

O-173-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2420872
IN THE NAME OF EARLY LEARNING CENTRE LIMITED
FOR REGISTRATION OF THE TRADE MARK
TOWER OF DOOM IN CLASS 28**

AND

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 94746
IN THE NAME OF ID SOFTWARE, INC.**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2420872
in the name of Early Learning Centre Limited
for registration of the trade mark TOWER OF DOOM
in Class 28**

And

**IN THE MATTER OF Opposition thereto under number 94746
in the name of Id Software, Inc.**

DECISION

1. On 3 May 2006, Early Learning Centre Limited applied to register the trade mark TOWER OF DOOM in Class 28 in respect of “Toys; games and playthings; playing cards; gymnastic and sporting articles; parts and fittings for all the aforesaid goods.”

2. On 30 October 2006, Id Software, Inc. filed notice of opposition, the grounds being in summary:

1. Under Section 5(2)(b) because the application is for a mark that is similar to the opponent’s earlier trade marks, and is in respect of goods that are identical or similar to those for which the opponent’s earlier marks are registered.

2. Under Section 5(3) because the trade mark applied for is similar to the Opponent’s registered trade marks and the latter having a reputation in the UK such that use of the mark applied for, without due cause, would take unfair advantage of, or be detrimental by diluting the distinctive character or repute of the earlier registered trade mark or by affecting its perception or attractiveness in the event of the applicant’s goods being of an inferior quality.

3. Under Section 5(4)(a) by virtue of the law of passing off.

3. The applicants filed a counterstatement in which they deny the grounds on which the application is based, putting the opponents to proof in respect of the use, reputation and goodwill claimed.

4. The applicants and the opponents both ask for an award of costs in their favour.

5. Only the opponents filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. The matter came to be heard on 1 March 2010 when the opponents were represented by Mr David Tate of Maguire Boss, their trade mark attorneys. The applicants were represented by Mr Alan Fiddes of Urquhart-Dykes & Lord LLP, their trade mark attorneys.

Opponent's evidence

6. This consists of two Witness Statements. The first is dated 23 October 2007 and comes from David Tate, a Trade Mark Attorney with Maguire Boss and the opponent's representatives in these proceedings. Mr Tate introduces a series of exhibits as follows:

- Exhibit DT1 Extract from the Wikipedia online encyclopaedia relating to the opponent's DOOM computer game. This states the game to have originated in 1993, over the years developing into versions such as DOOM II: Hell on Earth (1994), The Ultimate Doom (1995), Master Levels for DOOM II (1995) and Final DOOM (1996). Mr Tate highlights the mention of DOOM having been voted the No 1 game of all time in a poll, and having been described as "the most influential game of all time".
- Exhibit DT2 Print from the ebay auction site listing the "Best Selling Computer Games Ever – Top PC Games" (as of 27 June 2007). DOOM is shown as No 9 with 3 million sales.
- Exhibit DT3 Article dating from 12 March 2007 taken from the New York Times website nytimes.com that includes a list of the "...10 most important video games of all time" which includes DOOM (1993).
- Exhibit DT4 Extract taken from the "Guardian Unlimited: Arts blog – art – The computer games canon" dating from 15 March 2007 reporting and commenting on the compilation of the list referred to in DT3.
- Exhibit DT5 Extract from the PriceRunner price comparison website listing "The Best Video Games in the History of Humanity" as suggested by various gaming publications, a number from 2000, 2001 and 2003 showing DOOM amongst their top ten.
- Exhibit DT6 Print from a website of the CVG Network listing "The 101 best PC games ever, part four" as at 20 May 2007. DOOM is mentioned as having originated in 1993 and occupies 8th position.
- Exhibit DT7 Prints from bbc.co.uk dating from 2004 and 2005. Mr Tate highlights comments from various reviews that describe DOOM (and its later derivatives) in terms such as "a classic computer game", "genre-defining", "ground-breaking", "incredible", "a runaway hit with UK gamers", etc. He also refers to a review of the DOOM video game inspired movie, in particular to it being "...the best videogame to movie adaptation ever made..." but omitting the next part "...but that's not saying much."
- Exhibit DT8 Further extract from the bbc.co.uk website dating from 13 August 2004 headed "Remembering the first Doom", Mr Tate highlighting comments such as "...memories of playing the ground-breaking game."
- Exhibit DT9 Extract from "iguk" games website reporting an interview with Kevin Wilson from the company that released the DOOM board game.

Exhibit DT10 Copy of a report dated 8 October 2007 prepared by Amsel & Co headed “In the matter of Id Software Inc and DOOM” prepared on behalf of Maguire Boss. The report is the result of a news database search, Mr Tate referring to the mention of DOOM that appeared in the Daily Mirror and The Independent in August 1996, and the Financial Times in May 1996.

Exhibit DT11 Rule Booklet for playing the DOOM board game that bears a copyright statement of 2005.

Exhibit DT12 Article from “iguk” games website dated 25 July 2005 reviewing The DOOM Board game.

Exhibit DT13 Extract from the Wikipedia online encyclopaedia relating to DOOM the board game. The page records that it was last modified on 9 October 2007.

Exhibit DT14 Pages headed as being “DOOM Miniatures Gallery” produced by Reaper Miniatures, Mr Tate stating that these have been produced for the opponents. The pages cannot be dated. A reference to a link for prices indicates that the goods are on sale but there is no way of telling whether this is to the public or the opponents for inclusion in the board game.

