

BL O/378/21

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION 3195909

IN THE NAME OF ONE NOVA LIMITED

FOR THE TRADE MARK

BILLIONAIRE

IN CLASS 28

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NO. 503101

BY

Rajinder Sharma

1. On 09 November 2016, One Nova Limited (“the registered proprietor”) filed trade mark application number UK3195909 for the mark “BILLIONAIRE” for “Games, toys and playthings” in class 28.
2. The application was published in the Trade Marks Journal on 02 December 2016. No opposition was received, and the mark was registered on 17 February 2017.
3. On 23 April 2020, Rajinder Sharma (“the cancellation applicant”) filed application number CA503101 to have the registered proprietor’s mark declared invalid, for all of the goods for which it is registered, relying upon section 5(2)(b) and section 3(6) of the Trade Marks Act 1994 (“the Act”).
4. The cancellation applicant relies upon the following marks:

UK3178871



Filing date: 6 August 2016

Registration date: 4 November 2016

UK3143970

★FOOTBALL★
BILLIONAIRE£

Filing date: 11 January 2016

Registration date: 8 April 2016

UK3195687



Filing date: 8 November 2016

Registration date: 27 January 2017

UK3195688



Filing date: 8 November 2016

Registration date: 27 January 2017

UK3195691



Filing date: 8 November 2016

Registration date: 27 January 2017

5. All of the earlier marks relied upon are registered for the same goods and services in the following classes:

Class 28: Games adapted for use with television receivers; Games and playthings; Games (balls for-);Games of chance; Games relating to fictional characters; Games (Marbles for -);Games (Counters [discs] for -);Games (Balls for -);Games (Apparatus for -);Games (Bats for -);Games .

Class 41: Games equipment rental; Games offered on-line (on a computer network); Games services provided on-line from a computer network.

6. The cancellation applicant states that the goods and services at issue are identical or similar and the marks are highly similar.

7. The cancellation applicant was instructed by the Registry to provide evidence to support its claim under Section 3(6) of the Act however, none was provided. Therefore, as per the Registry's letter of 21 December 2020, the application for invalidity under section 3(6) has been deemed withdrawn.

8. The marks relied upon qualify as earlier marks in accordance with section 6 of the Act. Given the registration dates of each earlier mark relied upon, they are not subject to the proof of use provisions contained in section 47(2A) of the Act.
9. The registered proprietor filed a counterstatement, in which it denied the cancellation applicant's grounds and stated that it did not believe there was any reason for its mark to be declared invalid.
10. The registered proprietor made reference in its counterstatement to prior rights in the mark BILLIONAIRE since at least as early as 2013. It also referred to an earlier trade mark registration, namely UK 2601470, dated from November 2011. However, these issues were not expanded on in later evidence and the earlier UK registration referred to is not in the name of the registered proprietor.
11. Neither side filed evidence or written submissions and no hearing was requested and so this decision is taken following a careful perusal of the papers.
12. The registered proprietor is represented by Bromhead Johnson LLP and the cancellation applicant is represented by Withers & Rogers LLP.
13. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Decision

Section 47:

14. Section 47 of the Act states as follows:

“47. –

(1) [...]

(2) The registration of a trade mark may be declared invalid on the ground -

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

15. As I have noted above, given that the cancellation applicant’s marks were all registered within 5 years of the date of the application for invalidity, there is no requirement for proof of use of the marks.

Section 5(2)(b)

16. Section 5(2)(b) of the Act is 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”.

Case law

17. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“the CJEU”) 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.

(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

18. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

19. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

20. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, 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;

(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.

21. In *Gérard Meric v Office for Harmonisation in the Internal Market* ('Meric'), Case T-133/05, the General Court ("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 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".

22. The Parties respective specifications are:

Registered Proprietor's specifications	Cancellation Applicant's specifications
Class 28: Games, toys and playthings	Class 28: Games adapted for use with television receivers; Games and playthings; Games (balls for-); Games of chance; Games relating to fictional characters; Games (Marbles for -); Games (Counters [discs] for -); Games

	(Balls for -);Games (Apparatus for -);Games (Bats for -);Games .
	Class 41: Games equipment rental; Games offered on-line (on a computer network); Games services provided on-line from a computer network.

