

O/710/18

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATIONS NO 3 214 746 DIRTQUAKE
AND NO 3 214 740 SNOWQUAKE IN CLASSES 09, 28, 38 AND 41 BY NORTH
ONE TELEVISION LIMITED**

AND

**IN THE MATTER OF THE CONSOLIDATED OPPOSITIONS THERETO BY ID
SOFTWARE INC.**

Background and pleadings

1. North One Television Limited (the applicant) applied to register the trade marks DIRTQUAKE and SNOWQUAKE in the UK on 23rd February 2017. They were accepted and published in the Trade Marks Journal on 24th March 2017 in respect of the following goods and services:

Class 09:

Pre-recorded television programmes and films; pre-recorded videos; compact discs; DVDs; computer games, including downloadable computer games; electronic publications (downloadable); electronic apparatus relating to broadcasting; cinematographic films and photographic films; sunglasses; sound recordings; data carriers; clock radios; computer software; video cassettes and audio cassettes; audio and visual recordings; audio apparatus and instruments; computer software and computer hardware; educational apparatus and instruments; projectors.

Class 28:

Games, toys and playthings; gymnastic and sporting articles; decorations for Christmas trees; video game apparatus.

Class 38:

Broadcasting services; telecommunications services; provision of access to a global computer network; online broadcasting; electronic mail; satellite transmission.

Class 41:

Entertainment services; television, film, audio and radio production and distribution; electronic publications (non-downloadable); organisation and provision of games and competitions, including provision of games and

competitions via the Internet; sporting and cultural activities; organisation, presentation and production and performance of shows and live performances; educational services.

2. Id Software LLC (the opponent) oppose the trade marks on the basis of Section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act). In respect of the grounds under Section 5(2)(b) and 5(3), this is on the basis of the following earlier trade marks:

1. Earlier UK Trade Mark No 2 005 738: QUAKE. Registered on 22nd December 1995. The following goods in Class 09 are relied upon: computer software, computer games and computer game programs.
2. Earlier European Union (formerly Community) trade mark NO 1 478 1611 QUAKE. Registered on 8th June 2016 in respect of the following goods and services which are relied upon in this opposition:

Class 09:

Downloadable computer game software offered via the internet and wireless devices; computer game software for use with computers and video game consoles; computer game software for use on cell phones and other handheld wireless devices; computer game software for use with on-line interactive games; Downloadable publications, namely, guides featuring computer and video game strategy; Computer games; Computer games software; Computer game programs; Recorded computer programs; Software for video games; Downloadable publications relating to computer games.

Class 28:

Apparatus for games adapted for use with television receivers.

Class 41:

Entertainment services, namely, providing websites featuring news, information, art, video clips, trailers, and other multimedia materials in the

fields of video and computer games; Entertainment services, namely, providing on-line interactive computer games; entertainment services, namely, providing information relating to electronic computer games via the Internet; Entertainment services in the nature of organizing and presenting computer game competitions, tournaments, events and exhibitions; Providing on-line computer games.

3. Under Section 5(2)(b), the opponent argues that the respective goods and services are identical or similar and that the marks are similar. Under Section 5(3), the opponent claims that it enjoys a reputation and that use of the later trade mark would be detrimental to the distinctive character of the earlier trade mark by dilution so that it would no longer be capable of arousing immediate association with the goods and services for which it is registered. Further, it would be detrimental to its repute by degrading or tarnishing the same and reducing its power of attraction. Finally, use of the later trade mark would take unfair advantage by free-riding on its distinctive character and/or repute and would constitute exploitation of QUAKE and/or an attempt to trade upon its recognition.
4. Under Section 5(4)(a), the opponent relies upon the following signs: QUAKE, QUAKE II, QUAKE III, QUAKE III ARENA and QUAKE 4. It claims these have been used since 1996¹ throughout the UK in respect of computer games and have acquired an extensive goodwill. The adoption by the applicant of the later trade marks would constitute a misrepresentation and cause damage to the opponent's goodwill.
5. The applicant filed a counterstatement denying the claims made (and requesting that the opponent provides proof of use of its earlier UK trade mark relied upon).
6. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate.

