

**O/0175/23**

**TRADE MARKS ACT 1994**

**SUPPLEMENTARY DECISION**

**IN THE MATTER OF APPLICATION NO. UK00003434017**

**BY PLAY'N GO MARKS LTD**

**TO REGISTER:**

**FORTUNES OF ALI BABA**

**AS A TRADE MARK IN CLASSES 9, 28 AND 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 419211 BY**

**ALIBABA GROUP HOLDING LIMITED**

## **BACKGROUND**

1. On 4 June 2021, a decision in the above opposition proceedings was published under reference number BL O/423/21. Whilst upholding the opposition, my decision was provisional due to the fact that the opponent's first and third marks (being the EUTMs numbered 017971585 and 017889036, respectively) were subject to pending applications for invalidation before the EUIPO. The provisional nature of my decision also applied to the opponent's second mark despite the fact that this was not subject to any invalidation action before the EUIPO. At the conclusion of my decision, I directed that the opponent informs the Tribunal when the EUIPO invalidation proceedings were decided.
2. The EUIPO invalidation applications directed against the opponent's first and third marks were rejected in full and the EUTMs remain registered for all of their respective goods and services.
3. As was the case for decision BL O/423/21, this supplementary decision is decided on the basis of the law as it stood at the date of the application at issue (being 4 October 2019). As the UK was still a Member State of the EU at that time, the opponent's EUTMs were the relevant rights and remain as such as at the date of this supplementary decision.
4. This supplementary decision makes no change to the contents of decision BL O/423/21 insofar as it concerns the assessment of the goods and services, the extent of likelihood of confusion nor the overall outcome of the decision. The consequence of all of this is that, by way of a supplementary decision, I hereby confirm the upholding of the opposition in full and that, subject to appeal, the application for registration is hereby refused.

## **COSTS**

5. In decision BL O/423/21, I reserved a decision on costs until this supplementary decision. Given that the opponent has been successful, it is entitled to a

contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016.

6. In the present proceedings, I remind myself that the opponent filed both evidence in chief and evidence in reply. The evidence was predominantly aimed at proving that the opponent's marks enjoyed an enhanced degree of distinctive character. In my decision, I found that the evidence filed was insufficient to prove enhanced distinctiveness meaning that it was of no real assistance to the opponent's claim. Despite this, I note that the applicant also filed its own evidence that the opponent was required to consider. As such, I consider that it is still appropriate to make a costs award in favour of the opponent in respect of the evidence filed by both parties. In the circumstances, I award the opponent the sum of **£1,100** as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition:	£200
Preparing evidence in chief, considering the applicant's evidence and preparing evidence in reply:	£500
Preparing written submissions in lieu:	£300
Official fees:	£100
<b>Total</b>	<b>£1,100</b>

7. I hereby order Play'n GO Marks Ltd to pay Alibaba Group Holding Limited the sum of £1,100. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 17<sup>th</sup> day of February 2023**

**A COOPER**  
**For the Registrar**