

O/1133/22

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. UK3612801
IN THE NAME OF CITY GAMING LIMITED
TO REGISTER AS A SERIES OF 2 TRADE MARKS**

GAME NATION 

GAME NATION 

IN CLASS 41

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 426277
BY GAME RETAIL LIMITED**

BACKGROUND AND PLEADINGS

1. On 19 March 2021, City Gaming Limited (“the applicant”) applied to register trade mark number UK3612801 as a series of 2 marks, for the marks shown on the cover page of this decision, in the United Kingdom. The application was accepted and published for opposition purposes on 21 May 2021, in respect of the following services:

Class 41: *Casino services; casino facilities; casinos; on-line casino services; providing casino and gambling services; betting services; gambling; on-line gambling services; amusement services, providing amusement services on electronic, video and computer systems; providing amusement arcade services and facilities; providing services and facilities and making arrangements for playing amusement apparatus and machines; organising events, competitions, puzzles and quizzes; providing on-line publications (not downloadable); all of the aforementioned services being in the field of gambling and betting services.*

2. The application is opposed by Game Retail Limited (“the opponent”). The opposition was filed on 19 August 2021 and is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the services in the application. The opponent relies upon the following mark:

GAMESNATION

UK trade mark registration number 3259825

Filing date: 28 September 2017

Registration date: 26 January 2018

Registered in Classes 9, 35, 38, 41 and 42

Relying on all goods and services, as shown in the table under paragraph 15.

3. The opponent submits that although there are slight differences between the competing marks, these are very minor and do not detract from the otherwise high similarity between the two marks, which it submits are visually, aurally and

conceptually highly similar. It further submits that the respective marks cover identical and highly similar services in Class 41, and that the opponent's mark also covers similar goods and services in other classes. In view of this, the opponent submits that there is a risk of confusion and/or association between the marks such that the applicant's mark should be refused in its entirety under Section 5(2)(b) of the Act, and it requests an award of costs be made in favour of the opponent.

4. The applicant filed a counterstatement denying the claims and submits that the marks are visually, phonetically and conceptually dissimilar, with the services of the later application dissimilar to the goods and services of the earlier registration. It therefore submits that there is no likelihood of confusion, that the opposition should be rejected, and costs awarded to the applicant.

5. Both parties filed written submissions which will be referred to as and where appropriate during this decision. Neither party elected to file evidence¹ and neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

6. In these proceedings, the opponent is represented by Lane IP Limited and the applicant is represented by Wilson Gunn.

DECISION

7. Although the UK has left the European Union, 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 on in these proceedings are derived from an EU Directive. Therefore, this decision contains references to the trade mark case-law of the European courts.

¹ I note that in its Observations in Reply, dated 18 March 2022, the opponent included Attachment 1, which was considered evidential content. The Tribunal wrote to the opponent on 12 April 2022 to confirm that it was unable to accept the filing in such a format and advised it to either remove the evidential content or refile it in the correct format. The opponent elected to amend the written observations and to remove the attachment, as confirmed in its email to the Tribunal on 14 April 2022.

Section 5(2)(b)

8. Section 5(2)(b) is relied on, which reads as follows:

“5(2) A trade mark shall not be registered if because -

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

9. Section 5A states:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

10. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.- (1) In this Act an “earlier trade mark” means –

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

...”

11. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As the trade mark had not been registered for more than five years at the date the application was filed, it is not subject to the use provisions contained in section 6A of the Act. The opponent is, therefore, entitled to rely upon it in relation to all of the goods and services indicated without having to prove that genuine use has been made of them.

12. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("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 greater 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 to mind the earlier mark, is not sufficient;

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

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

Comparison of goods and services

13. Section 60A of the Act provides:

“(1) For the purposes 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 1979.”

14. I am therefore mindful of the fact that the appearance of respective goods and services in the same class is not sufficient in itself to find similarity between those goods and services, and that likewise, neither are goods and services to be automatically found to be dissimilar simply because they fall in a different class.