7. The second Witness Statement is dated 23 October 2007 and comes from Todd S Hollenshead, Chief Executive Officer of Id Software, Inc. a position he has held since October 1996.

8. Mr Hollenshead says that in 1993 the opponents released a software game via an internet download with the name and trade mark DOOM, with further games under the names DOOM II, FINAL DOOM and DOOM III following. He states that millions of units of games under these titles have been distributed or sold by means of end-user sublicenses with total worldwide receipts exceeding US\$150,000,000, estimating 20-30% of this to have been derived from the UK. Mr Hollenshead says that 2005 saw the worldwide (including UK) release of a motion picture based on the game, also titled DOOM which has grossed US\$50,000,000 worldwide and approximately US\$642,000 in the UK. Sales of the DOOM board game are “believed” to be approximately US\$702,000 to date. Mr Hollenshead says that to the best of his knowledge the opponent’s distributors have spent US\$ millions advertising the DOOM games in the UK through gaming publications and other media. An estimate of US\$20,000,000 is given for expenditure by the distributor on the worldwide promotion of the motion picture.

9. Mr Hollenshead refers to four exhibits as follows:

Exhibit A Prints taken from amazon.co.uk on 22 October 2007 relating primarily to the re-sale of DOOM 3 (PC), DOOM 3 (Xbox), DOOM 3: Limited Collector’s Edition (Xbox), DOOM 3: Resurrection of Evil (Xbox), DOOM 3: Resurrection of Evil Expansion Pack (PC), DOOM Collector’s Edition, Best of DOOM, DOOM (Extended Edition) DVD, DOOM Advance, Final DOOM, DOOM 64, DOOM II (GBA), The Ultimate DOOM – Thy Flesh Consumed (PC),

- Exhibit B Extract from gamespy.com listing their 50 top games of all time showing the DOOM game (1993) as position 1.

- Exhibit C Print from the website of Fantasy Flight Games, a licensee of the opponent, showing use of DOOM in connection with a board game. This refers to there being "...more than 60 finely detailed plastic miniatures..."

- Exhibit D Prints showing that the opponent's licensee, Reaper Miniatures has used DOOM in connection with figurines. This duplicates Exhibit DT14.

10. Mr Hollenshead concludes by submitting that as a result of the opponent's use, DOOM has become well known to the general public, buyers and users of computer software games and related goods, as being uniquely associated with, and distinguishes the computer software games and related products.

11. That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

12. The first ground of objection is made under Section 5(2)(b) which reads as follows:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected

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

(a)

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

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

13. An earlier trade mark is defined in Section 6 of the Act as follows:

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

(a) a registered trade mark, international trade mark (UK), 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,”

14. The opponents rely on two prior registrations for the trade mark DOOM (UK registration numbers 1587153 and 2005994) in the latter case in a stylised form but undoubtedly still the word DOOM, and Community Trade Mark 3892023 for the mark DOOM 3. In his submissions Mr Tate stated that for the 5(2)(b) ground the opponents would be relying on registration No. 1587153 for the trade mark DOOM, and not on goods in Class 16. This is a realistic and helpful concession but I will, in any event, still consider the issues under Section 5(2)(b) as if all three marks were involved as this can assist in the remaining two grounds under Section 5(3) and 5(4)(a). Mr Tate also said that he did not think that there was a question of “proof of use” because “...the other side has not raised the objection that the registrations are not valid for non-use. However, in their counterstatement the applicants point to the fact that the two UK registrations have a date of registration that is more than five years prior to the relevant date, so the provisions of The Trade Marks (Proof of Use, etc.) Regulations 2004 apply. This provision reads as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),

(b) or (ba) in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

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

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

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

(5) ...

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of

this section as if it were registered only in respect of those goods or services...”

15. The requirements for “genuine use” have been set out by the European Court of Justice (“the ECJ”) in its judgment in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and in its reasoned Order in Case C-259/02, *La Mer Technology Inc. v Laboratoires Goemar S.A.* [2005] ETMR 114. In *Ansul*, the ECJ held as follows:

“35. ... ‘Genuine use’ therefore means actual use of the mark....

36. ‘Genuine use’ must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user...

37. It follows that ‘genuine use’ of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of its enforceability *vis-à-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns...

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

16. In *La Mer* the ECJ held as follows:

“21. ... it is clear from paragraph [39] of *Ansul* that use of the mark may in some cases be sufficient to establish genuine use within the meaning of the Directive even if that use is not quantitatively significant. Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.

22. The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case by case assessment

which it is for the national court to carry out....

...

25. In those circumstances it is not possible to determine *a priori*, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down.”

17. Before considering the evidence I will say that apart from requiring proof of use the applicants do not challenge any of the opponent’s evidence or the claims made, or seek to test the evidence through cross examination. Therefore, on the basis of the guidance provided by Mr Richard Arnold Q.C. (as he was) when acting as the Appointed Person in *Extreme* BL O 161-07, I shall take the evidence at face value based on the relevance of what it establishes and its likely credibility.

18. I do not consider that there can be much doubt from the exhibits that the opponents have used the mark DOOM in respect of a computer game since 1993 and that the game has been singularly successful with sales stated to be at 3 million (DT2). The question is whether there has been genuine use within five year period ending with the date of publication of the application in suit, or in other words, during the period 29 July 2001 to 28 July 2006.

