

O/0110/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3622471

BY

IGG SINGAPORE PTE. LTD.

TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 9 AND 41

Time Princess

AND OPPOSITION THERETO UNDER NUMBER 428813

BY

PLAY'N GO MARKS LTD.

Background and Pleadings

1. On 7 April 2021, IGG Singapore Pte. Ltd. (“the Applicant”) applied to register the trade mark Time Princess, numbered 3622471 (“the contested mark”), in the UK for goods and services in classes 9 and 41 as set out below. The trade mark was accepted and published in the Trade Marks Journal on 3 September 2021.

Class 9: Computer game programs; computer operating programs, recorded; computers; computer peripheral devices; computer game software, downloadable; computer software, recorded; computer programs [downloadable software]; computer programmes [programs], recorded; electronic publications, downloadable; video game cartridges; computer software applications, downloadable.

Class 41: Game services provided on-line from a computer network; entertainment information; entertainer services; providing on-line electronic publications, not downloadable; publication of electronic books and journals on-line; publication of texts, other than publicity texts; electronic desktop publishing; games equipment rental; entertainment; organization of competitions [education or entertainment]; club services [entertainment or education]; arranging and conducting of conferences; exhibitions (Organization of —) for cultural or educational purposes; publication of books.

2. On 3 December 2021, Play'n GO Marks Ltd (“the Opponent”) filed an opposition to the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) relying on the following two trade marks:

(i) UKTM no. 3207500

MOON PRINCESS

Filed: 19 January 2017

Registered: 7 April 2017

Class 9: Computer games and video games; software for gaming machines.

Class 28: Slot machines for gambling; videogaming apparatus.

Class 41: Games services provided online (via computer networks); prize draws [lotteries]; organising and conducting lotteries.

("the first earlier mark")

(ii) UKTM no. 918222785



Filed: 7 April 2020

Registered: 5 August 2020

Class 9: Computer games and video games (software), hereunder software for slot machine games, betting and wagering games, video slot games, casino games and bingo games provided online and via computer networks and playable on any type of computing device including arcade games, personal computers, handheld devices and mobile phones; software for slot machine games, betting and wagering games, video slot games, casino games and bingo games provided online and via computer networks and playable on any type of computing device including arcade games, personal computers and handheld devices.

Class 28: Videogaming apparatus, hereunder slot machines for gambling, gaming machines, poker machines and other video based casino gaming machines; arcade games; gaming machines, namely, devices that accept a wager; reconfigurable casino and lottery

gaming equipment, hereunder gaming machines including computer games and software therefor sold as a unit.

Class 41: Games services provided online (via computer networks), hereunder providing slot machine games, betting and wagering games, video slot games, casino games and bingo games, playable via local or global computer networks; on-line gaming services; entertainment services, namely, conducting a game of chance simultaneously at multiple, independent gaming establishments; entertainment services, hereunder providing on-line computer games; prize draws [lotteries]; organising and conducting lotteries; Services for the operation of computerised bingo.

(“second earlier mark”)

3. The Opponent claims that the respective marks are similar and that the goods/services are either identical or highly similar leading to a likelihood of confusion on the part of the relevant public.

4. The Applicant filed a defence and counterstatement denying the claims. In particular it denies that the marks are similar which would result in consumers being confused. It did, however, concede that the goods/services covered by the application are identical and similar to those goods/services covered by the earlier registrations, but it argues that given that the marks are so dissimilar, any overlap is irrelevant.

5. Given their filing dates the Opponent’s trade marks qualify as earlier marks in accordance with section 6 of the Act. Since they completed their registration process within five years of the date the application was filed, the Opponent does not need to establish proof of use of its marks pursuant to section 6A of the Act. It may therefore rely on the entirety of the goods and services of its registrations, without needing to demonstrate what use it has made of them on the market.

6. In these proceedings, the Opponent is professionally represented by Appleyard Lees IP LLP, whereas the Applicant is represented by Murgitroyd & Company. During the evidence rounds the Opponent filed initial submissions and thereafter both parties

filed evidence. The Applicant requested to be heard on the matter, that hearing took place before me on 16 November 2022, via video conference. Mr Hoole of Appleyard Lees IP LLP appeared on behalf of the Opponent, and Ms Coates of Murgitroyd & Company attended on behalf of the Applicant. Both parties filed skeleton arguments prior to the hearing.

7. 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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts on trade mark matters.

Evidence and submissions

8. The Opponent did not file evidence in chief, preferring to file submissions dated 20 April 2022. The Applicant filed evidence dated 17 June 2022, consisting of the witness statement of Eleanor Coates accompanied by two exhibits marked EC1-EC2. The Opponent filed evidence in reply dated 19 August 2022 consisting of the witness statement of Hanna Nattfogel accompanied by seventeen exhibits marked Exhibits 1-17.

The Opponent's initial submissions

9. The Opponent's submissions serve to expand on the arguments put forward in support of the ground of opposition under section 5(2)(b) and to introduce dictionary definitions for the word PRINCESS. I do not propose to summarise the submissions here, but I have read them in full and will refer to them where appropriate later in my decision.

The Applicant's evidence

10. Ms Coates is a director at Murgitroyd & Company, the Applicant's representatives. The purpose of Ms Coates' statement is to introduce evidence to show that the use of the word PRINCESS is highly common in the gaming industry. She states that there are a number of games that feature the word PRINCESS in their title or name, or feature a princess as a main character. In support of this argument she exhibits a list of 150 games to illustrate that numerous games are on the market by different entities

containing the word PRINCESS.¹ Some examples include Prison Princess, Ice Princess, Princess Pyro, Coco Princess, Kohime: Mystic Princess and Xena: Warrior Princess. It is argued by Ms Coates that the word PRINCESS, therefore, cannot be indicative of the origin from one entity.

