

**O/786/21**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION No. 3311291**

**IN THE NAME OF PLAY'N GO MARKS LTD**

**AND**

**OPPOSITION No. 413624**

**BY DREAMWORKS ANIMATION LLC**

## Background and pleadings

1. On 16<sup>th</sup> May 2018 (“the relevant date”), Play’n GO Marks Ltd (“the applicant”) applied to register **TROLL HUNTERS** as a trade mark in relation to:

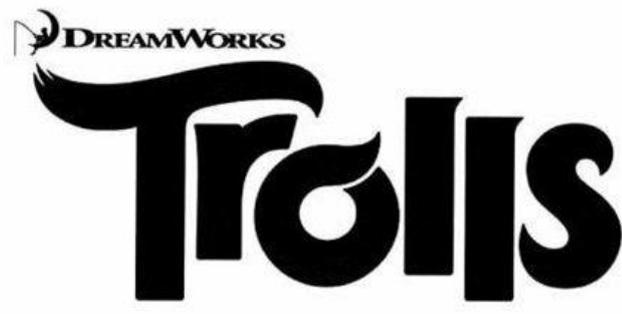
Class 9: Computer games and video games (software), hereunder software for slot machine games, betting and wagering games, video slot games and casino games provided online and via computer networks and playable on any type of computing device including arcade games, personal computers, handheld devices and mobile phones; software for slot machine games, betting and wagering games, video slot games and casino games provided online and via computer networks and playable on any type of computing device including arcade games, personal computers and handheld devices.

Class 28: Videogaming apparatus, hereunder slot machines for gambling, gaming machines, poker machines and other video based casino gaming machines; arcade games; gaming machines, namely, devices that accept a wager; reconfigurable casino and lottery gaming equipment, hereunder gaming machines including computer games and software therefor sold as a unit.

Class 41: Games services provided online (via computer networks), hereunder providing slot machine games, betting and wagering games, video slot games and casino games, playable via local or global computer networks; online gaming services; entertainment services, namely, conducting a game of chance simultaneously at multiple, independent gaming establishments; entertainment services, hereunder providing online computer games; prize draws [lotteries]; organising and conducting lotteries.

2. The application was accepted and the mark published in the Trade Marks Journal on 1<sup>st</sup> June 2018.

3. On 3<sup>rd</sup> September 2018, DreamWorks Animation LLC, (“the opponent”) opposed the registration of the applicant’s trade mark. The opponent is the proprietor of the earlier registered EU trade marks shown below.

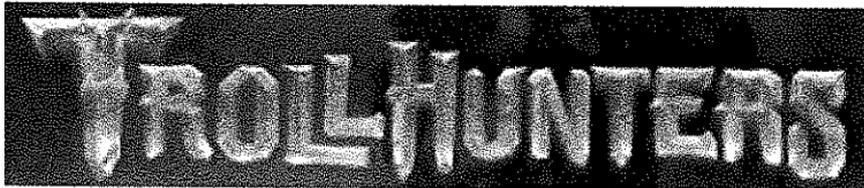
Trade mark	Classes of goods/ services	Application date
EU14554026  <b>TROLLS</b>	9, 16, 25, 28 & 41	11 <sup>th</sup> September 2015
EU14873624  	9, 16, 25, 28 & 41	3rd December 2015
EU16072514  	3 & 28	22 <sup>nd</sup> April 2016

4. The opponent claims that the earlier marks are similar to the contested mark, that they cover identical or similar goods and services, and that the distinctive character of the earlier trade marks has been enhanced through use. Consequently, the opponent claims that:

- (i) There is a likelihood of confusion on the part of the public, including the likelihood of association, and
- (ii) Use of the contested mark would, without due cause, take unfair advantage of, and/or be detrimental to, the reputation and distinctive character of the earlier marks.

5. Additionally, the opponent claims that it has used the following unregistered trade marks in the UK since 2016 in relation to the same goods/services for which EU14554026 is registered and has acquired goodwill under these signs:

TROLLHUNTERS



6. According to the opponent, use of the contested mark would constitute a misrepresentation to the public that would damage the goodwill in its business. Therefore, use of the contested mark would be contrary to the law of passing off.

7. In view of the above, the opponent claims that registration of the contested mark would be contrary to sections 5(2)(b), 5(3) and/or 5(4)(a) of the Trade Marks Act 1994 ("the Act").

8. The applicant filed a counterstatement denying the claims made. I note that the applicant put the opponent to proof of:

- (i) the reputation and enhanced distinctiveness claimed for the earlier trade marks, and

- (ii) The goodwill claimed to exist in the UK under the unregistered trade mark TROLLHUNTERS.

9. Both sides seek a contribution towards their costs.

### **Representation**

10. The applicant is represented by Appleyard Lees IP LLP. The opponent is represented by Mishcon De Reya LLP.

### **The evidence**

11. Both sides filed evidence. The opponent's evidence in chief consists of a witness statement (with seven exhibits) by Christina S. Monteiro, who is the Vice President, Intellectual Property for NBCUniversal, including its DreamWorks Animation LLC subsidiary. Ms Monteiro says the opponent was founded in 1994 and is involved in the creation, distribution, licensing and marketing of quality entertainment content to consumers around the world. The opponent's business consists of the production of animated feature films and television series, location based entertainment, brand licensing, and consumer merchandise, including videogames.

12. The purpose of Ms Monteiro's evidence is to establish the extent of the opponent's use of TROLLS and TROLLHUNTERS since 2016 in relation to feature films and related goods/services, including films on DVDs, films accessed via video on demand, television series, and merchandise, including toys, games, books, clothing, stationery, food and personal care products, and video games.

13. The applicant's evidence consists of a witness statement (with eight exhibits) by Sissel Weitzhandler, its chief risk and compliance officer. Ms Weitzhandler says that the applicant is a leading supplier of specialised software for slot gaming. One of the main purposes of her evidence is to show that trolls are well known mythological beings originating in Scandinavian culture. According to Ms Weitzhandler, trolls have become an integral part of modern culture, including being rendered into numerous films, books and games. In support of this claim she points to J. R. R. Tolkien's *The Hobbit* and *The Lord of the Rings*.

14. The other main purpose of Ms Weitzhandler's evidence is to show that the applicant has used TROLL HUNTERS in relation to an online slot gambling game since 2013 without any evidence of confusion with the opponent.

15. The opponent filed evidence-in-reply in the form of a witness statement (with nine exhibits) by Stuart Donald Lester, who is a solicitor with Mishcon De Reya. Mr Lester provides evidence that the opponent's TROLLS and TROLLHUNTERS films were available in the UK on Netflix and on Sony's Pop channel between 2016 and 2020. He also provides evidence of public expressions of concern about the growth of online child gambling. This part of Mr Lester's evidence appears to be intended to support the opponent's case that if the public make a link between the parties' marks and goods/services then it is liable to be detrimental to the reputation of the earlier marks and damage the goodwill in the opponent's business.

#### **Applicant's first request to file additional evidence**

16. Neither party requested to be heard on the substance of this opposition. Instead, on 9 June 2020, the parties' filed written submissions in lieu of a hearing. However, at the same time, the applicant sought leave to file additional evidence in the form of a witness statement by Johan Tornqvist, who is the applicant's director. A case management conference ("CMC") was held on 6<sup>th</sup> July 2020. I refused the applicant's request for the reasons given in my letter of the same date. In doing so, I applied the guidance given by Carr. J. in *Property Renaissance Ltd (T/A Titanic SPA) v Stanley Dock Hotel Ltd (T/A Titanic Hotel Liverpool)*.<sup>1</sup> The key points are that:

- (i) There was no good reason why the evidence could not have been filed earlier.
- (ii) Admitting additional evidence after the evidence rounds were closed, and after both parties had filed their final written submissions, would add significantly to the already substantial length of time taken to conclude the proceedings, and would add significantly to the opponent's costs.

