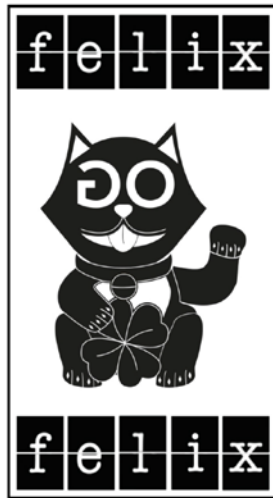


O-614-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3180957 BY
FELIX GO FELIX LTD
TO REGISTER:**



AS A TRADE MARK IN CLASSES 9 & 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 408034 BY DREAMWORKS ANIMATION LLC**

BACKGROUND & PLEADINGS

1. On 18 August 2016, Felix Go Felix Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the goods and services shown in paragraph 10 below. The application was published for opposition purposes on 9 September 2016.

2. On 8 December 2016, the application was opposed in full by DreamWorks Animation LLC (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent relying upon the two European Union Trade Mark (“EUTM”) registrations shown below:

No. 5767975 for the trade mark: **FELIX THE CAT** which has an application date of 19 March 2007, registration date of 9 March 2010 and in relation to which the following goods are relied upon:

Class 9 - Video and computer game programs;

Class 25 – Clothing, footwear, headgear.

No. 5768205 for the trade mark shown below which has an application date of 19 March 2007, registration date of 23 March 2010 and in relation to which the opponent relies upon the same goods mentioned above:



3. The applicant filed a counterstatement signed by Felix Molle. As these are the only submissions I have from the applicant, they are reproduced below verbatim:

“I would first like to explain the etymology of my company name and logo, as I feel this is important regarding the distinction between my logo, and that of the claimant.

My Company name Felix Go Felix is based on the Latin translation of the word Felix, i.e. Happy or Lucky, thus making one possible meaning of my company name Happy Go Lucky. The animated version of my logo starts with the word Happy displayed on top, and Lucky displayed below. These letters then flip to reveal the words Felix on both.

I can certainly provide a copy of the animated logo by email if required.

More personally, as my name is Felix, the company name also has a secondary meaning as a phrase to spur myself on, though I don't imagine this is pertinent information.

With this in mind, I can explain the relevance of my logo. The first thing to note is that it is not a cat, it is a Maneki-neko, an Asian symbol of luck. The logo was not chosen due to the similarities between the words “feline” and “Felix” as I imagine the claimant's logo was. It is based on the fact that Felix means luck, and as explained above, Maneki-neko is a symbol of luck. This symbolism is further established by the clover leaf being held by the Maneki-neko. The Maneki-neko in my logo also has a broad smile, which links to the meaning of the first Felix in the company name; Happy.

The claimant has remarked “it is highly likely that consumers would consider this to be connected to our client's business and intellectual property rights”. This seems to be a gross generalisation, without any evidence to support it. I would

argue the exact opposite, particularly since the likelihood of any possible confusion is reduced by the fact the claimant's exposure is minimal. The claimant only has a minute amount of product in my main domain (Trademark Class 9). I can only find a computer game from 1992, and a couple of iOS only apps which are clearly aimed at young children.

With all this said, I will acknowledge that my decision to use the same colour scheme for my Maneki-neko as the claimant has used for their cat may not have been the wisest decision, and I would be willing to change the colour scheme of my logo to white and red, these colours being more associated with a Maneki-neko. With these changes made, I argue that the claim that confusion will be "highly likely" concerning the two logos to be totally unreasonable."

4. In these proceedings, the opponent is represented by Kilburn & Strode LLP; the applicant represents itself. Although neither party filed evidence or asked to be heard, the opponent filed written submissions in lieu of attendance at a hearing. I shall refer to these submissions, as necessary, below.

DECISION

5. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

"5 (2) A trade mark shall not be registered if because –

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

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

6. An earlier trade mark is defined in section 6 of the Act, which states:

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

7. In these proceedings, the opponent is relying upon the EUTM registrations shown in paragraph 2 above, both of which qualify as earlier trade marks under the above provisions. As these earlier trade marks had been registered for more than five years at the date the application was published, they are, in principle, subject to the proof of use provisions contained in section 6A of the Act. However, because in its counterstatement the applicant ticked the box (in question 7) to indicate that it did not want the opponent to provide proof of use, the opponent can rely upon its earlier trade marks in relation to the goods in classes 9 and 25 mentioned earlier without having to make good its claim to having used these trade marks in relation to such goods.