11. It is said that the Opponent's MOON PRINCESS mark is used for an online slot game and the word PRINCESS is widely used and is featured on several slot games by third parties. A selection of screenshots of online slot games is produced which feature the word PRINCESS as the second word within the name of the game.² Examples within the screenshots include Jaguar Princess Slots, Golden Princess, and Ocean Princess.

12. It is argued by Ms Coates that the word PRINCESS cannot be the dominant element of the Opponent's mark and it does not serve as an indicator of origin. It is said that the nouns that precede all of the examples it produced in Exhibit EC2 serve to indicate to the player the type of princess that is the focus of the game. A consumer would not conclude that all of the slot game examples as exhibited derive from the Opponent.

13. Ms Coates states that despite the respective parties' marks sharing the same word, this will not lead consumers to conclude they are a product extension, co-brand or sub brand.

The Opponent's evidence in reply

14. Hannah Nattfogel is the Director of the Opponent and has authority to complete the statement on its behalf. The purpose of Ms Nattfogel's statement is to dispute the claims made by the Applicant in its evidence and to introduce evidence that it is common practice of video game developers to develop sequels to existing games, spin offs and video game franchises, where the same core trade mark is used within the name, either having the same ending or same beginning, to demonstrate that it results from the same company.³ Furthermore her statement serves to demonstrate that as a result of the Opponent's extensive use of MOON PRINCESS in the UK, it enjoys an enhanced degree of distinctive character. I do not propose to outline the

¹ Exhibit EC1

² Exhibit EC2

³ Exhibit 14- 17

evidence in full here, but suffice to say I have considered it in its entirety and shall refer to it where appropriate later in my decision.

Decision

Section 5(2)(b)

15. Section 5(2)(b) of the Act states as follows:

“5(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.”

16. 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 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 the goods and services

17. The goods comparison shall be undertaken in relation to those goods as set out in paragraphs 1 and 2 of my decision.

18. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (“CJEU”)

in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where 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

19. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (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. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated 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 für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or Applicant relies on those goods as listed in paragraph 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 that the responsibility for those goods lies with the same undertaking”.

22. The Applicant has conceded that there is an “overlap of the goods in class 9 and the services in class 41 in so far that both relate to computer games and the provision of online games, albeit that the Applicant’s use relates to games aimed at children whereas the Opponent provides games to casinos, whether online or otherwise and there is monetary gambling element to them.” It did not expand further, however. The Opponent submits that the goods are either identical or highly similar stating that the application covers goods and services related to games, computer software and entertainment, whereas the Opponent’s cover online slot games which are to be played on electronic devices. Specifically the Opponent argues that “the nature of the respective games and services are identical, sharing the same purpose, being a form of entertainment for users and overlapping in end users. They are also complementary and in competition with one another, potentially being offered or advertised on the same platforms.”

23. Given that the parties have not outlined the extent of similarity between the respective registrations where the goods/services are not self-evidently identical, I shall consider each term in turn, grouping terms together where appropriate.⁴

Class 9

Computer game programs; computer operating programs, recorded; computer game software, downloadable; computer software, recorded; computer programs

⁴ *Separode Trade Mark* BL O-399-10 (AP)

[downloadable software]; computer programmes [programs], recorded; electronic publications, downloadable; video game cartridges; computer software applications, downloadable.

24. The Applicant's goods are all in essence computer related software, publications, applications and programmes, downloadable or recorded. They are all therefore identical in accordance with principles as set out in *Meric* being encompassed in the Opponent's broader category of goods or vice versa namely *Computer games and video games; software for gaming machines* (first earlier mark) and *Computer games and video games (software)*..... *software for slot machine games, betting and wagering games, video slot games, casino games and bingo games provided online and via computer networks and playable on any type of computing device including arcade games, personal computers and handheld devices* (second earlier mark).

computers; computer peripheral devices

25. These goods are considered the hardware/physical devices upon which the software is downloaded or the games are played and therefore whilst not identical are similar to a medium degree to the Opponent's *software for gaming machines* (first earlier mark) and *software for slot machine games, betting and wagering games, video slot games, casino games and bingo games provided online and via computer networks and playable on any type of computing device including arcade games, personal computers and handheld devices* (second earlier mark). Whilst differing in nature and purpose, the software and the hardware/computer devices overlap in end users, reach the market through the same trade channels and are complementary.

Class 41

Game services provided on-line from a computer network;

26. The above services are self-evidently identical to the Opponent's *Games services provided online (via computer networks)*... (both earlier marks).

entertainment information; entertainer services; entertainment; club services [entertainment or education];

27. The Applicant's terms as outlined are broad terms and are all either encompassed in the Opponent's equally broad terms or encompass the Opponent's services in class

41 namely *prize draws [lotteries]; organising and conducting lotteries* (first earlier mark) and *entertainment services, namely, conducting a game of chance simultaneously at multiple, independent gaming establishments; entertainment services, hereunder providing on-line computer games* (second earlier mark).

games equipment rental;

28. These services being a provision service, will encompass the Opponent's *games services provided online (via computer networks); organising and conducting lotteries* (first earlier mark) and *services for the operation of computerised bingo* (second earlier mark) as often those providing the games machines and apparatus are responsible for setting these machines into operation and those organising lotteries and gambling events may well hire the equipment rather than purchase the equipment themselves. The terms are identical in accordance with *Meric*.

providing on-line electronic publications, not downloadable; publication of electronic books and journals on-line; publication of texts, other than publicity texts; electronic desktop publishing; publication of books.