19. The evidence shows that over the years the DOOM game developed into versions such as DOOM II: Hell on Earth (1994), The Ultimate Doom (1995), Master Levels for DOOM II (1995) and Final DOOM (1996) all well outside the relevant five year period. These are, however, presumably the launch dates and although the latest is potentially a decade prior to the relevant date there is evidence of recent use. A review on the “iguk.co.uk” games website on 25 July 2005 (Exhibit DT12) refers to the DOOM board game as being based on “...the hit PC and X-Box game of 2004, Doom 3, Doom 3 itself an updating of the original games...”

20. As can be seen from the above cases, in establishing genuine use the opponent would usually be expected to provide evidence relating to the “...characteristics of the market concerned and the scale and frequency of use of the mark.” In this case there is an absence of much of this market-related evidence, but this is not fatal to the opponent’s case. The ECJ accept that circumstances even where there is no evidence of actual sales of goods can nonetheless still equate to genuine use provided there is evidence of commercial activity that has created or preserved a market share for the goods protected by the mark. Evidence of such commercial activity can be found in the reviews at Exhibit DT7 which refer to the release of DOOM3 post August 2004.

21. It is clear from the various exhibits that an awareness of DOOM continues to exist with the computer game featuring in many lists for the “best”, “best-selling”, “most important” computer/video games of all time. Reviews dating from 2004 and 2005 describe DOOM (and its later derivatives) in terms such as “a classic computer game”, “genre-defining”, “ground-breaking”, “incredible”, “a runaway hit with UK gamers”, etc. Prints taken from amazon.co.uk on 22 October 2007 also refer to the sale of DOOM 3 (PC), DOOM 3 (Xbox), DOOM 3: Limited Collector’s Edition (Xbox), DOOM 3: Resurrection of Evil (Xbox), DOOM 3: Resurrection of Evil Expansion Pack (PC), DOOM Collector’s Edition, Best of DOOM, DOOM (Extended Edition) DVD, DOOM Advance, Final DOOM, DOOM 64, DOOM II (GBA), The Ultimate DOOM – Thy Flesh Consumed (PC), albeit primarily as

second-hand re-sales. I appreciate that the print dates from after the relevant date, but given that it is surrounded by other evidence it should be accepted as showing a continuing market. On the strength of the evidence I see no reason to doubt that there has been genuine use of DOOM in relation to computer games or as they are also described, video games within the relevant period.

22. Then there is the DOOM board game. Exhibit DT11 consists of a Rule Booklet for the game that bears a copyright statement of 2005, a date that corresponds to a review of the game that appeared on the “iguk” games website on 25 July 2005 (Exhibit DT12). Todd S Hollenshead, Chief Executive Officer of Id Software, Inc states that sales of the DOOM board game are “believed” to be approximately US\$702,000 to date. Although a figure for the UK is not given, from the review on the iguk.co.uk games website it was clearly available to UK consumers. On the basis of this evidence I consider there to be genuine use on board games within the relevant period. Notwithstanding that such goods are not encompassed by the registrations and consequently has no direct relevance for the objection under Section 5(2)(b), being based on the computer game it will have added to the awareness of the same. I would add that whilst the game uses “miniatures” there is no evidence that shows that these were on sale separately to the public or simply supplied to the opponents for inclusion in the board game.

23. The final item is the DOOM motion picture based on the game. Mr Hollenshead says this had a worldwide (including UK) release in 2005 and is said to have grossed US\$50,000,000 worldwide with approximately US\$642,000 in the UK. An estimate of US\$20,000,000 is given for expenditure by the distributor on the worldwide promotion although without any information on the amount expended in the UK. Whilst the UK receipts do not amount to a particularly significant sum and the proportion of advertising in the UK is not known, any activity in relation to the motion picture will probably have added to, and extended the awareness of the DOOM games, particularly to non-gamers. However, whilst there is genuine use of DOOM in relation to motion pictures these goods are not part of the specification for any of the earlier marks relied upon.

24. Having determined the question of use, and in doing so, also the likely extent of any reputation of the DOOM trade mark, I will now go on to look at the substantive ground. There was nothing between the parties in terms of case law; both relied upon the decision in *Hotel Cipriani SRL & Ors v Cipriani (Grosvenor Street) Ltd & Ors* [2008] EWHC 3032 (Ch). With this case in mind and the guidance from the settled case law provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

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

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably

well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

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

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

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

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

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

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

(i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

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

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-3/03P *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* [2004] ECR I-3657 at 32, That is the case where the component in the complex is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it (Case T-6/01 *Matratzen Concord v OHIM – Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph

25. So, where marks have a number of component features it is the contribution of the individual elements to the mark as a whole and in the impression conveyed to the “average consumer” of the goods in question that are important factors when considering whether two marks are similar and the potential for confusion as part of the “global appreciation”. Therefore, before looking at the question of whether the respective marks are similar it seems necessary to look first at the distinctiveness and dominance of the component parts. For the record, I take the “relevant consumer” to potentially be the public at large and probably more at the younger end, but bearing in mind the BBFC rating of 18 (Exhibit A of Hollenshead), around that age and over.

26. Three earlier marks are cited by the opponents, all for the word DOOM. One in plain block script, the second is in a sort of modernised Gothic style but is still plainly the word DOOM. The third also in plain block capitals but followed by the numeral “3”. The Single numerals with no added matter are generally considered to be devoid of distinctive character, amongst other reasons because they are used in the very way that the opponents use it; as version denominators. Accordingly I shall proceed on the basis that the opponent’s earlier marks are all DOOM marks. In doing so I take note that the opposed mark is not stylised in any way so the manner in which the second of the earlier marks is represented will not be a factor that creates similarity where there would otherwise be little or none.