¹ QUAKE used since 1996; QUAKE II used since 1997; QUAKE III and QUAKE III ARENA used since 1999; QUAKE 4 used since 2005;

7. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

Evidence

Opponent's evidence

8. This is a witness statement, dated 31st October 2017, from Mr David Tate, a trade mark attorney representing the opponent in these proceedings. Mr Tate explains that the opponent claims use and reputation in respect of computer games. The relevant trade marks include that relied upon in this opposition, namely QUAKE.
9. Mr Tate claims that the opponent is responsible for some of the biggest selling computer games of all time. Mr Tate explains that the opponent was the creator of a computer game called "DOOM" which was very popular. There is other information regarding this game and its fame, but this is not directly relevant to the use of QUAKE and so will not be summarised. As regards QUAKE, Mr Tate explains that this was released worldwide in 1996. Exhibit DT2 appears to confirm that at the end of 2005, QUAKE was the 13th best selling computer game of all time. This exhibit appears to be from the eBay website and is dated 1st February 2006. QUAKE II was released worldwide by the opponent in 1997. Exhibit DT4 is compilation of polls and lists from 2007 entitled "the best video games in the history of humanity". Its source is a website called www.filibustercartoons.com, but no context about this website is provided. It is noted that several of the opponent's games are listed therein, namely QUAKE, QUAKE II and DOOM. Exhibit DT5 is a copy of a feature, dated 2007, entitled "The 101 best PC games ever, part four" from the website www.computerandvideogames.com a computer and video games

magazine published on-line by the UK-based company, Future Publishing Limited.

10. Exhibit DT7 is a list by CVG (we are not told who or what CVG is) ranks QUAKE III: ARENA as 19th in the list of the best computer games of all time. Exhibit DT6 is a selection of pages from the BBC's website from 2002-2009 referring to the QUAKE computer game. In 2002, the BBC describes the opponent a "gaming goliath". Exhibit DT7 includes a selection of material showing sales of the opponent's QUAKE series of games in the UK. Much of this is dated after the relevant date in these proceedings. There are two entries from 2015 and 2016, but these appear to be in the form of an article alerting the reader that the QUAKE games can be purchased in the sale together with a print from a website called "HotUKdeals" advising that the games are now on offer to purchase at a cheaper price. Some of the entries also describe "e sports". This appears to refer to what is, in effect, gaming competitions or tournaments whereby players can compete against others across the world.

DECISION

Section 5(2)(b)

11. Section 5(2)(b) of the Act is 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".

Comparison of goods and services

12. It is noted that the earlier European Union Trade Mark relied upon is not subject to the proof of use provisions as five years had not elapsed by the relevant date in these proceedings. It can therefore rely upon the full breadth of the specification as registered. As such, this decision will focus upon this earlier trade mark.
13. Some of the contested goods and services, i.e. computer games and entertainment services are identical to the goods and services on which the opposition is based. For reasons of procedural economy, the Tribunal will not undertake a full comparison of the goods and services listed above. The examination of the opposition will proceed on the basis that the contested goods and services are identical to those covered by the earlier trade mark. If the opposition fails, even where the goods/services are identical, it follows that the opposition will also fail where the goods/services are only similar.”

Comparison of marks

14. 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 Court of Justice of the European Union 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.”

15. 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.

16. The respective trade marks are shown below:

QUAKE	1. DIRTQUAKE 2. SNOWQUAKE
Earlier trade mark	Contested trade mark

17. Neither the earlier nor later trade marks contain any particular stand out dominant and distinctive feature. They must therefore be compared as wholes.

18. Visually, the earlier trade mark is solely QUAKE which appears in both later trade marks. They differ in respect of the additional elements SNOW and DIRT which appear at the front of the later trade marks. The additional words in the later trade appear at the beginning of the marks and make a significant visual impact. They are similar to the earlier mark, but only to a low degree.

19. Aurally, the position is similar, the additional words in the later trade marks add an extra syllable not found in the earlier trade mark. They would also be articulated first which has a clear and obvious impact. They remain similar to

the earlier mark due to the inclusion of QUAKE but this is pitched as being to a low degree.