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<sup>1</sup> [2016] EWHC 3103 (Ch)

- (iii) The additional evidence was intended to support a case based on honest concurrent use (so far as the earlier marks were concerned) and prior use (so far as the earlier unregistered mark was concerned) that was not pleaded, and there was no application to amend the pleadings.
- (iv) The materiality of the additional evidence was further diminished by the quality of it. Whilst it made bold claims about the number of UK users of the applicant's online gambling software and the income derived from their use of it, there was barely any supporting information or material showing the websites through which UK users accessed this online gambling software prior to the relevant date, or whether they saw the contested mark when they did. Therefore, even if it had been relevant to the applicant's pleaded case, the materiality of the additional evidence was too ambiguous to justify its last-minute admission into the proceedings.

**Applicant's second request to file additional evidence and first request to amend its counterstatement to introduce a defence based on prior and honest concurrent use**

17. On 22<sup>nd</sup> September 2021, just as this decision was about to be issued, I received a further application from the applicant for leave to file additional evidence about its use of TROLL HUNTERS in the UK since 2013. This request was accompanied by a further witness statement by Johan Tornqvist with 7 exhibits (numbered 9 – 15), and an amended counterstatement which sought to introduce a defence based on prior and honest concurrent use of the contested mark.

18. Applications to amend pleadings and/or file additional evidence should be made as soon as possible. This is particularly important where the the need to amend the case and/or file additional evidence only becomes evident as the registrar is due to decide the matter. Taking your time to make such applications in these circumstances runs a high risk that they will be overtaken by a final decision, or be refused as an abuse of process. After taking my instructions, the case worker replied to the applicant on 24<sup>th</sup> September 2021, as follows:

*“The Hearing Officer has considered your request to amend the applicant’s pleadings and file additional evidence. The Hearing Officer is minded to refuse your requests. This is mainly because of the very late nature of the requests which have come in a) just as a decision was about to be issued, and b) 2.5 months after the CMC held on 6 July when the absence of pleadings about prior use/honest concurrent use was pointed out (which was itself well after the date the evidence rounds closed and the final written arguments were filed).*

*The applicant is entitled to be heard before a final decision is made. If you wish to contest the Hearing Officer’s provisional decision you should state so in writing by 1 October and take part in a procedural hearing by teleconference at 2pm on 14 October 2021. The Hearing Officer will expect you to be ready to deal with the costs of this application.”*

19. In addition to the extremely late timing of the applications, I also took into account that while the new evidence answered some of the criticisms levelled against the evidence filed on 9<sup>th</sup> June (i.e. the new version included two screenshots from the website unibet.co.uk as it was in July and August 2013 showing TROLL HUNTERS as a new online casino game), doubts remained about the materiality of the evidence in other respects. For example, none of the invoices in exhibit 11 claimed to show that Unibet paid licence fees for using TROLL HUNTERS on its gaming website were issued by the applicant itself. They were issued by Play ‘N Go Alderney Limited and Play ‘N Go Malta Limited. How use of TROLL HUNTERS by these companies accrued to the applicant was not explained. The first of the six invoices in exhibit 11 is dated 12<sup>th</sup> April 2013. It is addressed to Unibet International Limited and is for €17k. The date of this invoice precedes the claimed launch of the TROLL HUNTERS casino game, suggesting that it was an initial licence fee. The other five invoices are dated in 2015. Four of these invoices are addressed to Unibet (Italy) Limited and Unibet (Denmark) Limited. These appear to relate to trade conducted by those companies, presumably in Italy and Denmark. The fifth invoice is addressed to Unibet Alderney Limited. It is for €257. This is the only invoice that looks like it could relate to royalties received by a company related to the applicant as a result of use of TROLL HUNTERS software on a UK gaming website. Therefore, whilst the quality of the re-filed evidence was better in some respects than the version filed in June, there still appeared to be

room for argument as to whether it showed prior use and/or honest concurrent use, by the applicant, of the TROLL HUNTERS mark in the UK since 2013. To expect the opponent to deal with an amended case based on such evidence at this stage of the proceedings presented a clear risk of causing prejudice to the opponent through unnecessary further delay.

20. The applicant did not contest my provisional decision to refuse leave to amend its pleadings and file additional evidence. Consequently, my provisional decision became my final decision and the applications were refused.

### **The opposition under section 5(2)(b) of the Act**

21. 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.”*

#### Comparison of goods/services

22. The earlier trade marks had not been registered for five years at the date the applicant's mark was published for opposition purposes. This means they are not subject to proof of use under section 6A of the Act. Consequently, the opponent is entitled to rely on all the goods/services covered by the registrations. However, for reasons that will become clear, it is sufficient for present purposes to set out the goods/services in classes 9, 28 and 41 covered by the opposed application, the goods in classes 9 and 28 covered by earlier trade mark EU14554026, and the services in class 41 covered by earlier trade mark EU14873624. These are shown below.

<i>Applicant's goods/services</i>	<i>Goods/services covered by the earlier marks</i>
<p>Class 9: Computer games and video games (software), hereunder software for slot machine games, betting and wagering games, video slot games and casino games provided online and via computer networks and playable on any type of computing device including arcade games, personal computers, handheld devices and mobile phones; software for slot machine games, betting and wagering games, video slot games and casino games provided online and via computer networks and playable on any type of computing device including arcade games, personal computers and handheld devices.</p>	<p>Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus; prerecorded video discs and dvds featuring motion pictures, television series or other entertainment programs; prerecorded optical and magneto-optical discs featuring music, motion pictures, television programs or other entertainment programs; prerecorded cds featuring music and motion picture sound tracks; downloadable shows featuring television and short form programs and motion pictures; interactive multi-media software for playing games; downloadable software in the nature of a mobile application for playing games for use with computers, portable handheld digital electronic communication devices, mobile devices and wired and wireless communication devices; computer game software for wireless and electronic mobile devices, mobile phones and hand-held electronic devices; computer game discs; video</p>

<p>Class 28: Videogaming apparatus, hereunder slot machines for gambling, gaming machines, poker machines and other video based casino gaming machines; arcade games; gaming machines, namely, devices that accept a wager; reconfigurable casino and lottery gaming equipment, hereunder gaming machines including computer games and software therefor sold as a unit.</p> <p>Class 41: Games services provided online (via computer networks), hereunder providing slot machine games, betting and wagering games, video slot games and casino games, playable via local or global computer networks; online gaming services; entertainment services, namely, conducting a game of chance simultaneously at multiple, independent gaming establishments; entertainment services, hereunder providing online computer games; prize draws [lotteries]; organising and conducting lotteries.</p>	<p>game discs; eyewear, eyeglasses, sunglasses and cases therefor; decorative magnets; cinematographic machines and apparatus; wireless communication devices and systems; computer game cartridges; animated cartoons; electronic publications, downloadable.</p> <p>Class 28: Games; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; Toys and playthings, namely, kites, toy building blocks, board games, die cast miniature toy vehicles, flying discs, jigsaw puzzles, marbles, ride-on toys, skateboards, balloons, roller skates, toy banks, water squirting and toy vehicles; Christmas tree ornaments; pinball machines; playing cards; hand-held unit for playing electronic games adapted for use with an external display screen or monitor; hand-held unit for playing electronic games other than those adapted for use with an external display screen or monitor; and golf and sports balls.</p> <p>Class 41: Education; providing of training; entertainment; sporting and cultural activities; Television programming services; production and distribution of films, television and multimedia entertainment programs; entertainment in the nature of television programming, cable television programming, and satellite television programming; entertainment services, namely, continuing programs featuring news, comedy, drama, reality, and variety delivered by internet and wireless and mobile networks; ongoing television programs featuring news, comedy, drama, reality, and variety; providing</p>
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	<p>online journals, namely, blogs in the fields of entertainment, celebrities, television, movies, music, fashion, pop culture and general interest; provision of news and information in the fields of entertainment, celebrities, television, movies, music, fashion, pop culture and general interest via the internet and mobile and wireless networks on-line non-downloadable electronic publications, namely, books, magazines, manuals and pamphlets featuring information related to entertainment; providing audio or video studios; motion picture and video rental services; artists education; operation of parks and amusement parks; digital image photographing; gathering and dissemination of news; organizing and arranging exhibitions for entertainment purposes; providing facilities for movies/shows/plays/music or educational training</p>
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23. 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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