27. DOOM is an ordinary English word that I consider likely to be sufficiently well known to the “notional average consumer” of computer games software (and ancillary goods such as manuals) so as to understand its meaning without need for recourse to a reference work. They will also appreciate that it alludes to the nature of the game but says nothing about computer games and software per se. As a trade mark for the relevant goods it has a distinctive character. What is also clear from the evidence is that DOOM is no run-of-the-mill game; it appears to be universally accepted as being a milestone in the evolution of computer/video gaming. It achieved significant sales of the various version produced over the years and features in the top section of all-time lists. The use is expressed as a totality (...millions of units of games distributed or sold with UK sales/receipts of between US\$30-45 million) but this does not say anything about the scale and frequency of use. Nonetheless, in my view this use has enhanced the distinctive character of the mark, and contributed to a strong reputation in respect of computer/video games and software.

28. As I have said, the opponent’s marks are essentially the word DOOM, albeit in one case with a single and separated numeral 3 as a suffix. As the only significant element of the marks there can be little doubt that DOOM is what the consumer’s eye will record. In the applicant’s mark the word DOOM is at the end of a three-word description TOWER OF DOOM. Mr Tate asserted that the word “TOWER” is wholly descriptive of the product for which the applicants use the mark. There can be no dispute that in this mark DOOM has a visual significance, but with the preposition leading the eye to the relation of a TOWER the mark hangs together with no dominant distinctive element. To the extent that the earlier mark and the mark applied for have DOOM in common it is reasonable to say that there must be some visual similarity, but in a comparison of the marks in their totality, this is not enough to say that the respective marks should be regarded as similar. The mark DOOM 3 cannot be any closer in terms of similarity.

29. Again, as both of the respective marks either consist of, or include the word DOOM it is a reasonable to say that to this extent there will be some identity in their sound. The words “TOWER OF...” clearly create a difference that is not outweighed by the identity in the word DOOM. In the case of DOOM 3, I consider that the consumer will say it as they see it; word and number. So whilst there is aural identity in DOOM this dissipates when the marks are taken as a whole.

30. The message from the opponent’s marks can only be derived from the word DOOM, the meaning of which will be known to the consumer, or at least the essence or feeling of it will. Used in connection with the goods the numeral 3 will simply indicate that this is the third version. I have already said that I consider the elements of applicant’s mark to hang together, so whilst it brings to mind a tower, the words “of doom” creates the same aura of fear, dread, etc, as the opponent’s mark. This leads to the conclusion that whilst the respective marks may, in totality have differences, they should nonetheless be regarded as having some conceptual similarity.

31. Balancing of these assessments I consider the differences to easily outweigh the similarities such that whilst there is some similarity the respective marks cannot be considered similar.

32. When comparing the respective goods, the established tests in assessing the similarity or otherwise is set out in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*. I also have regard to the decision of the General Court in *Saint-Gobain SA v OHIM* Case T-364/05. I must consider the uses and users of the respective goods or services, the physical nature of the goods, and the trade and distribution channels through which they reach the market. In the case of self-serve consumer items this will also include consideration of where the respective goods are likely to be found, particularly in multi product outlets such as supermarkets. The extent to which the respective goods or services are competitive or complementary is also a relevant consideration guided by how they are classified in trade, and known by the relevant consumer. Where the proof of use provisions have been applied, the comparison is based on the use established, otherwise it is a notional one based on the wording used in the specifications. Mr Fiddes submitted that I could take judicial note that the applicant is a specialist retailer of educationally based toys for younger children. This may be the case but is not reflected in the specification.

33. The decisions in *Claudia Oberhauser v OHIM (Fifties)* [2003] E.T.M.R. 58, and *Criminal Clothing Ltd v Aytan’s Manufacturing (UK) Ltd*, [2005] EWHC 1303 adds that the circumstances in which the relevant goods and the trade marks are encountered by the consumer, particularly at the point at which the purchase is made, is also an important consideration. That matter must be considered by applying an assessment of all relevant factors. Taking into account my findings in respect of the Proof of Use requirements, the relevant goods of the earlier marks are as follows:

1587153 Computer software and computer programs, all for playing electronic games; ~~parts and fittings for all the aforesaid goods;~~ all included in Class 9.

2005994 Computer programs, computer software and data carriers therefor; video and audio games; electric and electronic apparatus for playing the aforesaid games, parts and fittings for all the aforesaid goods. (Class 9)

CTM3892023 Computer software games, computer software game programs and computer game cartridges or CD-ROMs for video games for entertainment uses. (Class 9)

Manuals sold as a unit with computer software games, computer software game programs and computer game cartridges or CD-ROMS for video games for entertainment uses. (Class 16)

34. The mark in suit is sought to be registered in respect of:

2420872 Toys; games and playthings; playing cards; gymnastic and sporting articles; parts and fittings for all the aforesaid goods. (Class 28)

35. As can be seen, the goods of the opponent's earlier marks fall in Classes 9 and 16 of the Nice Classification (International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement), whereas the application is for goods that fall in Class 28. The question is therefore not whether the goods are identical; they can, at best only be similar. Additionally, this also means that the specific goods, namely computer games will not be expressly mentioned in the target specification, and in this respect I take note of the decision of the General Court in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM)* ("Meriç" Case T-133/05, where, at para 29, it is stated:

"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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42)."