29. I see no obvious similarity between these services and any of the Opponent's goods/services. However, since the Applicant has conceded similarity I shall proceed on the basis that they are similar to a low degree.

organization of competitions [education or entertainment]

30. These services encompass the Opponent's *organising and conducting lotteries* given that the organisation of a competition could be related to the gambling/lottery industry for entertainment or educational purposes. They are identical in accordance with *Meric*.

arranging and conducting of conferences; exhibitions (Organization of -) for cultural or educational purposes

31. Taking the ordinary meaning of the words, a conference is a formal meeting of people with a shared interest in a particular subject whereas an exhibition is a public event at which work is shown or displayed to the public.⁵ Although the particular subject of the conference/exhibition may relate to the gambling/lottery industry I see

⁵ www.collinsdictionary.com

no obvious similarity between these services and the goods and services of the Opponent. However, since the Applicant has conceded similarity I shall proceed on the basis that they are similar to a low degree.

32. Overall the respective goods and services are either identical or similar in varying degrees ranging from low to medium.

Average consumer and the purchasing process

33. When considering the opposing marks the average consumer is deemed reasonably informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods/services in question.⁶

34. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

35. At the hearing Mr Hoole submitted on behalf of the Opponent that the “relevant public is the public at large possessing an average level of attention. This includes the average consumer of games for everyday play and the purchaser or user of casino slot or bingo games. No special skill or knowledge is required to purchase any of these games which can be viewed played and downloaded on a simple mobile device.”

36. I do not consider that the Applicant disputes these submissions accepting that the average consumer of the products is likely to be those members of the public who play computer games or access games online save that in relation to those goods/services

⁶ *Lloyd Schuhfabrik Meyer*, case c- 342/97.

which relate to gambling they are specifically directed to those members of the public that have attained the age of 18. I agree.

37. In so far as the level of attention undertaken in the selection process I consider that this will be at a normal level, no higher or lower than the norm for such goods/services with suitability, ease of use, entertainment value and cost being factors in the consideration. Taking into account the nature of the goods/services visual considerations will dominate the purchasing process although there may be an aural aspect as a result of word of mouth recommendations for example.

Comparison of the marks

38. 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.”

39. It would be wrong to artificially dissect the trade marks, although, it is necessary to consider 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.

40. The respective trade marks are shown below:

Applicant's mark	Opponent's first earlier mark	Opponent's second earlier mark
Time Princess	MOON PRINCESS	

41. At the hearing it was accepted by Mr Hoole that the first earlier mark offers the Opponent its best case. He conceded that if the Opponent did not succeed in relation to its word only mark, it was unlikely to be in any better position with its figurative mark. I shall proceed, therefore, to compare the first earlier mark and the contested mark, only returning to consider the second earlier mark if it becomes necessary to do so.

42. At the hearing Mr Hoole submitted on behalf of the Opponent that “..the term PRINCESS is identical in both marks, placed in the same position and prefixed by a four-letter qualifier. The word PRINCESS is eight letters long and two syllables, compared to MOON or TIME, which are each four letters long and a single syllable. On weight alone, the term PRINCESS is double in length and for that reason possesses a dominant role in the respective marks.”

43. Ms Coates argued that the Opponent does not have a monopoly in the word PRINCESS and in fact it is the words MOON and TIME that dominate the marks. It is said that “it exists on the marketplace with a lot of other parties using the word PRINCESS in their computer games and that therefore the average consumer, on seeing these, would not immediately assume that a computer game including the word PRINCESS would immediately come from one entity.”

Overall Impression

44. The respective marks consist of two words which are easily understood words in the English language. The respective words TIME and MOON qualify the word PRINCESS, however, the combination of words in each mark is slightly odd in that the first word is not obviously descriptive. Despite the differences in length, both words

making up the marks, make an equal contribution when considered as a whole such that the overall impression of each lies in the combination of the two words.

Visual comparison

45. The Opponent submits that “the marks at issue are highly similar and partially identical. The word PRINCESS which is positioned as the second word in all marks plays an independent distinctive role, especially in regard adult casino games and entertainment as it carries no descriptive, suggestive nor obvious meaning for those goods and services...and is seen, pronounced and understood entirely independently. The words TIME and MOON are qualifiers of the noun PRINCESS and they do not change the overall meaning of the distinctive term PRINCESS.” Furthermore it was argued by Mr Hole that the words MOON and TIME bear a visual similarity since they are each four letters long and contain the letter M. Given these factors he argues that there is a high degree of similarity between the marks.

46. The Applicant refutes this argument. Whilst conceding that the word PRINCESS is identical in both marks, at the hearing Ms Coates submitted that the remaining words are dissimilar and the marks should be considered and compared as wholes and not artificially dissected. She disputes any similarity between the words MOON and TIME.

47. Given that notional and fair use of word only marks allows them to be presented in any font or case,⁷ nothing turns on the difference in casing between the respective marks, such that it will impact on my findings. Each mark contains the identical word PRINCESS which is a point of similarity between the respective marks. They differ to the extent that each comprises a different first word; the word TIME as opposed to the word MOON. I do not accept the arguments put forward by Mr Hoole that consumers will see similarity between the first words because they are each four letters long and contain the letter M. They will be seen as different words.