24. Goods/services can be considered as identical when the goods/services designated by the earlier mark are included in a more general category, designated by the trade mark application, or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.<sup>2</sup>

25. The applicant's goods in class 9 are essentially computer and video games software, including downloadable software. The applicant's representative submits that the class 9 goods in the application are restricted to digital gambling games and

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<sup>2</sup> *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court

can only be targeted at adult consumers. However, this is not reflected in the applicant's specification of goods which currently covers *computer games and video games (software)* at large. It is true that the specification goes on to list "*hereunder*" various kinds of gambling games. However, "*hereunder*" has the same non-limiting meaning as "*including*." It does not limit the claim to only the named gambling games, as would be the case if the applicant had used the word "*namely*." In any event, the opponent's games software is not limited to non-gambling games and could therefore include the same goods. On this footing I find that the applicant's class 9 goods are covered by one or more of the following descriptions of goods in the specification of trade mark EU14554026:

*Computer software; computer game software for wireless and electronic mobile devices, mobile phones and hand-held electronic devices; downloadable software in the nature of a mobile application for playing games for use with computers, portable handheld digital electronic communication devices, mobile devices and wired and wireless communication devices.*

Therefore, the goods in class 9 must be considered identical.

26. The applicant's goods in class 28 are videogaming apparatus, arcade games, gaming machines that accept a wager, and reconfigurable casino and lottery gaming equipment, including computer games and software therefor sold as a unit. The applicant's representative submits that the goods in class 28 relate to gambling and can only be targeted at adult consumers. However, for the reasons given in the previous paragraph, *videogaming apparatus* must be treated as covering all the goods falling under that description, not just for gambling. In any event, earlier trade mark EU14554026 covers *games* and *hand-held unit for playing electronic games* in class 28. These terms are broad enough to naturally describe all the specific types of gaming apparatus and machines specified in the applicant's application. If that is right, the respective goods in class 28 must also be considered identical. However, in case I am wrong, I will also consider whether the goods are similar.

27. In *Canon*<sup>3</sup> the CJEU stated 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.”*

28. The goods in classes 9 and 28 covered by earlier trade mark EU14554026 are plainly similar in both nature (electronic games), purpose (gaming) and method of use (on a gaming machine). Therefore, even if the respective goods in class 28 are not identical, the applicant’s goods are highly similar to the goods in classes 9 and 28 covered by the earlier mark.

29. The applicant’s services in class 41 are, essentially, online gaming/gambling services, conducting a game of chance simultaneously at multiple, independent gaming establishments, and organising and conducting lotteries. The opponent’s representative submits that these are identical or similar to *entertainment* services in the specification of the earlier trade mark EU14873624. I note that the applicant’s specification includes *providing online computer games* as one of the things covered by its class 41 listing of *entertainment services*. I therefore agree that all the applicant’s services fall within the broad term *entertainment*. The services in class 41 must therefore be considered identical.

30. As the respective goods/services are identical or highly similar, it is necessary to conduct a global assessment of the likelihood of confusion. 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*

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<sup>3</sup> Case C-39/97

*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.

#### Average consumer and the selection process

31. 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.<sup>4</sup>

32. The applicant's representative submits that:

(a) the average consumer of the applicant's goods and services is an adult engaged in regulated gambling who pays a high level of attention to the purchasing decision because of the financial consequences of making an incorrect decision and

(b) the opponent's evidence shows that its goods/services are aimed at children;

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<sup>4</sup> *Lloyd Schuhfabrik Meyer*, CJEU

(c) the average consumer of the opponent's goods and services will be those highly accustomed to identifying the specific platforms upon which the opponent's goods and services will appear.

33. I cannot accept submission (a) above. This is because when assessing the likelihood of confusion under section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.<sup>5</sup> As things stand, the applicant's specification covers *computer games and video games (software)*, *videogaming apparatus*, *online gaming services* and *providing online computer games*, at large. The average consumer of such services is not limited to adults, and the means of accessing such goods/services is not restricted by gambling regulations.

34. Submissions (b) and (c) above are misconceived. This is because it is necessary to consider the effect of all normal and fair uses of the earlier marks in relation to the goods/services covered by the registered specifications.<sup>6</sup> Consequently, the fact that the opponent's evidence shows that goods/services sold under the mark to date are aimed primarily at children and/or that the opponent has so far tended to make its goods/services available through certain entertainment platforms, such as Netflix, is irrelevant.

35. I find that the average consumer of *computer games and video games (software)*, *videogaming apparatus*, *arcade games*, *online gaming services* and *providing online computer games* is likely to be a member of the general public who will pay an average (or medium) degree of attention when selecting such goods/services.

36. I accept that the average consumer of the other goods/services covered by the application, which all appear to be for use in gambling of one kind or another, is likely to be a member of the general public with an interest in gambling or, in the case of the goods in classes 9 and 28, a business providing gambling services and associated goods to the public. A member of the general public is likely to pay a higher degree of attention when selecting such goods/services. This is because of the financial risks and rewards associated with gambling and the added risk of placing bets with online

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<sup>5</sup> See *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, CJEU, Case C-533/06

<sup>6</sup> See the judgment of Kitchen L.J. in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220

(remote) operators. I find that an average member of the public is likely to pay a medium-to-high degree of attention when selecting any gambling goods/services and a high degree of attention during the selection process for online gambling services, Because of the substantial financial and business risks involved, a business user of such goods/services is likely to pay a high degree of attention when selecting goods under the earlier marks.

37. The parties appear to agree that the goods/services at issue are selected primarily through visual means. However, it is necessary to take oral recommendations into account. Therefore, the way the marks sound also matters, albeit as a matter of secondary importance to the way they look.

#### Distinctive character of the earlier marks

38. I will again focus on earlier trade marks EU14554026 and EU14873624 as representing the opponent's best case. The former mark consists of the word TROLLS. The word TROLLS is also a prominent feature of the latter mark.

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

40. According to Ms Weitzhandler, troll characters have appeared in numerous films and frequently appear in popular media accessible in the UK. As regards films, she cites, amongst others, THE BOY WHO LOVED TROLLS (a 1984 American made-for-TV fantasy/adventure film) and the 2014 BAFTA nominated animation film, BOXTROLLS. Ms Weitzhandler also provides examples of trolls appearing on third party websites. Most of these examples are after the relevant date and/or on websites that are not obviously aimed at consumers in the UK. The most relevant appear to be:

(a) Children’s Books about trolls with TROLL in the title released in 2007, 2009 and 2010 and still available for sale on Amazon’s UK website;<sup>7</sup>

(b) A computer game for Play Station 4 entitled ‘TROLL’ advertised on the UK website game.co.uk in November 2020 (i.e. after the relevant date), but which appears to have been released in 2017;

(c) An extract from what appears to be the website of the British Board of Film Censors showing that nine films with titles with the word TROLL were certified for viewing in the years 1987 to 2011, including THE TROLL HUNTER in 2011.

