

O-302-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3035816
BY FAT FISH GAMES LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 9, 28, 41 & 42:**




AND

**OPPOSITION THERETO (NO. 402272) BY
FULL FAT PRODUCTIONS LTD**

Background and pleadings

1. This dispute concerns an opposition to the registration of the following trade mark:

Trade mark:	
Filing date:	20 December 2013
Publication date:	7 March 2014
Applicant:	Fat Fish Games Limited
Goods:	<p>Class 9: Video game software and accessories; providing computer games and video games that can be downloaded over computer networks and global communications networks; game controller operational software; electronic mail and messaging software; computer software for playing video games and computer games with others via a global computer or communication network and for accessing and browsing global and communication networks; computer software for compressing or decompressing data and video images; operating system software programs and utility programs for use with the above referenced machines; user manuals sold as a unit with the above referenced machines; game software for use on computers; magnetic discs; optical discs and other storage media storing computer programs and consumer video games; programs for handheld games; downloadable computer software and applications accessible via the internet and wireless devices and mobile telephones.</p> <p>Class 28: Toys; games; puzzles and playthings; amusement machines and apparatus for use in amusement parks; electronic games; handheld electronic games; gaming apparatus (other than adapted for use with televisions receivers); apparatus for games adapted for use with television receivers and/or monitors; bags and cases adapted or shaped to contain any of the aforementioned goods; parts and fittings for all of the aforementioned goods.</p> <p>Class 41: Entertainment services; providing interactive multiplayer games services for games played over computer networks and global communications networks; providing computer games and video games</p>

that can be accessed and played over computer networks and global communications networks; arranging and conducting competitions for video game players and computer game players; publication of electronic magazines; video game events; rental of consumer video games; rental of games machines and apparatus; providing games via telecommunications networks.

Class 42: Computer services; providing software and mobile applications for social networking, blogging and file sharing; developing, designing and providing of computer software and mobile applications; hosting of a blog in the fields of social networking, advertising and promotion, computers, education, entertainment and recommendations; acting as an application service provider; providing websites relating to mobile applications and technology.

2. Full Fat Productions Ltd (“the opponent”) opposes the registration under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying on the following trade marks:

i) UK registration 2579116 for the mark **FAT** which was filed on 19 April 2011 and was registered on 23 September 2011. The mark is registered for the following goods and services:

Class 9: Computer games programs and software; video games software; electronic games software; software for playing video, computer and on-line games; games for mobile phones; games for handheld devices; video games; computer games.

Class 28: Games and playthings; handheld computer games equipment; video games machines; parts and fittings for all the aforesaid goods.

Class 41: Provision of computer games online; provision of video games online; providing online electronic publications and information relating to computer games and video games; providing online electronic publications and information relating to the development of computer games and video games; providing games by mobile telephone communication; providing games by or for use on a mobile telephone.

Class 42: Development of computer software; development and design of computer games; development and design of video games; information and advisory services relating to the aforesaid services; software that enables users to play games on mobile telephones devices.

ii) UK registration 2579118 for the series of three marks **FULL FAT**, **FULLFAT** and **FULL-FAT** which were filed on 19 April 2011 and registered on

30 September 2011. The marks are registered for the following goods and services:

Class 9: Software that enables users to play games in mobile telephone devices.

Class 41: Providing games by mobile telephone communication; providing games by or for use on a mobile telephone.

Class 42: Creating and maintaining websites.

iii) UK registration 2508409 for the series of four marks **FULL FAT, FULL-FAT, FULL/FAT** and **FULLFAT** which were filed on 11 February 2009 and registered on 17 July 2009. The marks are registered for the following goods and services:

Class 9: Computer games programs and software; video games software; electronic games software; software for playing video, computer and on-line games; games for mobile phones; games for handheld devices; video games; computer games.

Class 28: Games and playthings; hand held computer games equipment; video games machines; parts and fittings for all the aforesaid goods.

Class 41: Provision of computer games online; provision of video games online; providing online electronic publications and information relating to computer games and video games; providing online electronic publications relating to the development of computer games and video games.

Class 42: Development of computer software; development and design of computer games; development and design of video games; providing information relating to the development of computer games and video games; information and advisory services relating to the aforesaid services.