Section 5(2)(b) – case law

8. The following principles are gleaned from the decisions of the courts of the European Union 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.

The principles:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

(i) mere association, in the strict sense that the later mark brings 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.

The opponent's strongest case

9. The goods in classes 9 and 25 relied upon by the opponent in its two earlier trade marks are identical. Bearing that in mind, it is EUTM no. 5768205 which, in my view, offers the opponent its strongest case and it is on the basis of that registration I shall conduct the comparison.

Comparison of goods and services

10. The competing goods and services are as follows:

Opponent's goods	Applicant's goods and services
Class 9 - Video and computer game programs.	Class 9 - Application software; Application

<p>Class 25 – Clothing, footwear, headgear.</p>	<p>software for mobile phones; Computer application software; Computer application software featuring games and gaming.</p> <p>Class 42 - Fashion design.</p>
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11. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court 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”.

The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) The extent to which the respective goods or services are competitive. This enquiry 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.

In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) 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) (IP TRANSLATOR)* [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."

In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

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

In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....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.”

In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the GC stated:

“29 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 Vedral 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).”

12. In its counterstatement, the applicant refers to the opponent’s “minute amount of product in my main domain” i.e. in class 9. Although that appears to refer to examples of actual use the applicant has found of the opponent’s goods, as the applicant elected not to ask the opponent to prove use of its earlier trade marks, what I must do is compare the wording in the competing specifications as they appear on the Trade Mark Register applying the case law set out above. For the sake of convenience, I shall deal with the matter on a class-by-class basis.

Class 9

13. The applicant’s specification contains “application software” at large (which would include all the other application software in its specification). It also specifies application software for use on a specific device i.e. a mobile phone and computer application software for a specific purpose i.e. for “games and gaming”. As the latter is simply an alternative way of describing the opponent’s goods in class 9, the competing goods are identical. In addition, as all of the remaining application software (either at large or for mobile phones or computers) would include, inter alia, the “video and computer game programs” in the opponent’s specification, such goods are to be regarded as identical on the principle outlined in *Meric*. Thus as matters stand, all of the applicant’s goods in class 9 are to be regarded as identical to the opponent’s goods in class 9. In its submissions, the opponent states:

“34...Where the application software of the applicant embraces functions not specific to gaming, the goods should therefore be classed as highly similar to the opponent’s class 9 goods i.e. all being types of software...”

I shall return to this point when I consider the likelihood of confusion later in this decision.

Class 42

14. In its submissions, the opponent refers to one of my own decisions (BL-O-069-17) in which I assessed the degree of similarity between “Clothing, footwear, headgear” in class 25 and “Design of clothing; Design of clothing, footwear and headgear; Design of fashion accessories; Design services for clothing; Designing of clothing” in class 42 and in relation to which I stated:

“22. The applicant seeks registration in respect of a range of, broadly speaking, design services relating to clothing, footwear, headgear and fashion. In its submissions, the opponent states:

“39. The class 42 services of the opposed application are similar to the class 25 goods of the earlier registration. There is a degree of similarity between clothing and fashion design services since the respective goods/services share the same relevant public. Further, the goods/services might also coincide in originating from the same producer or provider. It is common that the producers of ready-made clothing, such as suits or wedding dresses, also provided tailoring services. These are obviously closely related to fashion design which is part of the clothing production process...”

23. The opponent’s submission to the effect that undertakings that design clothing, footwear, headgear etc. also conduct a trade in such goods is unsurprising. It reflects my own experience and, more importantly, is likely to reflect the average consumer’s view of the matter. The applicant’s services I have identified are, as a consequence, complementary to the opponent’s goods in class 25 in these sense that one is important for the use of the other such that

the average consumer will think that the responsibility for both lies with the same undertaking. The well-established connection between the goods and services at issue results, in my view, in at least a medium degree of similarity.”

15. As the applicant’s “fashion design” services would, in my view, be understood to refer to the same services I dealt with in the previous decision and as the comparison is with the same goods in class 25, having had my memory of that previous decision refreshed and having reviewed my reasoning, I see no reason to reach a different conclusion here. I therefore find that the opponent’s goods in class 25 are complementary to the applicant’s services in class 42 and, as a consequence, similar to at least a medium degree.

The average consumer and the nature of the purchasing act

16. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods and services at issue; I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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.”

