

O-582-20

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF

TRADE MARK APPLICATION NOS. 3202310 AND 3244332

BY ADP GAUSELMANN GMBH

TO REGISTER

LIBERTY BELLS

AS TRADE MARK IN CLASSES 9 AND 41, RESPECTIVELY

AND

OPPOSITION THERETO

UNDER NOS. 409467 AND 411078

BY IGT GERMANY GAMING GMBH

Background and pleadings

1. Adp Gauselmann GmbH (“the applicant”) applied to register the following trade mark shown below under numbers 3202310 (“310 mark”) and 3244332 (“332 mark”) on 14 December 2016 and 17 July 2017, in Classes 9 and 42, respectively:

LIBERTY BELLS

2. The applications for 310 mark and 332 mark were published for opposition purposes on 17 March 2017 and 20 October 2017, respectively.
3. The registrations of the applicant’s marks are opposed by IGT Germany Gaming GmbH (“the opponent”). It filed two notices of opposition. The oppositions are based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The oppositions are directed against all the goods and services in the applications, namely:

Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media: cash registers, calculating machines, data processing equipment, computers: computer software; fire-extinguishing apparatus; musical jukeboxes and parts for the aforesaid automatic machines: automatic cash dispensers, automatic money counting and money changing machines; coin-operated mechanisms: computer and video games software; games software for use on any computer

platform, including electronic entertainment and games consoles; computer game programs; computer games programs; video games (software); computer games provided through a global computer network or supplied by means of multi-media electronic broadcast or through telecommunications or electronic transmission or via the Internet; computer games, leisure and recreational software. video games and computer software, all being provided in the form of storage media; programs for operating electric and electronic apparatus for games, amusement and/or entertainment purposes; automatic lottery machines: computer software for computer games on the Internet; on-line games (software), in particular for en-line [sic] betting games, on-line prize games, on-line gambling games, on-line games of skill and on-line casino games; computer software in the form of an application for mobile devices and computers: calculating apparatus in coin-operated machines and parts for the aforesaid goods: apparatus for recording, transmission, processing or reproduction of data, including sound or images, including parts for all the aforesaid goods, except radio sets, television receivers, hi-fi systems, video recorders, telephone apparatus, fax machines and telephone answering machines; computer hardware and software for casino and amusement arcade games, for gaming machines, slot machines or video lottery gaming machines or games of chance via the Internet; electric, electronic, optical or automatic apparatus, for identifying data carriers, identity cards and credit cards, bank notes and coins; electric, electronic or optical alarm and monitoring installations, including video cameras and apparatus for image transmission and image processing; data processing apparatus and computers, including data processing apparatus and computers being components for data networks and parts facilitating data network

communications; electric wiring harnesses; circuit boards, printed circuit boards (electronic components.) and combinations thereof, being assemblies and parts for apparatus, included in class 9.

Class 41 Education; provision of training; entertainment; sporting and cultural activities; rental of automatic slot machines and entertainment machines for casinos and amusement arcades; leasing of casino games; entertainment services connected with gaming and playing games; arranging and conducting games; gambling; operation of lotteries; provision of games; provision of games via the Internet, including on-line and by way of applications for smartphones, tablets and computers; on-line games services (by way of a computer network); provision of entertainment and educational content by way of applications for mobile devices and computers: conducting quizzes by way of applications for smartphones, tablets and computers; provision of casino facilities (gambling) and betting offices; conducting casino games and games of chance; operation of gaming establishments, arcades and on-line Internet casinos and betting platforms; gambling services provided via the Internet; provision of an on-line library of downloadable games over a global computer network.

4. For both oppositions, the opponent relies upon the following European Union ("EU") trade mark registration:

LIBERTY BELL

EU registration no.: 8205999

Filing date: 08 April 2009

Date of entry in register: 31 August 2009

5. In its notice of opposition, the opponent indicates that it relies upon all the goods and services for which its earlier mark is registered, namely;

Class 9 Programs for operating electric and electronic apparatus for games, amusement and/or entertainment purposes; calculating apparatus in coin-operated machines and parts for the aforesaid goods.

Class 28 Electric and electronic coin and token-operated entertainment machines, automatic slot machines and automatic lottery machines; electric and electronic apparatus for games, amusement or entertainment purposes; coin-operated gaming machines and entertainment machines; automatic gaming machines; the aforesaid automatic machines, machines and apparatus operating in networks.

Class 41 Casinos; operating a jackpot system involving one or more automatic slot machines, namely a jackpot or prize with a fixed minimum value which increases until the jackpot is won.

