

IN THE MATTER OF THE TRADE MARKS ACT 1994
IN THE MATTER OF TRADE MARK APPLICATION NO. 2604118 IN THE NAME
OF OLESEGUN VICTOR IBITOYE AND OPPOSITION NO. 103209 THERETO BY
HASBRO, INC.

DECISION

Introduction

1. This is an appeal from the decision of Mr David Landau on behalf of the Comptroller (24 January 2013, O-039/13) whereby he upheld the opposition to the registration of the mark GALATOPOLY in a slightly stylised font for games and certain related products on the basis of earlier registered trade marks in the name of Hasbro, Inc. for MONOPOLY, *inter alia*, for games.

2. The Hearing Officer based his decision on sections 5(2) and 5(3) of the Trade Marks Act 1994. He did not find it necessary to decide the case based on section 5(4) or that based on other marks of the opponent registered for the mark “-OPOLY”.

Approach to this appeal

3. This appeal is a review of the Hearing Officer’s decision. Robert Walker LJ (as he then was) said of such appeals:

“...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle” (*Reef Trade Mark* [2003] RPC 5 at [28]; see also *BUD Trade Mark* [2003] RPC 25).

4. More recently, in *Okotoks v Fine & Country* [2013] EWCA Civ 672, Lewison LJ said at [50]:

“...in many cases the appellant's complaint is not that the judge has misdirected himself in law, but that he has incorrectly applied the right test. In the case of many of the grounds of appeal this is the position here. Many of the points which the judge was called upon to decide were essentially value judgments, or what in the current jargon are called multi-factorial assessments. An appeal court must be especially cautious about interfering with a trial judge's decisions of this kind.”

5. Lewison LJ also referred to the statement of Lord Steyn in *Smith New Court Securities Ltd v Citibank NA* [1997] AC 254, 274:

"The principle is well settled that where there has been no misdirection on an issue of fact by the trial judge the presumption is that his conclusion on issues of fact is correct. The Court of Appeal will only reverse the trial judge on an issue of fact when it is convinced that his view is wrong. In such a case, if the Court of Appeal is left in doubt as to the correctness of the conclusion, it will not disturb it."

6. On appeals of this kind, it is necessary to bear these principles in mind.

The Hearing Officer’s decision and the grounds of appeal

7. The Hearing Officer’s decision included a comprehensive, careful and detailed review of the evidence and the principles of law. On this appeal, in which the applicant has appeared in person as he did below, no challenge has been made to the Hearing Officer’s statement of the principles of law he applied, nor, in my judgment, could there be. It is therefore unnecessary to reproduce these in this decision: reference should be made to the Hearing Officer’s summary in the decision under appeal.

8. It is also unnecessary to reproduce the marks or their detailed specifications, which centre on games but go somewhat broader, because there is no challenge to the Hearing Officer’s decision that the goods were similar or identical or that the font affected the arguments either way. On this appeal, the issue in effect boils down to whether the

word GALATOPOLY should be registered for games in the light of the prior registration and reputation in MONOPOLY for games, all other points following from that.

9. Although the appellant's grounds of appeal are not conventionally structured, his appeal centres on the criticisms that the Hearing Officer wrongly evaluated the likelihood of confusion under section 5(2) and the likelihood of dilution under section 5(3). He contends, in summary, that the game he is proposing to market under the mark GALATOPOLY (a) would be of high quality; (b) would be quite different to MONOPOLY, since it is inspired by and based on the Holy Bible (in particular the ninth book of the New Testament, St Paul's Epistle to the Galatians); (c) would be sold at such prices as would be likely to lead the average consumer to take considerable care in selecting the game; and (d) would be sold in specialist outlets specializing in Christian teaching. The applicant points to the significant differences between the words GALATOPOLY and MONOPOLY as to the first element of the marks. The applicant also draws attention to the fact that in other areas, marks which had similar suffices (such as Coca-Cola and Pepsi-Cola) existed with no confusion. He also submits that there would be no possibility of dilution of the MONOPOLY mark so as to cause damage because that mark had a very large reputation and because the applicant's proposed game would be of high quality.

