

BL O-462-17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS 3176886 AND 3176894
IN THE NAME OF ROYAL CIRCUS LIMITED

AND

OPPOSITIONS THERETO UNDER NOS 407576 AND 407577
BY CIRCUS BELGIUM S A
(CONSOLIDATED PROCEEDINGS)

Background

1. This decision is issued in respect of the following applications:

1: application no 3176886 which seeks registration of the trade mark **ROYAL CIRCUS GAMES**;

2: application no 3176894 which seeks registration of the trade mark **ROYAL CIRCUS**.

2. Both applications have a filing date of 27 July 2016, stand in the name of Royal Circus Limited (“the applicant”) and, following later amendments, now seek registration for identically worded specifications of goods and services in classes 9, 16, 28, 35, 38, 41, 42 and 45 which I set out later in this decision.

3. Following publication of both applications in the *Trade Marks Journal* on 26 August 2016, notices of opposition were filed on behalf of Circus Belgium S.A. (“the opponent”). In both cases, there is a single ground of opposition under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and in support of which the opponent relies on European Union Trade Mark (“EUTM”) 11664547. The EUTM has a filing date of 18 March 2013, was entered in the register on 17 May 2014 in respect of goods and services in classes 9, 28 and 41 which again I will set out later in this decision and is for the following mark:



Circus

4. The applicant filed counterstatements essentially denying the grounds of opposition.

5. The two oppositions were consolidated. Both parties filed evidence and both filed written submissions. The matter came before me on 27 July 2017 for a hearing. The applicant attended and was represented by Ms Daniele Selmi of Counsel, instructed by Marks & Clerk LLP. The opponent did not attend and was not represented in person but written submissions in lieu of attendance were filed on its behalf.

The evidence

6. The opponent's evidence takes the form of two witness statements (one filed in reply) from its trade mark attorney, Mr Philippe Partoune. The applicant's evidence takes the form of a witness statement from its trade mark attorney, Mr Campbell Newell. I do not intend to summarise the evidence here but have read all of it and will refer to it and the written submissions as necessary in this decision.

The decision

7. The oppositions are founded on grounds under section 5(2)(b) of the Act which states:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

8. The opponent relies on the EUTM referred to above which is an earlier mark in accordance with section 6A of the Act. The earlier mark is not subject to the requirement that proof of its use be shown as it had not been registered for a period of five years as at the date of publication of the applications. The opponent is therefore entitled to rely on it for each of the goods and services for which it is registered.

9. In determining whether there is a likelihood of confusion between the respective marks, I note the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the respective goods and services

10. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court ("GC") stated that:

"29. ...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 where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

The same, by analogy, is true in respect of services.

11. 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”.

12. 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 users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

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

14. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as “complementary” and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

15. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

16. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

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

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

18. In *Separode Trade Mark* BL O-399-10 the Appointed Person stated:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

19. The goods and services to be compared are as follows:

The specification of the earlier mark	The applicant’s specifications
<p>Class 9: Computer game software (in particular casino games), sports betting and forecasting games; Data processing software for information relating to games and sports information; Computer program; Data recording systems; Apparatus for recording, transmission or</p>	<p>Class 9: Game software; computer and video games software; electronic game software; computer and video game programs; computer and video game discs; video games on disc [computer software]; computer and video game cartridges; computer and video game cassettes, disks and</p>

reproduction of sound or images; Magnetic recording supports; Phonograph records; Mechanisms for coin-operated apparatus; Discs, cassettes and floppy discs containing programs, in particular for computer games; Magnetically encoded cards, chip cards, electronic cards; CD-ROMs, Cards for electronic games; Interactive games terminals; Electronic apparatus enabling the consultation, completion and validation of forms and grids for forecasts, bets, games and competitions; Electronic purse systems; Data communication servers; Games programs for controlling games and bets; Computer programs for paying players online; Website development software; Computer software for creating dynamic websites; Terminals for gaming (in particular for casino games), sports betting and forecasting games; Telecommunications terminals and multimedia terminals relating to games (in particular casino games), sports betting and sports news.

Class 28:

Games; Playing cards; Counters [discs] for games; Playing cards; Board games; Dice for games; Layout cloths; Casino fittings namely roulette tables, roulette wheels; Betting terminals; Games machines, prepaid and token-operated games machines; Electronic game apparatus for use online or offline; Electronic table game apparatus with optical display screens; Console gaming devices.