6. The applicant in its counterstatements dated 29 September 2017 and 14 March 2018 indicated that a revocation action was pending at the EUIPO against the earlier mark on the grounds of non-use in relation to all the goods and services. Further to the applicant's request, the registry suspended the UK opposition proceedings pending the outcome of the revocation action. I will return to the outcome of the EUIPO revocation proceedings later in the decision.
7. The opponent argues that there is a likelihood of confusion, including a likelihood of association, because the respective marks are similar, and the goods are either identical or similar. The applicant filed a counterstatement in each case, denying the grounds of oppositions.
8. Given its date of filing, the trade mark upon which the opponent relies qualifies as an earlier trade mark in accordance with section 6 of the Act.
9. The oppositions were subsequently consolidated.

10. The opponent is represented by Armin Herlitz of IGT Austria GmbH, and the applicant is represented by Dr Walther Wolff & Co. Both parties filed evidence which I will mention to the extent I consider appropriate. Only the applicant filed written submissions in lieu of a hearing. I make this decision after a careful reading of all the papers filed by the parties.

Revocation at the EUIPO


11. The earlier mark was partially revoked at the EUIPO with effect from 28 July 2017 for all the goods and services *save programs for operating electric and electronic apparatus for games, amusement and/or entertainment purposes* in Class 9.

12. Although the EUIPO has partially revoked the earlier mark, the outcome of the EUIPO proceedings has no bearing on the current proceedings. This is because the revocation date, i.e. 28 July 2017 postdates the application dates of contested marks, i.e. 14 December 2016 and 17 July 2017. It follows that on the date of application of the contested marks, the opponent's mark was validly registered for all the goods and services in Classes 9, 8 and 41. The opponent can, therefore, rely on all the goods and services it has identified in its notice of opposition. I note that the applicant has put the opponent to proof of use of its goods and services in the current proceedings. As I am not bound by the EUIPO's decision, I am required to assess the genuine use of the earlier mark based on the evidence filed in these proceedings.

Evidence

Opponent's evidence

13. This consists of a witness statement from Armin Herlitz and is accompanied by seven exhibits. Mr Herlitz states that he is the SR Manager Intellectual Property of IGT Austria GmbH, a position he has held since 2001. Mr Herlitz claims that IGT Austria GmbH and the opponent (IGT Germany Gaming GmbH) are economically linked and that he is an employee representative of the opponent.

14. According to Mr Herlitz, the opponent has undergone several name changes over the years. The company was originally called Atronic International GmbH, which then changed to Spielo International Germany GmbH, then to GTECH Germany GmbH and finally to IGT Germany Gaming GmbH.
15. Atronic's brochure from the *website www.atronic.com* from the year 2009 is provided as Exhibit A. The brochure refers to LIBERTY BELL as a 3-reel, 5-line fruit game. I note that this material pre-dates the relevant five-year periods (discussed later in the decision) during which the opponent is required to demonstrate genuine use.
16. Exhibits B consists of a brochure from IGT with a copyright date of 2015. The sign appearing on the brochure is . The brochure contains details of the game variations and the gaming platform.
17. Exhibits C, D and E consist of another set of brochures from IGT. Exhibits C, D contain a copyright date of 2015, while the copyright date on Exhibit E is 2012. The brochures contain photographs of gaming machines of Atronic. The brochures refer to LIBERTY BELL as one of the IGT's multi games namely "Brilliant Blue Deluxe", "Pure Purple Deluxe" and "Master Collection". No circulation figures have been provided for anyone of the brochures.
18. Mr Herlitz states that Exhibit F is an extract from the commercial register. It purports to substantiate Mr Herlitz's claim of the opponent company's name changes over the years. The document is in German, and no English translation has been provided. Mr Herlitz submits:

"I believe that a translation of the whole document is not necessary, as the company names can be identified easily"¹

¹ See Mr Herlitz's witness statement para 3.

19. Twelve invoices dated between 2012 – 2015 are provided as Exhibit G. Although the invoices are redacted, relevant information such as the recipients' names, locations, the products sold, and the sellers' details are visible. The invoices show sales of LIBERTY BELL, Master Collection, Pure Purple Deluxe and Brilliant Blue Deluxe. The invoices are in the name of Spielo International Germany GmbH, GTECH Germany GmbH and IGT Germany Gaming GmbH. The recipients have addresses in various locations in the EU, including the UK.

20. Mr Herlitz provides the following turnover figures (in Euros):²

2012	27,900.00
2013	250,305.30
2014	142,350.00
2015	109,500.00

Although Mr Herlitz confirms that the revenue figures provided exclude the rental revenue, it is not clear whether the turnover figures specifically relate to the revenue generated from the sale of goods under the mark LIBERTY BELL.

Applicant's evidence

21. This consists of a witness statement from Dr Schröder. There are no exhibits attached to the witness statement. Dr Schröder is the technical executive of the applicant company, a position he has held since 2005.

