

BL O/660/22

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3677551

BY

ISB MAGMA LIMITED

TO REGISTER THE FOLLOWING TRADE MARK:

Rise of the Genie

AND

OPPOSITION NO. 60002215 THERETO

BY

DESIGN WORKS STUDIOS, LLC

Background and pleadings

1. On 5 August 2021, ISB Magma Limited (the “Applicant”) applied to register the trade mark **Rise of the Genie**. The contested application was accepted, and published for opposition purposes in the Trade Marks Journal on 19 November 2021. Registration of the mark is sought in respect of the following goods and services in Classes 9, 35 and 41:

Class 9 *Apparatus, instruments and cables for electricity; Diving equipment; Information technology and audio-visual, multimedia and photographic devices; Magnets, magnetizers and demagnetizers; Measuring, detecting, monitoring and controlling devices; Navigation, guidance, tracking, targeting and map making devices; Optical devices, enhancers and correctors; Recorded content; Safety, security, protection and signalling devices; Scientific and laboratory devices for treatment using electricity; Scientific research and laboratory apparatus, educational apparatus and simulators.*

Class 35 *Advertising, marketing and promotional services; Business assistance, management and administrative services; Auctioneering services; Providing information via the Internet relating to the sale of automobiles; Providing market information in relation to consumer products; Providing recommendations of goods to consumers for commercial purposes; Provision of an online marketplace for buyers and sellers of goods and services; Provision of information and advice to consumers regarding the selection of products and items to be purchased; Provision of information concerning commercial sales; Provision of online price comparison services; Purchasing agency services; Purchasing of goods and services for other businesses; Purchasing services; Sales administration; Sales management services; Subscription to a television channel; Subscription to an information media package; Subscriptions (arranging -) to a telematics, telephone or computer service [internet]; Subscriptions (arranging of) to books, reviews, newspapers or comic books; Subscriptions to electronic journals; Subscriptions to*

telecommunications database services; Tariff information and advisory services; Telemarketing services; Telephone order-taking services for others; The bringing together, for the benefit of others, of a variety of insurance services, enabling consumers to conveniently compare and purchase those services; The bringing together, for the benefit of others, of a variety of telecommunications services, enabling consumers to conveniently compare and purchase those services; Wholesale ordering services.

Class 41 *Education, entertainment and sport services; Publishing, reporting, and writing of texts; Ticket reservation and booking services for education, entertainment and sports activities and events; Translation and interpretation; Education, entertainment and sports.*

2. On 19 March 2022, Design Works Studios, LLC (the “Opponent”) filed a Fast Track opposition. The Opponent opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), on the basis of its earlier United Kingdom Trade Mark (UKTM):

UKTM No. 917986890

GENIE RISING

Filing date: 18 November 2018

Receiving date: 19 December 2020

Registration date: 1 March 2019

3. For the purposes of this opposition, the Opponent relied upon all the services for which the earlier mark is registered, namely:

Class 41 *Online casino services; Providing online games; Leasing of casino games; Online gambling services; Game services provided by means of communications by computer terminals or mobile telephone; Provision*

*of online information in the field of computer games entertainment;
Interactive entertainment services.*

4. Since the filing date of the earlier mark predates that of the contested application, the Opponent's mark is considered to be an "earlier mark" in accordance with section 6 of the Act. However, as the earlier mark has not been registered for a period of five years or more before the filing date of the application, it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent may rely upon any or all of the services for which the earlier mark is registered without having to show that it has used the mark at all.

5. The opposition is aimed against the entire list of goods and services in the contested application. In its notice of opposition, the Opponent argued there to be a likelihood of confusion in the following terms:

The signs are conceptually identical and given the imperfect recollection of average consumers there is a high degree of visual and aural similarity. The opposed mark has an unusual and diverse specification and the opponent's primary concern is class 41 services which are identical or highly similar to those of the earlier mark. The nature of the mark is such that it seems improbable that it would be used for anything other than a game and the applicant's business is described as "mobile casino game supplier" so it seems inevitable that the consumers for the two parties would be the same. Confusion in the same field of business between these two marks is highly likely.