23. The cancellation applicant has “games and playthings” registered and so does the registered proprietor. These goods are therefore identical.

24. The registered proprietor’s “Toys” are defined as an object designed to be played with.¹ Given that games and playthings are also items that are intended to be played with, the nature, purpose, users and channels of trade may be the same. I find therefore, that ‘toys’ are identical to ‘games and playthings’, in line with the principle set out in *Meric*.

25. In *Boston Scientific*², the General Court described goods/services as “complementary” in circumstances where “... *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*”.

26. The cancellation applicant’s class 41 services are related entirely to games. Firstly, it covers ‘Games equipment rental’ which I would deem to be complementary to the proprietor’s ‘games’ as these are the goods that would be rented out by the cancellation applicant in order that the consumer may play the games themselves. I therefore deem these services to be similar to at least a low degree to the registered proprietor’s ‘Games’.

¹ <https://www.collinsdictionary.com/dictionary/english/toy>

² *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

27. The cancellation applicant's 'Games offered on-line (on a computer network); Games services provided on-line from a computer network' are services which provide games to be played on the internet. The services of offering games online I would therefore conclude to be similar to the registered proprietor's 'Games' to a medium degree as they share purpose and user and may share channels of trade, where the registered proprietors 'Games' may be available for purchase online. They may also be in competition with each other.

28. In conclusion, I have found the goods at issue to be identical and I have found there to be similarity to at least a low degree and a medium degree between the goods of the registered proprietor and the services of the cancellation applicant.

The Average Consumer and the Purchasing Act

29. 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.

30. 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*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“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.”

31. I consider that the average consumer for 'games, toys and playthings', whether that be the traditional physical goods or online games and related services, would

be the public generally, with perhaps a particular emphasis on children or young adults and parents. These items would be purchased for personal use.

32. I believe that particularly in the case of children, the purchase of these items would be a fairly regular occurrence with the frequency reducing with age. The price point of the goods can also vary hugely and this will undoubtedly have an effect on the level of attention paid.

33. The selection of such goods will largely be a visual process mainly from websites online and within retail establishments. However, I do not dismiss the potential for the marks to be expressed aurally in conversation with salespersons, or when visiting retail outlets.

34. The purchase process will likely require more attention than casual inexpensive purchases (*e.g. daily consumables*) as this is more likely to be a less frequent purchase and the goods are likely to be used on an ongoing basis. However, that said, the cost of games and toys is likely to vary depending on the type of good, for example, a simple board or card game may be relatively cheap, whilst the latest computer or console game is likely to attract a much higher price.

35. Depending on the nature and cost of the games, toys and playthings in question, I consider the average consumer would pay between a low and a high degree of attention.

Comparison of marks

36. 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.”

37. It would be wrong, therefore, to artificially dissect the trade marks, 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.

38. For the sake of procedural economy, I will focus my comparison initially on the cancellation applicant’s earlier UK3143970. I will deal with the cancellation applicant’s other marks later in my decision. The respective trade marks are shown below:

<p style="text-align: center;">BILLIONAIRE</p>	
<p>Registered Proprietor’s mark</p>	<p>Cancellation Applicant’s mark UK3143970</p>

39. The registered proprietor’s mark comprises the single word BILLIONAIRE and so the overall impression lies solely in that word.

40. The cancellation applicant’s mark is a figurative mark containing several elements. The words FOOTBALL and BILLIONAIRE are the dominant elements within the whole. The mark also contains stylised ‘star’ devices and the ‘£’ symbol, which is used as a replacement for the final letter ‘E’ in the word BILLIONAIRE. These

stylised and figurative elements are fairly non-distinctive and play a limited role in the mark. The verbal elements in the mark can be said to be co-dominant, however when considering the nature of the goods and services at issue, it is likely that the word 'FOOTBALL' will be perceived as descriptive and non-distinctive. The word BILLIONAIRE in the cancellation applicant's mark can be said to be the more distinctive element in the mark. The overall impression in the earlier mark lies in the combination of the words FOOTBALL BILLIONAIRE.

