

O-322-15

TRADE MARKS ACT 1994

**TRADE MARK APPLICATIONS NOS. 3011060 AND 3018068
BY GLOFONE UK LIMITED
TO REGISTER THE TRADE MARKS**

glo glu

AND



IN CLASSES 9, 14, 28, 38, 39 AND 41

AND

**THE CONSOLIDATED OPPOSITIONS THERETO UNDER NOS. 401170 AND
401337
BY GLU MOBILE INC**

Background and pleadings

1. Glofone UK Limited (“the applicant”) applied for the trade marks shown below on 23 June 2013 and 14 August 2013, in classes 9, 14, 28, 38, 39 and 41:

glo glu (number 3011060)



(number 3018068)

2. The applications were published on 2 August 2013 and 13 September 2013, respectively. Glu Mobile Inc (“the opponent”) opposes the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) on the basis of the following earlier Community Trade Mark, registered in classes 9, 35 and 41:

4388237

GLU

Filed: 14 April 2005

Date registration procedure completed: 8 February 2007

3. As the opponent’s earlier mark had been registered for five years or more on the publication dates of the opposed applications, it is subject to proof of its use. The opponent made a statement that it had put its mark to genuine use for all the registered goods and services. The applicant, in its counterstatement, put the opponent to proof of use except in relation to the following, for which the applicant accepts use:

Class 9: Computer software, namely, entertainment software, computer games all for use on mobile and cellular telephones, hand-held computers, computers, video game consoles, video game machines, and/or television set-top boxes for use in accessing a global computer network.

Class 41: Providing on-line computer games, accessed and/or played via mobile devices and cellular phones.

4. The proceedings were consolidated. The opponent was afforded time in which to file evidence of use. It did not do so during the time permitted and was refused an extension of time request to file evidence, at a case management conference held on 6 March 2015¹. Consequently, the opponent has not substantiated its claim to have made genuine use of its mark on all the goods and services registered in classes 9, 35 and 41, and so may rely only upon the goods and services, listed in the preceding paragraph, for which the applicant concedes that there has been use.

¹ The case management decision was taken by a different hearing officer, Mr Allan James.

5. The applicant denies that the marks or the goods and services are similar. It denies that there is a likelihood of confusion.

6. Both parties are professionally represented. Neither filed evidence. Although a direction was made at the case management conference that a hearing should be appointed to decide the substantive ground, the Registry then gave both parties a choice as to whether they wished to have a hearing or for the decision to be made on the basis of the papers. Both parties chose to file written submissions in lieu of a hearing.

Decision

7. Section 5(2)(b) of the Act states that:

“(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.”

8. The following principles 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 will wrongly 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

9. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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 intended purpose and their method of use and whether they are in competition with each other or are complementary.”

10. ‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

“82 It is true that goods are complementary if 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...”.

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

12. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. 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.”

13. The competing specifications are shown in the table below (the specifications for the two applications are almost identical, but where there are differences, these are shown in the table).

Earlier mark	Applications
<p>Class 9: <i>Computer software, namely, entertainment software, computer games all for use on mobile and cellular telephones, hand-held computers, computers, video game consoles, video game machines, and/or television set-top boxes for use in accessing a global computer network.</i></p> <p>Class 41: <i>Providing on-line computer games, accessed and/or played via mobile devices and cellular phones.</i></p>	<p>Class 9: <i>Global Positioning System (GPS) apparatus; mobile phones; mobile phones to be worn like a watch; mobile telecommunication apparatus and instruments and parts and fittings therefor.</i></p> <p>Class 14: <i>Watch straps; clocks and watches; watches incorporating a mobile phone; watches incorporating a mobile phone and Global Positioning System (GPS) apparatus; watches incorporating Global Positioning System (GPS) apparatus; horological and chronometric instruments and parts and fittings therefor.</i></p> <p>Class 28: <i>Toys, games and playthings; toy clocks and watches [3011060].</i></p> <p><i>Toys, games and playthings; toy clocks; watches and wearable devices [3018068].</i></p>