48. It is settled caselaw that the beginning of marks have more visual impact than their endings and therefore weighing up the identical use of the word PRINCESS against the differences arising from the use of different first words, I consider that the marks are visually similar to a medium degree.

⁷ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02,GC

Aural comparison

49. From an aural perspective both marks consist of well-known dictionary words which will be given their ordinary English pronunciation. In totality they are each three syllables long, consisting of a one syllable word followed by a two syllable word. Despite Mr Hoole's submissions, there is no aural similarity between the first words TIME and MOON as they are different words and will therefore be pronounced entirely differently. The second word however is common to both and will be pronounced identically. When pronouncing the words in combination, aural emphasis will be given to the first word in each mark resulting in a medium degree of aural similarity.

Conceptual Comparison

50. Individually each word will be given their ordinary meaning. The nouns MOON and TIME are not ones usually used to qualify the word PRINCESS. In combination these two words allude to the type or nature of the princesses namely one being related to time and the other being a mystical/celestial being originating or associated with the moon. The Opponent submits that the concept of MOON and TIME are closely linked, with Mr Hoole specifically arguing that "the term MOON is intrinsically linked to TIME, being responsible for the earth's length of day and night by determining the speed of the earth's rotation around its axis. In English the term MOON is used as an indicator of TIME, including in many common phrases such as 'many moons ago', meaning a time in the past, and 'it has taken many moons to complete', referring to a duration of time. The term MOON has also been used for centuries to indicate the passing of time, passing a year, including a number of cultures including in a lunar calendar."

51. In contrast Ms Coates argues that whilst "years ago, in medieval times we used to calculate time by the moon, that is no longer the case, such that there would be no conceptual overlap between the two words." Furthermore, she submits that it is not "something that the average consumer would make the mental leap or jump to get to at first sight of the word."

52. I agree with Ms Coates, whilst there may be, on a high level of generality, an overlap between the concept of TIME and MOON, for a conceptual message to be

apparent it must be capable of immediate grasp by the average consumer.⁸ On the whole I do not consider that the average consumer would make the immediate connection between the two words without further thought process, which I do not consider will be undertaken on first impression. Consumers, being members of the general public will attribute the ordinary meaning to the word TIME namely the measure or interval between two periods/events, and in relation to the word MOON the earth's satellite. The word PRINCESS will be attributed the identical meaning in each, namely, understood to describe the female member of the royal family, usually the daughter of the king or queen. In combination the contested mark will be regarded as meaning a princess relating to Time and the earlier mark as a celestial princess being associated or originating from the MOON. Given the nature of the goods, the consumer, in my view, will see the respective trade marks as alluding to the theme or storyline of the game or relate to a character within the game. Conceptually, therefore, given that each mark refers to a princess, the concepts overlap, but differ to the extent as to the type of princess. Overall they are conceptually similar to a medium degree.

Distinctive character of the earlier mark

53. The case of *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 sets out the legal position to determine the distinctive character of a mark. In this case 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

⁸ Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29

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).”

54. Registered trade marks possess varying degrees of inherent distinctive character, some being suggestive or allusive of a characteristic of the goods and services on offer, to those with high inherent characteristics such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion.

Inherent distinctive character

55. I shall consider the inherent distinctive position first. I note the submissions put forward by both parties in relation to the distinctiveness of the earlier mark. Ms Coates argues that the “word PRINCESS is commonly used in computer games by many different parties to indicate that the character is a princess, and for the goods and services at issue has a very low, to negligible, distinctive value... It will only be seen as a descriptor of the first word.” Mr Hoole disagrees and submits that the first earlier mark is highly inherently distinctive given that it has no connection to the goods/services and that the word princess plays an independent distinctive role in the mark as a whole. This is disputed by Ms Coates. Mr Hoole referred to the case of *Kalypso Media Group v Wizards of the Coast (Dungeons and Dragons)*⁹ which he argues has significant overlap with the issues in the decision in suit. In that decision the GC found on appeal, that:

“63. ...the fact that a game may take place in a dungeon and involve dragons is not sufficient to consider that those words are descriptive of a characteristic which is specific, in general, to the goods and services in question. As recalled in paragraph 35 above, the goods and services to be taken into account are

⁹ 10 October 2019 T-700/18

those designated in the act of registration of the trade marks at issue, and not the goods actually marketed under those trade marks.

64 Thus, the mere fact that games and computer games may contain references to 'dungeons' or 'dragons' in their content or name is not sufficient to make it possible to find that the words 'dungeons' and 'dragons' are descriptive of the characteristics of the games as such. Moreover, earlier mark No 8206336 does not refer to the goods and services which the applicant refers to as 'related' to games and computer games. As EUIPO quite pertinently points out, it would be unreasonable to consider that the mark DUNGEONS & DRAGONS alludes, for example, to 'computer game cartridges' or other goods or services in Classes 9, 28 and 41 associated with games and computer games."

56. It was held that the fact that the games in issue include a role playing element consisting of a progression in the game in a dungeon it did not make it possible to show that the word 'dungeons' generally alludes to characteristics specific to games as such and therefore could not be argued that it was weakly distinctive or even descriptive. It found that the Applicant had not demonstrated that "the word 'dungeons' identifies the purpose, type, nature or intended use of those goods and services, nor that the relevant public immediately perceives their meaning, without further thought or reflection, as designating a characteristic of the goods and services in question." Having regard to the goods and services in question and the relevant public, it was held that the earlier mark, DUNGEONS and DRAGONS has a distinctive character which is at the very least normal.