41. Ms Weitzhandler also provides evidence showing that the opponent’s TROLLS films and TV series feature troll characters based on the ‘troll doll’, also known in the UK as ‘good luck trolls’ or ‘gonk trolls’. It appears to be common ground that these troll dolls garnered significant international acclaim during the 1960s, which continues to this day.

42. The gist of Ms Weitzhandler’s evidence is that trolls are well known in the UK as mythological creatures, and the UK public is accustomed to seeing them featured in

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<sup>7</sup> See exhibit 3

films, books, games etc. Therefore, the word TROLL is descriptive of such products and consequently has little or no distinctive character for such goods.

43. The opponent does not appear to dispute that its films, TV shows etc. are themed around troll characters. Instead, it places weight on the extent of the use it has made of the earlier marks as showing that they have acquired a high degree of distinctive character. Ms Monteiro's evidence is that the film DreamWorks Trolls was released in 2016 and that between its release date and the date of her statement (October 2020) the film had earned over \$100m in sales in the EU via "*theatrical distribution*" (which I take to mean 'cinemas'), over \$30m of which came from the UK. A further \$5m was generated through UK sales of the film on DVD and Blu-Ray. A picture of the cover of the film box is in evidence.<sup>8</sup> It appears to bear earlier mark EU14873624 (see paragraph 3 above). I note that the accompanying description of the plot of the film states "*After the Bergens invade Troll Village, Poppy, the happiest Troll ever born, and the curmudgeonly Branch set off on a journey to rescue her friends.*" The film is an animated adventure with troll-based characters.

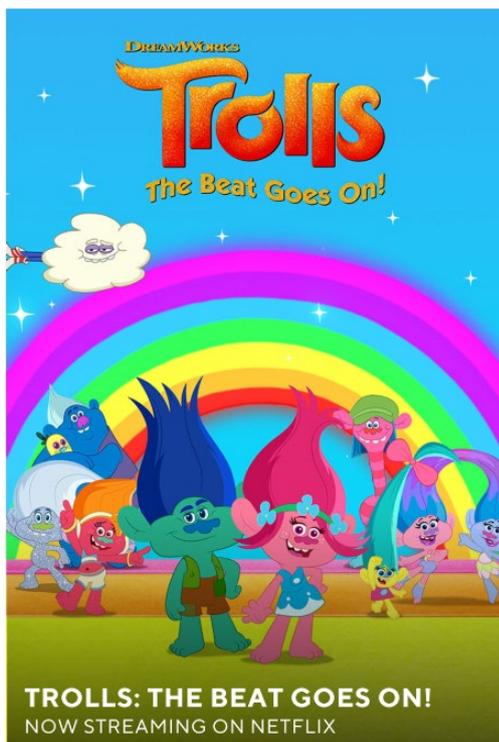
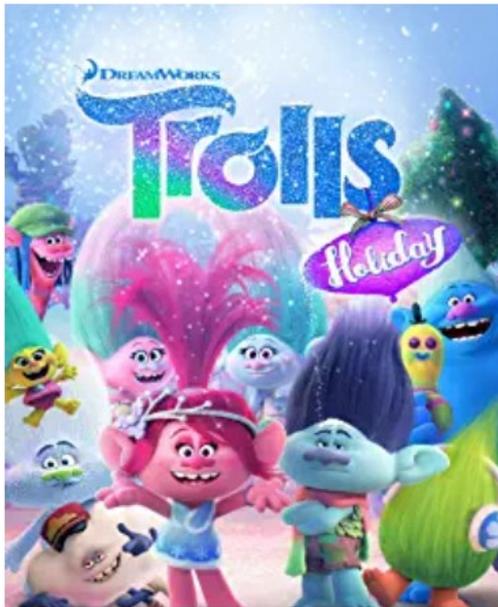
44. Ms Monteiro says that the opponent released TV series under the names 'Trolls: Holiday' in 2017 and 'Trolls: The Beat Goes On' in 2018', both of which debuted on the Netflix platform to worldwide audiences, including the UK's 13m subscribers (in 2019). Mr Lester provides screen shots from the website popfun.co.uk showing that 'Trolls: The Beat Goes On' aired on Sony's pop channel.<sup>9</sup> However, these pages appear to show the position in 2021, not how the series was promoted prior to the relevant date.

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<sup>8</sup> See exhibit CM1

<sup>9</sup> See exhibit SDL6

45. The TV series appear to have been marketed like this.<sup>10</sup>



46. It is not clear from Ms Monteiro or Mr Lester's evidence how many views or downloads these TV programs had in the UK or EU prior to the relevant date.

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<sup>10</sup> See exhibits CM3 and CM6. I note from Mr Lester's evidence that a trailer for Trolls: Holiday on Netflix used a slightly different mark, but this trailer appears to have been downloaded in 2021, albeit referencing the film released in 2017. See also exhibit SDL4 to Mr Lester's statement, although these downloads also appear to date from 2019 or 2021.

47. I note that prior to that date the opponent's 'DreamWorks Trolls' film and 'Trolls: The Beat Goes On' TV series received international awards, mostly from organisations based in the USA. The opponent also has social media accounts accessible from the UK, with names including the word TROLLS. These accounts have large numbers of followers/viewers, including some UK followers/viewers. However, the number of such followers/viewers from the UK/EU prior to the relevant date is not clear.

48. Ms Monteiro's evidence is that the opponent marketed a video game bearing the mark 'Trolls: Crazy Forest Park', which was accessible from the UK before the relevant date. She provides a representative example of the mark which looks like this.<sup>11</sup>



49. This is taken from an article dated December 2016 published on the website entertainment-focus.com. The associated text says that:

*“DreamWorks Animation’s Trolls movie delighted cinema audiences up and down the country the official mobile game of the film available now on the App Store and Google Play.*

*Build an awesome Trolls village in a fuzzy world bursting with colour!”*

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<sup>11</sup> See exhibit CM4

50. It appears that once again the word TROLLS referred to the content of the game. It is not clear how many times the game was bought, played or downloaded by users in the UK or EU prior to the relevant date (if at all).

51. Mr Lester provides screen shots from the website popfun.co.uk showing a game available under the 'Trolls: The Best Goes On' mark.<sup>12</sup> However, once again this appears to show use in 2021, not prior to the relevant date.

52. The applicant's position seems to be that Trolls designates the subject matter of the goods/services at issue. In *Canary Wharf Group plc v The Comptroller General of Patents, Designs and Trade Marks*,<sup>13</sup> Mr Iain Purvis QC sitting as a Deputy Judge of the High Court set out the correct approach to assessing whether a trade mark is descriptive of the subject matter of the goods/services. He stated that:

*"39. The general approach to be taken by a tribunal dealing with a 'subject matter' or 'theme' objection under s3(1)(c) or s3(1)(b) was recently considered by Geoffrey Hobbs QC sitting as the Appointed Person in NMSI Trading Ltd's Trade Mark Application (Flying Scotsman) [2012] RPC 7 by reference to a number of authorities including the General Court in Danjaq v OHIM (Dr No) [2009] ECR II-2097, Mr Richard Arnold QC (as he then was) sitting as the Appointed Person in Linkin Park [2006] ETMR 74, the First Board of Appeal of OHIM in Ferrero OHG v FIFA [2008] ETMR 76 and Mr Allan James in Diana Princess of Wales Trade Mark [2001] ETMR 25.*

*40 Following, in general terms, the approach of Mr Hobbs as set out in particular in paragraph 18 of Flying Scotsman, I believe that at least three matters need to be considered where a 'subject matter' or 'theme' objection arises under s 3(1)(c) or (b) :*

*(a) The nature of the goods or services for which the application is made. Are they in principle apt to provide or convey information about (or imagery relating to) the subject matter of the sign?*