	<p>Class 38: <i>Telecommunication services; providing internet chatrooms, chatroom services for social networking; provision of online forums for communication on topics of general interest</i> [3011060].</p> <p><i>Telecommunication services providing internet chatrooms; chatroom services for social networking; provision of online forums for communication on topics of general interest</i> [3018068].</p> <p>Class 39: <i>GPS navigation services; GPS services for tracking people and animals.</i></p> <p>Class 41: <i>Publication of material on watches, mobile phones and Global Positioning System (GPS) apparatus accessed from databases or the Internet; electronic games services provided by means of the internet</i> [3011060].</p> <p><i>Publication of material on watches, wearable devices, mobile phones and Global Positioning System (GPS) apparatus accessed from databases or the Internet; electronic games services provided by means of the internet</i> [3018068].</p>
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14. The opponent’s specification in class 9 includes the word “namely”. The word “namely” is to be approached as set out in the Trade Marks Registry’s classification guidance:

“Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states "namely" to mean "that is to say" and the Cambridge International Dictionary of English which states "which is or are".

On the basis of the above guidance, the opponent’s computer software in class 9 is limited to *entertainment software, computer games all for use on mobile and cellular telephones.*

15. Further, the wording and use of commas, rather than semi-colons, in the class 9 specification indicates that the entertainment software and computer games are all for use on mobile and cellular telephones, on hand-held computers, on computers, on video game consoles, on video game machines, and/or on television set-top boxes for use in accessing a global computer network. The opponent does not have

cover for any of this hardware *per se*: it has cover for entertainment software and computer games which are played on the various types of hardware.

16. The opponent relies upon two opposition division decisions from the OHIM, B1848160 (*Sony Computer Electronics Europe Limited v Beats Electronics LLC, BEATS Device/BEATS PRO*, 10 August 2012, and B2053125 (*Bentley Motors Limited v Bentley 1962 Ltd*), 15 May 2014. In the first of these decisions, the opposition division found that computer game software was similar to recording, transmission and reproduction of sound and images apparatus because producers can coincide, there is competition between them and they are complementary. In the second decision, the opposition division said:

“The contested Global Positioning System [GPS] apparatus are similar to the opponent’s computer software, as they can coincide in end user and distribution channels. Furthermore, they are complementary.”

I am not bound by the decisions of OHIM, although they may be informative. In this instance, it is not explained why trade channels coincide, and why the goods can be both in competition and be complementary. The opponent submits that its entertainment software covers smartphone applications which utilise a device’s GPS capabilities for the user’s entertainment. There is no evidence of this. The natural interpretation which average consumers would give GPS apparatus is that the apparatus provides positioning or navigational information using orbiting satellites. It is stretching matters beyond the parameters of the caselaw to extend that purpose and method of use to entertainment; at least, without providing evidence of such applications. There is no similarity between the opponent’s goods and services and the following of the applicant’s goods and services:

- Class 9: Global Positioning System (GPS) apparatus;
- Class 14: Watches incorporating Global Positioning System (GPS) apparatus;
- Class 39: GPS Navigation services; GPS services for tracking people and animals;
- Class 41: Publication of material on Global Positioning System (GPS) apparatus.

17. I will group the remainder of the applicant’s class 9 goods together: *mobile phones; mobile phones to be worn like a watch; mobile telecommunication apparatus and instruments and parts and fittings therefor*. It does not automatically follow that the mobile phones are similar to games software which can be played on a mobile phone. Again, there is no evidence about the way the parties’ goods reach the market, but I know from personal experience of owning a smartphone that games are downloaded as ‘apps’ from online stores. The nature and purpose of the device and the games differ, although there may be a coincidence of channels of trade. There is also a one-way level of complementarity because to play a games app, one needs to download it to a device. However, neither of these considerations make for a strong level of similarity; in fact, any similarity to the opponent’s goods and services is of a very low level. By parity of reasoning, there is even less similarity, that is to say no similarity, between the opponent’s goods and services and the applicant’s class 14 goods.