22. According to Dr Schröder, the trade mark LIBERTY BELLS was adopted in 2016, and the mark has been applied for or registered in over ten countries worldwide.³ Dr Schröder states that the game under the mark LIBERTY BELLS is distributed online in the UK through a number of organisations.

Proof of Use

² See Mr Herlitz's witness statement para 5.

³ See Dr Schroer's witness statement para 2.

23. As the applicant's marks were filed before 14 January 2019, the proof of use provisions under the old law apply.

Section 6A of the Act states:

“(1) This section applies where -

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

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

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

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

(3) The use conditions are met if -

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

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

(4) For these purposes -

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

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

24. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

25. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno*

Merken BV v Hagelkruis Beheer BV [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 *P Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].
- (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the

form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

- (5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].
- (6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].
- (7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate

that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

26. As the earlier mark is an EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C149/11, that applies to trade marks subject to proof of use in the EU are relevant. The court noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And:

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And:

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A de minimis rule, which would not allow the national court to appraise 13 all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)”.

27. At paragraphs 57 and 58, the court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the mark concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

28. In *Awareness Limited v Plymouth City Council*,⁷ Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use.....
However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

29. Pursuant to section 6A of the Act, the relevant periods for assessing whether there had been genuine use of the earlier mark is the 5-year periods ending with the date of publications of the contested marks, i.e.

310 mark: 18 March 2012 to 17 March 2017;

332 mark: 21 October 2012 to 20 October 2017

30. Although registered as a word mark, the evidence shows the use of the mark LIBERTY BELL in a slightly stylized form. It also appears to me that mark is presented in a combination of colours. Neither of the modifications, in my view, alter the distinctive character of the words LIBERTY BELL.⁴ The evidence also shows the use of the words LIBERTY BELL in conjunction with an image of a bell. The image merely reinforces the concept of a bell in the mark, and the average consumer is likely to perceive LIBERTY BELL as indicative of the origin

⁴ See *Nirvana Trade Mark*, BL O/262/06, paras 33 and 34.

of the product. As the use in conjunction with another sign falls within the ambit of genuine use, the opponent can rely on the use of the mark as demonstrated.⁵

31. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁶

32. The opponent submits:

“As previously explained, in a multigame, different game (software) can be selected on one machine, and whenever a player chooses the game LIBERTY BELL out of a number of games, only this game is available for play at that moment.”⁷

33. The opponent’s specification includes “programs for operating electric and electronic apparatus for games, amusement and/or entertainment purposes”. The applicant makes the following submissions on the opponent’s specification:

“The Class 9 goods of No. 98205999 identify the apparatus as apparatus for games, amusements and/or entertainment, but that does not mean the operating program is itself a game.”⁸

34. The apparatus for games, amusement and/or entertainment described in the opponent’s specification is designed to, for example, allow users to play games. Therefore, in the ordinary and natural meaning, the opponent’s programs are apt to cover any program that enable users to play games on such equipment. I am aware from my own experience that when a user activates a classic slot game such as LIBERTY BELL, the gaming machine randomly generates numbers and displays the results. In such circumstances, a gaming machine depends upon gaming software programmed on it in order to work. The

⁵ See *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, paras 32 and 35.

⁶ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

⁷ See the opponent’s witness statement dated 12 March 2020, para 4.

⁸ See the applicant’s written submissions dated 27 August 2020, para 2.

programs that operate the apparatus described in the opponent's specification is not, therefore, in my view, limited to an operating system (OS) that facilitates the playing of a game but includes any software such as a gaming software which allows the users to play games on that machine. Therefore, I proceed on the basis that the opponent's specification is broad enough to include gaming software.

35. Various brochures filed in evidence indicate to me that Brilliant Blue Deluxe, Pure Purple Deluxe and Master Collection are the names of multi-games available on the gaming machines of Atronic. It is also clear to me from the images of the gaming machines filed in evidence that LIBERTY BELL is one of the multi-games of Brilliant Blue Deluxe, Pure Purple Deluxe and Master Collection. In this regard, I note that the applicant concedes that LIBERTY BELL is one of the games that can be selected from the games package.⁹

36. The applicant submits:

“According to the pictorial evidence filed by Mr Hertz, the games machines themselves are identified by the trade mark ATRONIC and these machines then appear to be loaded with a games package which has a designation such as, for example ‘diversity’, ‘oxygen’, etc. The trade mark LIBERTY BELL does not appear on the games machine itself and in order to see a game called LIBERTY BELL, the machine firstly has to be powered on and then a particular games package (for example, ‘diversity’, ‘oxygen’, etc) selected, following which the LIBERTY BELL game can be selected from within that games package. This indicates that the trade mark LIBERTY BELL has not been used in relation to a product which can be purchased or is supplied by itself and not specifically as an integral part of a games software package installed in a branded (Atronic) games machine.”¹⁰

⁹ See the applicant's submissions dated 27 August 2020, para 3.