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<sup>12</sup> See exhibit SDL7

<sup>13</sup> [2015] EWHC 1588 (Ch)

*(b) The nature of the sign. Is it something which it is reasonable to believe would be recognised by the relevant class of persons (that is to say average consumers of the goods or services in question) as indicating a particular subject matter or theme?*

*(c) Is the subject matter or theme of a kind which (in the context of the goods or services in question) the average consumer would consider was controlled by a single economic undertaking, as opposed to something which was free to be used and exploited by anyone. See for example *Psytech International v OHIM* [2011] ETMR 46 at [34]-[43] and the concept of ‘official merchandise’ recognised in *Arsenal Football Club v Reed* [2003] RPC 9 (CJEU) and [2003] RPC 39 at [50]-[69] (Court of Appeal).”*

53. The evidence before me is far from perfect, but I do not think it can be seriously disputed that it was well-known at the relevant date that trolls are mythological creatures. Therefore, my answer to questions (a) and (b) above is that the average consumer’s *prima facie* reaction to the use of TROLLS in relation to films, TV programs, video/computer games, and related goods/services, is likely to be that it indicates a particular subject matter or theme of the goods/services. As to (c), I see no reason to believe that *prima facie* the relevant public would expect one undertaking to control the marketing of films, TV programs and video/computer games, or related goods/services, themed on trolls. As the earlier marks are registered, it is not open to me to find that EU14554026 has no distinctive character. However, I can and do find that it has only a low degree of inherent distinctive character. Earlier trade mark EU14873624 plainly has more distinctive character because it includes part of a fanciful figure based on the well-known troll doll, the distinctive word DreamWorks, as well as other non-distinctive figurative elements, such as colour and fancy lettering. Considered as a whole the mark has an average degree of inherent distinctive character. However, for the reasons already given, the element of this mark which makes up part of the contested mark (i.e. the word TROLL) is of low inherent distinctiveness.

54. Turning to the question of acquired distinctiveness, I first note that there is little or no evidence of the use of TROLLS alone to market the opponent’s goods. This is not

fatal to the opponent's case that TROLLS has acquired a highly distinctive character through use. This is because, as a matter of law, use of a mark as part of another mark may have that effect.<sup>14</sup> However, on the evidence before me I find that the word TROLLS alone had not acquired a highly distinctive character through use in relation to films, TV programs and video/computer games, or related goods/services. This is because:

(a) It is clear from the evidence that the use of TROLLS was descriptive in nature;

(b) In these circumstances, there is no reason to believe that the average consumer would have come to expect all films, TV programs and video/computer games bearing the word TROLLS to originate from a single undertaking;

(c) It is more likely that average consumers' expectations would have been that only those goods/services bearing the words DreamWorks Trolls and/or other distinctive figurative elements of EU14873624 designated goods/services marketed under the control of the opponent;<sup>15</sup>

(d) Although it is clear that the DreamWorks Trolls film had significant success in the UK and EU following its release in 2016, to the extent that TROLLS was seen as anything more than a description of the theme or subject matter of the goods/services, it was likely to be seen as a film title distinguishing a film on release at that time, rather than as a mark distinguishing the trade source of all films bearing that word;

(e) There is no evidence as to the amounts spent advertising goods/services under the earlier marks in the UK/EU;

(f) Although there is evidence as to the number of UK subscribers to Netflix in 2019, there is no evidence as to the number of consumers in the UK/EU that

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<sup>14</sup> *Société des Produits Nestlé SA v Mars UK Ltd*, CJEU, Case C-353/03 (Have a Break)

<sup>15</sup> This is consistent with Ms Monteiro's evidence that international awards were given to the film entitled DreamWorks Trolls.

actually viewed TV programs under the trade marks shown above prior to the relevant date;

(g) There is no evidence showing sales of video games, or any other goods/services, under the earlier marks (or any marks) prior to the relevant date.

55. I therefore conclude that EU14554026 had only a low degree of inherent or factual distinctiveness at the relevant date in relation to the goods/services relied on by the opponent in classes 9, 28 and 41. I accept that EU14873624 had acquired a higher degree of factual distinctiveness through use in relation to films, but the distinctive character of this mark was not vested in the word TROLLS alone.

Comparison of marks

56. The respective trade marks are shown below:

Earlier trade marks	Contested trade mark
<p data-bbox="379 1216 507 1249">TROLLS</p>  <p>The image shows the 'Trolls' logo. It features a blue troll character with a large, spiky mane and green shoes, standing behind the word 'trolls' written in a bold, orange, lowercase, rounded font. Above the character, the DreamWorks logo is visible.</p>	<p data-bbox="1023 1308 1294 1341">TROLL HUNTERS</p>

57. The opponent submits that the respective marks are highly similar because:

(a) The contested mark incorporates the first 5 letters of the word TROLLS;

(b) The word TROLL is the dominant and distinctive element of the contested mark because it appears first whereas HUNTERS is “insignificant”;

(c) The figurative earlier marks will be referred to by their verbal elements;

(d) The word TROLL in the contested mark will strike the listener distinctively and independently of HUNTERS, and the consumer will pay more attention to TROLL because it comes first;

(e) The earlier marks and the contested mark convey the idea of mythical troll characters, which the addition of the word HUNTERS does not detract from (and in fact supports).

58. I do not accept that TROLL is the dominant and distinctive element of the contested mark. TROLL qualifies HUNTERS. The words are therefore a ‘unit’ describing a person or thing that hunts trolls. Consequently, I see no reason to depart from the general rule that consumers normally perceive trade marks as a whole rather than breaking them down into their constituent parts. I find that TROLL HUNTERS will be perceived as a whole.

59. The earlier word mark consists solely of the word TROLLS. It is true that the first word in the contested mark accounts for the first 5 letters of TROLLS. I accept that this introduces a degree of visual similarity between these marks. However, the contested mark as a whole consists of twelve letters whereas TROLLS has only six. The average consumer is unlikely to overlook this strong visual difference. I therefore conclude that there is a moderate degree of overall visual similarity between these marks.

60. TROLLS is a one-syllable word. TROLL HUNT-ERS has three syllables. Again, the aural difference is unlikely to be missed by average consumers, even after allowing for the tendency of consumers to recall the beginnings of word marks better than the ends. I find that there is a moderate degree of aural similarity between these marks.

61. As I explained in paragraph 58, TROLL HUNTER means a person or thing that hunts trolls. TROLLS describes the mythical beings themselves. Therefore, the marks have different specific meanings. They are conceptually similar to the limited degree

that both meanings have something to do with trolls. I find that the marks are conceptually similar to only a low degree.

62. Much the same considerations apply to the comparison between the contested mark and the opponent's earlier figurative mark. However, the additional figurative elements in the earlier mark, and the inclusion of the non-negligible word 'DreamWorks', reduces the degree of visual similarity between the marks to 'low'.

63. I accept that the figurative elements of the earlier mark are unlikely to be expressed verbally. However, if I am right that average consumers will not overlook the word 'DreamWorks', then the degree of aural similarity to TROLL HUNTERS is also reduced to 'low'. If I am wrong about that, then the degree of aural similarity is the same as for the word TROLLS alone, i.e. moderate.

64. For the reasons given in relation to the word TROLLS alone, I find that the earlier figurative mark also has a low degree of conceptual similarity to TROLL HUNTERS.

#### Likelihood of confusion

65. Even allowing for the identity of the goods/services, making allowance for imperfect recollection, and assuming that average consumers will pay no more than a medium degree of attention during the selection process,<sup>16</sup> I find that the differences between the marks are sufficient to exclude a likelihood of direct confusion, i.e. that consumers will mistake the contested mark for one of the earlier marks.