3. Given their dates of filing, all of the opponent's marks constitute earlier marks in accordance with section 6 of the Act. Furthermore, given that none had been registered for five years or more at the date of publication of the applicant's mark, they are not subject to the proof of use provisions contained in section 6A. Consequently, they may all be relied upon for their specifications as registered. It should be noted that the opponent initially pleaded grounds under sections 5(3) and 5(4)(a) of the Act, however, due to the opponent filing no primary evidence in support of its case¹, the tribunal informed the opponent that the grounds were to be struck-out. Even though the opponent subsequently filed evidence in response to that of the applicant, evidence which included some details of the use made by the opponent of

¹ Evidence to demonstrate reputation/goodwill is needed to support these grounds.

its marks, the opponent nevertheless confirmed that the opposition should continue under section 5(2)(b) only.

4. The applicant filed a counterstatement. In addition to denying the opposition, it highlighted a number of other marks on the register which contain the word FAT (plus another word) for similar goods and services.

5. Both sides are professionally represented. The opponent is represented by Marks & Clerk LLP, the applicant by Rohan & Co Solicitors. Both sides filed evidence, albeit the opponent only filed evidence (and a set of written submissions) in response to the evidence of the applicant. Neither side requested a hearing. The applicant filed written submissions in lieu of a hearing, the opponent did not. The only point the opponent added was to highlight (as I have done already) that its earlier marks are not subject to the proof of use provisions.

The evidence/submissions

6. The applicant's evidence comes from Mr Rupert Rohan, a solicitor at Rohan Solicitors. The majority of Mr Rohan's evidence is not evidence of fact, consisting mainly of submission as to the merits of the case. I will not summarise this in full, but the gist of the submissions is that the marks are "fundamentally distinct" on account of the logo, the stylisation, and that the respective words in the marks are FAT FISH (which will be read together) against marks which consist of or contain the word FAT. Mr Rohan considers the concepts to differ as one relates to a fat fish (which is reinforced by the logo) whereas the others relate purely to the word FAT or FULL FAT. Mr Rohan also considers the respective services to differ. He gives some examples of services applied for by the applicant ("electronic mail and messaging software; computer software for playing video games and computer games with others via a global computer or communication network and accessing and browsing global and communication networks") which he submits are not equivalent to "computer and on line games". He goes on to contend that the applicant's range of services do not conflict with those of the opponent and that there is "significant distinction between the words used to define the goods and services.". The final point Mr Rohan makes repeats what was stated in the applicant's counterstatement in that there are other marks on the register which contain the word FAT (plus another word). The marks are all Community Trade Marks. He provides details of them in an accompanying exhibit and which include marks such as: FAT BOY, L30W FAT, FAT MAX & FAT FACE.

7. The opponent's evidence comes from Ms Tina Rees-Pedlar, a trade mark attorney at Marks & Clerk LLP. She gives some background information regarding the opponent, a company which was founded in 1996 as an independent computer games production company which has contributed to many "big brand games" across a number of formats. In 2009, due to the expansion in smart phones and digital technology, the opponent embarked on creating its own independent mobile games. They have released 20 mobile games and achieved over 55 million downloads. In 2003 they started the development of an independent flick golf game for the Nintendo 3DS. Reference is made to changing technology and the shift to mobile technology and wireless communications devices. It is explained that mobile games are distributed either by "over the air" delivery via wireless carrier networks,

“side-loaded” (loaded via a computer connection), “pre-installed” (a game already loaded on the device by the manufacturer), or “mobile browser download” (download via a mobile website). It is stated that most games are distributed via wireless carrier networks. Reference is made to Google Play and Apple’s App Store as key distribution channels. Data is provided showing that there has been a huge increase in recent years in the use of mobile games. It is stated that both the applicant and the opponent use the same distribution channels. Some games are free or go up to around £2. It is stated that both parties would use the same marketing methods, such as websites and social media. It is stated that the marks will be displayed on mobile screens so will be small in nature and, furthermore, in practice only the words in the marks will be used. Also provided is a dictionary definition of the word FAT.

8. In the opponent’s accompanying submissions, three cases are cited to support its submissions that:

- i) a likelihood of confusion can arise if the earlier mark is comprised entirely in a later mark where that element plays an independent distinctive role even if the earlier mark has only a normal level of distinctiveness; it is later submitted that the word FAT plays an independent and distinctive role in the applicant’s mark;
- ii) when a mark has both verbal and figurative elements, the verbal element is normally more distinctive and;
- iii) consumers pay more attention to the beginnings of marks.