6. On 19 May 2022, the Applicant filed a counterstatement, in which it acknowledged that both trade marks use the term 'Genie' in their composition. However, the Applicant went on to argue that this was the extent of the similarity between the marks. The Applicant argued that grammatically and visually there are significant differences between the marks at issue, "both in-text structure and wording used", which would be "easy to spot and differentiate by the average consumer". In relation to the respective specifications, the Applicant made clear that it disagreed with the Opponent's position that they are similar. The Applicant stated that the services in each respective party's Class 41 are different, and the differences between the goods and services in Classes 9 and 35 of the contested mark and the opponent's services in Class 41 are even greater.

7. By virtue of being a Fast Track Opposition, the routine filing of evidence was not permitted and neither party requested leave to file evidence. Each party elected to file written submissions in lieu of a Hearing.

8. In its submissions of 30 June 2022, the Opponent explained that it originally opposed all of the contested goods and services in "...the hope that the Applicant would abandon the application altogether by not defending it." The Opponent acknowledged that there is "clearly no similarity between many of the goods and services", and stated its new intention is to oppose only *entertainment* in Class 41, for being identical to its earlier Class 41 services, and *sport services; recorded content; educational apparatus and simulators; advertising, marketing and promotional services; providing market information in relation to consumer products; providing recommendations of goods to consumers for commercials purposes; provision of information and advice to consumers regarding the selection of products and items to be purchased; subscription to a television channel; subscription to an information media package; subscriptions (arranging-) to a telematics, telephone or computer service [internet]; subscriptions to telecommunications database services; the bringing together for the benefit of others, of a variety of telecommunications services, enabling consumers to conveniently compare and purchase those services*; for being highly similar to several of its Class 41 services.

9. The Opponent submitted that the relevant consumer of entertainment is the average consumer, particularly in respect of online games, and the degree of attention will therefore be modest. The Opponent argued that the purchase of such entertainment services tends to be quick and superficial. Accordingly, it is unlikely that any apparent text structure or grammatical differences would be spotted and differentiated by the relevant consumer. The Opponent described the Applicant as a mobile [phone] casino game supplier and argued that despite the breadth of the services applied for, it is the services considered to be identical or similar by the Opponent that seem to be the most significant to the Applicant. The Opponent requested an award of costs in its favour as the Applicant "had the opportunity to voluntarily remove the contested terms".

10. On 8 July 2022, the Applicant submitted that whilst both parties have an interest in services in Class 41, it is only the contested *provision of online information in the*

field of computer games entertainment; and interactive entertainment services which have the potential for any overlap, and even then, this overlap is only due to the broad scope of the term *entertainment services* in the earlier mark's specification. The Applicant reiterated its position that there exist significant differences between the marks at issue, and as a consequence it argued that there is little risk of confusion to be made by the average consumer.

11. Both parties are represented. The Applicant is represented by Mark Halstead, and the Opponent is represented by Filemot Technology Law Ltd

Decision

12. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Section 5(2)(b)

13. Section 5(2)(b) of the Act is as follows:

“(2) A trade mark shall not be registered if because-

(a) ...

(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”.

Section 5A

14. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

trade mark is applied for, the application is to be refused in relation to those goods and services only.”

15. 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.

(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.

Comparison of goods and services

16. Both parties provided submissions in relation to the respective goods and services at issue. Whilst the parties' comments are noted, the degree of similarity or identity of the specifications, as the case may be, is something which fundamentally contributes to whether there is a likelihood of confusion. I must therefore conduct my own full analysis of the goods and services at issue.

17. Further to the Opponent's submissions of 30 June 2022, it has become apparent that the opposition should now be treated as partial, with a reduced scope of goods and services considered to be identical or similar. The list of goods and services against which the objection now directly pertains is reflected below.

| | |
|--------------|---|
| Earlier mark | Application |
| | <i>Class 9: Recorded content; educational apparatus and simulators.</i> |

| | |
|---|---|
| | <p><i>Class 35: Advertising, marketing and promotional services; Providing market information in relation to consumer products; Providing recommendations of goods to consumers for commercial purposes; Provision of information and advice to consumers regarding the selection of products and items to be purchased; Subscription to a television channel; Subscription to an information media package; Subscriptions (arranging -) to a telematics, telephone or computer service [internet]; Subscriptions to telecommunications database services; The bringing together, for the benefit of others, of a variety of telecommunications services, enabling consumers to conveniently compare and purchase those services.</i></p> |
| <p><i>Class 41: Online casino services; Providing online games; Leasing of casino games; Online gambling services; Game services provided by means of communications by computer terminals or mobile telephone; Provision of online information in the field of computer games entertainment; Interactive entertainment services.</i></p> | <p><i>Class 41: Entertainment and sport services; entertainment and sports.</i></p> |

18. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

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

- (a) The respective 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.