66. I recognise that an important part of the opponent's case is that there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc.*,<sup>17</sup> 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*

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<sup>16</sup> As I have found would be the case with *computer games and video games (software), videogaming apparatus, online gaming services and providing online computer games*

<sup>17</sup> Case BL O/375/10

*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.”*

67. The opponent submits that the average consumer would see the word TROLL, prefixed to the word HUNTERS and conclude it is “another brand of the owner of the earlier mark”. In this connection, it is pointed out that *“the opponent frequently and consistently uses the earlier registered marks in combination with other words or figurative elements to denote different movies, television series, or games. Therefore the public are used to seeing the earlier registered marks in conjunction with other words and associating such combinations with the Opponent.”*

68. It is not entirely clear what the opponent has in mind when it submits that the public are aware that the earlier marks have been used in conjunction with other words. This may be a reference to its use of the unregistered mark TROLLHUNTERS. In *J.W.Spear & Sons Ltd and Others v Zynga Inc.*,<sup>18</sup> Floyd L.J. considered the CJEU’s judgment in *Specsavers*,<sup>19</sup> which it was submitted established that matter used with, but extraneous to, an earlier mark should be taken into account in assessing the likelihood of confusion with a later mark. The judge rejected this submission stating:

*“46. Mr Silverleaf submitted that, in the light of this guidance, the proposition stated by Jacob LJ in L’Oreal can no longer be regarded as representing the law. He starts by recognising that acquired distinctiveness of a trade mark has long been required to be taken into account when considering the likelihood of confusion. He goes on to submit that Specsavers in the CJEU has made it clear that the acquired distinctiveness to which regard may properly be had included not only matter appearing on the register, but also matter which could only be discerned by use. The colour, on which reliance could be placed in Specsavers,*

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<sup>18</sup> [2015] EWCA Civ 290

<sup>19</sup> Case C-252/12

*was matter extraneous to the mark as it appeared on the register. It followed that if something appears routinely and uniformly in immediate association with the mark when used by the proprietor, it should be taken into account as part of the relevant context.*

*47. I am unable to accept these submissions. The CJEU's ruling does not go far enough for Mr Silverleaf's purposes. The matter not discernible from the register in Specsavers was the colour in which a mark registered in black and white was used. It is true that in one sense the colour in which a mark is used can be described as "extraneous matter", given that the mark is registered in black and white. But at [37] of its judgment the court speaks of colour as affecting "how the average consumer of the goods at issue perceives that trade mark" and in [38] of "the use which has been made of it [i.e. the trade mark] in that colour or combination of colours". By contrast Mr Silverleaf's submission asks us to take into account matter which has been routinely and uniformly used "in association with the mark". Nothing in the court's ruling requires one to go that far. The matters on which Mr Silverleaf wishes to rely are not matters which affect the average consumer's perception of the mark itself."*

69. There is a basis in law for pleading a section 5(2) case on the basis of a 'family'<sup>20</sup> of earlier registered marks, there is no basis in law for eliding the opponent's registered and unregistered marks and to assess the likelihood of confusion under section 5(2)(b) of the Act by considering the effect of the applicant's use of TROLL HUNTERS, and the opponent's use of its earlier registered TROLLS marks in conjunction with its own use of TROLLHUNTERS. Rather, the required assessment must be based on normal and fair use of the earlier registered marks, and normal and fair use of the contested mark.

70. In *L.A. Sugar* the Appointed Person pointed out that:

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

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<sup>20</sup> This means a number of marks with a common distinctive element

*(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).”*

71. For the reasons given earlier, I do not accept that TROLLS is inherently or factually highly distinctive in relation to the goods/services in classes 9, 28 and 41 at issue in this case. It is certainly not so distinctive that average consumers would be likely to assume that no one but the owner of the earlier marks would use another mark including TROLL or TROLLS in relation to games software, games, or on-line games. Nor do I accept that ‘HUNTERS’ would be regarded as the sort of ‘non-distinctive addition’ which might result in TROLL HUNTERS being seen as a sub-brand of TROLLS. The third category of case envisaged by the Appointed Person (i.e. changing one of a number of elements to indicate a brand extension) is plainly inapplicable to the marks at issue. This is because there is nothing logical about ‘extending’ the mark TROLLS to become TROLL HUNTERS. The latter has its own distinct meaning and appearance, which is not consistent with it being a brand extension. This is borne out by the opponent’s own use of TROLL HUNTERS, which does not appear to be a spin-off from its TROLLS film.

72. In *Duebros Limited v Heirler Cenovis GmbH*,<sup>21</sup> Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. This

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<sup>21</sup> BL O/547/17

is mere association not indirect confusion. I find that this is the most that can be said of the resemblance between the marks at issue here. I therefore reject the opponent's case based on indirect confusion with earlier trade marks EU14554026 and EU14873624.

73. The opponent's case based on EU16072514 is no stronger and I reject it for the same reasons.

74. I should also record that even if I am wrong in finding that TROLLS was a mark of low distinctive character at the relevant date, I would still have rejected the opponent's opposition under section 5(2) of the Act because of the differences between the marks.

### **The opposition under section 5(3) of the Act**

75. At the relevant date, section 5(3) stated:

*“(3) A trade mark which-*

*(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.*

76. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs

particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

#### Procedural economy

77. It is only necessary to consider the section 5(3) case based on earlier trade mark EU14554026 (TROLLS). If the opponent cannot succeed based on this mark it is no better off with its other two earlier marks. This is because they are less similar to the contested mark.

#### Reputation

78. I will assume, without deciding, that TROLLS had a qualifying reputation in the EU at the relevant date as a trade mark for entertainment services consisting of films, and goods consisting of recorded films. There is insufficient evidence to establish that the mark had a qualifying reputation in the EU for under any other goods/services.

#### Link

79. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

*The degree of similarity between the conflicting marks*

80. I earlier found that there is a moderate degree of visual and aural similarity between the word TROLLS and the contested mark, and a low degree of conceptual similarity.

*The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public*

81. The goods/services for which the opponent's mark has a qualifying reputation (films) are aimed at the general public. The goods/services covered by the application are also aimed, in part, at the general public. Some of the applicant's goods are relatively close to the opponent's goods/services, i.e. video and computer games, whilst others are further removed and largely dissimilar, i.e. online casino games.

*The strength of the earlier mark's reputation*

82. The evidence indicates that DreamWorks TROLLS was a reasonably successful children's film in the EU and UK.

*The degree of the earlier mark's distinctive character, whether inherent or acquired through use*

83. The earlier mark had a low degree of distinctive character at the relevant date because of its descriptive nature. At best, it had acquired a 'normal' degree of distinctiveness through use.

*Whether there is a likelihood of confusion*

84. There was no likelihood of confusion.

85. Taking all these points into account, I find that the relevant public would not have made the required link between the contested mark and the earlier mark. That is to say that it would not have brought the earlier mark to mind. That would also have been my conclusion if I had accepted that the earlier mark had acquired a 'normal' degree of distinctive character through use prior to the relevant date in relation to films.

## Unfair advantage/detriment to reputation or distinctive character

86. It follows that use of the contested mark would not have taken unfair advantage, or been detrimental to the reputation or distinctive character, of the earlier mark. I should add that even if I had found that the public would make a link between the marks, I would have found that it was liable to be a weak link and attributable to no more than that both marks have something to do with trolls. Without more, that would not have been sufficient to uphold the opponent's complaints under section 5(3).