36. The same must apply to situations such as this where there is potential for goods to be found similar.

37. Referring me to the WiiFit, Mr Tate submitted that "gymnastic and sporting articles" should be regarded as similar to computer games. This is, I consider stretching the point. The WiiFit may well be "sporting" in its orientation but is still nonetheless a computer based activity and quite different and distinct from the equipment used in the sports. There is no evidence that Nintendo, the manufacturer of the WiiFit also trades in gymnastic or sporting equipment so as to create an expectation amongst consumers. Likewise, although a computer game may involve card games, playing cards that does not make them similar any more than a driving game creates similarity with vehicles.

38. In general, computer/video games software is a sophisticated item, and based on its usual and ordinary meaning would not be described as a “toy”. Likewise, whilst computer/video games software is “played” it would not ordinarily be considered a “plaything”. Looking at this in more detail and applying the specific factors set out above, I see no reason why the respective users should not be the same. On a broad interpretation the goods may have the same uses (insofar as they are for amusement/recreation) but are not in competition or complementary and clearly differ in their physical nature. Whilst they may have the potential to share the same trade and distribution channels (although I have no evidence of this) it is reasonably safe to say that they will be found in the same multi-product outlets albeit discrete from each other. These goods tend to be obtained by self-selection whether purchased in an outlet, physical or virtual (included downloads) making the visual appearance of the marks of added importance. I have no evidence that informs me as to whether the trade classifies these goods together or as distinct. The consumer may go to a large toy shop (but not an outlet specialising in sporting or gymnastic articles) where computer games software on a carrier such as a disc or cartridge may be available for sale. They may also visit an online store where they have the option of downloading in addition to buying something physical. Balancing this I come to the conclusion that “toys, playthings, gymnastic and sporting articles” are not similar goods to computer/video games software, carriers for such software or manuals for their use.

39. This leaves “games” which as a description would encompass any game, including electronic, but other than those adapted for use with an external display screen or monitor (Nice, 9th Edition). It does not cover software however provided, or carriers for software which are mostly found in Class 9, the exception being those of paper or card which are found in Class 16. However, apparatus to play the opponent’s games could fall in Class 28 and on a broad interpretation be covered by the term “games”. However, even though there is no evidence that goes to the consumer’s understanding of the market, namely, whether computer games manufacturers also trade in apparatus, such apparatus is closely allied to the games themselves so even without need for a detailed consideration I would say that “games” covers similar goods to those covered by the opponent’s earlier marks. Relying on the opponent’s use of DOOM in relation to a board game Mr Tate argued that it is “...very commonplace these days for a computer games franchise to branch out into things like board games...” and that the applicant’s play-set could be seen as an offshoot. With the exception of the use by opponents there is no evidence to support this assertion.

40. I have already said that in my view the average consumer of the computer software goods and computer games is likely to be younger, but not exclusively and that it is the perception of the public at large that should be considered.

41. I have no clear picture on the cost of the computer games software sold by the opponents; the exhibit from the Amazon site seems to place these in a range up to around £16, but as many appear to be being sold on by the original purchaser the prices tend to be low. It is generally accepted that the more expensive the goods, the greater the care taken; there is some logic in this, but it is not always the case. Some goods have a “must-have” appeal or cachet that makes the cost less significant; I would put computer games in this category. Gamers will know the names of hot or classic games and will make their selection with this knowledge and a degree of forethought, or in other words, will be nothing less than observant and circumspect. The Amazon exhibit also illustrates that games software is manufactured in

versions for particular platforms, such as PC and Xbox, so requiring a degree of care in the selection to ensure compatibility with the system used.

42. So where does this lead me? I do not know whether the opponents are the only users of DOOM in the computer/video gaming industry so as to make any use of the word more likely be linked back to them. Mr Tate argued that the opponent's use amounted to use of a family of marks, inviting me to infer that the consumer would see the applicant's mark as a relative. Mr Fiddes argued that the use did not amount to a family, but rather different versions of the same mark. I agree with Mr Fiddes, the use is of DOOM as the identifier followed by either numerical or descriptive matter, aptly illustrated by the example "DOOM II: Hell on Earth". Versions such as "The Ultimate Doom" and "Master Levels for DOOM" say nothing more than this is a more sophisticated DOOM, and "The Final Doom" needs no explanation. There is no evidence that the opponents have used DOOM in a similar way to that of the applicants. Accordingly, do not consider that the use of different versions of DOOM has created a scenario where any use of DOOM, even for computer/video games and software will inevitably be associated with the opponents; that will depend on factors such as the manner in which the word is used and cannot be assumed simply on the potential for imperfect recollection.

43. Taking all of the above into account and adopting the global approach advocated, I reach the conclusion that notwithstanding the commonality in the use of the word DOOM, the potential similarity in respect of "games" and the connected "notional" circumstances of the manufacture, market and consumer, for the reasons I have given, in particular the difference in the respective marks, use of the mark applied for will not lead to confusion. The opposition under Section 5(2)(b) therefore fails.

44. The next ground is under Section 5(3), which reads as follows:

"5.- (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 Community trade mark or international trade mark (EC) in the European Community) 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."