20. Conceptually, it is considered that the earlier trade mark will be immediately understood as meaning an earthquake. It may also be understood as meaning to shake or tremble, though it is considered that the reference to the natural disaster is far more likely. The later trade marks have no clear and unequivocal meaning. The combinations of SNOWQUAKE and DIRTQUAKE are quirky, imprecise, conceptually fanciful and create no immediately obvious meaning. There is therefore considered to be a conceptual gap between the earlier trade mark and the later trade marks.

21. Bearing in mind all of the foregoing, it is accepted that there is some similarity between the trade marks, though this is not pitched as being particularly high.

Average consumer and the purchasing act

22. 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*.

23. 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.”

24. The average consumer for the goods and services in question will be the general public, including those who have a particular interest in computer games, that is, gamers. The purchasing process for the goods and services will be online via websites or other provision such as app stores where a particular game can be downloaded and played instantly. The products can also be purchased from specialist bricks and mortar shops or over the telephone. As regards the nature of the purchasing process, it is considered that in respect of these goods and services, the consumer is likely to decide to play a particular computer game or use a related service following a period of consideration and following the perusal of customer reviews or a word of mouth recommendation. It is possible that consumers, having already purchased a particular game, may be presented with further games of similar interest (via pop ups for example) and invited to purchase such games. Both visual and aural considerations are therefore likely to be important.
25. The level of attention expected to be displayed therefore will normally be reasonable, but may be on occasion, be fairly low (for example, in the pop up scenario already described).

Distinctive character of the earlier trade mark

26. 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).”

27. In its evidence, the opponent presents information which it considers supports its claim to enhanced distinctiveness. It is noted that QUAKE appears in a number of lists regarding popular games. However, this evidence is overwhelmingly historical in nature. In addition, there is no information regarding market size (presumably it is large) nor market share held by the opponent. It is also difficult to say whether or to what extent the reputation extended to the UK. From the information filed, it is impossible to gauge the status and popularity of QUAKE at the relevant date in these proceedings and so it cannot make good its claim to enjoy an enhanced degree of distinctive character. As such, its degree of distinctiveness must be assessed on a prima facie basis. To that end, it has already been found that the immediate meaning that will be associated with QUAKE is as referring to an earthquake. It is considered that QUAKE is descriptive to a degree for computer games and related goods and services as it communicates to the user that these goods and services are earthquake themed. On that basis, it is considered that QUAKE is distinctive to a below average degree.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

28. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

29. The goods and services have been assumed to be identical and so the interdependency principle is in full operation. The average consumer is likely to display a reasonable degree of attention during the purchasing process, but a low degree of attention is not discounted. Further, the marks are visually and aurally similar to only a low degree. Conceptually, the later trade marks are quirky and unusual with no immediate obvious meaning. This is in contrast to the earlier QUAKE which is most likely to be understood as specifically referring to an earthquake. As such, there is a conceptual gap between them. It is noted that the respective trade marks coincide only in

respect of an element which is, in any case, distinctive to a below average degree. In this respect I bear in mind the following guidance:

30. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

31. The additional elements SNOW and DIRT in the later trade marks appear at the beginnings of the marks and will be noticed. It is considered that bearing in mind all of the foregoing, the average consumer, even if allowing for the effect of imperfect recollection, is unlikely to mistake the trade marks for one another. There is no likelihood of direct confusion.

32. However, this is not the end of the matter as I take into account the following guidance in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where Mr Iain Purvis Q.C., as the Appointed Person, explained 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.

33. The marks coincide in respect of QUAKE, which is distinctive to a below average degree. It is difficult to see how the later trade marks could be perceived to be an obvious or natural brand extension. Illustrative support for this comes from the opponent's own evidence. It is noted that subsequent versions of QUAKE include a numbering system (QUAKE II, QUAKE III) or indeed an additional context, such as QUAKE III ARENA. In all these examples, it is clear that the brand remains QUAKE and the other elements either tell the consumer via number that the version is a sequel and/or that there is a change to the context somehow (like ARENA). This cannot be said of the later trade marks, which do not create the impression of an obvious brand extension. As already stated, they are each quirky, unusual combinations and neither have an immediate obvious meaning. This is in contrast to the earlier trade mark which immediately conveys a natural disaster, that is, an earthquake. At best, from the opponent's perspective, the common element QUAKE in the later trade marks may call the earlier trade marks to mind. However, this is mere association and not confusion².