### **The opposition under section 5(4)(a) of the Act**



Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus; prerecorded video discs and dvds featuring motion pictures, television series or other entertainment programs; prerecorded optical and magneto-optical discs featuring music, motion pictures, television programs or other entertainment programs; prerecorded cds featuring music and motion picture sound tracks; downloadable shows featuring television and short form programs and motion pictures; interactive multi-media software for playing games; downloadable software in the nature of a mobile application for playing games for use with computers, portable handheld digital electronic communication devices, mobile devices and wired and wireless communication devices; computer game software for wireless and electronic mobile devices, mobile phones and hand-held electronic devices; computer game discs; video game discs; eyewear, eyeglasses, sunglasses and cases therefor; decorative magnets; cinematographic machines and apparatus; wireless communication devices and systems; computer game cartridges; animated cartoons; electronic publications, downloadable.

Paper, cardboard; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional

and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; Books and magazines; paper party decorations; paper party supplies, namely, paper napkins, paper place mats, gift wrapping paper and paper gift wrapping ribbons, paper gift wrap bows, paper table cloths and paper party bags; children's activity books; children's storybooks; comic books; graphic novels; coloring books; book marks; loose leaf binders; stationery-type portfolios; wire-bound notebooks; note pads; writing pads; diaries; daily planners; calendars; scrapbook albums; sketchbook albums; photograph albums; sticker albums; stickers, decals; stamp pads; inking pads; rubber stamps; heat applied appliques in the form of decals made of paper; temporary tattoo transfers; slateboards for writing; pencils; pens; pencil erasers; decorative pencil-top ornaments; pen cases and pencil cases; pen boxes and pencil boxes; pencil sharpeners; chalk; markers; posters; postcards; trading cards; greeting cards; pennants made of paper; painting sets for children; arts and crafts paint kits; study kits, consisting of pencil erasers, drawing rulers, pencil sharpeners and pencil case; stationery packs consisting of writing paper, envelopes, markers, and stencils; and activity kits consisting of stickers and rubber stamps.

Clothing, footwear, headgear; Clothing namely, shirts and tops, dresses, skirts, pants, trousers, jeans, shorts, rompers, overalls, sweatshirts and sweat pants, sweatsuits, gloves, suspenders, ties, coats and jackets, hosiery, pajamas, robes, sleepshirts, sleepwear, underwear, Halloween costumes, infantwear and cloth baby bibs; hats; caps; shoes, boots, and slippers.

Games; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; Toys and playthings, namely, kites, toy building blocks, board games, die cast miniature toy vehicles, flying discs, jigsaw puzzles, marbles, ride-on toys, skateboards, balloons, roller skates, toy banks, water squirting and toy vehicles; Christmas tree ornaments; pinball machines; playing cards; hand-held unit for playing electronic games adapted for use with an external display screen or monitor; hand-held unit for playing electronic games other than those adapted for use with an external display screen or monitor; and golf and sports balls.

Education; providing of training; sporting and cultural activities; entertainment services, namely, continuing programs featuring news and reality delivered by internet and wireless and mobile networks; ongoing television programs featuring news and reality; providing online journals, namely, celebrities, music, fashion and pop culture; provision of news and information in the fields of celebrities, music, fashion and pop culture via the internet and mobile and wireless networks; providing audio or video studios; motion picture and video rental services; artists education; digital image photographing; gathering and

dissemination of news; providing facilities for movies/shows/plays/music or educational training.

88. Section 5(4)(a) of the Act states:

*“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—*

*(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or*

*(b) [...]*

*A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark”.*

89. In *Discount Outlet v Feel Good UK*,<sup>22</sup> Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

*“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.*

*56. In relation to deception, the court must assess whether “a substantial number” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501, [2013] FSR 21).”*

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<sup>22</sup> [2017] EWHC 1400 IPEC

90. The establishment of the goodwill required to succeed under the law of passing off requires evidence of customers in the UK.<sup>23</sup>

Relevant date for the purposes of section 5(4)(a) of the Act

91. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*,<sup>24</sup> Mr Daniel Alexander QC, as the Appointed Person, endorsed my assessment of the relevant date for the purposes of section 5(4)(a) of the Act in *SWORDERS TM*,<sup>25</sup> as follows:

*“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”*

92. The applicant claims to have used the contested mark prior to the date of the application for registration. However, I will start by examining whether the opponent has established that use of the contested mark at the date of the applicant’s trade mark application would have been contrary to the law of passing off. If it has, then I will move on to consider the applicant’s claim to have used the contested mark at an earlier date and how that affects the opponent’s section 5(4)(a) case.

93. Ms Monteiro gives evidence that:

*“In and around 2010, Opponent acquired the intellectual property rights in and to TROLLHUNTERS and announced plans to develop the property with Oscar-winning director Guillermo del Toro into new entertainment content. Opponent has since used the property extensive throughout the world, including in the*

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<sup>23</sup> See *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31

<sup>24</sup> BL O-410-11

<sup>25</sup> BL O-212-06

*UK, including, but not limited to, an Emmy-award winning television series released globally in 2016 and consumer merchandise that includes games.*

*These series remain available to its 14.7 million subscribers (see Annex CM2). In addition, Trollhunters aired on Sony's Pop and Pop Max channels in the UK since September 2018, with a total of 1,248 telecasts since launch (excluding repeats on their respective +1 channels), and with a peak quarterly reach of 1.7 million individuals (3% of the UK population of individuals 4+)."*

### Goodwill in the UK

94. I note that September 2018 is after the date of the application to register the contested mark. The airing of Trollhunters on Sony's Pop and Pop Max channels in the UK from September 2018 is therefore irrelevant.

95. Mr Lester's evidence includes the listing of Trollhunters (2016) on Netflix's UK website<sup>26</sup> and that the official trailer for Trollhunters was posted by Netflix UK & Ireland on their official YouTube Channel on 8 October 2016.<sup>27</sup> Ms Monteiro provides screenshots from the opponent's YouTube channel and points out that Trollhunters has been viewed 476,704 times. She also provides screenshots from Netflix's YouTube channel noting there have been 1.84 million views of the video, and that *"each video viewed since at least 8 October 2016, i.e. long before the Relevant Date."*<sup>28</sup> However, the information provided shows the position in 2020. It is not clear how many views the trailer or film video received between October 2016 and the date of the contested application in May 2018, or how many of the viewers were based in the UK.

96. More information about Trollhunters is contained in exhibit CM7, which consists mainly of UK media coverage of a planned film and later TV series. The Belfast Telegraph 27<sup>th</sup> September 2010 included a report that *"Guillermo del Toro is to write and direct Trollhunters, an animated horror movie aimed at children, it has been announced."* In January 2016, The Independent reported that a *"New Guillermo del Toro animated series coming to Netflix"* and that it was doing to be titled Trollhunters.

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<sup>26</sup> See exhibit SDL1

<sup>27</sup> See exhibit SDL2

<sup>28</sup> See exhibit CM6

The website list.co.uk recorded that Trollhunters was new on Netflix UK on 23 December 2016. The Independent of 15th May 2018 reported that “*Guillermo Del Toro making horror series for Netflix*” and that “*Del Toro has worked with Netflix on multiple occasions, having previously collaborated with the streaming service on Trollhunters – the third and final season of which reaches Netflix on the 25 May [2018].*”

97. It seems clear from these reports that two seasons of Trollhunters were aired in the UK between December 2016 and May 2018 on the Netflix subscription TV channel. Indeed, Mr Lester provides evidence that Trollhunters received a nomination in 2018 from the British Academy of Film and Television Arts (BAFTA), Children's Awards in the category of best international animation.<sup>29</sup> There is no doubt that the name of a TV series can, in principle, be protected under the law of passing off.<sup>30</sup> The opponent's TV series appears to have been marketed like this:<sup>31</sup>



98. An article on Yahoo! News dated 22<sup>nd</sup> December 2016<sup>32</sup> explains what the Trollhunters TV show is about, as follows:

*“It’s about Jim, a typical high school youth who finds an amulet that automatically makes him “chosen” to assume the mantle of Trollhunter — a*

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<sup>29</sup> See exhibit SDL8

<sup>30</sup> See *Comic Enterprises Ltd v Twentieth Century Fox Film Corp* [2016] EWCA Civ 41

<sup>31</sup> See exhibit CM6

<sup>32</sup> See exhibit CM7

*protector, not an actual hunter, of trolls. Who's trying to hunt down and destroy trolls? A group of huge evil trolls such as Bular, voiced by Ron Perlman."*

It therefore appears that 'Trollhunters' is allusive, but not directly descriptive, of the content of the opponent's TV programmes. In these circumstances, I accept that TROLLHUNTERS (with or without stylisation) had become distinctive of the opponent's TV shows on Netflix in the UK by the filing date of the opposed trade mark application. The true extent of the goodwill generated under Trollhunters by that date is not clear. This is because there is no evidence showing how many UK subscribers to Netflix watched these programs by May 2018. However, considering the evidence as a whole, I accept that by then the opponent owned a non-trivial goodwill in the UK under Trollhunters in relation to TV entertainment services.