20. It has also been established by the General Court (GC) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that:

“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 trade mark application (Case T-388/00 Institut fur Lernsysteme

v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

21. 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 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 the responsibility for those goods lies with the same undertaking.”

Class 9

22. The Class 41 services of the Opponent’s earlier mark relate to the provision of casino, gambling, and entertainment games and services. The provision of these services, and their accessibility, is made available via computer terminals and mobile telephones, as well online. The services of the Opponent’s earlier mark also include the leasing of casino games, and information related to computer game entertainment.

23. Whilst the Applicant has argued that “items from one class do not usually interfere with items from another”, this is not necessarily the case, and it depends wholly on the potential overlap of the type of factors as identified in the *Treat* case, for example. In the current proceedings, however, I do not consider there to be overlap between the contested *educational apparatus and simulators* in Class 9 and the services in Class 41 of the earlier mark. Based on the wording of these goods, it is apparent to me that the apparatus and simulators are specifically designed to assist in the field of education. There does not appear to be any obvious correlation between educational tools (*apparatus and simulators*) and the services of the earlier mark as highlighted by the Opponent, i.e., *providing online games; game services provided by means of communications by computer terminals or mobile telephone; or interactive services*. Whilst services such as *providing online games* are relatively broad and could include all manner of games, I nevertheless consider the services to have a different intended

purpose, use, end user and trade channel from those of goods designed to assist in educating. I also do not envisage them to be in competition, nor do I find them to be complementary. As such, the contested *educational apparatus and simulators* are found to be dissimilar to the services of the earlier mark.

24. The contested *recorded content* is a broad term, and is ordinarily of a different nature to the services of the earlier mark. For example, *recorded content* in Class 9 is something that is tangible, usually stored on a hard-disc or device, whereas the contested services are non-tangible. It is worth nothing that a certain number of services in Class 41 of the earlier mark are provided online, and are therefore not downloadable or transferable to a tangible form. However, due to the broad nature of the contested *recorded content*, I can envisage an example whereby the recorded content is in the form of a video game or video game software. It is quite common nowadays for a games manufacturer to offer a video game on a disc, and/or in a form that is downloadable to be played directly on a console or mobile phone, and/or be played online. It is therefore possible that the contested *recorded content* is offered by the same manufacturer/company as that which offers the services of *providing games online* and *game services provided by means of communications by computer terminals or mobile telephone*. In addition, the recorded content can contain the information that is used during the *Interactive entertainment services*. With this in mind, I consider the contested *recorded content* to be at least complementary to the services of the earlier mark, and also similar to a low degree, based on the possibility that the manufacturer and end user may be the same.

Class 35

25. Although the provision of the Opponent's services would often likely be advertised, marketed and promoted, the delivery of such services is invariably provided by a separate entity, unless otherwise stated by the provision of such services in the earlier mark. It is clear that the Opponent is not registered for advertising, marketing or promotion, and it is therefore assumed that the decision to use such services would be acquired via paying a third party. Advertising, marketing and promotional services have a distinct and different intended purpose, use, user and trade channel from gambling, entertainment and casino-type services of the Opponent. In addition, such

services are not in competition. Further, they are not complementary. As stated above, although it is common for service providers to advertise, market and promote their services, the delivery of one is not necessarily indispensable or important for the use of the other. The contested *advertising, marketing and promotional services* are therefore dissimilar to the services of the earlier mark.

26. The provision of market information, commercial recommendations, and advice relating to product purchases have a different intended purpose, use, user and trade channel from the provision of casino, gambling, and entertainment games and services. In addition, such services are neither in competition nor are they complementary. The contested *Providing market information in relation to consumer products; Providing recommendations of goods to consumers for commercial purposes; Provision of information and advice to consumers regarding the selection of products and items to be purchased* are therefore dissimilar to the services of the earlier mark.