Class 41:

Casino facilities; Betting and sporting forecast services; Providing amusement arcade services; Gambling; Gambling services; Games offered on-line on a computer network; Organization of competitions (education or entertainment); Organisation of games via the Internet,

DVDs; downloadable electronic game programs; downloadable computer and video game programs and software; interactive computer and video game programs; interactive multimedia software for playing games; recorded computer game software; games software for use for use with video game consoles; computer game entertainment software; interactive multimedia computer game programs; computer game software for use with online games; memory cards for video game machines; electronic game software for mobile phones, handheld electronic devices and wireless devices; computer programs for pre-recorded games; pre-recorded compact discs featuring games; computer hardware for games and gaming; video games [computer games] in the form of computer programs recorded on data carriers; computer and video game software and programs downloadable from the internet; computer game software downloadable from a global computer network and wireless devices; downloadable information relating to games and gaming; computer application software featuring games and gaming; downloadable software in the nature of mobile applications for playing games; mobile apps; application software for social networking services via the internet; downloadable interactive entertainment software for playing computer and video games; downloadable electronic publications relating to games and gaming; computer software for the administration of online games and gaming; computer firmware relating to games and gaming; firmware for computer peripherals; computers and computer hardware for games and gaming; game programs for arcade video game machines; computer software to enable virtual reality viewing of environments; computer

<p>television, radio, mobile telephone and telecommunications systems; Publication of books, newspapers and periodicals; Publication of books, newspapers, periodicals and electronic media on the Internet or telecommunications systems, relating in particular to games, competitions, sports betting and pools, and sports information; Production of films, television programmes and reports (entertainment), in particular in the field of sports, games, competitions, lotteries, sports betting and sports forecasting; Consultancy and information relating to games, casino game competitions, sports, sports competitions and entertainment, competitions, lotteries, sports betting and sports forecasting; Providing of assistance to players in the field of games, lotteries, sports betting and sports forecasting (providing of training); Providing of facilities for casinos and bookmakers for sports betting and sports forecasting, namely rental of gaming tables, slot machines and gaming accessories including cards and tokens.</p>	<p>graphics software; graphical user interface software; interactive video software; interactive multimedia computer programs; virtual reality software; virtual reality headsets; virtual reality game software; augmented reality software; augmented reality software for creating maps; augmented reality software for use in mobile devices; augmented reality software for use in mobile devices for integrating electronic data with real world environments; optical viewing screens; computer programs for providing an all-around view of virtual environments; video processors for providing an all-around view of virtual environments; display monitors for providing an all-around view of virtual environments; three dimensional viewers; three dimensional picture manipulators; audio-visual instruments, apparatus and receivers; 3D glasses and spectacles; 3D spectacles for television receivers; computer software for sending and receiving electronic messages, graphics, images, audio and audio visual content via global communication networks.</p> <p>Class 16: Printed materials, namely, manuals, pamphlets, booklets, books, magazines, posters and guides in the field of computer and video games.</p> <p>Class 28: Computer game apparatus; hand held computer games.</p> <p>Class 35: Online retail services in relation to the sale of video and computer game hardware and software products.</p>
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	<p>Class 38: Provision of access to internet platforms and portals for the purpose of online gaming; transmission of videos, movies, pictures, images, text, photos, games, user-generated content, audio content, and information via the internet; providing online forums and instant messaging services for communication in relation to gaming and online gaming; providing access to computer databases in the fields of computer and video games.</p> <p>Class 41: Video game entertainment services; rental of video games; providing online computer and video games; providing online interactive computer games; providing information relating to online computer and video games; providing information online relating to computer games and computer enhancements for games; rental of electronic games equipment, machines and apparatus; internet games (non-downloadable); rental of computer game programs; providing entertainment services in the nature of computer, video and electronic games; games services provided online from a computer network; providing online entertainment in the nature of game tournaments; providing online information to game players about the ranking of their scores; providing online information on computer and video game strategies; games services provided via computer networks and global communications networks; games services provided by means of communications by computer terminals or mobile telephone; games services provided via computer networks and global communication networks; provision of an online magazine featuring information in the field of computer games; providing newsletters in the field of computer games via e-</p>
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	<p>mail; video game arcade services; amusement arcade gaming machine rental services; computer and video game software publishing services.</p> <p>Class 42: Development of computer and video game software and programs; design of computer and video game software and programs; computer programming of computer and video games; design and development of computer game software; design and development of computer hardware for computer and video games; computer and video game software authoring; computer and video game software installation; computer and video game software maintenance; computer and video game software engineering; rental of computer and video game software.</p> <p>Class 45 Software licensing; licensing of computer games.</p>
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20. The applicant submits that the opponent’s mark is protected:

“...when used in relation to goods and services in classes 9, 28 and 41 connected with casino gaming, gambling and betting”.