9. The opponent further submits that the earlier marks are registered without any specific graphic elements, so are protected for the words themselves regardless of any stylisation in the applicant’s mark. It submits that the marks are conceptually similar due to the FAT message, which it submits is re-enforced in the applicant’s mark by a picture of an engorged fish – it states that the word FAT is clearly important in defining the nature and appearance of the word/device FISH. It further submits that FULL FAT and FAT FISH are conceptually similar because the applicant’s mark is indicative of a “full” (full up) fat fish. In terms of goods/service similarity, the opponent contends that there is identity and similarity on the basis, particularly, of the new ways in which mobile games are distributed; it submits that, in fact, many of the terms either overlap or essentially overlap. It is submitted that the average consumer is the general public and that only a low degree of attention will be deployed by them because of the low cost nature of mobile games. It is submitted that the word FISH (and the device) could be seen as a description (of a fish based game) which supports the view that FAT is the dominant/distinctive element. The opponent does not consider the state of the register evidence to be significant because it does not show the “propensity of use in the marketplace”.

10. To round off the picture, I will make a brief summary of the applicant’s written submissions filed in lieu of a hearing. Various points are made including:

- i) There is no evidence of the opponent’s FAT mark being used. However, as I have already noted, it is not necessary for the opponent to file any evidence in order to rely on this mark.

- ii) That if the beginnings of the marks were more important, FULL FAT and FAT FISH would not be confused because the beginnings are different.
- iii) That the word FAT in the applicant's mark is not even full because a bite has been taken out of it.
- iv) FULL FAT has its own meaning relating to milk, cheese etc in the sense that it has not had any fat removed.
- v) When purchasing apps the consumer will normally search for the title and not the producer. Only when the game is found will the developer be identified which will normally be through the use of a full trading name (such as Fat Fish Games Ltd).

Section 5(2)(b)

11. Section 5(2)(b) of the Act states that:

“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.”

12. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks

bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

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

(k) if the association between the marks creates a risk that the public 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/services

13. When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

14. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

15. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

16. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

17. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the

purposes of the trade”² and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning³. I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

18. Even if goods/services are not worded identically, they can still be considered identical if one term falls within the ambit of another (or vice versa), as per the judgment in *Gérard Meric v OHIM*, Case T-133/05.

19. I will make the comparison with reference to the applied for goods/services, but grouping certain terms together when it is appropriate to do so. In terms of the earlier marks' specifications, 2579116 and 2508409 have essentially the same specification⁴ so I will make just one comparison covering both. Earlier mark 2579118 has a much narrower specification so for the most part will not improve the opponent's position (and thus will not feature in the comparison below), although, I note that it does have one term (creating and maintaining websites in class 42) which is not covered by the other two earlier marks so I will bear this in mind if it becomes necessary to do so. I will start with the applied for goods in class 9:

Video game software and accessories; providing computer games and video games that can be downloaded over computer networks and global communications networks; game software for use on computers; programs for handheld games

20. The opponent's specification covers a range of terms which essentially boil down to video and computer games. In view of this, the above terms are effectively identical.

² See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

³ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

⁴ Even though 2579116 has slightly more terms, they do not materially add to that already covered by 2508409.

Computer software for playing video games and computer games with others via a global computer or communication network and for accessing and browsing global and communication networks

21. Here the software is for playing video games and for accessing global computer and communication networks. There is no reason why the opponent's video and computer games could not have this same functionality. The goods are either identical or similar to a very high degree.

Magnetic discs; optical discs and other storage media storing computer programs and consumer video games

22. It is clear that the goods in question are not blank media but actually contain computer programs (which could be computer games) and video games. I consider this to be identical to the opponent's computer and video games which could also be provided on such storage media.

Downloadable computer software and applications accessible via the internet and wireless devices and mobile telephones

23. Although the above term is not limited to computer games software, it nevertheless covers such software and must therefore be considered identical to the opponent's computer games software.

Game controller operational software

24. I accept that these goods are not identical to the opponent's goods. However, the purpose of the goods has a degree of similarity as one is the game itself whereas the other facilitates the playing of the game by way of the controller software. They could be purchased through similar channels and they would appear to have a complementary relationship. I consider there to be a reasonable degree of similarity. There is also a reasonable degree of similarity with development of computer software in class 42 of the earlier marks, as a software developer and the software produced are inextricably linked.