¹⁰ See the applicant's submissions dated 27 August 2020, para 3.

37. Invoices indicate the sale of Master Collection, Pure Purple Deluxe and Brilliant Blue Deluxe to mainly casinos and clubs during the relevant periods. Given that LIBERTY BELL is one of the multi-games included in Brilliant Blue Deluxe, Pure Purple Deluxe and Master Collection, it appears to me that LIBERTY BELL was sold to the customers as a part of the multi-game package. In this regard, in the absence of cross-examination, I accept the opponent's following submissions on the point:

"The opponent sold or rented out these slot machines including the software packages."¹¹

38. In those circumstances, it is likely that the invoices would refer only to the name of the multi-game instead of the individual games. Bearing in mind the opponent's submissions that different games can be installed on existing hardware (gaming machines)¹², I infer that where there are specific references to LIBERTY BELL in the invoice,¹³ the games software LIBERTY BELL as opposed to multi-games package was sold to the customer. In assessing the genuine use of a mark, I must consider the nature of the goods and the characteristics of the market concerned. I bear in mind that the opponent's goods are games software and I am aware of my experience that games software can be sold either on its own or as pre-installed software. In those circumstances, I do not consider that it necessary for the opponent to show that its goods were always sold independently of the multi-games package.

39. The invoices indicate a combined sale of seventy-eight units of Brilliant Blue Deluxe, Pure Purple Deluxe and Master Collection and two units of LIBERTY BELL between the years 2012 - 2015. The unit price of the goods sold ranges between 500 Euros to 14,300 Euros. Although in my view, the volume of sales recorded is not especially considerable, I bear in mind that the goods were sold mainly to casinos and clubs at a relatively high price. Considering the specific market, it is unlikely for game software that is sold with slot machines or as a

¹¹ See the opponent's witness statement dated 12 March 2020, para 4.

¹² Opponent's evidence in reply dated 12 March 2020

¹³ Invoice no. 93502231 dated 7 September 2015 issued to Holland Casino.

multi-game package to be subject to frequent purchase. The evidence also indicates sales across the EU including the UK, Romania, Germany and Netherlands. Considering the evidence as a whole, I am satisfied that the use of the opponent's earlier mark is sufficient to create and maintain a market for programs for operating apparatus for games, amusement and/or entertainment purposes in the EU during the relevant five-year periods.

40. Although there are references to rental of multi-games in the invoices, it is not apparent that the opponent's Class 41 specification covers rental of software games. In any event, there is insufficient evidence to support a finding for genuine use in relation to rental services. I also do not consider that the opponent has demonstrated genuine use of the mark LIBERTY BELL in relation to the remaining goods and services in the specification. Accordingly, I conclude that the opponent is entitled to rely only on the following goods for the purpose of this opposition:¹⁴

Class 9: Programs for operating apparatus for games, amusement and entertainment purposes.

Section 5(2)(b) – case law

41. 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 C3/03, *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:

¹⁴ See *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10 and *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch).

(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 the 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 to mind the earlier mark, 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 and services

42. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, 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”.

43. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the Treat case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

44. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

45. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion 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”.

46. 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 (in that case, 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 is 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., sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/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”.

47. 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 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

48. In carrying out my own assessment of identity or similarity between the goods and services, where appropriate, I will group together the applicant’s goods and services.¹⁵

49. I did not have the benefit of submissions from the parties on the point of identity or similarity between the goods and services. In those circumstances, I am left to form my own view. I approach this comparison exercise bearing in mind that the earlier goods are a form of software that interact with hardware (a machine) for the purpose of amusing the user. This could include, as the evidence shows, software for gambling purposes but may reasonably be construed more widely, for example, to include any arcade game. I will begin by comparing the opponent’s goods with the applicant’s specification covered by its 310 mark.

Contested goods in Class 9

Computer software; computer and video games software; games software for use on any computer platform, including electronic entertainment and games consoles; computer game programs; computer games programs; video games (software); computer games leisure and recreational software; video games and computer software, all being provided in the form of storage media; programs for operating electric and electronic apparatus for games, amusement and/or entertainment purposes; software for casino and amusement arcade games, for gaming machines, slot machines or video lottery gaming machines

50. The applicant’s goods listed above are either identically contained in or included in the broad category of the opponent’s programs for operating electric and

¹⁵ See *Separode Trade Mark* BL O-399-10 para 5.

electronic apparatus for games, amusement and/or entertainment purposes. The contested goods are, therefore, identical under the *Meric* principle.

Computer games provided through a global computer network or supplied by means of multi-media electronic broadcast or through telecommunications or electronic transmission or via the Internet; computer software for computer games on the Internet; on-line games (software), in particular for en-line [sic] betting games, on-line prize games, on-line gambling games, on-line games of skill and on-line casino games; software for games of chance via the Internet.