41. Comparing the marks visually, the registered proprietor's mark is registered for the plain word BILLIONAIRE itself. I remind myself of the comments of Mr Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation* case BL O/281/14 who found that:

"It is well established that a 'word mark' protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks.....A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or handwriting as opposed to print) from that which appears in the Register whilst remaining 'identical' to the registered mark."

42. I therefore acknowledge that the registered proprietor's mark may be presented in any font, size, or combination of upper and lower-case fonts.

43. The word elements in the cancellation applicant's mark are presented in upper-case lettering with a bold font and in a gold colour, with one word placed on top of the other, but both words presented in the same sized font. The final 'E' of the word 'billionaire' has been replaced with the '£' symbol. That symbol resembles a letter 'E' to a significant degree. There are two basic star devices on either side of the word 'football'. These elements are not negligible and frame the word within the mark, however they cannot be said to be highly innovative or particularly distinctive.

44. Both marks contain the word 'billionaire' and considering all of the above, in particular the fact that the registered proprietor's mark may be used in any standard

font, size and colour that they might decide upon, I find that the marks are visually similar to a medium degree.

45. Regarding the aural similarities between the marks, they are similar to the extent that the word 'billionaire' will be pronounced identically. The cancellation applicant's mark also contains the word 'football' which will be articulated first. I am confident that both words will be spoken by the average consumer as they are both the same size and are shown one of top of the other. Given that the articulation of one half of the cancellation applicant's mark is identical to the entirety of the registered proprietor's mark, I find the marks to be aurally similar to a medium degree.

46. Conceptually, the word 'billionaire' has a dictionary definition as a person whose assets are worth over a billion of the monetary units of his or her country³. Therefore, the registered proprietor's mark conveys the message of a person worth more than a billion. The same concept is shared in the cancellation applicant's mark however the additional word 'FOOTBALL', which is defined as a game played by two teams of eleven players using a round ball.⁴ and is a globally renowned sport, will result in the conceptual notion of someone who is a billionaire and is also involved in the sport of football. That could mean an owner, manager or player, as football is well-known to be a sport that attracts large amounts of money. Notwithstanding the conceptual impact of the word 'FOOTBALL' in the earlier mark, both marks are conceptually linked to a person who has very large amounts of money, and therefore I consider them to be similar in this respect to a medium degree.

47. In conclusion, I find the registered proprietor's mark to be visually, aurally and conceptually similar to a medium degree. to the cancellation applicants UK3143970 mark.

³ <https://www.collinsdictionary.com/dictionary/english/billionaire>

⁴ <https://www.collinsdictionary.com/dictionary/english/football>

Distinctive character of the earlier trade mark

48. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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).”

49. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in

Sabel. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”

50. The cancellation applicant did not file any evidence and has made no claim of an enhanced level of distinctiveness in respect of any of its earlier marks. I must therefore consider the position based on the inherent distinctiveness of the mark.

51. The cancellation applicant’s mark is a figurative mark that contains the words “football billionaire”, which are both ordinary dictionary terms that will be readily understood. The mark also contains devices of two golden stars and the stylised use of the ‘£’ symbol. The words in the mark do not directly describe the goods or services being provided but the word ‘football’ may be said to be suggestive of a characteristic of the cancellation applicant’s goods and services. Therefore, when considered as a whole, the earlier mark can be said to be inherently distinctive to no more than a medium degree.

Likelihood of Confusion

52. There are two types of confusion that I must consider. Firstly, direct confusion i.e. one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

53. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, 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.”

54. I have found that the registered proprietor’s goods under Class 28 are identical to the Class 28 goods of the cancellation applicant. The registered proprietor’s goods are also similar to between a low and medium degree to the cancellation applicant’s Class 41 services. I have found the marks to be visually similar to a medium degree given that the registered proprietor’s mark is a word mark and fair use of such a mark means that it may be depicted in a font or colour that is very similar or even identical to that of the word elements in the cancellation applicant’s mark. Aurally and conceptually, I have concluded that the marks are similar to a medium degree. I have found the cancellation applicant’s mark to be inherently distinctive to no more than a medium degree and that the average consumer would pay between a low and high degree of attention when selecting the goods and services at issue.