Electronic mail and messaging software; computer software for compressing or decompressing data and video images; operating system software programs and utility programs for use with the above referenced machines

25. There is less similarity here with the opponent's video/computer games as the purpose is quite different. There is, though, for the reasons given above, a reasonable degree of similarity with development of computer software (which would cover development of computer software for messaging purposes, for compression of images etc, or for producing operating system or utility programs).

User manuals sold as a unit with the above referenced machines

26. A user manual sold as a unit with the above could well accompany a computer game. There is a clear complementary relationship and are clearly sold through the same channels to the same user. The goods are reasonably similar.

I next consider the applied for goods in class 28:

Toys; games; puzzles and playthings

27. The earlier marks cover “games and playthings” in class 28 which I consider to be identical to the above.

Amusement machines and apparatus for use in amusement parks

28. The term “games” covered by the earlier mark is broad enough to include amusement machines and, therefore, the goods are identical. The earlier mark also includes “video games machines” which would also cover amusement machines and apparatus, including those used in amusement parks. These goods are also identical.

Electronic games; handheld electronic games; gaming apparatus (other than adapted for use with televisions receivers); apparatus for games adapted for use with television receivers and/or monitors

29. The earlier mark covers “video game machines” and “hand held computer game equipment”. I consider the goods to be identical despite the different terminology used.

Bags and cases adapted or shaped to contain any of the aforementioned goods

30. Although the earlier mark does not cover such goods, it does cover the things that the bag is to contain. This creates, in my view, a clear complementary relationship despite the fact that the exact purpose of the individual items differ. The goods are likely to be sold through the same channels and will be sold to the same users. There is a reasonable degree of similarity.

Parts and fittings for all of the aforementioned goods

31. The same reasoning as above applies to parts and fittings. The goods are reasonably similar.

I next consider the applied for services in class 41:

Entertainment services

32. Entertainment is a broad term, but one wide enough to include entertainment in the form of providing online gaming. The latter is something covered by the earlier marks and, on the principle established in *Gerard Meric*, the services are identical. I accept that many entertainment services would not be similar at all to online gaming which opens the door to a possible restricted specification. If the opposition were to otherwise succeed, I will return to this point later.

Providing interactive multiplayer games services for games played over computer networks and global communications networks; providing computer games and video games that can be accessed and played over computer networks and global communications networks; providing games via telecommunications networks

33. Despite the different terminology used, the services are essentially identical to the opponent's "provision of computer games online".

Arranging and conducting competitions for video game players and computer game players

34. I accept that these services are not identical to any services covered by the earlier mark. However, the provider of online computer games may well also offer a competition in relation to the games being played. The exact purpose is not the same but there is a degree of similarity. There is also a degree of complementarity inherent in this type of relationship. The services could be accessed through the same trade channels (a gaming website for example) and will be provided to the same users. I consider there to be a medium degree of similarity.

Video game events

35. For similar reasons to that given above, I also consider there to be a medium degree of similarity here.

Publication of electronic magazines

36. The earlier marks cover "providing online electronic publications...relating to computer games and video games". The applied for term could, of course, be in the field of video games and, consequently, identity must be found on the *Gerard Meric* principle.

Rental of consumer video games

37. The earlier marks do not cover rental of video games, but they do cover the provision of computer games online. It is at least arguable that "provision" would include provision by way of rental agreements and, so, the services could be identical. However, even if this were not right then the purpose of the services are similar (to allow users to play video games), the method of use may be similar (going on a website to play a game or to rent one (which is then played)), the channels of trade could be the same and the services aimed at the same users. In practice, the only real difference may be the extra step required to sign up to the rental agreement. I consider the services to be highly similar.

Rental of games machines and apparatus

38. The earlier marks do not cover rental of these machine and apparatus, but do cover games machines per se. I consider there to be a clear aspect of similarity. Both are aimed at providing the same goods to the consumer, albeit, one situation involves rental as opposed to owning. The trade channels are likely to overlap and

the same consumers will be involved. There is a clear competitive relationship. I consider the service and the goods to be highly similar.

I next consider the applied for services in class 42:

Computer services

39. “Computer services” is a broad term which would include things such as the opponent’s “development of computer software”. As such, the services are identical on the *Gerard Meric* principle. The broadness of the term gives rise to the possibility that other services it covers are less similar (or not similar at all) – I will return to this point if it is necessary to do so.