27. The contested subscription services relate to television channels, media packages, and telematics, telephones, internet and telecommunication databases. Subscription services require regular monetary payments in exchange for the receiving of particular goods or services, in this instance either television, media, or telephones etc. The services of the earlier mark are neither subscription based, nor do they relate to television channels, media packages, telematics, telephones, internet or telecommunication databases. They therefore have a different intended purpose, use, user and trade channel. In addition, they are neither in competition nor are they complementary. I do note that the earlier mark offers *leasing of casino games*. Leasing is similar to subscription to the extent that a financial agreement is in place in exchange for services. However, as indicated above, services relating to the provision of casino games is markedly different from those relating to television, media, or telephones etc. The contested *Subscription to a television channel; Subscription to an information media package; Subscriptions (arranging -) to a telematics, telephone or computer service [internet]; Subscriptions to telecommunications database services* are therefore dissimilar to the services of the earlier mark.

28. In my opinion, none of the services in Class 41 are similar to the contested *bringing together, for the benefit of others, of a variety of telecommunications services,*

enabling consumers to conveniently compare and purchase those services. This is because it seems to me that making possible the ability to purchase telecommunication services is entirely different to the provision of casino and games entertainment. The contested *the bringing together, for the benefit of others, of a variety of telecommunications services, enabling consumers to conveniently compare and purchase those services* is therefore dissimilar.

Class 41

29. The earlier mark is registered for *interactive entertainment services*, which are included within the more general category of the contested *entertainment services*; and *entertainment*. The contested *entertainment services*; and *entertainment* are therefore considered to be identical under the *Meric* principle.

30. The contested application includes *sport services* and *sports*. As stated by the Opponent, such terms are quite broad. The watching of sport, and the participation in sport are, to all intents and purposes, forms of activities conducted for the purposes of entertainment. To watch sport is entertaining, and whilst playing sport offers additional benefits related to health, for example, the participation in sport is at its core a form of entertainment. The earlier right is registered for *interactive entertainment services*, which are included within the more general category of the contested *sport services* and *sport*. The contested *sport services* and *sport* are therefore considered to be identical under the *Meric* principle.

31. To summarise, the contested *entertainment services*; *entertainment*; *sport services*; and *sports* in Class 41 have been found to be identical, whilst the *recorded content* in Class 9 has been found to be complementary and/or similar to a low degree. The remaining contested goods and services have been found to be dissimilar.

Comparison of the marks

32. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover, I consider that no useful purpose is served by

holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

33. In relation to those contested goods and services that have been found to be dissimilar (see paragraph 31) there can be no likelihood of confusion. It is therefore not necessary to conduct a comparison of the marks in relation to those particular goods and services.

34. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

35. It would be wrong, therefore, to dissect the trade marks artificially, 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.

36. The respective trade marks are shown below:

| | |
|---------------------|--------------------------|
| Earlier mark | Application |
| Genie Rising | Rise of the Genie |

37. The earlier mark consists of the English language words ‘Genie Rising’. Each word is well-known and understood by the English-language speaker, with ‘Genie’ being a noun to refer to a fantastical spirit that obeys commands, and ‘Rising’ being either an adjective for going up, ascending, elevate, sloping upward etc., or an insurrection/revolt. The words are presented in standard typeface, and neither word is larger or more dominant, nor more distinctive than the other. The words hang together and will be read as a combination. The overall impression therefore lies in the perception of the combination, which is also where any distinctiveness lies.

38. The contested mark consists of the English language words ‘Rise of the Genie’, which are equally well-known and understood. The word ‘Rise’ is a verb meaning to go up, ascend, elevate, sloping upward, and increases. Depending on the context of its use, the word ‘Rise’ can also be a word used to refer to an insurrection or revolt. The word ‘of’ is a proposition, whilst the word ‘the’ is a determiner. The word ‘Genie’ has been defined above. Each word has its own independent meaning, however, the words hang together to create a phrase, which has the meaning of a fantastical spirit that is either ascending or rebelling/revolting against an unidentified and unnamed persecutory foe. The overall impression therefore lies in the perception of the combination, which is also where any distinctiveness lies. The words are presented in standard typeface, and neither word is larger or more dominant, nor more distinctive than the other.