15. The goods and services to be compared are:

Opponent's goods and services	Applicant's services
<u>Class 9</u> <i>Games software; computer game software; video game software; electronic computer game and video game software; interactive computer game and video game software; virtual reality computer game and video game software; interactive electronic computer game and video game software; computer game and video game programs; programs; electronic computer game and video game programs; interactive computer game and video game programs; virtual reality computer game and video game</i>	

<p><i>programs; downloadable computer and video game software and programs; downloadable electronic computer game and video game software and programs; downloadable interactive computer game and video game software and programs; downloadable virtual reality computer game and video game software and programs; interactive multimedia computer game and video game programs and software; data storage media for computer games programs; computer games equipment; computer games equipment adapted for use with external display screens or monitors.</i></p>	
<p><u>Class 35</u></p> <p><i>Retail services in relation to computer games and video games; computer gaming and video gaming subscriptions; retail services in relation to entertainment products and merchandise provided via global communications networks; digital distribution of advertising, marketing and promotional material; advertising services; collection, compilation, organisation and systemisation of information into computer databases and directories; searching, browsing and retrieving information, computer databases and directories via the Internet and global computer networks; organisation of public and private events for commercial or advertising purposes.</i></p>	
<p><u>Class 38</u></p> <p><i>Telecommunication services; provision of user access to the Internet; provision of</i></p>	

access and connection to server centres, database server centres, worldwide communication networks or private or restricted access networks; electronic data exchange; providing access to gaming websites; transmission of computer games, video games, electronic games and interactive games via the internet, computer networks, and electronic computer networks; transmitting information electronically including web pages, computer programs, text and other data; provision of access to on-line chat rooms and bulletin boards; providing online facilities for real-time interaction with other computer users; web-streaming being the transmission of data, information and audio-visual data via the Internet or other computer network; direct and on-demand streaming video audio and video material, interactive content, video games and applications over Local Area, wireless and global computer networks; providing networking services for establishing multiple-user access to a Wide Area Network and Local Area Network; transmission of written and digital communications; leasing and rental services in connection with telecommunications apparatus, equipment and computer databases; operation of chat rooms; transmission of news and news information via a computer network and/or the Internet; remote data access services; online instant messaging; provision of access to computer

<p><i>databases and directories via the Internet and global computer networks; rental of access time to computer apparatus and database server centre; advisory and consultancy services relating to the aforesaid.</i></p>	
<p><u>Class 41</u> <i>Entertainment services; entertainment services in the nature of on-line computer games, video games, electronic computer and video games, interactive computer and video games, multiple player computer and video games; gaming services; interactive entertainment and electronic games services on any computer and communication networks, including both online and offline, and other multi-player computer games networks; on-line gaming services; computer gaming services; arranging of on-line gaming; arranging and organising of computer gaming events, contests, competitions and tournaments; arranging and organising of on-line gaming events, competitions and tournaments; video game entertainment services; video game arcade services; internet games; rental of video and computer games; provision of online computer games; provision of online video games; provision of online interactive computer and video games; conducting multiple player games; provision of online interactive computer games; provision of pay to play games services; peer to peer interactive games and gaming services; providing</i></p>	<p><u>Class 41</u> <i>Casino services; casino facilities; casinos; on-line casino services; providing casino and gambling services; betting services; gambling; on-line gambling services; amusement services, providing amusement services on electronic, video and computer systems; providing amusement arcade services and facilities; providing services and facilities and making arrangements for playing amusement apparatus and machines; organising events, competitions, puzzles and quizzes; providing on-line publications (not downloadable); all of the aforementioned services being in the field of gambling and betting services.</i></p>