Acting as an application service provider

40. Such services are for the provision of computer and mobile applications via some form of network link. The consumer uses the application but without the need to have a physical copy on the relevant device. Applications could cover those for gaming, so, in comparison to computer game software per se, the purpose is very similar and there could well be an overlap in trade channels. There is also a key competitive choice between a physical piece of software and using what is, effectively, software as a service. I consider the service to be highly similar to the goods.

Providing software and mobile applications for social networking, blogging and file sharing

41. The same type of service will be in play here as described in the preceding paragraph. However, the software and applications here are for a specific purpose (social networking, blogging and file sharing) which contrast with the earlier marks software which is for gaming. Any similarity here must, therefore, be considered as low.

Developing, designing and providing of computer software and mobile applications

42. The earlier marks cover development of computer software (which could also be mobile applications). I consider the terms to be identical or highly similar.

Hosting of a blog in the fields of social networking, advertising and promotion, computers, education, entertainment and recommendations

43. A host service relates to the technical side of a weblog as opposed to the finished blog itself. It will provide space on a server for people to place their blog which can then be accessed by users. I do not consider such a service to clash with development of software or even computer games per se. The closest one gets is the term I identified earlier that is covered by earlier mark 2579118, “creating and maintaining websites”. A website could be in the form of a blog. I consider that there is a reasonable degree of similarity between creating/maintaining and the subsequent hosting of such things.

Providing websites relating to mobile applications and technology

44. Here, again, I consider the closest term to be creating and maintaining websites covered by earlier mark 2579118 because providing a website may include as part of that service its creation and maintenance. The services are identical, or, if not, highly similar.

Average consumer and the purchasing act

45. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

46. The goods and services vary from computer games software to computer software development to toys and games to entertainment type services. The average consumer and the degree of care and consideration they use when selecting the goods and services may, therefore, also vary. I will highlight a few examples, but will return in more detail if it is necessary to do so. In relation to computer games and other software and apps, the average consumer would be a member of the general public. Whilst some games (and other software and apps) may be reasonably expensive, there are many which are either low cost, or even free. Confusion must, therefore, be considered from this perspective. For such goods the average consumer will still consider the intended purpose of the goods, but, nevertheless, they may be subject to a level of care and attention lower than the norm.

47. For computer services, the average consumer could be either a member of the general public or a business and, depending on exactly what is involved, a higher or lower degree of care could be used in the selection of them. The same applies to hosting services, with the same (differing) average consumers with a somewhat higher than average level of care given that the reliability, security and usability of the hosting service will be important. With regard to providing software in the sense of software as a service, the same (differing) average consumers will be involved with what could range from a casual to careful selection process depending on the type of software being provided. In relation to toys and games, the average consumer would be a member of the general public, selecting goods in a fairly causal manner (depending on the exact product involved). However, in relation to

gaming equipment, this may be more expensive and will be subject to a degree of care and attention somewhat higher than the norm. That leaves the class 41 services which seem to be services aimed at the general public, with a reasonable (neither higher nor lower than the norm) degree of care and consideration.

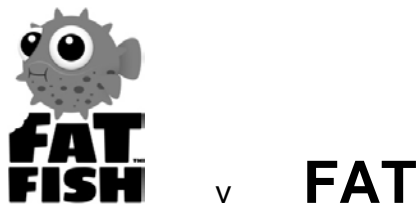
48. In terms of the selection process, all of the goods and services strike me as ones likely to be selected more by the eye (through websites, brochures etc) rather than by aural request. However, I will not ignore the aural impacts of the marks completely.

Comparison of marks

49. 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 at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

50. 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. The marks to be compared are:



and



⁵ Although there are other marks in the series, it is only necessary to make one comparison.

51. The overall impression of the earlier mark FAT is based purely upon that word. In terms of the earlier mark FULL FAT, the words combine to create a phrase which, in line with the applicant's submission, I consider to be a known term indicating a full fat product such as full fat milk or cheese; neither word materially dominates the other or has greater relative weight. In terms of the applied for mark, there are two main components, the device of a bloated (or fat) fish, and the word combination FAT FISH. The word combination, for obvious reasons, hangs together. Both the device element and the word combination make a roughly equal contribution to the overall impression of the mark. The stylisation in the mark has much less relative weight. It goes from the foregoing that I reject the opponent's submission that the word FAT is an independent distinctive element of the applicant's mark. Put simply, it is not, even if the mark were used on a product relating to fish.