57. I agree with this reasoning. Reference to a princess, be it a time or moon princess does not describe the characteristics specific to the goods/services even for those that are games related, although it may allude to a princess character in the games or the theme of the games at issue. On this basis I do not accept that the earlier mark has a very low or weakly distinctive character as argued by Ms Coates. Nor do I agree that the earlier mark is highly distinctive or that its distinctiveness resides solely in the word princess. The word PRINCESS does not have distinctive significance independently of the whole mark, given that the word MOON qualifies it.¹⁰ In my view, the

¹⁰ *Medion v Thomson* Case C-120/04 [2005] ECR I-8551

distinctiveness of the mark lies in the two words MOON and PRINCESS in combination and therefore to an extent they form a unit. This combination of words is slightly odd; the use of the word MOON would not ordinarily be used to describe or qualify the word PRINCESS. Individually the words are ordinary dictionary words with no connection to or are descriptive of the goods/services on offer. They may allude to a fictional mystical character or the theme/subject matter of the products on offer, but only where those products relate to a princess theme.

58. Taking these factors into account, I consider that, inherently, as a whole, the earlier mark possesses an average degree of distinctive character.

Enhanced distinctiveness claim

59. The Opponent has filed evidence to support its argument that as a result of the use made of the marks it has acquired an enhanced level of distinctive character. At the hearing, Ms Coates argued that the Opponent did not specifically plead this nor file evidence in chief to support this position at the outset and therefore Ms Nattfogel's evidence should be dismissed in its entirety. In response Mr Hoole argued that it was not necessary to file evidence initially, given that the Opponent's position was that the earlier mark had a normal level of distinctive character. It only became necessary to file evidence on this issue when the Applicant questioned the distinctiveness of its marks.

60. In so far as the question of whether enhanced distinctive character needs to be specifically pleaded this was addressed in *YS Garments, LLC v Next Retail Limited*.¹¹ In that decision the hearing officer stated:

“21....whilst I accept the general point that pleadings should be as full as possible so as to set out the scope of the dispute, the absence of any specific reference in the pleadings to enhanced distinctiveness is not fatal to the opponent's case. This is because the assessment of distinctiveness is one of the fundamental factors that needs to be assessed in every case and, as is clear from the case-law, this can come from either the inherent nature of the mark, its use, or indeed a combination of both. Therefore, if evidence has been

¹¹ BL O/379/19

filed, which it has in the case before me, it is incumbent upon me to factor that evidence into the assessment to decide upon the overall distinctiveness of the earlier mark. It would be perverse to do otherwise, as it would require a pretence as to the true level of distinctiveness on the part of the average consumer, based on a technicality.”

61. Accepting that that decision is a first instance decision and not binding on me, I nevertheless adopt the same approach. In relation to the issue raised of dismissing Ms Nattfogel’s evidence, I note that the Applicant had the opportunity to apply to cross examine her and did not do so. Furthermore, I consider that the Applicant has put forward submissions in reply challenging the evidence at the hearing. I do not consider therefore, that it has been at a disadvantage or prejudiced in the way that the Opponent filed its evidence. Consequently I dismiss Ms Coates’ submissions in this regard and shall now consider whether Ms Nattfogel’s evidence supports the contention of an enhanced degree of distinctive character.

Ms Nattfogel’s witness statement

62. It is said that the Opponent is the market leader and leading supplier of specialised software in building online networks for slot gaming in Sweden and across the world. The Opponent is said to be recognised as one of the first game developers to move into the mobile arena and has developed 160 games to date.

63. An undated screenshot (save for a print date of 16/8/2022) of its activities taken from its website www.playngo.com is produced. The screenshot includes thumbnails of the various games offered by the Opponent to include Forge of Fortune, Leprechaun’s Vault, Mega Don and Cash of Command. No further meaningful information is produced other than the existence of the website itself. There are no references made to the earlier marks.

64. Ms Nattfogel states that the Opponent has attracted much praise winning and being nominated for several awards namely

- 2019- Best Online Casino Innovator at MGBS; Compliance Officer of the Year at the Compliance Regulatory Awards.

- 2018 - EGR B2B Slot Provider of the Year Award; Leader of the Year iGaming (Supplier) Award at the 9th Gaming Women in Gaming Diversity Awards.
- 2017- Casino Supplier Award at the EGR Italy Awards; Diversity Award at the 8th Women in Gaming Diversity Awards; Slot Provider of the Year at the International Gaming Awards.¹²

65. Ms Nattfogel states that the MOON PRINCESS game was released on 26 July 2017 in various countries, including the UK and two sequels were subsequently released on 1 December 2021 and 6 April 2022 (MOON PRINCESS:CHRISTMAS KINGDOM and MOON PRINCESS 100). Screenshots of promotional posts at the time of launch, taken from the Opponent’s websites are produced, accessed on 2/08/21.¹³ The following text are included in the releases, “The princesses return in a magical sequel.”; “Everyone’s favourite princesses in their next adventure. Love, Storm and Star are back...”; “Love, Storm and Star find themselves on a journey into the realm of The Christmas Kingdom.”