Visual similarity

39. Visually, the marks are similar insofar as they each contain the word Genie, although their position within in each mark differs, with ‘Genie’ being the first word of the earlier mark, and last word of the contested mark. The marks are also visually similar due their coinciding of the three letters R-I-S. The marks are visually different due to their respective remaining letter and word combinations, with ‘-ING’ in the

second word of the earlier mark, and the words 'of the' in the contested mark, having no counterpart in the other mark.

40. The marks are considered to be visually similar to a medium degree.

Aural similarity

41. The marks are aurally similar insofar as the word 'Genie' will be pronounced identically in each mark, albeit in a different location, being pronounced as the first element of the earlier mark and last element of the contested mark. The first part of the earlier mark's second word 'RIS-' will be pronounced identically to the first word of contested mark 'Rise'. This is because '*RISING*' is the present participle of the verb 'Rise'. The marks differ aurally due to the positioning of the respective word 'Genie' (from beginning to end), and due to the inclusion of the words 'of the' in the contested mark.

42. The marks are aurally similar to a medium degree.

Conceptual similarity

43. The concept of the earlier mark is that of a fantastical spirit (Genie) that is ascending or rebelling/revolting. The concept of the contested mark is the ascension or rebellion/revolution of a Genie. Whilst the grammatical construction of the marks at issue is different, the overall concepts are essentially the same, to the extent that each mark refers to a protagonist genie that is rising up, either literally and physically or against someone or something.

44. Due to the potential for a certain number of average consumers to perceive only the first of the two apparent concepts in the earlier mark, and to perceive only the second of the two apparent concepts in the contested mark for example, or vice versa, there may be instances when the perceived concepts of each mark do not coincide in the mind of average consumers. However, in my opinion, the majority of average consumers have the capacity to perceive each concept equally and simultaneously, in which case each mark contains two highly similar or identical concepts.

45. The marks are conceptually similar to at least a very high degree, if not being conceptually identical, with the only difference being the order in which the concept is expressed aurally.

Average consumer and the purchasing act

46. 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.¹ 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.”

47. The goods and services found to be identical or complementary are considered to be everyday items, insofar as they are the type of goods and services which are bought frequently and used on a daily basis. The price paid for such goods and services can vary greatly, but on average they will fall within a generally affordable price range. Accordingly, the level of attention will be no more than medium.

48. Based on the nature of the goods and services at issue, I consider it most likely that the purchase process will be visually dominated. Whether the consumer is watching the sport and entertainment or viewing the recorded content, the consumer is clearly predominantly using their eyes and would therefore most likely be making a purchase decision based on the visual appearance of the product or service provider. I do not entirely discount the possibility that the marks may be spoken, over the

¹ *Lloyd Schuhfabrik Meyer*, Case C-342/97

telephone for instance, especially when ordering a product or service, and as such I accept that there may be an aural element to the purchasing process.

Distinctive character of the earlier trade marks

49. The Opponent has not made a direct claim that its earlier mark has acquired an enhanced degree of distinctive character, nor has the Opponent filed any evidence of use that may indicate such a position. My assessment of the degree of distinctive character of the earlier mark is therefore to be made only on the basis of its inherent features.

50. 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).”

51. The earlier mark is a plain word mark, and so the distinctive character of the mark rests entirely in the meaning of the combination 'Genie Rising'. This is also where the overall impression lies. The combination has no immediate, apparent or obvious meaning in relation to the goods and services at issue, other than possibly being the theme/story of the entertainment provided. As such, I consider the earlier mark to be inherently distinctive to at least a medium degree.

Likelihood of confusion

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

53. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*, C-251/95, para 22). The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

54. The earlier mark consists of the word combination Genie Rising, whilst the contested mark consists of the word combination Rise of the Genie. In those instances where the marks are compared side-by-side the average consumer may perceive the apparent visual and aural differences between the marks. However, it must be kept in mind that, as referred to above and as is well-established in case law, the average consumer very rarely has the opportunity to compare marks side by side, and ordinarily and invariably the consumer has to compare marks using their imperfect recollection.