51. The opponent's specification is broad enough to include games software for apparatus such as gaming computers or consoles provided through internet or computer network. Accordingly, I consider that the applicant's goods are included in the opponent's specification. The competing goods listed above are, therefore, identical under the *Meric* principle.

Computer software in the form of an application for mobile devices and computers

52. The above term in the applicant's specification is apt to cover gaming software and must be, therefore, considered identical to the opponent's specification under the *Meric* principle.

Cash registers, calculating machines; automatic cash dispensers; automatic money counting and money changing machines; coin-operated mechanisms; musical jukeboxes and parts for the aforesaid automatic machines; calculating apparatus in coin-operated machines and parts for the aforesaid goods; computer hardware for casino and amusement arcade games, for gaming machines, slot machines or video lottery gaming machines or games of chance; electric, electronic, optical or automatic apparatus, for identifying data carriers, identity cards and credit cards, bank notes and coins; electric, electronic or optical alarm and monitoring installations, including video cameras and apparatus for image transmission and image processing; apparatus for recording, transmission, processing or reproduction of data,

including sound or images, including parts for all the aforesaid goods, except radio sets, television receivers, hi- fi systems, video recorders, telephone apparatus, fax machines and telephone answering machines; apparatus for recording, transmission or reproduction of sound or images

53. While goods such as cash registers, calculating machines or automatic cash dispensers are also recognisable stand-alone items such as banknote counting machines or automated teller machine (ATM), in an ordinary and natural meaning, all the terms listed above are also apt to be considered as components of a gaming/slot machine that would interact with the programs installed on that machine. They differ in nature, purpose and method of use with the opponent's goods. The goods do not compete. The users are the same. The competing goods will share channels of trade. As all of the applicant's hardware is for use in, broadly speaking, the fields of amusement/gaming and the opponent's specification in class 9 are the program that operates the applicant's goods, I find that the goods are complementary in the sense described by the case law. The competing goods are similar to low to medium degree.

Automatic lottery machines

54. The competing goods differ in nature and method of use. The applicant's goods are, to my mind, lottery vending machine that allows users to play lottery as a game and the opponent's goods are programs that operate the applicant's goods. The average consumer is likely to think that the responsibility for the lottery machines and the lottery games programs installed on it lies with the same undertaking. They are complementary in the sense described by the case law. The goods do not compete. The users are the same. The competing goods are similar to no more than a medium degree.

Data processing equipment; data processing apparatus and computers, including data processing apparatus and computers being components for data networks and parts facilitating data network communications;

55. Although these goods are not expressly focused on games, I bear in mind that they are digitally based. The terms are broad enough to cover gaming computers that depend upon gaming software to function. The purpose, users and channels of trade will coincide. The goods are not complementary in the sense described by the case law, nor do they compete. Considering these factors, I find that the goods and services are similar to a low degree.

Magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media

56. The applicant's goods are used to record, store or/and carry data. There is a correlation between the recording and data storage devices and the opponent's games software, as very often these devices come with their own integrated software. In those circumstances, the consumers are likely to think that the goods could coincide in origin or producer. Considering these factors, I find that the competing goods are similar to (at most) a very low degree.

Circuit boards, printed circuit boards (electronic components.) and combination thereof, being assemblies and parts for apparatus, included in class 9.

57. The applicant's goods are circuit boards that integrate the electronics of a device while the opponent's goods are software. The goods differ in nature, purpose, method of use and channels of trade. They do not compete, nor they are complementary in the sense described by the case-law. The competing goods are dissimilar.

Electric wiring harnesses

58. They are assembly of electric cables and wires that relay information and electric power. They differ with the opponent's goods in nature, purpose, method of use and channels of trade. They do not compete, nor they are complementary in the sense described by the case-law. The competing goods are dissimilar.

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments

59. In the ordinary and natural meaning the terms cover broad range of equipment, for example, devices used for scientific purposes, maritime navigation, viewing or inspecting objects in detail or to save life. These goods differ with the opponent's goods in nature, purpose, method of use and channels. They are not complementary, nor do they compete. The competing goods are dissimilar.

Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity.

60. While the applicant's goods are equipment used to convey, divert, alter, collect, adjust or direct electrical power, the opponent's goods are programs for operating equipment for amusement and/or entertainment purpose. The competing goods differ in nature, purpose, methods of use, channels of trade. They are not complementary in the sense described by the case law. The goods do not compete. Considering these factors, I find that the competing goods are dissimilar.

Fire-extinguishing apparatus

61. The applicant's goods are used to put out fire. Their nature, purpose, method of use differs from programs covered by the opponent's specification. They are not complementary, nor do they compete. The goods are dissimilar.