18. The applicant's services in class 38 are telecommunications services (in the case of the specification wording for 3011060, the applicant has cover for telecommunications at large). The opponent submits that its class 9 software includes smartphone applications which provide access to internet chatrooms and forums. I am not sure that the opponent's term "entertainment software" covers this type of application, which seems to me to be a telecommunications application, for the primary purpose of communicating with others, rather than for entertainment (e.g. Twitter, Instagram etc). I cannot discern any similarity between the applicant's telecommunications services providing access to chatrooms and the opponent's entertainment software in class 9 and its provision of online computer games in class 41.

19. In *Gérard Meric v OHIM*, Case T-33/05, the GC stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

The opponent's services in class 41 are covered by the following services in the applicant's class 41 specifications: electronic games services provided by means of the internet. These are identical.

20. The applicant's class 41 services - publication of material on watches, wearable devices and mobile phones accessed from databases or the Internet – cover the opponent's providing on-line computer games, accessed and or played via mobile devices and cellular phones. This is because both parties' services cover the placing of material, including games, on devices.

21. The applicant has cover for all types of toys, games and playthings, including non-electronic versions of electronic games, electronic games which are not adapted for television receivers, and hand-held electronic games. If not exactly the same in nature (electronic games must be close in nature to games software), they are similar in purpose, method of use, share trade channels and are in competition. Additionally, the applicant's wearable devices could include electronic hand-held games. They are highly similar. However, toy clocks and watches (which must be simply toys, otherwise they would be proper to class 14) do not share any meaningful similarity to the opponent's goods or services: they are purely toy versions of clocks and watches. They do not share nature or purpose, are unlikely to share trade channels except on the most general of levels, are not in competition and are not complementary.

Average consumer

22. 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 or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. The average consumer for the parties' goods and services is the general public: these are consumer goods and services. Some will be more expensive than others (such as watches and sophisticated electronic devices), whilst others, such as toys and watch straps will be at the cheaper end of the spectrum. Expensive technological devices, infrequently purchased, will cause a considerable amount of attention to be paid to their purchase; whilst, for example, a game (whether computer or otherwise) will be likely to cause an average degree of care to be taken in selection. For all the goods and services, the purchasing process is likely to involve a primarily visual inspection of the goods or services on offer, such as online or via shop shelving, but I do not discount the potential for aural reference to the marks, such as during discussion with a retail assistant.

Comparison of marks

23. 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 Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, 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 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.”

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 impression created by the marks.

24. The opponent's best chance of success lies in comparing its mark to the applicant's word mark, which is closer to its own word mark than the applicant's stylised mark. The respective marks are:

Opponent	Applicant
GLU	glo glu

25. The overall impression of the opponent's mark is of a three letter invented 'word'. This is the second component of the applicant's mark, which also consists of two, three-letter, invented words. Neither element of the applicant's mark is more dominant than the other; they contribute equally to the impression of two short, invented, words.

26. Although all the components in each party's mark are invented (or are misspellings), they may nevertheless evoke dictionary words: 'glow' and 'glue'. To this extent, the marks share some evocation of glue, although the applicant's mark has potential for an evocation of glue that glows. However, there is a fair amount of disguise as the words primarily appear invented.

27. The marks are visually similar to a medium degree. The second element of the applicant's mark is identical to the entirety of the opponent's mark, and the first element is also a three letter combination beginning with the letters gl. The level of aural similarity is moderate since glo, with a different vowel sound, is enunciated first. The two components in the applicant's mark are alliterative, which also puts an aural distance between the marks, as there is no alliteration in play in the earlier mark.

Distinctive character of the earlier mark

28. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*² 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 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).”

29. The opponent has filed no evidence, so I have only the inherent position to consider. The mark has the appearance of an invented word, possibly evocative of (and identical to, aurally) the dictionary word 'glue'. As an invented word, it has a high level of distinctive character; as a word evocative of glue, its distinctive character is still of a reasonably high level since glue would not seem to have any descriptive or allusive meaning in relation to the opponent's goods and services.