66. It is said that the three games in the series are available to play on various UK licensed online casino platforms including bet365, Play Ojo and Grosvenor Casinos. Undated screenshots are produced showing the availability of the Opponent’s MOON PRINCESS games on these platforms taken from www.playojo.com; www.grosvenorcasinos.com and www.games.bet365.com. The prices on the Grosvenor Casino platform are in pounds sterling and the screenshots are all dated with an access date 16 August 2022.¹⁴ The other screenshots display the prices in euros.

67. The game is said to be heavily promoted and advertised on various platforms to include YouTube, LinkedIn, Facebook and Instagram. Screenshots of these accounts are produced.¹⁵ Ms Nattfogel states that the Opponent is a:

“buyer to buyer business where marketing and promotional materials are provided to their partners such as licensed online casinos. These are provided via a platform known as Client Zone. The Client Zone is a portal accessible via

¹² Exhibit 2

¹³ Exhibit 3

¹⁴ Exhibit 4

¹⁵ Exhibit 10

Playngo.com, where [its] clients and partners can get updates on game data and information and independently download assets pertaining to our games for marketing purposes.”

68. Screenshots consisting of Client Zone Login details are produced dated 4 August 2022.¹⁶ The screenshots appear to consist of generic stills of the process a client goes through to access this platform. No reference is made to the earlier mark.

69. Exhibit 5 includes rankings and reviews of the MOON PRINCESS trilogy of games taken from various sources including www.bigwinboard.com; www.bonuscode.co.uk; www.freebieslots.co.uk; www.gamblegenie.co.uk; www.luckymobileslots.com; www.casino.partycasino.com; www.slotstemple.com; www.slotsource.ie; www.lcb.org.org; www.casiomentor.com. The screenshots are all undated save for an access date of 11/12 August 2022. Each website gives a general overview of the games and provides its own rating and ranking system as to ease of use, enjoyability and available wins and bonuses. The images on bigwinboard and luckymobileslots show that access to the UK is restricted and the prices in the photographs are displayed in euros.

70. Exhibit 6 consists of screenshots of various video stills taken from YouTube videos/channels mostly with an access date of 12 August 2022. The captions generally are headed “HUGE WIN on Moon Princess” or similar. The stills appear to relate to individuals who have posted a video of themselves winning on one of the MOON PRINCESS games.

71. Exhibits 7, 8 and 9 consist of Google Trend and Slot Catalog search results which are said to show the dominance of MOON PRINCESS games in comparison to other games. It is said that the graph at exhibit 9 shows that MOON PRINCESS has kept a steady interest with consumers over the last five years. A detailed table of the search frequency per game per year of five comparable games in comparison to MOON PRINCESS is produced.¹⁷

72. Ms Nattfogel states that the MOON PRINCESS game page on the Opponent’s website was viewed by UK based consumers over 14,352 times during 2021-2022.

¹⁶ Exhibit 11

¹⁷ Paragraph 18

73. Ms Nattfogel states that from 2017 until July 2022 the Opponent’s MOON PRINCESS game generated a gross gaming revenue of almost £13 million, with 597,000 unique players. The specific figures for each year are produced namely:

Year	Bet (Pounds)	GGR (Pounds)	Unique Players
2017	22,169,943	817,935	56,507
2018	72,549,286	3,078,006	112,464
2019	69,164,583	2,746,305	143,442
2020	68,688,306	3,112,045	118,863
2021	44,819,890	2,222,064	93,704
2022 – 15.07.2022	18,788,528	932,410	72,617

74. The articles which it is claimed shows the games being the centre of media attention do not demonstrate attention from the UK as the article taken from europeangaming.eu is an EU based website.

Assessment of the evidence

Revenue

75. The gross revenue figures amount to some £13 million over five years but I am not told as to what proportion specifically relates to the UK market. At the hearing Mr Hoole stated that the gross revenue figures should be read in the context of paragraph 3 (of Ms Nattfogel’s statement) which “...provide[s] the Office with information about the Opponent’s extensive use of MOON PRINCESS in the UK.” On this basis, it was argued that the gross figures should be read as relating to UK figures. The way in which Ms Nattfogel has described the figures and phrased paragraph 21, however, does not appear to suggest that this is the way in which the table is to be interpreted. The statement sets out that “the MOON PRINCESS game generated a gross gaming revenue” which leads me to believe that they represent the total revenue generated for the game across all jurisdictions. There is nothing to suggest that they solely relate to the UK or UK consumers. This is particularly so, given the context of the other evidence produced which does not exclusively relate to the UK. For example the evidence consists of a number of screenshots where the prices are displayed in euros, screenshots of non UK websites and the promotional video expenditure referred to is produced in euros. This clearly demonstrates that they are directed at a European audience and not specifically restricted to the UK. I cannot therefore with any degree

of certainty accept the submission put forward by Mr Hoole. In any event, even if I am wrong and they do represent revenue figures only for the UK, this does not assist the Opponent, given that the figures are fairly modest. Over a five year period they do not represent a significant market share, taking into account that the gambling/betting industry within the UK is a multi-billion pound industry. Accepting that the first column represents the number of bets placed in pounds sterling, the number of unique players is less than 73,000 in 2022 which appears to suggest that these unique players place multiple bets. Furthermore, the figures are not broken down by category or attributed to the specific goods and services of the Opponent's specification as relied upon.

Awards

76. It appears that a number of the awards are either industry awards to the Opponent or its employees or relate to awards outside the UK. Very little, if any, awards refer to the earlier mark and therefore these awards tell me very little as to how well known the marks are to the average UK consumer.