45. The raft of recent case law relating to objections under Article 8(5) of Regulation 40/94, equivalent to Section 5(3) of the Trade Marks Act was considered by the General Court in some detail in *Sigla SA v. Office for Harmonisation in the Internal Market* Case T-215/03, namely, Case C-292/00 *Davidoff & Cie SA v Gofkid Ltd* [2003] E.C.R. I-389 at [24]-[26], and Case C-408/01 *Adidas-Salomon AG v Fitnessworld Trading Ltd* [2003] E.C.R. I-12537 at [19]-[22], Case T-67/04 *Monopole SpA v OHIM--Spa-Finders Travel Arrangements* [2005] E.C.R. II-1825 at [30], the Opinion of Advocate General Jacobs in *Adidas-Salomon and Adidas Benelux* at [36]-[39], Case T-104/01 *Oberhauser v OHIM-- Petit Liberto* [2002] E.C.R. II-4359 at [25], Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1998] E.C.R. I-5507 at [29], Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] E.C.R. I-3819 at [17], Case C-251/95 *Sabel BV v Puma AG* [1997] E.C.R.

I-6191 at [20] and Case C-375/97 *General Motors Corp v Yplon SA* [1999] E.C.R. I-5421 at [30]. I will refer to some of the cases in more detail.

46. Clearly the earlier mark must have a reputation. There must be a risk that the use of the mark applied for, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark. In *Sigla* the CFI went on to say that along with the “similarity” requirement for the marks, these conditions are cumulative and a failure to satisfy one of them is sufficient for a case to fail.

47. A requirement for an objection under Section 5(3) is that the respective marks be either the same or at the very least similar, but what does “similar” actually mean? In *Inlima S.L.’s* application [2000] RPC 661 Mr Simon Thorley QC, sitting as the Appointed Person posed the question of what “similar” meant in the context of Section 5(3):

“13..The word ‘similar’ is a relative term. One has to ask the question ‘similar for what purpose’. The question of similarity accordingly can only be answered within the context of a particular set of facts, once one has identified both the facts and the purpose for which similarity is required. In the case of section 5(3), the purpose of requiring similarity is so that the possibility of detriment or unfair advantage might arise. In any particular case, a conclusion as to whether it does arise must depend not only upon the degree of similarity but on all the other factors of the case, not least, the extent of the reputation.

I therefore conclude that the same global appreciation as is required for confusion under section 5(2) is likewise to be applied to the changed circumstances of section 5(3).”

48. The General Court also concluded that the mark at issue must be either identical or similar to an earlier mark relied upon. In its judgment in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd*, Case C-408/01, the ECJ were not so conclusive about the need for the respective marks to be “similar”, only that they should have a “certain degree of similarity”:

“29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them: see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23”

49. In *Esure Insurance Limited v. Direct Line Insurance plc*, a decision of the High Court of Justice, Chancery Division, [2007] EWHC 1557 (CH), Mr Justice Lindsay stated that whether marks were found to be similar involved the passing of a “threshold”. Mr Justice Lindsay concluded:

"94. At his para 114 the Hearing Officer concluded:

In my view, a distinctive feature of both marks is the unusual juxtaposition of wheels attached to (albeit recognisably different) electronic communication

devices. I find that this gives rise to a recognisable similarity between the marks".

But if the threshold question is more a matter of law and first impression rather than one requiring detailed analysis or evidence and, if the threshold is as I have taken it to be, it is in my judgment here satisfied; I would not be able to say that duly-arrived-at overall impressions made by the rival marks are such that one could reasonably say that a likelihood of confusion could not thereby have been created. Despite the differences -- and there are several -- between the phone on wheels and the mouse on wheels, the relevant services are identical and both the sign and the mark are indicators of a means of making contact and doing business with the provider of those identical services and in both cases (against all experience) black road wheels have been added to that means of communication and give it the appearance of a vehicle. As a matter of first impression I would take the low threshold to have been cleared.

95 Mr Silverleaf draws attention to the passage in the Hearing Officer's paragraph 110 where he said:

"The requirement for similarity is therefore passed when there is any visual, aural or conceptual similarity between marks which is likely to be recognised as such by an average consumer."

He had said much the same in his paragraph 108; once there was that degree of similarity then the Tribunal was obliged to go on to consider the other factors identified in section 5(2)(b) or section 5(3) of the 1994 Act. As will have been seen from my observations on thresholds, I take a different view but it is not, as it seems to me, a difference that can here be magnified into a material and clear error of principle. The difference in approach would only have been a material error of principle if, upon adopting my view as to the threshold, I had taken the view that the threshold had not been equalled or exceeded. But, as I have indicated, in my view the threshold is low, as I have described it, and was exceeded. The Hearing Officer, in my view, was thus obliged to go on to consider whether there was a likelihood of confusion in the manner that he did and, equally, to consider questions as to unfair advantage and detriment, as I shall come on to, as he did.

96 I would add this (as I apprehend Mr Silverleaf asserted error in principle as to the Hearing Officer's response to conceptual similarity): it is difficult to elevate matters essentially of weight and degree into ones of principle but, even if one were to take out of the Hearing Officer's evaluation his concept of desk top electric communication devices as a feature common to both, I would, having regard to other similarities between the mark and the sign (especially if the mouse could be used in red with black wheels) nonetheless take the low threshold to have been exceeded.

97 If that is right then I next need to look into whether such similarity as there was, as globally appreciated in the way described in the authorities which I have touched upon in paragraphs 24 et seq. above, caused a likelihood of relevant confusion."

50. The paragraph 46 referred to (and paragraph 45 which puts it into context) read as follows:

“45 Lewison J's judgment does not itself specify what kind of minimum threshold Mr Wyand QC had contended for but I have been given a copy of the very full Skeleton argument which Mr Wyand and his junior, Mr Moody-Stuart, deployed before Lewison J.. At para 29 the Skeleton Argument makes the point that "absent at least similarity there can be no infringement". The argument continues:--

"This is a threshold test and is to be considered in each case by a visual, aural and conceptual comparison of the mark and sign".