55. I have found the element ‘FOOTBALL’ of the earlier mark to be descriptive and non-distinctive. As such, whilst the overall impression of the cancellation applicant’s mark rests in the combination of the verbal elements of its mark, I find the word ‘BILLIONAIRE’ to be the more distinctive aspect of that mark. The conceptual impact of the earlier mark will be that of a billionaire who has some connection to the sport of football, whether that be as the owner of a football club or a player/manager who has been very successful.

56. Based on the above conclusions, I am not convinced that the average consumer, even one paying a low degree of attention when selecting e.g. playing cards, would mistake one of these marks for the other in this instance. There is an additional word in the cancellation applicant's mark which will be seen and spoken by the average consumer. The word 'football' is at the beginning of the mark and conveys a clear conceptual message which will not go unnoticed. Therefore, I do not find there to be a likelihood of direct confusion.

57. I therefore need to consider indirect likelihood of confusion. Mr Iain Purvis Q.C. said further in *L.A. Sugar Limited v By Back Beat Inc*:

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

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

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

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

58. These examples are not exhaustive but provide helpful focus.

59. Having found that the word 'Football' in the earlier mark conveys a message relating to the well-known sport, that word can be said to be descriptive in the relevant sector of games, toys and playthings, as well as online gaming services. The word Billionaire has been found to be co-dominant in the earlier mark and the

more distinctive aspect of that mark. The average consumer of the goods and services at issue, who is aware of the applicant's 'Football Billionaire' brand will, when faced with the contested 'Billionaire' mark, assume that that mark is simply a brand extension or evolution of the applicant's range of products.

58. I find therefore, that indirect confusion will occur between the contested registration and the cancellation applicant's UK registration 3143970.

59. Whilst I accept that indirect confusion should not be reached merely because the marks share a common element, and that what is required by the average consumer is an instinctive reaction that leads them to the conclusion that the good or services come from the same (or related) trade origin, I find that that instinctive reaction is present in this case.

60. The cancellation applicant's remaining earlier marks, UK3178871, UK3195687, UK3195688 and UK3195691 are registered for the same goods and services as UK3143970, and therefore my finding regarding the assessment of the goods and services in paragraph 28 above must be the same. The marks shown in paragraph 4 are no closer to the contested registration than UK3143970 which has been the subject of my initial comparison and therefore do not provide the cancellation applicant with any stronger case. These remaining marks all contain the word BILLIONAIRE, presented in the same or a very similar fashion. These marks can also be said to be more stylized in their design and overall appearance than UK3143970. The additional verbal elements in the remaining marks, that replace of the word 'FOOTBALL' e.g. 'CRICKET' or 'RUGBY', will be perceived in the same way as the word 'FOOTBALL' in the mark I have already compared i.e. as a well-known popular sport. Those sports related words will therefore play the same role in those marks as the word 'FOOTBALL' has done in UK3143970. My findings in respect of the non-distinctive and descriptive nature of those words, and the conceptual impact they will have in those marks does not therefore change from the findings I have made in respect of UK3143970. Therefore, I find no reason to consider the cancellation applicant's remaining marks any further.

Conclusion

61. As I have found that there is a likelihood of confusion, the application for a declaration of invalidity has been successful. Subject to appeal, the contested mark is invalidated in respect of all of the goods it is registered.

Costs

62. The cancellation applicant has been successful and is entitled to a contribution towards its costs. Award of costs in proceedings are based upon the scale as set out in Tribunal Practice Notice 2 of 2016. The award of costs is calculated as follows:

Official fee	£200
Preparing an Application for Declaration of Invalidity and reviewing Counter Statement	£300
Total	£500

63. I therefore order One Nova Limited to pay Rajinder Sharma 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 20th day of May 2021

L Nicholas
For the Registrar