10. As noted, no criticism is made of the way in which the Hearing Officer addressed the question of similarity of goods as such, although the applicant contends that the Hearing Officer should have given more weight to the fact that the applicant's proposed GALATOPOLY game would, in fact, be dissimilar to well known MONOPOLY game, because of its Christian focus. There was, however, no attempt to limit the specification, nor in my judgment would such have been effective.

11. The applicant's arguments were principally directed at the question of confusion and dilution with respect to the actual games (MONOPOLY and GALATOPOLY as sold or proposed to be sold). However, as I explained to the applicant at the hearing, the Act requires the Hearing Officer and me to consider the respective registrations on the

assumption of notional and fair use of them across their respective scope, a somewhat more abstract question. Moreover, the Act requires this assessment to be made on the assumption that matters such as disclaimers (which the applicant indicated he would be prepared to include) are not present – the comparison is mark for mark.

The reputation in the opponent’s MONOPOLY mark

12. I turn first to the issue of reputation of the MONOPOLY mark, since it featured heavily in the Hearing Officer’s conclusions.

13. The Hearing Officer found that the opponent had a very substantial reputation in the mark MONOPOLY in respect of board games and related products, including card games and electronic games, at the relevant date, the date of application, as a result of substantial use and licensing (see the review of evidence at paragraphs 13 to 23). He said that it was a matter for judicial notice that MONOPOLY was a well-known trade mark used in relation to a board game; probably the best known trade mark in the United Kingdom for a board game (paragraph 23). Indeed, the opponent’s evidence suggests that some 500 million people world-wide have played MONOPOLY and it continues to be sold in its millions in various different forms in many countries of the world including the UK.

14. The Hearing Officer summarized his conclusions in paragraphs 30 and 32, where he found that, in relation to the mark MONOPOLY, there had been diversification to include electronic games and card games and that the opponent’s goodwill extended to games at large, both electronic and non electronic. He also held that for the purpose of the opposition based on section 5(3) that the opponent had the requisite reputation in MONOPOLY in respect of “board games and articles included in Class 28 for use in playing board games; electronic games and computer games”.

15. I have not been able to detect any error in the Hearing Officer’s evaluation of the reputation of the mark MONOPOLY. It accords with the evidence given on behalf of the

opponent. In short, it is, in my judgment, self-evident that MONOPOLY is one of the best-known games marks in the world.

Likelihood of confusion

16. The Hearing Officer went on to consider the likelihood of confusion in the following way.

The average consumer and the circumstances of sale

17. The Hearing Officer took account of the fact that games, playthings and playing cards would be bought by the public at large including children as well as adults and might be low cost, purchased on impulse (paragraphs 35-35 of the decision). He said that, because of this, the impact of imperfect recollection might be increased. I agree. He also said, and I also agree, that the goods in question would primarily be brought from displays in stores, from mail order catalogues and via the internet and, as a result would be purchased primarily by eye and that visual similarity would have a greater impact than aural. I am unable to accept the point made by the applicant that the average consumer would be particularly observant because of the price of the games in question. Even if the applicant's actual game was expensive, games in general may not be.

18. The applicant also contends that the game GALATOPOLY will be sold through different outlets (in particular those selling Christian books). However, there is nothing inherent in the nature of the specification (which covers games in general) which would limit them to such outlets. Moreover, even if there were such a limitation, such games could well be sold in general shops. I am therefore unable to accept this criticism of the Hearing Officer's decision.

Similarity of goods

19. The applicant contends that because the actual game MONOPOLY and the GALATOPOLY game that the applicant has devised are different games, the goods in question are not similar. However, it is well established that the law requires the Hearing Officer and this tribunal to consider not the actual games as sold or proposed to be sold

but the respective specifications for “games” in all the circumstances in which the mark applied for might be used if it were to be registered (see, for example, *O2 Holdings v. Hutchinson 3G UK*, Case C-533/06 Judgment of the CJEU at [66]). I am therefore satisfied that the Hearing Officer’s conclusion in this respect cannot be challenged.