17. The average consumer of the goods and services at issue is a member of the general public purchasing on their own behalf or a business user buying on behalf of a commercial undertaking. Such goods are, in my experience, most likely to be obtained by self-selection from the shelves of a bricks and mortar retail outlet or from the equivalent pages of a website or catalogue. As a consequence, while visual considerations are likely to dominate the selection process, as such goods may also be the subject of, for example, oral requests to sales assistants (in person and by telephone), aural considerations must not be forgotten. As to the applicant's "fashion design" services in class 42, as these too are likely to be selected from physical premises on the high street or from, for example, information provided in hard-copy or on-line, visual considerations will, once again, be an important part of the process. However, as such services are also likely to be the subject of word-of-mouth recommendations, aural considerations are likely to be a not insignificant feature of the selection process.

18. I see no reason why, in principle, a business user would not select the goods and services in much the same way, with intermediaries such as wholesalers and trade-focused sales representatives also likely to feature in the process.

19. As to the degree of care such average consumers will display when selecting the goods and services at issue, my own experience tells me that although the cost of application software varies, when selecting such goods, the average consumer is likely to be alive to factors such as the purpose of the software, for example, if it is a game, what type of game is it, the platform(s) on which it will operate and the age group for which it is considered appropriate, all of which suggests at least a normal degree of attention will be paid to the selection of such goods. I reach the same conclusion in relation to the goods and services in classes 25 and 42, where factors such as size, fit, material, colour, compatibility with other items of, for example, clothing etc. will all come into play. Considered overall, I think a business user selecting for commercial purposes where, for example, larger sums may be in play and contracts may be negotiated over a



period of time, is likely to pay a somewhat higher degree of attention when selecting the goods and services at issue.

Comparison of trade marks

20. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, 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.”

21. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are:

Opponent’s trade mark (strongest case)	Applicant’s trade mark
	

22. In reaching the conclusions which follow, I have taken into account (but do not intend to record here) all of the opponent's submissions on this aspect of the case.

23. The opponent's trade mark consists of two components. The first, is a stylised (cartoon like) device of a cat presented in black and white, below which there appears the words "FELIX THE CAT" presented in capital letters in a bold, unremarkable font. Although in the counterstatement Mr Felix Molle refers to the Latin origins of the name "FELIX" (meaning happy), that is not how the average consumer is most likely to understand the word. Rather, the average consumer is most likely to recognise the word "FELIX" as a male forename. Although much smaller than the device, the words are obviously meant to be read in conjunction with the device to indicate that the stylised cat is called "FELIX". Considered in that context, both components will, in my view, make a roughly equal contribution to both the overall impression the opponent's trade mark conveys and its distinctiveness.

24. Turning to the applicant's trade mark, this consists of the word "felix" presented in white in lower case letters against black squares which act as backgrounds. This component appears at the top and bottom of the trade mark. Between these two components, in the centre of the trade mark, there appears a device presented in black and white. In its counterstatement, the applicant states that it is "not a cat, it is a Maneki-neko, an Asian symbol of luck." In its submissions, the opponent states:

"25....we note that the English translation of the Japanese term [i.e. Maneki-neko] is in fact "Lucky cat", "beckoning cat" or "fortune cat."

25. In the absence of evidence as to how the average consumer will construe the device component, I have to reach my own conclusion. Speaking as a member of the public unfamiliar with the Maneki-neko, my first impression of the device present in the applicant's trade mark was that it was a stylised cat of some sort. As I see no reason why my view of the matter is likely to be regarded as atypical, that is the basis on which

I shall proceed. Of course, if the average consumer is familiar with the Maneki-neko, it is also likely to be aware that it is meant to represent a cat.

26. As to the device itself, I note that it is holding a clover leaf, has its tongue out, is raising its left paw and where one would normally expect to find its eyes, there appears a reversed letter “G” and a conventional letter “O”. In its submissions, the opponent states:

“25...We submit that the inverted word “GO” in the applicant’s mark would only be perceived by the average consumer if particular attention was drawn to this and therefore has very little bearing on the visual, conceptual or aural aspect of the mark.”

27. I agree with that submission. Like the opponent’s trade mark, both components will, in my view, make a roughly equal contribution to both the overall impression the applicant’s trade mark conveys and its distinctiveness.

28. I will now compare the competing trade marks from the visual, aural and conceptual standpoints with those conclusions in mind. Both trade marks contain the word “FELIX”/“felix” and both contain a stylised device of a cat. In its submissions, the opponent comments on the competing devices in the following terms:

“26...Both feature a cat, the main body of which is coloured black. Both cat devices are coloured partly in white, have large, round eyes and pointed ears of very similar proportions. Both cat devices have a leg protruding in the guise of a wave...”