55. I have made clear my position that Genie Rising and Rise of the Genie are conceptually highly similar, if not identical. Both marks leave in the mind of the average consumer the image of an elevating or rebelling genie. Such a concept is memorable, uncommon, and distinctive to at least a medium degree. In my opinion, I consider it a likely possibility that upon seeing the contested mark the average consumer, who is paying only a medium degree of attention to the everyday goods and services at issue, would perceive the concept of an elevating or rebelling genie and recall having seen an earlier trade mark with the highly similar or identical concept, being used to sell identical services. The consumer could misremember the fact that the order of the wording in the earlier mark is different, and based upon their imperfect recollection could mistake the contested mark for the earlier mark. I therefore find there to be a likelihood of direct confusion for the contested services found to be identical, i.e., *entertainment services; entertainment; sport services; and sports* in Class 41.

56. In relation to the contested *recorded content* in Class 9, which I have found to be either complementary or similar to a low degree, I also find a likelihood of direct confusion based on the principle of interdependency. As identified in *Canon*, a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. I consider the marks to be conceptually highly similar if not identical. In addition, I have found the marks to be aurally and visually similar to a medium degree, which is not an insignificant degree, and must be considered to have impact in the overall comparison of the marks. Therefore, although the degree of similarity between the contested *recorded content* and services of the earlier mark is towards the lower end of the scale, I nevertheless believe that due to the high degree of overall similarity between the marks at issue, there is a likelihood that the average consumer would directly confuse the marks. By way of example, I can perfectly imagine an average consumer buying a video game called Rise of the Genie, and misremembering having played an online video game called Genie Rising, and mistake one mark for the other.

57. In the event that I am found to be wrong in my finding of a likelihood of direct confusion in respect of the contested *recorded content* due to the lower degree of similarity between the respective goods and services, I shall now consider the possibility of indirect confusion specifically in relation to the *recorded content*. In *L.A.*

Sugar Limited v By Back Beat Inc, Case BL O/375/10, 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.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

58. Although the above scenarios are not a definitive list, I consider example (a) to apply neatly to the current proceedings. Based on the fact that I have found the marks at issue to share the uncommon and distinctive concept of an elevating/rebelling genie, I believe it likely that the average consumer would assume that no-one else but the brand owner would be using marks with such a concept. I envisage a scenario whereby the average consumer encounters the contested mark on goods that are complementary or similar (to a low degree) to the services of the earlier mark, and either consciously or subconsciously conducts the mental process of thinking along the lines of: "The later mark is different from the earlier mark, but also has something in common with it. In fact, it is visually and aurally similar to a mark I have seen previously and has a highly similar/identical concept. Taking account of the common element of an elevating/rebelling genie, I conclude that it is another brand of the owner of the earlier mark." I therefore believe it likely that the marks at issue will cause at least a likelihood of indirect confusion in relation to *recorded content*, if not first having directly confused them.

Conclusion

59. The opposition is partially successful. Subject to an appeal, the contested application will be refused for the following goods found to be complementary and similar to a low degree, and services found to be identical:

Class 9 *recorded content*

Class 41 *entertainment services; entertainment; sport services; sports*

Costs

60. I note that the Opponent has requested an award of costs in its favour, citing the reason that the Applicant had the opportunity to voluntarily remove the contested terms. I do not find the reasoning given to be a fair reflection of the actions by the parties. In its submissions after filing the notice of opposition, the Opponent acknowledged that its original position to oppose the entire specification had not been accurate as "Clearly there is no similarity between many of the goods and services". The Opponent also explained that it had originally objected to the entire application in

“...the hope that the Applicant would abandon the application altogether by not defending it.” Upon review of the file, it does not appear to me to be accurate to say that the Applicant had the opportunity to voluntarily remove the contested terms, until later in the proceedings when they were clearly identified by the Opponent in its submissions in lieu.

61. I cannot disregard the possibility that there may have been conversations between the parties in person that I am unaware of. However, based on the state of the file and correspondence before me, this is unclear and undocumented. It may be the case that had the Opponent identified the genuinely contested goods and services earlier in the initial notice of opposition, the Applicant may have acted to try to avoid these proceedings altogether by perhaps deleting certain terms from its specification of goods and services, thus avoiding costs being incurred by either side.

62. The Opponent has been only partially successful, with a significant number of the contested goods and services having being found to be dissimilar. Neither party has therefore been wholly successful, with both parties having achieved some measure of success. As a result of this I decline to make an award of costs, and I direct each party to bear their own costs.

Dated this 4th day of August 2022

Dafydd Collins

For the Registrar