB4 of a display at Hamleys which shows that on 30 April 2004 packs of playing cards were stacked on shelves along with games such as backgammon and Roulette.

11) That concludes my review of the evidence. I now turn to the decision.

DECISION

12) The ground of opposition is under Section 5(2)(b) which reads:

"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) An "earlier trade mark" is defined in Section 6, the relevant parts of which state:

"6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,"

14) The opponent is relying on a UK Trade Mark No 1243791 “BILLIONAIRE” registered with effect from 12 June 1985, which is plainly an “earlier trade mark”.

15) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. It is clear from these cases that:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel Bv v Puma AG*;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel Bv v Puma AG*;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel Bv v Puma AG*;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.*;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel Bv v Puma AG*;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel Bv v Puma AG*;

(h) further, 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; *Marca Mode CV v Adidas AG*;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.*

16) In essence the test under Section 5(2)(b) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned

above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services, the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's registration on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

17) I will first compare the goods of the two parties. For ease of reference these are:

Applicant's goods	Opponent's Goods
Class 28: "Board games and parts and fittings therefor".	Class 28: "Card games (other than ordinary playing cards)"

18) In carrying out a comparison I take into account the factors referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, the ECJ stated at paragraph 23:

"23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary."

19) Whilst the goods may not share a shelf in a retail outlet they would clearly be displayed in the same area, as the evidence shows. Whilst I accept the applicant's contentions that the games are different in the manner in which they are played and in some of the physical characteristics of the games themselves, I have to have regard to all of the factors identified above. Both sets of goods would be used by members of the general public for their amusement. Clearly, both would be sold in the same parts of a department store or by toy shops or shops specialising in games. It is clear that they would be in competition.

20) In my opinion the goods in the applicant's specification are similar to those of the opponent.

21) I will now compare the applicant's mark "Billionaire or Bust" with the opponent's mark "Billionaire". Clearly they both share the same first word. The difference between them is that the applicant's mark also has the words "or bust" in addition to the shared word. There are therefore visual and phonetic similarities and also differences.

22) Conceptually the marks convey a similar message, that the games are based on wealth creation in a similar fashion to other such games, the best known of which is Monopoly. The additional part of the mark in suit clearly implies that one can lose the wealth acquired as part of the game, but this "danger" is clearly an intrinsic part of

any game where the winner is judged to be the one who makes the most money or achieves a set goal first.

23) I also have to consider whether the opponent's marks have a particularly distinctive character either arising from the inherent characteristics of the marks or because of the use made of them. The opponent has not filed any evidence of use of their mark. To my mind the opponent's mark has a slightly allusive nature in that it implies the fundamental nature of the card game, but it is not descriptive. The opponent's mark must be regarded as having an inherently distinctive character when used in relation to card games.

24) It is accepted that the beginnings of trade marks are the most important, and I must also take into account imperfect recollection. To my mind the similarities in the marks outweigh the differences.

25) Taking account of all of the above when considering the marks globally, I believe that there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore succeeds.

26) As the opponent was successful it is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £1100. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 25th day of August 2004

George W Salthouse
For the Registrar,
the Comptroller-General