29. When compared forensically, the competing devices have a number of differences. However, that is not how the average consumer will consider them in the course of the selection process. Although the opponent’s device is more simplistic and cartoon like in its appearance than the applicant’s device and is unlikely to be regarded as waving, a

number of the opponent's submissions are, nonetheless, well-founded i.e. the colour, large eyes and pointed ears. Considered overall, the competing trade marks are visually similar to a fairly high degree. As to the offer contained in the applicant's counterstatement regarding its willingness "to change the colour scheme of [its] logo to white and red", even if such an amendment was permissible, as fair and notional use of the opponent's trade mark would permit it to present its trade mark in exactly the same colours, such an offer does not assist the applicant.

30. As to the aural comparison, it is well-established that when a trade mark consists of a combination of words and figurative components, it is by the words that the trade mark is most likely to be referred. Approached on that basis, the opponent's trade mark will be referred to as "FELIX THE CAT" and, given my conclusion earlier regarding the word "GO" in the applicant's trade mark, the applicant's trade mark as "felix" or "felix felix". As "FELIX" will be the first word articulated in the opponent's trade mark and the only word in the applicant's trade mark, even if it is repeated (which is arguable), there remains a fairly high degree of aural similarity between the competing trade marks.

31. Finally, the conceptual comparison. As both trade marks evoke the concept of a cat called "FELIX"/"felix", they are conceptually identical.

Distinctive character of the earlier trade mark

32. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

33. As the opponent has filed no evidence of any use it may have made of the trade mark upon which it relies, I have only its inherent characteristics to consider. As far as I am aware (and there are no submissions to the contrary), the opponent's earlier trade mark is neither descriptive of nor non-distinctive for the goods upon which it relies in these proceedings. To the contrary, it is, in my view, inherently distinctive to a well above average degree.

Likelihood of confusion

34. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

35. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods/services down to the responsible undertakings being the same or related.

36. Earlier in this decision, I concluded that (i) the competing goods and services are either identical or similar to at least a medium degree, (ii) whilst aural considerations must be kept in mind, visual considerations are likely to dominate the selection process, and (iii) the average consumer will pay at least a normal degree of attention to the selection of such goods and services. Having then identified the overall impression the

competing trade marks convey and where their distinctiveness lies, I found that there was (iv) a fairly high degree of visual and aural similarity, (v) conceptual identity and (vi) that the opponent's earlier trade mark was inherently distinctive to a well above average degree.

37. Applying those conclusions to the matter at hand, I am satisfied that when considered in relation to identical goods, and to services which are similar to a medium degree, a consumer paying at least an average degree of attention during the selection process is likely to be confused. Given, in particular, the visual and conceptual similarities between the competing trade marks and factoring in the concept of imperfect recollection, this confusion is, in my view, likely to be direct. However, even if the consumer notices the differences between the competing trade marks, the similarities I have identified above and the distinctiveness of the opponent's trade mark are likely, in my view, to lead the consumer to erroneously conclude that the applicant's goods and services emanate from the opponent or an undertaking related to the opponent i.e. there will be indirect confusion.

Conclusion in relation to the specifications as filed

38. The opposition against "computer application software featuring games and gaming" in class 9 and "fashion design" in class 42 succeeds regardless. As matters stand, the application also succeeds in relation to the applicant's "Application software", "Application software for mobile phones" and "Computer application software". Earlier in this decision, I mentioned that in its submissions, the opponent stated:

"34...Where the application software of the applicant embraces functions not specific to gaming, the goods should therefore be classed as highly similar to the opponent's class 9 goods i.e. all being types of software..."

39. However, in *Mercury Communications* (1995) FSR 850 Laddie J, stated:

“In my view it is thoroughly undesirable that a trader who is in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those far removed from his own area of interest. If he does he runs the risk of his registration being attacked on the grounds of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act.”

40. Applying the guidance in *Mercury*, if the applicant were to offer a revised specification which positively limited its remaining goods in class 9 to a purpose completely unrelated to the opponent’s goods, it may be possible for the application to proceed to registration for a limited specification.

Next steps

41. With the above in mind, the applicant is allowed 14 days from the date of this interim decision to offer a revised specification in class 9. Any such revised specification offered should be copied to the opponent who will then be allowed a period of 14 days from the date that it receives a copy of the revised specification to provide comments. At the conclusion of that period, I will review any submissions the parties may make and issue a supplementary decision, deal with costs and in which a period will be set for appeal.

Dated this 1st day of December 2017

C J BOWEN

For the Registrar

The Comptroller-General