<p><i>information relating ghnjnfgfvggghbe information on computer and video game strategies; electronic games services in the nature of computer games provided online or by means of a computer network; provision of online information in the field of computer games; providing interactive multi-player computer games via the internet and electronic communication networks; provision of computer and video game arenas; organisation of parties and events in respect of computer and video gaming; organisation of parties and events in a computer and video game arena; organisation, arranging and provision of conventions; organisation, arranging and provision of conventions in respect of computer and video games, gaming, online gaming, virtual reality gaming, interactive gaming and multiplayer gaming; organisation and production of shows, events and conferences; provision of online electronic publications and digital media; entertainment booking services; entertainment ticket booking and reservation services; organisation, management and production of live shows and events; information and advisory services in respect of all the aforementioned services. (sic)</i></p>	
<p><u>Class 42</u> <i>Computer programming; computer consultancy services; rental of computer hardware; rental of computer equipment; design and development of computer</i></p>	

<p><i>software and hardware; installation, maintenance and repair of computer software; design, drawing and commissioned writing for the compilation of web sites; computer network services; creating, maintaining and hosting the web sites of others; provision of an internet platform for social networking services; compilation, creation and maintenance of a register of domain names; hosting websites; data storage and retrieval services; operating of search engines; information, consultancy and advice relating to the aforesaid services provided on-line from a computer database or from the Internet.</i></p>	
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16. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.²

17. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated that:

“In assessing the similarity of the goods or services concerned, ... 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

² Paragraph 29

purpose and their method of use and whether they are in competition with each other or are complementary”.³

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

19. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.⁴

20. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where appropriate. In *Separode Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”⁵

³ Paragraph 23

⁴ Paragraph 82

⁵ Paragraph 5

21. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

22. In its Statement of Grounds, the opponent has included a table to demonstrate the comparison of each parties’ services in Class 41. In its observations in reply, it submits that the use, end user and nature of the services covered by the applicant’s mark are clearly the same as those of the earlier mark, which is enhanced by the fact that many gaming and betting locations and casinos have video games and other games machines available to play in their premises and online.⁶

23. In its written submissions, the applicant submits that it is immediately clear that it provides gambling and betting services which are a specific, niche service, while the opponent’s goods and services are essentially computer and video games and software. It submits that the uses, users, nature and purpose of the respective goods and services are different, and that there is no overlap in trade channels. It further submits that while the opponent’s services in Class 41 include the unrestricted term “entertainment services”, which is part of the class heading, this does not necessarily cover casino, gambling and betting services.

24. *providing on-line publications (not downloadable); all of the aforementioned services being in the field of gambling and betting services.*

Given the qualification “*all of the aforementioned services being in the field of gambling and betting services*” to the applicant’s above services, they are encompassed within the opponent’s wider term in Class 41 “*provision of online*

⁶ I note that the applicant submitted Form TM21B on 4 October 2022 to amend the Class 41 specification to include the restriction “*all of the aforementioned services being in the field of gambling and betting services.*” However, in an email sent on 06 October 2022, the opponent confirmed that the amendment was insufficient for it to withdraw the opposition.

electronic publications and digital media”, rendering them identical as outlined in Meric.

25. organising events, ... ; all of the aforementioned services being in the field of gambling and betting services.

The applicant’s “organising events, ...” are qualified as “*all of the aforementioned services being in the field of gambling and betting services*”. As such, they are encompassed within the opponent’s broad term in Class 41 “*organisation and production of shows, events and conferences*”, and are therefore identical as per *Meric*.

26. organising ..., competitions, puzzles and quizzes; all of the aforementioned services being in the field of gambling and betting services.

I note the qualification to the above services as “*all of the aforementioned services being in the field of gambling and betting services*”. However, by their nature, I consider that “(organising ...,) *competitions, puzzles and quizzes*” would be provided as a form of entertainment and therefore they would be covered by the opponent’s broad term “*Entertainment services*”, also found under Class 41. As such, I consider the competing services to be identical, as per the guidelines outlined in *Meric*.

27. amusement services, providing amusement services on electronic, video and computer systems; providing amusement arcade services and facilities; providing services and facilities and making arrangements for playing amusement apparatus and machines; all of the aforementioned services being in the field of gambling and betting services.