Although that is not a complete specification of the test for the relevant 4(1)(b) similarity -- it leaves out, *inter alia*, the concept of interdependence -- it is hard to fault it as far as it goes. If all that Mr Wyand was arguing for was that there had to be at least some similarity, I would not think that Lewison J. was intending to reject that argument. Nor does the fact that the question is one of degree of itself exclude there being a threshold. I notice, too, that, so far as one can tell from the report, Vedral *supra* was not referred to the Judge. But Lewison J's observation that whether "something is relevantly similar to another thing must depend on why you are asking the question" is, as it seems to me, irresistible. "Are they similar", asked of marks, would be almost bound to meet the response "For what purpose?"

46 That is not to say that in every case where some one or more items or aspects, howsoever insignificant, of the rival marks can be said to be similar, the fact-finding body necessarily has to go on to examine into the existence or not of a likelihood of confusion because that would obviate the necessity for an overall impression being formed of the rival marks in the relevant surrounding circumstances and for those overall impressions then to be compared. There can be cases -- see e.g. Vedral and Soffass *supra* -- where the fact-finding body, deploying the proper approach to the overall assessment which the authorities require and having due regard for interdependence and the other relevant surrounding circumstances, is able to conclude that notwithstanding some aspects of similarity, no likelihood of confusion could have been created. But, although I am far from sure I am here differing in any material way from Lewison J, I would hold there to be some form of threshold, albeit a low one. In a case such as the one before me, the threshold, in my judgment, is arrived at as follows. First, overall impressions of the rival marks are formed, paying full regard to all the requirements of the autonomous concept of 4(1)(b) similarity. Next one has to have in mind the types of confusion which are then relevant, namely (as I shall come on to below) those identified in Sabel *supra* at its para 16. Then the threshold question arises: are those overall impressions such that one can reasonably say that a likelihood of confusion could not thereby be created?"

51. The opponent relies on the same earlier rights as it did under section 5(2)(b) although in his submissions Mr Tate stated that this ground "...probably only refers to those peripheral goods: the gymnastic, sporting equipment and sporting articles. In my assessment of the Section 5(2)(b) ground I found the respective marks not to be similar and gave my reasons why. To my mind that is the case whether determined by reference to the law and first impression, or by detailed analysis; there is no evidence for me to consider on this point. Even if the respective marks had been similar, that does not necessarily mean that the opponents would have succeeded with this ground. Both the ECJ and the General Court have

reiterated the comment made in *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 (in relation to Section 10(3)), that the purpose of the Regulation is not to prevent registration of any mark which is identical or similar to a mark with a reputation. Given these findings, and bearing in mind the difference in the test for “similarity” I propose to consider this ground in respect of all goods, taking account of my earlier findings under the proof of use requirements.

52. On the “cumulative” approach advocated in *Sigla* the lack of similarity in the marks should effectively be the end of the matter. However, in the *Esure* case Mr Justice Lindsay indicated that the threshold of similarity that had to be crossed, and seemed to have said that this is higher for a test requiring a likelihood of confusion under Section 5(2) than the “association” test found in Section 5(3); to my mind this is a logical position. Given the common use of “DOOM” there must be at least some similarity; it would be nonsense to say otherwise. Therefore, I will, for completeness go on to consider this similarity in the context of the circumstances of Section 5(3).

53. The next issue to consider is reputation. The standard test for the sort of reputation that is needed to underpin a Section 5(3) action is set out in *General Motors Corp v Yplon SA* [2000] R.P.C. 572. In this case the Court concluded that the requirement implies a certain degree of knowledge amongst the public, and that the required level would be considered to have been reached when the earlier mark is known by a significant part of the relevant sectors of the public. In deciding whether this requirement is fulfilled all relevant factors should be considered, including, the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking promoting it; the stronger the reputation and distinctive character, the easier it will be to accept that detriment has been caused to it.

54. In my consideration of the ground under Section 5(2)(b) I found the opponents to possess a strong reputation in DOOM in respect of computer/video games/software, and that this extends to DOOM 3, the added numeral saying little more than it is a later version of DOOM. In doing so I highlighted the absence of fact relating to the characteristics of the market, mentioning that much of what information there is could date from many years prior to the relevant date, the exception being the reference to the board game being based on 2004 versions of DOOM 3. There is no information that enables me to gauge whether, or to what extent there may be a reputation in respect of any other goods covered by the earlier marks, but for some such as carriers and manuals for use with the software there will be an inevitable wash-over. But this takes the case no further forward than under the previous ground.

55. I have given my conclusion that “toys, playthings, gymnastic and sporting articles” are not similar goods to computer/video games software, carriers for such software or manuals for their use. However, the description “games” notionally covers similar goods to those covered by the opponent’s earlier marks. What this assessment does not do is to take into account the way in which the consumers perceive or understand the computer games market; would they expect a computer/video games software manufacturer to be responsible for a board game? As I have already said, apart from the opponents themselves there is no evidence that such activity is commonplace. And what about DOOM? Is it distinctive of the opponents or used by other traders, be it in relation to the same, similar or unconnected goods? The answer to these questions would have been useful in the determination of whether there are contributing circumstances that would have led the consumer to associate

the applicant's use of TOWER OF DOOM with the opponents.