34. The opposition under Section 5(2)(b) therefore fails.

Section 5(3) - Reputation

35. The opponent also bases its opposition on Section 5(3) of the Act.

² *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

36. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

37. The relevant case law can be found in the following judgments of the CJEU:

Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Addidas-Salomon, Case C-487/07, L’Oreal v Bellure and Case C-323/09, Marks and Spencer v Interflora. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29 and Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a

reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

38. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

39. In *Rise Construction Management Limited v Barclays Bank*,³ Professor Philip Johnson as the AP rejected an appeal against the HO's decision that the earlier mark had not been shown to have acquired a reputation for s.5(3) purposes. He said:

“76. Even if the Hearing Officer had considered all the evidence of other successful management projects (Bow Street Magistrates' Court, the UK

³ BL O/635/17

Pavilion at the Madrid Expo, the Royal Opera House, or Kidzania) and the attendant publicity as well as given some (possibly) very little weight to the awards it would have made no material difference. None of this material addresses the fundamental difficulties faced by the Respondent namely that there was no evidence presented as to market share, no evidence from trade bodies or from people with standing in the industry, and no evidence of the market in which the reputation was claimed.

77. In respect of this final point, at the end of the Hearing, I asked Mr Hollingworth in what market the Respondent claimed reputation. He said the “construction industry” and that his client was known as a project manager in that industry. There was no evidence presented as to the size of the construction industry market (a further problem for Mr Hollingworth identified by the Hearing Officer: see paragraph 56). Nevertheless, I can take notice of the fact that the industry is worth many tens of billions of pounds and employs well over a million people. The Respondent’s turnover (which as the Hearing Officer pointed out, does not break down between UK and overseas: paragraph 12) is at most £8million and the number employed nearly 100.

78. While the requirement for a reputation is “not onerous” (see *Enterprise Holdings, Inc v Europcar Group UK Ltd & Anor* [2015] EWHC 17 (Ch) at paragraph 120) and there was possibly more evidence the Hearing Officer should have considered to make her determination, none of the missing evidence could have materially changed her conclusion that “RISE has positive connotations of moving upwards” (paragraph 56) and that the Respondent did not have the necessary reputation in relation to construction management (paragraph 73). Furthermore, once the relevant market was identified by Mr Hollingworth as the behemoth that is the construction industry, the Hearing Officer’s statement might even appear generous. Accordingly, I dismiss the cross-appeal in relation to section 5(3).”

40. It is considered that the evidence of the opponent suffers from similar defects: no evidence about the market and no evidence of market share. Indeed, it is

also unclear as to the position in the UK. Further, much of the information contained within the evidence is several years old, with the bulk dated many years prior to the filing date of the later trade marks. Taking the evidence as a whole, it is impossible to place the use made of the earlier trade marks into any meaningful context and it is unclear as to the knowledge threshold of the earlier trade marks in the UK. As such, it has not shown that it enjoys a reputation and so its claim under Section 5(3) fails.

Section 5(4)(a) – Passing Off

Legislation

41. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

42. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case

(Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "*a substantial number*" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

43. Halsbury's Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

44. The evidence filed by the opponent has already been discussed above. As regards goodwill, even if it is notionally concluded that the opponent’s business enjoys a goodwill in respect of the earlier signs, the reach and extent of this cannot be determined as little of the evidence filed is put into context (including the geographical reach) for the reasons already given.

45. Bearing all of this in mind and also that it has already been found that there is no confusion, it is difficult to see how the claim under passing off puts the opponent in any better position. The earlier sign QUAKE has already been found to not be confusingly similar. It is also considered that there is no misrepresentation. This is even more stark in respect of the additional signs⁴

⁴ QUAKE, QUAKE II, QUAKE III, QUAKE III ARENA and QUAKE 4

relied upon which include other elements which have no counterpart in the later trade marks. The claim under Section 5(4)(a) therefore also fails.

COSTS

46. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £800 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering notice of opposition and accompanying statement - £200

Statement of case in reply - £300

Considering evidence⁵ - £300

TOTAL - £800

47. I therefore order ID Software Inc. to pay North One Television Limited the sum of £800. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 8th day of November 2018

Louise White

For the Registrar

⁵ This reflects the fact that the opponent's evidence was light.