Comparison of marks

20. The Hearing Officer went on to compare the marks, pointing out that, in accordance with established case law, the marks needed to be considered as a whole. He drew attention to the fact that MONOPOLY was a well-known word and that GALATOPOLY was an invented word which, for the average consumer, would not connote any biblical reference. There was as a result no conceptual similarity. I cannot detect any error in this evaluation. He then considered the font of the application pointing out, again correctly, that the mark would be seen primarily as a word mark since the font was not unusual. This is not challenged and is clearly correct.

21. Taking all of the factors into account, he considered that there was a “very low degree of similarity” between MONOPOLY and GALATOPOLY. On this issue, while there is much to be said for the Hearing Officer’s conclusion, in my view there was, perhaps, somewhat greater similarity than he was prepared to accept, which is reflected in findings in some of the decisions on similar issues from other trade mark offices.

22. The applicant contends that greater emphasis should have been placed on the early parts of the words, GALAT- and MONO-. He refers to a case under the Trade Marks Act 1938, *TRIPCASTROID* 42 RPC 264 and the co-existence of COCA-COLA and PEPSI-COLA. The general principle he articulates is correct that the first part of marks can be more important but there is no rigid rule (see for example *Wagamama v. City Centre Restaurants* [1995] FSR 713 and *Devinlec Developpement Innovation v. OHIM* Case T-147/03 [2006] ECR II-11). In any event, the Hearing Officer took the differences in the first parts of the words into account in making his evaluation.

23. The Hearing Officer came to the assessment of the likelihood of confusion at paragraph 47 and he took into account the various factors which the case law of the ECJ, especially *Canon* (to which he referred) required him to consider, including the nature of the respective marks, their distinctive character and the reputation in the earlier marks, the similarity and identity of the goods. In reaching his conclusion, the Hearing Officer placed weight on the fact that MONOPOLY used for games is a household name at the “very highest level of distinctiveness owing to use”. He also took into account the fact that there was a low degree of similarity between the respective marks. In making his evaluation of the likelihood of confusion, the Hearing Officer held, at paragraph 48, that this was a situation in which there was a common element which was “strikingly distinctive” such that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark sense at all (a situation sometimes described as “indirect” confusion). The Hearing Officer therefore held that there was a likelihood of confusion.

24. The applicant argues that the Hearing Officer was wrong to hold that there was a likelihood of confusion on the basis that a reasonably well-informed person would not confuse COCA-COLA with PEPSI-COLA. In my judgment, there is no relevant analogy, inter alia because COLA is a descriptive element. The Hearing Officer was entitled to find, on the evidence and, taking the nature of the uses of the respective marks into account, that there would be a likelihood of confusion by way of what he described as “indirect” confusion, namely an assumption that those behind the MONOPOLY game had extended their brand under a somewhat similar mark.

25. It may not follow automatically from the fact that an earlier mark is very well-known that the average consumer would be likely to conclude that a mark which is somewhat, but not very, similar to it denoted products or services connected with the proprietor of the earlier mark. At the hearing, there was some discussion of the different aspects that a mark’s reputation may have, even if well-known, some of which may increase the likelihood that the average consumer would reach that conclusion and some of which may even possibly diminish the likelihood of that happening. The opponent

does not contend that this is a case in which it is well known in the United Kingdom for producing or licensing games under marks of the form “X”-OPOLY, other than MONOPOLY itself. Its variants in the United Kingdom are primarily “X”-MONOPOLY or similar although there is evidence of licensing a “MAKE YOUR OWN-OPOLY”. I have reached the clear conclusion that the Hearing Officer cannot be criticized for taking the view that the MONOPOLY mark was sufficiently distinctive that there would be the risk of the kind of confusion to which he referred. In *Wagamama*, to which the applicant referred, Laddie J said that one kind of confusion likely to occur between WAGAMAMA and RAGAMAMA was that some would think that the marks were associated “in the sense that one is an extension of the other ...or otherwise derived from the same source.”