While I acknowledge the qualification to the applicant’s “*amusement services...*” as “*all of the aforementioned services being in the field of gambling and betting services*”, to my mind, amusement services include the kind provided by way of arcade games and family entertainment centres. Although gambling by minors under the age of 18 is illegal, in the case of Category D low stake fruit machines and coin pushers which have no such restriction, they are likely to appeal to children and adults alike who wish to access them for entertainment purposes. Consequently, I consider “*amusement services, providing amusement services on electronic, video and computer systems; providing amusement arcade services and facilities; providing*

services and facilities and making arrangements for playing amusement apparatus and machines; all of the aforementioned services being in the field of gambling and betting services” to be encompassed within the opponent’s broad term “Entertainment services” based on the principles outlined in Meric.

28. Casino services; casino facilities; casinos; on-line casino services; providing casino and gambling services; all of the aforementioned services being in the field of gambling and betting services.

I acknowledge that casinos may be perceived as a form of adult entertainment, however, they are primarily a source of gambling, which provide the opportunity to win what could constitute a substantial amount of money, which would be the main purpose for some users, with any entertainment value playing a secondary role. Meanwhile, there will be other “casual” consumers who visit casinos primarily for entertainment purposes, with any “winnings” considered to be a bonus. To my mind, the opponent’s term “*Entertainment services*” is so broad that it could relate to a vast range of different fields. As such, it can be argued that the term clearly encompasses the provision of casinos and gambling services, and therefore includes the applicant’s services listed above. In *Chartered Institute of Patent Attorneys v Registrar of Trade Marks*, Case C-307/10, the CJEU held that the use of the general indications of the class headings of the Nice Classification may be acceptable⁷, and thus the term within the registration was accepted at examination stage. However, in relation to this opposition, I also note the guidance outlined in *Avnet* regarding broad specifications. Having considered all of the goods and services being relied upon by the opponent, there is a clear emphasis on entertainment services in the nature of on-line computer games, video games, electronic computer and video games, interactive computer and video games, multiple player computer and video games. I acknowledge the applicant’s submissions that gambling and betting services are a specific, niche service. I also acknowledge the opponent’s submissions that video games and other games machines are often available to play in premises such as casinos and online. However, there is also a distinction between online casinos and bricks and mortar casino premises, where the latter are likely to provide additional facilities such as money exchange (for gambling chips), dealer services at tables, as well as food and

⁷ At [64].

drink. I note that the applicant's services are qualified as "*all of the aforementioned services being in the field of gambling and betting services*". Overall, I consider the applicant's "*Casino services; casino facilities; casinos; on-line casino services; providing casino and gambling services; all of the aforementioned services being in the field of gambling and betting services*" to be similar to the opponent's "*Entertainment services*" to no more than a medium degree.

29. *betting services; gambling; on-line gambling services; all of the aforementioned services being in the field of gambling and betting services.*

I consider the applicant's "*betting services; gambling; on-line gambling services; all of the aforementioned services being in the field of gambling and betting services*" to include such services as those of a turf accountant, be that via high street betting shops or provided online, although it could also include those services being provided by a casino. For the same reasons outlined above in paragraph 28, I consider the applicant's "*betting services; gambling; on-line gambling services; all of the aforementioned services being in the field of gambling and betting services*" to be similar to the opponent's "*Entertainment services*" to no more than a medium degree.

The average consumer and the nature of the purchasing act

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. (as he was then) described the average consumer in these terms:

"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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median".⁸

⁸ Paragraph 60

31. 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.

32. In its written submissions, the applicant submits that the average consumer of its casino and betting and gambling services will be an adult over the age of 18 who will be interested in the specific services it provides with the sole purpose being to win money, and that consumer will pay a higher degree of attention to the purchasing process. Meanwhile, it submits that the average consumer of the opponent's goods and services will be the general public, and in particular the "gaming community", and therefore the target consumer of each party is different.

33. As far as I am aware, as well as there being games tournaments which do not provide a financial reward, there are also those which offer cash prizes, and as such, the consumer of the opponent's services may include amateurs and professional gamers, and may be targeted towards both minors and adults over the age of 18. Given the strict gambling laws in the UK, the applicant's services will predominantly be targeted at adults aged 18+⁹.