99. There is very little evidence that the goodwill extended to other goods/services. Exhibit CM3 includes a listing of a paperback book for sale on Amazon in 2020 entitled *Welcome to the Darklands, Volume 2 (Trollhunters)* at a price of £5.41. I note that this is shown as having been available since 12 December 2017. The same exhibit includes pages from Amazon showing various dolls and figures from Trollhunters on sale in October 2020, also priced in pounds sterling. However, there is nothing to show that these goods were on sale prior to the filing date of the contested mark. Further, there is no evidence as to the number of paperbacks or toys sold under Trollhunters prior to that date. The evidence is therefore insufficient to establish that the opponent had acquired a protectable goodwill in the UK by May 2018 under Trollhunters in relation to books, or dolls, or toy figures, or any other merchandise.

100. Ms Monteiro states that:

*"In collaboration with partner entities, Opponents Earlier Marks have been extended to video games, including those which prominently feature the Earlier Marks, including, but not limited to, Trolls: Crazy Party Forest! and Trollhunters: Defenders of Arcadia."*

And that

*“Representative examples of the Earlier Marks used in video games which are accessible from the United Kingdom before the Relevant Date include those set forth in Annex CM4.”*

101. Exhibit CM4 consists of an article from the website entertainment-focus.com dated 21<sup>st</sup> December 2016. It is about a competition to win, inter alia, a game called ‘Trolls: Crazy Party Forest’. There is nothing in this exhibit (or any of the other exhibits) which shows use of Trollhunters in relation to computer or video games. In these circumstances, I regard Ms Monteiro’s evidence that a video game called ‘Trollhunters: Defenders of Arcadia’ was “*accessible*” from the UK before the relevant date as mere assertion. In any event, there is a difference between showing that a video game is “*accessible*” from the UK and that anyone in the UK actually accessed and used the game. I therefore find that the opponent has failed to establish that the goodwill that existed under Trollhunters in relation to the TV series extended to a trade in Trollhunters video or computer games.

#### Misrepresentation and damage

102. I accept that there would be substantial damage to the opponent’s goodwill under TROLLHUNTERS, if the applicant’s use of TROLL HUNTERS in relation to the goods/services covered by its trade mark application caused a substantial number of the opponent’s customers or potential customers to believe the goods/services were authorised by the opponent.

103. In these circumstances, use of the contested mark in relation to video games would result in the opponent losing control of its reputation in relation to children’s TV programs. Further, if the opponent was perceived as responsible for use of the contested mark in relation to wager or betting games or services, this would be likely to tarnish the opponent’s reputation under TROLLHUNTERS in relation to children’s TV programs. I accept that this would be particularly damaging if the opponent was perceived as using, or authorising the use of, its title in a way that encouraged children to gamble.

104. On the other hand, use of the contested mark which does not cause a substantial number of the relevant public to believe, or assume, that use of TROLL HUNTERS

indicates a connection with the opponent, will not cause substantial damage to the opponent's goodwill. When making the required assessment it is necessary to keep in mind that merely reminding the public of a mark used in relation to TV programs, or causing some members of the public to wonder whether or not there might be a connection with the TV program, does not constitute passing off.<sup>33</sup>

105. Given the inherent plausibility of an extension of the opponent's trade from children's TV programs to computer and video games for children with related content, I consider that use of the contested mark in May 2018 in relation to such goods or services, would have constituted a misrepresentation to the public liable to cause substantial damage to the opponent's goodwill.

106. The likelihood of the opponent having been assumed to have authorised use of its mark in relation to arcade games, including slot machines, and prize draws [lotteries], i.e. the sort of thing one can find in amusement arcades or social events, is much less. Nevertheless, I consider that in May 2018 there was a likelihood that a smaller-but-still-substantial number of the public would have assumed such a connection with the opponent; enough to still cause substantial damage to the opponent's goodwill.

107. I find that that use of the contested mark in relation to goods/services for use in online gambling through videogaming slot machines and other casino games, is still further removed from the opponent's TV programs. Additionally, the consumer of such goods/services is likely to pay a high degree of attention when selecting them. As a result, I find the position in May 2018 was that none, or only an insubstantial number, of the relevant public was likely to have assumed a connection with the opponent's use of TROLLHUNTERS for TV programs. Those consumers who were aware of the opponent's TROLLHUNTERS TV program are more likely to have assumed that use of substantially the same name for online gambling through videogaming slot machines and other casino games, was coincidental and purely the result of the casino games being themed on hunting trolls. It follows that there would be no real damage to the opponent's goodwill.

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<sup>33</sup> See, for example, *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd* [2007] RPC 5, at 16–17 per Jacob L.J.

108. Applying these findings to the goods/services covered by the application, I find that the opposition under section 5(4)(a) fails in respect of:

Class 9: Software for video slot games and other casino games provided online and via computer networks and playable on any type of computing device including personal computers, handheld devices and mobile phones.

Class 28: Video based casino gaming apparatus, being slot machines for gambling, poker machines, and other video based casino gaming machines; reconfigurable casino gaming equipment, hereunder casino gaming machines including computer games and software therefor sold as a unit.

Class 41: Casino games services provided online (via computer networks), being video slot games and other casino games, playable via local or global computer networks; entertainment services, namely, conducting a game of chance simultaneously at multiple, independent gaming establishments.

109. The opposition succeeds in relation to the balance of the goods/services covered by the application.

110. In reaching these conclusions I have kept in mind Ms Weitzhandler's evidence that:

*"The Applicant's TROLL HUNTERS game was first introduced on to the online gambling market in 2013. This is well before the filing date of any of the Opponent's Registrations."*

*"The game has been a success amongst consumers and has therefore been renewed into a sequel, TROLL HUNTERS 2."*

*"It is clear from this information that both parties have been able to co-exist in harmony on the market for over 7 years. The Applicant is unaware of any instances of consumer confusion to date."*

111. I have attached no weight to this evidence because:

(a) The applicant's pleaded case does not include a defence based on first use or honest concurrent use;

(b) Ms Weitzhandler's evidence is ambiguous as to whether, how, or to what extent the claimed use of TROLL HUNTERS took place prior to the relevant date in 2018 and/or was targeted at the UK market;

(c) The goods/services covered by the claimed use appear to be those for which I have found that the passing off based ground of opposition fails anyway.

### **Overall outcome**

112. The opposition succeeds in part. The trade mark will be registered for the goods/services specified at paragraph 108 above.

### **Costs**

113. Both sides have achieved a measure of success. I therefore order the parties to bear their own costs.

**Dated 20<sup>th</sup> October 2021**

**Allan James**  
**For the Registrar**