62. I will now proceed to compare the opponent's goods with the applicant's services in Class 41 covered by its 332 mark. In approaching this task, I note that the goods and services inherently differ in nature and methods of use. I also bear in mind the *Avent* guidance against wide construction of the terms in the specification.

Rental of automatic slot machines and entertainment machines for casinos and amusement arcades;

63. Given that slot machines and entertainment machines for casinos and amusement arcades require relevant gaming software to operate, the applicant's rental services would depend on the opponent's goods. The opponent's evidence indicates that the same undertaking may be responsible for producing games software as well as rental of slot machines with pre-installed games software.¹⁶ That accords with my own understanding of the correlation between the goods and the services and, I am satisfied, will also accord with the average consumer's understanding. The average consumer looking for rental services is likely to consider that the same undertaking is also responsible for the production of games software installed in the slot machine they intend to rent. There is no evidence to the contrary. In those circumstances, the relationship between the competing goods and services, in my view, creates a complementary relationship in the sense described by the case law. The nature and method of use of the competing goods and services are different. The users and the channels of trade will overlap. Considering these factors, I find that the competing goods and services are similar to no more than a medium degree.

Leasing of casino games

64. The competing goods and services share purpose as both are aimed to allow users to play games. The users and the channels of trade will overlap. The goods and services compete as the consumers may choose to lease casino games or buy casino games instead. Goods and services are complementary in the sense described by the case law. Considering these factors, I find that the competing goods and services are similar to a medium degree.

¹⁶ See the opponent's witness statement dated 12 March 2020, para 4 and Invoice no 93473183.

Operation of on-line Internet casinos and betting platforms; gambling services provided via the Internet; provision of an on-line library of downloadable games over a global computer network; provision of games via the Internet, including on-line and by way of applications for smartphones, tablets and computers; on-line games services (by way of a computer network)

65. The applicant's services are provided through the internet and will depend on gaming software to function. The opponent's goods are at least important for the provision of the applicant's services and such that, in my view, the average consumer is likely to think that the responsibility for the goods and the services lies with the same undertaking. The competing goods and services are, therefore, complementary in the sense described by the case-law. The purpose, users and channels of trade coincide. The competing goods and services are similar to no more than a medium degree.

Education, provision of entertainment and educational content by way of applications for mobile devices and computers: conducting quizzes by way of applications for smartphones, tablets and computers

66. There is an overlap in educational and entertainment content as educational content includes educational games content such as quizzes. As the applicant's services are of digital in nature that are provided by way of applications for mobile devices and computers, and the opponent's goods are games software, I find that the correlation between the goods and services create a complementary relationship in the sense described by the case law. The nature and method of use of the applicant's services differ from the opponent's goods. The users overlap. The goods and services are similar to a medium degree.

Entertainment services connected with gaming and playing games; Arranging and conducting games; gambling; operation of lotteries; provision of games; conducting casino games and games of chance

67. The applicant's terms cover entertainment services provided specifically in relation to games or gambling. The goods and services inherently differ in

nature and method of use. Given that the opponent's goods are games software, the opponent's goods are important for the applicant's services such that the average consumer is likely to think that the goods and services originate from the same undertaking. The purpose and users will overlap. The goods and services compete. Considering these factors, I find that the competing goods and services are similar to a medium degree.

Entertainment services

68. Entertainment services *per se* is a broad term. It encompasses any services intended to provide entertainment and will cover arranging and conducting games online. The applicant's services, therefore, depend on the opponent's goods and I consider that the goods and services are complementary in the sense described by the case-law. The goods and services compete as the average consumer may use either the applicant's services to play game or buy software games instead. The users overlap. Considering these factors, I find that the goods and services are similar to medium degree.

Provision of casino facilities (gambling) and betting offices; operation of gaming establishments, arcades

69. "Provision of casino facilities (gambling) and betting offices" seems to me to be concerned with services associated with the physical establishments. While such may include machines that in turn involve "programs for operating electric and electronic apparatus for games, amusement and/or entertainment purposes", it is unlikely that the average consumer would think that the undertaking responsible for the provision of casino facilities and betting offices are also responsible for producing the games software installed on the casino machines. Accordingly, I do not consider that the goods and services are complementary in the sense described by the case law. They do not compete. There is an overlap in the purpose as the opponent's goods and the applicant's services are, broadly speaking, intended to provide entertainment to the users. The users will overlap. Considering these factors, I find that the goods and services are similar to a very low degree.

Provision of training, sporting and cultural activities

70. Although the nature and method of use of the competing goods and services differ, they overlap in the purpose as both are aimed at providing entertainment or amusement. The users are the same. However, the goods and services are not complementary, nor do they compete. Considering these factors, I find that the goods and services are similar to a very low degree.

The average consumer and the nature of the purchasing act

71. 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.”