52. In terms of the comparison with the FAT earlier mark, there is a degree of similarity because both marks contain the word FAT. However, the additional word FISH together with the striking device of a bloated fish means that the visual similarity is low. There is greater aural similarity because the device element will not be articulated. The marks will be articulated as FAT-FISH and FAT respectively. I consider there to be a medium degree of aural similarity. Conceptually, the applicant's mark has a specific concept based upon a fish that is fat. The opponent's mark will be conceptualised on the basis of fat (either as in the substance or as in the state of being overweight) per se. Any conceptual similarity is limited at best.

53. In terms of the comparison with FULL FAT, there is a greater difference in terms of visual and aural similarity because of the additional difference created by the word FULL. I consider there to be only a very low degree of visual similarity and a low degree of aural similarity. In terms of concept, one relates to something having a full fat content (such as milk or cheese), the other relates to a fish that is overweight. The marks are conceptually different.

Distinctive character of the earlier marks

54 The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier marks, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been

registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

55. No claim to enhanced distinctiveness has been made. Indeed, the approach the opponent has taken is to only file some brief evidence in reply to that of the applicant. In terms of inherent characteristics, the marks FAT and FULL FAT make no allusions towards the goods and services for which they are registered. Indeed, they are somewhat fanciful. I consider them to be reasonably high in inherent distinctive character.

Likelihood of confusion

56. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

57. In relation to the FAT earlier mark, I will firstly consider the opposition on the basis of video/computer game software. I do so because from that perspective the opponent is in the best possible position because some of the relevant factors point in its favour, namely:

- i) the goods are identical (which, given the interdependency principle, may offset a lower degree of similarity between the marks),
- ii) the goods include those which may be subject to a casual selection process because they include some which may be low cost or even free (which has the potential to increase the likelihood of confusion because the effects of imperfect recollection may be increased),
- iii) the earlier mark has a reasonably high degree of inherent distinctive character (which may increase the likelihood of confusion).

58. Two submissions I reject are:

- i) The opponent’s submission that confusion is more likely due to marks in this field being displayed in small characters (on a mobile screen) and ordinarily in word only format. I can only consider the notional use of the marks (which includes the applicant’s device element) and I must consider them in a way in which the average consumer can clearly see them. This point also applies to the applicant’s submission that the full name of the developer will be displayed – it is the marks before me that must be considered.

- ii) The applicant's reliance on other marks on the register which include the word FAT because there is no evidence of them being exposed to the average consumer.

59. Confusion can be direct, in the sense that one mark is mistaken for the other, or indirect, in the sense that the average consumer will put some similarity between the marks down to the fact that the undertakings responsible for the goods are the same or are related. In terms of the former, direct confusion, I come to the view that this will not arise. Even bearing in mind the factors which clearly go in the opponent's favour, the marks are, put simply, sufficiently different to avoid any likelihood of them being misremembered or misrecalled as each other. Although they share the word FAT, as a whole, the marks are noticeably different and this will easily be recalled by the average consumer. **There is no likelihood of direct confusion.**

60. In terms of indirect confusion, this was summed up by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

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

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)."

61. Of course, I bear in mind that the three categories of indirect confusion identified by Mr Purvis QC are just illustrative – he stated that indirect confusion "tends" to fall

in one of them. The categories should not, therefore, be considered a straightjacket. In my view there will be no indirect confusion, in any of the categories identified by Mr Purvis QC, or any other categories. The word FAT is a fairly common English word. In the applicant's mark the word qualifies the physical state of the fish that is depicted. The average consumer will not assume that the use of this word in the respective marks is indicative of a shared economic origin. The use will be put down to co-incidence not economic connection. **There is no likelihood of indirect confusion.** The same applies to the other goods and services of the application, the opponent is in no better position.

62. In relation to the various FULL FAT marks, the opponent is in no better position. Indeed, I consider the opponent to be in an even weaker position on account of the additional visual, aural and conceptual differences that exist. **There is no likelihood of confusion.**

Costs

63. The applicant has succeeded and is entitled to a contribution towards its costs. My assessment is as follows:

Preparing a statement and considering the other side's statement - £400

Filing and considering evidence - £500

Written submissions (filed at the evidence stage) – £400

64. I therefore order Full Fat Productions Ltd to pay Fat Fish Games Limited the sum of £1300. This should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of June 2015

**Oliver Morris
For the Registrar,
The Comptroller-General**