56. In *Intel Corporation Inc v CPM United Kingdom Ltd* [2006] EWHC 1878, Patten J said at para 28:

“But the first step to the exploitation of the distinctive character of the earlier mark is necessarily the making of the association or link between the two marks and all that Neuberger J is, I think, saying in this passage [Premier Brands at p. 789] is that the existence of a later mark which calls to mind the earlier established mark is not sufficient to ground an objection under s.5(3) or s.10(3) unless it has one or other of the consequences specified by those provisions. It must be right that the making of the association is not necessarily to be treated as a detriment or the taking of an unfair advantage in itself and in cases of unfair advantage it is likely to be necessary to show that the making of the link between the marks had economic consequences beneficial to the user of the later mark. But in relation to detriment the position is more complicated. The association between two marks and therefore potentially between the products or services to which they relate may be detrimental to the strength and reputation of the earlier mark if it tarnishes it by association or makes it less distinctive. This is likely to take place as a consequence of the same mental process which links the two marks in the minds of consumers and is essentially a negative reaction and effect.”

57. In *Electrocoin Automatics Limited v Coinworld Limited and Others* [2005] FSR 7, Mr Geoffrey Hobbs Q.C. (sitting as a Deputy Judge stated:

“ 102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, ‘the link’ established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose

58. In *Daimler Chrysler v Alavi (the Merc case)* [2001] RPC 42 at para 88, Pumfrey J stated:

“In my view, the best approach is just to follow the section remembering Jacobs A.G.’s warning that it is concerned with actual effects, not risks or likelihoods...”.

59. For the reasons I have repeatedly given, I see no reason why a consumer seeing the applicant's mark would make the leap to connect it with the opponent's mark, let alone one that would affect their economic behaviour. The ground under Section 5(3) fails and is dismissed accordingly.

60. This leaves the ground under Section 5(4)(a). That section reads as follows:

“5.-(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)

61. 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”.

62. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD* Trade Mark [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponents’ goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents; and

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant’s misrepresentation.

63. To the above I add the comments of Pumfrey J in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case [2002] RPC 19, in which he said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden & Co Ltd’s Application (OVAX)* (1946) 63 RPC 97 as qualified by *BALI Trade Mark*[1969] RPC 472).

Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

64. The first issue to determine is the material date at which this objection must be judged. A similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20, 1993. This was the subject of consideration by the Court of First Instance in *Last Minute Network Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* joined cases T-114/07 and T-115/07. In that judgment the CFI stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000”

65. Where there has been use of the trade mark by the registered proprietors prior to the date of application this must be taken into account as it could establish that it was the senior user. Additionally, it may show that there are circumstances that mean that the use of the subject mark would not be liable to be prevented by the law of passing-off. (See *Croom's Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42.). However, in this case there is no evidence of any use by the applicants so the material date is the date of the application for registration.

66. I have already gone into some depth in considering the reputation of DOOM for computer games and software. Whilst there is a reference to DOOM 3 being available in 2004, I have commented in particular, on the lack of detail in the information such that it is not possible to gauge to what extent there may have been use in relation to trading activities. Whilst other facts supported that there was an established and continuing reputation, as was stated by Oliver L.J. in *Anheuser-Busch Inc v Budeejovicky Budvar NP* [1984] FSR413:

“That, as it seems to me, is to confuse goodwill, which cannot exist in a vacuum, with mere reputation which may, no doubt, and frequently does exist without any supporting local business, but which does not by itself constitute a property which the law protects.”

67. If there is a protectable goodwill based on the use of DOOM in relation to computer games and software for such, and I will take it that there is, it is of an uncertain quantity in the years approaching the relevant date. The use of “ball-park” figures based on unspecified approximations that have a potential 30% range does nothing to add clarity. The reputation and potentially also goodwill may have been bolstered by the use of DOOM in respect of a board game and the motion picture both from at least as early as 2005. However, even without information relating to the size of the markets for such goods it is possible to say that the activity did not create a significant amount of business, but being based on and so closely linked to the computer games would nonetheless have had some positive effect.

68. In my earlier assessments of the marks I have expressed my view that DOOM and TOWER OF DOOM have a similarity, but not to the extent that they could be considered similar. This being the case I do not see how, even when taking their goodwill into account, use by the applicants would amount to a misrepresentation, even in connection with the same or similar goods. I believe it follows that there is no real likelihood of damage.

69. The opposition having failed on all grounds the applicants are entitled to a contribution towards their costs. Both sides agreed that the circumstances of the case warranted an award being based on the set scale. I order the opponent to pay the applicants the sum of £2,250. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27 day of May

**Mike Foley
for the Registrar
the Comptroller-General**

Trade Mark 1587153

Mark: DOOM

Status: Registered

Filing date: 7 October 1994

Registration date: 26 April 1996

Class 09: Computer software and computer programs, all for playing electronic games; parts and fittings for all the aforesaid goods; all included in Class 9.

Trade Mark 2005994

Mark:



Status: Registered

Filing date: 21 December 1994

Registration date: 30 August 1996

Class 09: Computer programs, computer software and data carriers therefor; video and audio games; electric and electronic apparatus for playing the aforesaid games, parts and fittings for all the aforesaid goods.

CTM 3892023

Mark:

DOOM 3

Filing date: 18 June 2004

Registration date: 1 September 2005

Priority date: 13 February 2004

Country: United States

Reference: 76/575353

Class 09: Computer software games, computer software game programs and computer game cartridges or CD-ROMs for video games for entertainment uses.

Class 16: Manuals sold as a unit with computer software games, computer software game programs and computer game cartridges or CD-ROMS for video games for entertainment uses.