26. In my view, the Hearing Officer was entitled to conclude on the materials before him that a similar situation would obtain with respect to the respective trade mark registrations in this case. I am therefore satisfied that there is no basis for me reversing the Hearing Officer’s conclusion under section 5(2)(b) of the Act.

27. Moreover, this result is broadly in line with a number of other decisions of national trade mark offices and OHIM relating to marks with an –OPOLY suffix in respect of games and similar articles or services. See, for example: *Hasbro, Inc. v. Flick*, Decision of the First Board of Appeal of OHIM of 3 December 2004, R288/2003-1 (in which the mark EUROPOLY was refused in respect of certain games related services on the basis of prior registrations of MONOPOLY) and *Hasbro, Inc. v. Lasher*, Decision No 1565/2005 of 29 April 2005 (in which a mark of which the dominant element was the word GLOBOPOLY was refused in respect of, inter alia, games and playthings). There are similar decisions in Australia and other countries to which attention is drawn in the opponent’s evidence.

28. On the other hand, there is some material in the evidence which indirectly indicates that a number of games exist in the market in the US which are unconnected with the opponent in the form “X”-OPOLY which, it could be argued, lends some support to the applicant’s argument that GALATOPOLY would not be likely to cause

confusion with MONOPOLY. I was not addressed in detail on this issue and the position in the US may be different from that in the UK, both as a matter of fact and as a result of differences in the law including, possibly, the impact of the well-known “*Anti-Monopoly*” litigation (see e.g. *Anti-Monopoly Inc. v. General Mills Fun Group*, 611 F.2d 296 and subsequent related cases). Counsel for the opponent indicated that the opponent may simply have been less successful at opposing the registration or use of those kinds of marks in the US than in the UK and the EU. Tribunals in different countries or in different contexts may, in any event, reach different conclusions on the scope and validity of marks of this kind (cf. the Decision under the Australian Trade Marks Act 1995 of 12 August 2005 of the Delegate of the Registrar of Trade Marks in *LIVE-OPOLY* at [34]-[36]). None of this material casts doubt on the Hearing Officer’s evaluation of the likelihood of confusion between the marks in the context of this opposition in the UK on the particular facts of this case.

29. The decision in respect of section 5(2)(b) is sufficient to dispose of this appeal and I will therefore deal briefly with the remaining aspects. The Hearing Officer also held that the application should be refused on the basis of section 5(3) of the Act, finding that use of the applicant’s mark would be detrimental to the distinctive character of the mark.

30. The applicant justifiably urges caution before conferring an unduly wide monopoly in MONOPOLY. Oppositions based on section 5(3) which rely on claims of alleged dilution must be carefully scrutinized. He contends that the impact of a GALATOPLY game on MONOPOLY’s reputation would be miniscule. However, I am not satisfied that the Hearing Officer approached this aspect of the case incorrectly or reached a conclusion which was plainly wrong. He referred to the relevant authorities and applied the right principles. Having held that the average consumer was likely to assume a connection in the form, in effect, of a brand extension of MONOPOLY, the Hearing Officer was, in my judgment, entitled also to conclude that the use of GALATOPOLY would be likely to have a detrimental effect on the distinctive character of the MONOPOLY mark in respect of the goods for which it is registered.

31. For these reasons, the appeal will be dismissed.

Costs

32. Neither side has applied for any special order as to costs. Since the opponent has been successful on this appeal, it is entitled to its costs on the usual scale. The written submissions were not extensive on either side and oral argument was also brief.

33. In those circumstances, I award the opponent a further £500 in respect of the costs of this appeal. These are in addition to the costs awarded by the Hearing Officer below.

DANIEL ALEXANDER QC

Appointed Person

13 September 2013

The applicant appeared in person.

Mr Simon Malynicz instructed by Gill Jennings and Every LLP appeared for the opponent.