72. For reasons that will become clear, I will focus on the goods and services I have found to be identical or similar.

73. The average consumer of the opponent's goods is likely to be comprised of both business users and the general public. The price of the goods may vary, from being reasonably expensive to low cost. When making the purchase, the

general public is likely to pay attention to some details such as game options, features or types. These factors suggest that the general public is likely to pay a medium degree of attention to the purchase process. The business users, for example, casino providers, are likely to pay attention to factors such as variety and quality of games, the compatibility of the game's software which, in my view, is likely to attract a fairly high degree of attention.

74. The applicant's goods vary from games provided on platforms such as internet or mobile applications to specific hardware for gaming machines or slot machines. The average consumer and the degree of care and consideration they use during the purchase process may, therefore, also vary. The average consumer is likely to pay a medium degree of attention to the purchase of games software whether or not provided online. Gaming equipment may be more expensive and is likely to be subject to a degree of care and attention somewhat higher than the norm.

75. The applicant's Class 41 services seem to be services aimed both at the general public and businesses. Although the public selecting the services may pay only a medium degree of attention, the professional user of the services is likely to pay attention to details such as the business needs, the technological interface, or costs which, in my view, are likely to be important business decisions. Therefore, the level of attention paid will be fairly high by business users.

76. In terms of the selection process, all the goods and services strike me as ones likely to be selected primarily by visual means, after research conducted on websites, from brochures, catalogues, or visiting shops. However, I will not discount the possibility of an aural element to the purchase or selection process.

Distinctiveness of the earlier mark

77. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of

confusion (*Sabel BV v Puma AG*). 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).

78. 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).”

79. Invented words usually have the highest degree of distinctive character, while words which are allusive of the goods have the lowest. Distinctiveness can also be enhanced through the use of the mark.

80. The earlier mark is comprised of the words LIBERTY BELL. The term is not allusive or suggestive of programs for operating electric and electronic apparatus for games, amusement and/or entertainment purposes. The mark, therefore, possesses a medium degree of distinctive character. Although the opponent filed evidence to demonstrate genuine use of the mark, the opponent has not claimed enhanced distinctiveness of its mark. In any event, it does not

appear to me that the use on the scale shown by the opponent is sufficient to establish enhanced distinctiveness of the mark in relation to its goods.

Comparison of marks

81. 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 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.”

82. It would be wrong, therefore, artificially to 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.

83. The trade marks to be compared are as follows:

Applicant's trade mark	Opponent's trade mark
LIBERTY BELLS	LIBERTY BELL

84. The applicant's mark is comprised of the words "LIBERTY" and "BELLS". Both words contribute equally to the overall impression of the mark.

85. The opponent's mark is comprised of the words "LIBERTY" and "BELL". The overall impression of the mark lies equally in both words.
86. Visually, the opponent's mark is wholly contained in the applicant's mark. The only difference between the marks is the presence of the letter "S" at the end of the applicant's mark, which is absent from the opponent's mark. Weighing up the similarities and differences, I consider that the marks are visually similar to a high degree.
87. Aurally, both marks will be pronounced entirely conventionally. The marks coincide in the pronunciation of the word "LIBERTY BELL". Given that the applicant's mark will be pronounced like the plural form of the opponent's mark, the difference in sound between the marks is only in the last syllable. That difference, therefore, is likely to have a less impact on the average consumer. Considering these factors, I find that the marks are aurally similar to a reasonably high degree.
88. In a conceptual comparison, the opponent's mark is likely to be understood as an iconic symbol of American independence. However, I also bear in mind that some consumers may not be aware that the words "LIBERTY BELL" has a particular US historical connection. For those consumers, the individual words, as opposed to the combination, is likely to create conceptual imagery. In those circumstances, liberty would be understood as freedom and bell as a device that makes a sound. The applicant's mark is likely to be understood as the plural form of the opponent's mark. Therefore, whatever meaning is attributable to LIBERTY BELL in the opponent's mark is likely to be conveyed in a plural form in the applicant's mark. The marks are, therefore, conceptually similar to a high degree.

Likelihood of confusion

89. I have already concluded that there is no degree of similarity between the opponent's goods and the applicant's following goods covered by the 310 mark:

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; fire-extinguishing apparatus; electric wiring harnesses; circuit boards, printed circuit boards (electronic components.) and combination thereof, being assemblies and parts for apparatus, included in class 9.

90. In *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU), it was held that some similarity of goods is essential to establish a likelihood of confusion. Accordingly, the opposition against these goods fails.

91. I must now consider the matter in relation to those goods and services in the applications where I have found a varying degree of similarity with the opponent's goods.