Advertising and Promotion

77. In relation to advertising no advertising figures are produced other than one example of €8000 being expended on a promotional video. It is said that the promotion of the game is predominantly done by its licensees on their platforms but no details are provided as to how many users accessed these platforms specifically in relation to the MOON PRINCESS game. Given that there are licencing agreements in place I accept the criticisms made by Ms Coates that it would have been a relatively easy task for the Opponent to produce details as to the terms of those licences, the revenue generated or how the Opponent's products were advertised on the licensees' online platforms.

78. In relation to the YouTube video stills produced, whilst I note, for example, that Chipmonkz Slots accumulated 4.8k views, I am unclear as to when the video was first posted/uploaded. Looking at the print date, therefore, I am only able to say that up to August 2022 those number of views were reached. It is possible for the video to have accumulated these views after the relevant date. Furthermore, there is no way of telling from the information produced, the location of those posting or accessing the videos and whether they are based in the UK.

Reviews

79. It is unclear whether all the websites produced are directed towards the UK consumer although I do note that the addresses for some are “.co.uk” web addresses. I note that there are no or limited reviews from actual consumers and no information is provided as to how many people within the UK interacted with these review sites. I note that the review from bigwinboard, for example, has 10 comments but no indication is given as to the geographical location of these reviewers and whether they are located in the UK. I am unclear whether these websites are from independent reviewers or are paid promotions from within the industry.

Social media

80. The Opponent’s social media presence is minimal, no details are produced as to the number of followers on its platforms. For a start the accounts are under the handles @playngoofficial and not specifically for MOON PRINCESS which indicates that the account relates to all of the Opponent’s products. Furthermore, very few posts make reference to the earlier mark. The screenshots consist predominantly of images of cartoonlike female characters without text. In any event the posts show very little interaction with its consumers. For example, one post, dated 2 December 2021, taken from Instagram referring to MOON PRINCESS only shows 370 views and 3 comments.

81. The Opponent’s profile in LinkedIn is under the name Play’nGo and is therefore for the company as a whole and shows a very modest presence. Whilst it shows that it has 18,357 followers, no details are produced as to the location of these followers and whether they are in the UK, nor how many posts relate solely to the earlier mark. A promotional video/post, dated “4 mo” shows 2 shares and 72 reactions whereas a similar post for the MOON PRINCESS CHRISTMAS KINGDOM (which due to its release date must be after 2 December 2021) had 46 reactions, 2 comments and 4 shares.

82. The evidence relating to YouTube advertising appears to be aimed at a worldwide audience and there is no indication as to whether or what proportion of users (if any), accessed these videos or accounts from the UK. These videos do not demonstrate a significant presence in any event.

Websites and screenshots

83. The majority of screenshots from third party website are undated (save for an access/print date of 12/8/22) or do not include any meaningful information.

Conclusion

84. Taking all the above into account and assessing the evidence as a whole, it is insufficient to support of a claim of enhanced distinctiveness. I am not satisfied that the evidence shows that the UK consumer has become educated in the mark such that its distinctive character has become enhanced through use as claimed.

Likelihood of confusion

85. When considering whether there is a likelihood of confusion, I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion, where the similarities between the marks lead the consumer to believe that the respective goods and services originate from the same or related source.

86. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised 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, 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).”

87. A number of factors must also be borne in mind when undertaking the assessment of confusion. 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/services and vice versa. As I mentioned above, it is also necessary for me to keep in mind a global assessment of all relevant factors when undertaking the comparison and that the purpose of a trade mark is to distinguish the goods and services of one undertaking from another. In doing so, I must consider 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.

88. Earlier in my decision I assessed the average consumer to be a general member of the public and in the case of goods and services relating to gambling, members of the public over the age of 18. I found that the level of attention undertaken in the purchase/selection process to be average, predominantly using visual means but not discounting an aural element in the process. In relation to the similarities between the marks I found that visually and aurally the marks are similar to a medium degree. Conceptually to the extent that they each refer to a princess their concepts overlap,

but are dissimilar as the theme or character of the game or the type of princess. Overall I found that they are conceptually similar to a medium degree. I concluded that the first earlier mark is inherently distinctive to an average degree and I considered that the distinctiveness of the mark lay in the combination of the words MOON and PRINCESS rather than the word PRINCESS solus. I did not find that the Opponent had demonstrated that it had enhanced the distinctive character of its mark by the use it had made of it. In relation to the respective goods and services they were either identical or similar in varying degrees ranging between low and medium.

89. Dealing with direct confusion first. Given that the marks each include a different first word, the word MOON as opposed to TIME, and given that as a general rule the beginning of marks have more impact, I do not believe that the differences arising from these first elements will go unnoticed by the relevant consumer. Consequently they are unlikely to mistake or imperfectly recall one mark for the other. There is no likelihood of direct confusion.

90. Moving on to indirect confusion, for this to arise the average consumer must consider that as a result of the common element, there is an economic connection between the respective marks, such that the goods/services provided under one is regarded as a brand extension or sub brand of the other, for example.