34. The average consumer for the competing services will most likely be a member of the public with an interest in gaming, betting and gambling as a regular pastime, or they may be a professional gamer or gambler. The services are likely to be accessed relatively frequently, by predominantly visual means, although I do not discount aural considerations, and the level of attention will be commensurate with the prestige of the tournament or the size of the stake or prize, which will range from relatively low to comparatively high. Some facilities and tournaments will charge an entry or participation fee, which may also be a consideration on the part of the consumer when selecting the services. I also recognise that there may be the casual gambler who will only visit casinos occasionally, or place bets on special events such as the Grand National or FA Cup. These consumers will be less knowledgeable and are likely to pay a lower degree of attention to the purchasing process than either the regular player or professional gambler.

⁹ See paragraph 27 of this decision.


Comparison of marks

35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM* Case C-591/12P, 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.”¹⁰

36. 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.

37. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
GAMESNATION	Series of 2 

¹⁰ Paragraph 34

38. The opponent submits that the cherries device in the applicant's mark does not impact the visual inference of the words, which would be seen as nothing more than stylisation of the letter "O" in the word "NATION". Apart from the cherries device, it contends that the remainder of the contested mark is stylised only to a very low degree and that the space between the two verbal elements is negligible, with those verbal elements being wholly contained within the opponent's mark. It therefore submits that the applicant's mark is highly similar to the earlier mark visually, aurally and conceptually.

39. The applicant admits that overall, the two marks are similar to a certain degree, and that there is little difference between the marks phonetically. However, it submits that there are clear and obvious differences which would not go unnoticed by the average consumer. It submits that visually, its mark is presented in a stylised typeface which includes the distinctive cherries device element, and that conceptually, while both marks evoke the general concept of "GAME" and "NATION", the cherries device in the applicant's mark is a direct and immediate reference to gambling, a concept which it submits is not evoked by the opponent's mark.

Overall impression

40. The opponent's mark consists of the single word "GAMESNATION", presented in a standard font in capital letters. In my view, there is a natural break between the letter S and the letter N, which would lead the average consumer to perceive it as two separate, dictionary defined words, "GAMES" and "NATION". Neither word dominates, and as the mark contains no other elements, the overall impression therefore rests in the combined (conjoined) words.

41. The applicant's mark has been accepted and published as a series of two marks, pursuant to section 41(2) of the Act. As shown above, the first mark in the series is presented in colour, while the second mark of the series is presented in greyscale. For convenience, I will from this point refer to the series in the singular, though my comments should be taken as referring equally to both marks in the series, unless expressed otherwise.

42. The applicant's mark comprises the word "GAME" followed by the letters "N A T I", with a device element of a pair of cherries followed by the letter "N". The word and letters are in capitals and are presented in a relatively standard font. Given the overall presentation, the average consumer is likely to see the cherries device as a replacement for the letter "O", which they would read as the word "NATION". I consider that the two word combination dominates the overall impression of the mark, although the "cherries" device is not insignificant and would also play a part.

Visual comparison

43. Both parties' trade marks comprise the same 9 letters "G A M E N A T I N", which appear in the same order in both marks, presented in capitals in both, albeit that there is some (negligible) stylisation to the letters in the contested mark. The opponent's mark contains the additional letter S following the letter "E" which is not present in the applicant's mark, as well as the letter "O" before the final letter "N", and the letters are presented as a single word, "GAMESNATION". Meanwhile, in the later mark, there is a space between the words "GAME" and "NATI[O]N", which also contains the additional cherries element in place of the letter "O", as previously described. Considering the marks as a whole, I find there to be a moderately high degree of visual similarity between them.

Aural comparison

44. The applicant has admitted that there is little difference between the marks phonetically, with one mark being referred to as "GAME NATION" and the other being referred to as "GAMESNATION". I agree that in spite of the cherries device which replaces the letter "O" in the later mark, it would still be articulated as the word "NATION" and therefore the only difference in pronunciation would be in the plural of "GAME" in the earlier mark. Both marks would be pronounced as three syllables, "GAMES-NAY-SHUN" and "GAME-NAY-SHUN", respectively. Consequently, the marks are aurally similar to a very high degree.