² Case C-342/97

Likelihood of confusion

30. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). Where there is no similarity between goods and services, there can be no likelihood of confusion (also *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*) I have found no similarity in relation to the following goods and services, for which the opposition therefore fails:

Class 9: *Global Positioning System (GPS) apparatus;*

Class 14: *Watch straps; clocks and watches; watches incorporating a mobile phone; watches incorporating a mobile phone and Global Positioning System (GPS) apparatus; watches incorporating Global Positioning System (GPS) apparatus; horological and chronometric instruments and parts and fittings therefor.*

Class 28: *toy clocks and watches.*

Class 38: *Telecommunication services; providing internet chatrooms, chatroom services for social networking; provision of online forums for communication on topics of general interest [3011060].*

Telecommunication services providing internet chatrooms; chatroom services for social networking; provision of online forums for communication on topics of general interest [3018068].

Class 39: *GPS navigation services; GPS services for tracking people and animals.*

Class 41: *Publication of material on Global Positioning System (GPS) apparatus accessed from databases or the Internet [3011060].*

31. I said earlier that the opponent's mark, which is identical to the second of the two components of the applicant's mark, is highly distinctive. In *Julius Sämaan Limited (Bermuda) and Julius Sämaan Limited (Switzerland) v L&D S.A. ("Aire Limpio")* BL O/193/15, Ms Anna Carboni, sitting as the Appointed Person, stated:

"95. ...the approach that should be taken when assessing the similarity of a later composite mark that incorporates an element that is argued to be the same as or similar to the earlier mark or a dominant or distinctive component of it. In summary, this approach should be:

(1) is the earlier trade mark, or a dominant or distinctive component of it, the dominant element of the composite sign?

(2) if not, does it nevertheless retain a role in the composite sign that is perceived by the average consumer, notwithstanding the fact that another element of the sign may be more prominent?

(3) if so, it must be taken into consideration for the purposes of assessing the similarity between the composite sign and the earlier trade mark and is therefore relevant for the purposes of assessing the likelihood of confusion;

(4) but it is only one factor in the global assessment and does not mean that a likelihood of confusion will necessarily be found.”

32. I do not think that glu is a dominant part of the applicant's mark: the two elements glo glu contribute equally to the overall impression of the applicant's mark. It is also the second element. Nevertheless, its highly distinctive nature and complete lack of descriptiveness or allusion to the opponent's goods and services means that, for identical and highly similar goods and services to which an average degree of attention is paid, there is a likelihood that the average consumer will attribute the common presence of the glu element of the applicant's mark to the same or an economically linked undertaking. The bubble writing of the applicant's stylised mark makes no difference to this conclusion as the marks are still clearly glo glu marks. Therefore, there is a likelihood of confusion in relation to the following goods and services in the applications:

Class 28: *Toys, games and playthings.*

Class 41: *Publication of material on watches, wearable devices and mobile phones accessed from databases or the Internet; electronic games services provided by means of the internet.*

33. However, the very low level of similarity between the remainder of the goods in class 9, to which a considerable amount of attention will be paid during purchase, means that the average consumer is not likely to imperfectly recall the marks, or to attribute the common element glu to economically linked undertakings. There is no likelihood of confusion in relation to *mobile phones; mobile phones to be worn like a watch; mobile telecommunication apparatus and instruments and parts and fittings therefor.*

Outcome

34. The applications are refused for:

Class 28: *Toys, games and playthings.*

Class 41: *Publication of material on watches, wearable devices, mobile phones accessed from databases or the Internet; electronic games services provided by means of the internet.*

The applications may proceed to registration for all the remaining goods and services.

Costs

35. The applicant has been more successful than the opponent. I will make an award of costs in favour of the applicant, reduced to reflect the proportion of the proceedings for which the opponent has been successful, which I assess as being about 10%, applying a broad brush. I will also make an award for the applicant's attendance at the case management conference, at which the opponent's request for an extension of time was refused. The breakdown, using the scale of costs published in Tribunal Practice Notice 4/2007, is as follows:

Considering the notices of opposition and filing counterstatements (essentially identical)	£250
Filing written submissions	£400
Total, less 10%	£585
Preparation for and attendance at the CMC	£200
Total	£785

36. I order Glu Mobile Inc to pay Glofone UK Limited the sum of £785 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 9th day of July 2015

**Judi Pike
For the Registrar,
the Comptroller-General**