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

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

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be

confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

92. A shared common element alone, however, does not necessarily lead to a likelihood of confusion.¹⁸ It is important for me to note the aspects of the other elements within the respective marks and the part they play. I bear in mind not only the level of distinctiveness of the earlier mark as a whole but also the distinctiveness of the common element. I also accept that the examples as set out in *L.A.Sugar* (above) are not exhaustive and that they are only intended to be illustrative of the general approach.¹⁹

93. Lord Justice Arnold stated in *Liverpool Gin* that “trade mark law was about consumers' unwitting assumptions, not what they could find out if they thought to check.” It is necessary therefore for me to bear this in mind when undertaking the assessment and whether the common element ‘PRINCESS’ when viewed within the application is sufficiently powerful when weighed against the differences, that despite these differences the average consumer’s imperfect recollection of either mark on encountering the other gives rise to a belief that the two entities are connected, leading to a likelihood of confusion.²⁰

94. I also note in *Duebros Limited v Heirler Cenovis GmbH*,²¹ Mr James Mellor QC (as he then was), sitting as the Appointed Person, stressed that the finding of confusion should not be made merely because two marks share a common element, if a mark merely calls to mind another mark this is insufficient.

95. I accept the evidence filed by both parties that it is common practice within the gaming industry for retailers to market and use the same element in sequels and subsequent editions to denote the trade origin of their goods/services. For this to apply to the decision in suit, I would need to conclude that the distinctiveness of the Opponent’s mark resides in the element PRINCESS alone so that consumers will see any mark which includes the word PRINCESS as a sequel or that it is connected to

¹⁸ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

¹⁹ *Liverpool Gin Distillery Limited v Sazerac brands LLC* [2021] EWCA Civ 1207

²⁰ James Mellor as the appointed person on appeal in *Ashish Sutaria v Cheeky Italian Limited* O/219/16

²¹ BL O/547/17

the earlier mark and that the goods/services originate from the same or related undertaking.

96. The Applicant argues that “the Opponent does not have a “monopoly in the word PRINCESS, that it exists on the marketplace with a lot of other parties using the word PRINCESS in their computer games and that therefore the average consumer, on seeing these, would not immediately assume that a computer game including the word PRINCESS would immediately come from one entity.”

97. The Opponent relies on the decision in *Dungeons and Dragons*, arguing that due to the similarities between the respective proceedings I should follow the same conclusion reached by the GC in relation to a likelihood of confusion. The comparison in *Dungeons and Dragons* on this issue, however, is not on all fours with the decision in suit. For a start it is taken from the perspective of the EU consumer and secondly the assessments to be made are different, the comparison between the marks give rise to difference considerations. The overall conclusion reached by the GC is therefore irrelevant to my assessment.

98. When assessing whether as a result of the common word PRINCESS, consumers will be confused between the two entities, I place considerable weight on the fact that the evidence filed by the Opponent does not show that it has a reputation solely in the word PRINCESS alone, or that the average consumer of these products would consider that any mark including the word PRINCESS will be from the same stable or family. There is no evidence to suggest that consumers have learned to associate the word PRINCESS as designating goods/services from one particular source and more importantly particularly with the Opponent.²²

99. As I have already found I believe the distinctiveness of the earlier mark lies in its totality. Therefore given that the beginning of the later mark is different and the evidence filed shows that a number of entities use the word PRINCESS to refer to a character or theme of the game, I do not consider that the average consumer would consider that the one mark is a sub brand or brand extension of the other. Even without evidence, the word PRINCESS it is not so strikingly distinctive of the Opponent that

²² II Pont Finanziaria C-2354/06 at 61-64

the use of this word in combination with a totally different word would lead consumers to consider that it is a brand extension or linked to the Opponent.

100. Bearing in mind my assessment of the overall impression and the role each element plays within the marks as wholes, when coming across the respective marks, I find that the average consumer will not consider that the same provider is responsible for the goods/services. I am fortified in this finding by the fact that the Opponent's own evidence shows that the title of its sequels and subsequent editions include both the words MOON and PRINCESS and not solely the word PRINCESS.

101. If consumers note that the marks are different, I find it improbable that they would then acknowledge those differences but conclude that the goods and services are provided by one and the same undertaking. At best if the average consumer goes through this mental process in my view it would merely bring to mind the other's mark in a scenario as envisaged in *Duebros*. Consumers may consider that the marks coincidentally refer to a princess character or theme but this is where the similarity ends.

102. Noting that the interdependency principle allows for a lower degree of similarity between the marks to be offset by the identity between the goods/services, in my view the differences between the marks as identified are sufficient for no confusion to arise. Consumers will not view the contested mark as independent components or that the word 'PRINCESS' will have distinctive significance independent of the whole.²³ I do not find that there would be indirect confusion.

103. Having found no confusion in relation to the Opponent's word only mark I need not go on to consider its figurative second earlier mark since this is further away in terms of similarity and will not place the Opponent in any stronger position. Confusion is, therefore, even less likely.

²³ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

Conclusion

104. Based on these conclusions the opposition fails in its entirety under section 5(2)(b) of the Act. Subject to any successful appeal, the application may proceed to registration.

Costs

105. As the Applicant has been successful it is entitled to an award of costs in its favour on a contributory basis. Award of costs in proceedings are based upon the scale as set out in Tribunal Practice Note (TPN) 2 of 2016. Applying this guidance I award costs to the Applicant on the following basis:

Considering the notice of opposition and preparing a defence and counterstatement:	£200
Considering the Opponent's submissions/evidence and preparing evidence in reply:	£600
Preparing for and attending a hearing:	£800
Total	£1,600

106. I order Play'n GO Marks Ltd to pay IGG Singapore Pte. Ltd the sum of £1,600 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against the decision is unsuccessful.

Dated this 2nd day of February 2023

Leisa Davies

For the Registrar