Conceptual comparison

45. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006]¹¹.

46. The opponent submits that conceptually, there is a high level of similarity between the marks, given that “GAME” and “GAMES” share the same meaning, as does the word “NATION”. I agree that in this instance, the difference between the singular and plural of the word “GAME” does little to affect the overall concept. Each of the marks as a whole, in the context of the competing goods and services, is likely to be construed identically by the average consumer as referring to a community of people with a common interest in playing games, regardless of whether that is purely for entertainment purposes or as a form of gambling.

47. I agree with the applicant that the concept of the cherries device in the applicant’s mark, and which is not present in the earlier mark, is allusive of fruit machines and the like and thus for some consumers it will reinforce the message of gambling services, although this will not be the case for other consumers who will see the cherries as an arbitrary decorative inclusion.

48. Overall, I consider there to be a very high degree of conceptual similarity between the marks, owing to the highly similar dominant verbal elements.

Distinctive character of the earlier mark

49. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

50. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

¹¹ Paragraph 56.

“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).”

51. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not claimed that its mark has enhanced distinctiveness and no evidence has been filed. Therefore, I only have the inherent characteristics of the mark to consider.

52. As outlined in paragraph 40 of this decision, although the conjoined word “GAMESNATION” is not dictionary defined, I do not consider that the average consumer would see it as an invented word, but as two words “GAMES” and “NATION”. Given the goods and services are relating to entertainment and gaming, while not directly descriptive, I consider the mark to be allusive of a community of people who would participate in such games, and as such, I consider it to be at the

lower end of the range of inherent distinctive character, although not of the very lowest degree.

Likelihood of confusion

53. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

54. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one 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).”

55. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

56. Earlier in this decision, I found that the average consumer of the competing services will most likely be a member of the public with an interest in gaming, betting and gambling as a regular pastime, or they may be a professional gamer or gambler. They are likely to be access the services relatively frequently, by predominantly visual means, although I do not discount aural considerations, and the level of attention will range from relatively low to comparatively high, dependent on the size of the prize and the level of knowledge of the individual consumer.

57. The similarity of the services at issue range from identical to no more than a medium degree, with the competing trade marks being visually similar to a moderately high degree, and aurally and conceptually similar to a very high degree.

58. The earlier mark alludes to the goods and services being accessed by a community of gamers, and as such is at the lower end of the range of inherent distinctive character. I bear in mind the decision of the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, in which the CJEU confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion:

“The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”¹²

59. It is settled case-law that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind. While it is not always the case, a word or words are likely to be more memorable for the average consumer, who would perceive the verbal elements as the trade mark, while it is reasonable to assume that the figurative element would be seen as nothing more than a decorative element.¹³ In spite of the low degree of distinctive character of the earlier mark, given the very high degree of aural and conceptual similarity between the marks, and the moderately high degree of visual similarity, the consumer would be likely to recall the words as either “GAME” or “GAMES” and “NATION”, but be unlikely to remember whether the first word was in the singular or

¹² Paragraph 45.

¹³ See *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, at [37].

the plural, or whether the words were conjoined. I therefore find that there is a likelihood of direct confusion.

CONCLUSION

60. The opposition has been successful and, subject to any successful appeal, the application by City Gaming Limited will be refused.

COSTS

61. The opponent has succeeded, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 2/2016. Applying the guidance in that TPN, I award Game Retail Limited the sum of £700, which is calculated as follows:

Official fee:	£100
Preparing the notice of opposition and considering the counterstatement:	£300
Preparing and filing written submissions:	£300
Total:	£700

62. I therefore order City Gaming Limited to pay Game Retail Limited the sum of £700. 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 21st day of December 2022

Suzanne Hitchings
For the Registrar,
the Comptroller-General