92. I am required to assess a likelihood of confusion based on a global assessment of all factors relevant to the circumstances of the case (*Sabel* at [22]). It is necessary for me to factor in the distinctive character of the earlier trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion (*Sabel* at [24]). I must also have regard to the interdependency principle i.e. a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the respective trade marks and vice versa (*Canon* at [17]). I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and that the average consumer rarely has an opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

93. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/services down to the responsible undertaking being the same or related).

94. I will first consider the position in relation to the applicant's 310 mark. Earlier in the decision, I concluded that the competing goods are either identical or similar to varying degrees. I found that the marks are visually, aurally and conceptually similar to a high degree and the earlier mark is distinctive to a medium degree. I also found that the average consumer comprising of the general public will select the goods at issue primarily by visual means with a medium of attention while a fairly high degree of attention will be paid by businesses.

95. Applying the conclusions, I am satisfied that the degree of similarity between the marks is enough to result in a likelihood of direct confusion. Even where the goods are similar only to a very low degree and the average consumer pays a high degree of attention to the purchase process, in imperfect recollection, he/she is likely to misremember that the applicant's mark is the plural form of the opponent's mark. Considering the high degree of similarity between the marks, the consumer will, in my view, mistake one mark for the other. Confusion is more likely where the goods are identical or where a medium degree of attention is paid by the average consumer to the purchase process.

96. Concerning the applicant's 332 mark, I found that the competing goods and services are similar to varying degrees. I found that the marks are visually, aurally and conceptually similar to a high degree and the earlier mark is distinctive to a medium degree. I also found that the average consumer comprising of the general public will select the goods and services with a medium degree of attention. The business will select the services at issue with a fairly high degree of attention. I also concluded that the earlier mark is distinctive to a medium degree.

97. I find that the high visual, aural and conceptual similarity between the marks is enough to cause direct confusion. Even where the goods and services are similar only to a very low degree, the points of differences between the competing marks, in my view, are insufficient to dispel the impact of visual, aural and conceptual similarity between the marks. I conclude that there is a likelihood of direct confusion for both groups of average consumers.

Conclusion

98. The application for 310 mark will be refused in relation to:

Class 9: Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; cash registers, calculating machines, data processing equipment, computers: computer software; musical jukeboxes and parts for the aforesaid automatic machines: automatic cash dispensers, automatic money counting and money changing machines; coin-operated mechanisms: computer and video games software; games software for use on any computer platform, including electronic entertainment and games consoles; computer game programs; computer games programs; video games (software); computer games provided through a global computer network or supplied by means of multi-media electronic broadcast or through telecommunications or electronic transmission or via the Internet; computer games, leisure and recreational software. video games and computer software, all being provided in the form of storage media; programs for operating electric and electronic apparatus for games, amusement and/or entertainment purposes; automatic lottery machines: computer software for computer games on the Internet; on-line games (software), in particular for on-line [sic] betting games, on-line prize games, on-line gambling games, on-line games of skill and on-line casino games; computer software in the form of an application for mobile devices and computers: calculating apparatus in coin-operated machines and parts for the aforesaid goods: apparatus for recording, transmission, processing or reproduction of data, including sound or images, including parts for all the aforesaid goods, except radio sets, television receivers, hi-fi systems, video recorders, telephone apparatus, fax machines and telephone answering machines; computer hardware and software for casino and amusement arcade games, for gaming machines, slot machines or video lottery gaming machines or games of chance via the Internet; electric, electronic, optical or automatic apparatus, for identifying data carriers, identity cards and credit cards, bank notes and coins; electric,

electronic or optical alarm and monitoring installations, including video cameras and apparatus for image transmission and image processing; data processing apparatus and computers, including data processing apparatus and computers being components for data networks and parts facilitating data network communications

99. The application for 332 mark will be refused in relation to:

Class 41: Education; provision of training; entertainment; sporting and cultural activities; rental of automatic slot machines and entertainment machines for casinos and amusement arcades; leasing of casino games; entertainment services connected with gaming and playing games; arranging and conducting games; gambling; operation of lotteries; provision of games; provision of games via the Internet, including on-line and by way of applications for smartphones, tablets and computers; on-line games services (by way of a computer network); provision of entertainment and educational content by way of applications for mobile devices and computers: conducting quizzes by way of applications for smartphones, tablets and computers; provision of casino facilities (gambling) and betting offices; conducting casino games and games of chance; operation of gaming establishments, arcades and on-line Internet casinos and betting platforms; gambling services provided via the Internet; provision of an on-line library of downloadable games over a global computer network.

100. The application for 310 mark will proceed to registration in relation to:

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; fire-extinguishing apparatus; electric wiring harnesses; circuit boards, printed circuit boards (electronic components.) and combination thereof, being assemblies and parts for apparatus, included in class 9.

Costs

101. Both parties have achieved a measure of success and I order that the parties bear their own costs.

Dated this 19th day of November 2020

**Karol Thomas
For the Registrar
The Comptroller-General**