It further submits that:

“there is no sense in carrying out the comparison in respect of goods and services other than those in classes 9, 28 and 41 of the Applications. If the Opponent fails in relation to those goods and services, it must fail in relation to the others.”

And:

“...the goods and services in classes 9, 28 and 41 are plainly not identical or *highly* similar to the goods and services in those same classes in the Opponent’s mark”

though it admits there is

“*broad* similarity between them”.

21. For its part, the opponent submits that its goods and services are not limited to the field of gambling and casino games or even in the field of gaming. It submits that each of the applicant’s goods and services are similar or identical to goods and services within its own registration and “coincide in their distribution channels, producers and consumers...”.

22. As there is no clear agreement between the parties as to the extent of any similarity of the respective goods and services, it is necessary to carry out a full comparison of them. Before I do so, I pause to comment on the fact that within the opponent’s specification there is some use of the words “in particular” (e.g. Computer game software (in particular casino games)...” whilst within the applicant’s specification there is use of the word “namely” (e.g. Printed materials, namely, manuals, pamphlets...)” It is important to note that use of the words “in particular” does not have the effect of limiting the specification to those particularised goods in the way that use of the word “namely” does in the respective specifications.

23. I will deal with each of the applicant’s goods and services in turn, by class taking into account the case law set out above.

The applicant’s goods in class 9

24. The opponent’s *Computer program* is not limited in any way. I find that these, plus the opponent’s *Computer games software (in particular casino games), sports betting and forecasting games; Games programs for controlling games and bets* variously to include and therefore, on the basis of *Meric*, to be identical to the applicant’s *Game software; computer and video games software; electronic game*

software; computer and video game programs; downloadable electronic game programs; downloadable computer and video game programs and software; interactive computer and video game programs; interactive multimedia software for playing games; recorded computer game software; games software for use for use with video game consoles; computer game entertainment software; interactive multimedia computer game programs; computer game software for use with online games; electronic game software for mobile phones, handheld electronic devices and wireless devices; computer programs for pre-recorded games; video games [computer games] in the form of computer programs recorded on data carriers; computer and video game software and programs downloadable from the internet; computer game software downloadable from a global computer network and wireless devices; computer application software featuring games and gaming; downloadable software in the nature of mobile applications for playing games; mobile apps; application software for social networking services via the internet; downloadable interactive entertainment software for playing computer and video games; computer software for the administration of online games and gaming; game programs for arcade video game machines; computer software to enable virtual reality viewing of environments; computer graphics software; graphical user interface software; interactive video software; interactive multimedia computer programs; virtual reality software; virtual reality game software; augmented reality software; augmented reality software for creating maps; augmented reality software for use in mobile devices; augmented reality software for use in mobile devices for integrating electronic data with real world environments; computer programs for providing and all-round view of virtual environments; computer software for sending and receiving electronic messages, graphics, images, audio and audio visual content via global communication networks.

25. I find the applicant's *computer and video game discs; video games on disc [computer software]; computer and video game cartridges; computer and video game cassettes, disks and DVDs; pre-recorded compact discs featuring games; computer hardware for games and gaming; computer firmware relating to games and gaming to include and be identical to, at least, the opponent's Discs, cassettes and floppy discs containing programs, in particular for computer games.*

26. I find the applicant's *memory cards for video game machines* to be included within and therefore identical to at least the opponent's *Cards for electronic games*.

27. I find the applicant's *downloadable information relating to games and gaming* and *electronic publications relating to games and gaming* to be reasonably similar to the opponent's *Data processing software for information relating to games*.

28. I find the applicant's *firmware for computer peripherals*; to be highly similar if not identical to the opponent's *Magnetically encoded cards, chip cards, electronic cards, Cards for electronic games*.

29. I find the applicant's *computers and computer hardware for games and gaming* to include *Interactive games terminals* as appears in the opponent's specification and therefore these respective goods are identical.

30. I find the applicant's *video processors for providing an all-around view of virtual environments; display monitors for providing an all-around view of virtual environments; optical viewing screens; three dimensional viewers; three dimensional manipulators; audio-visual instruments, apparatus and receivers*; to be included within and therefore identical to the opponent's *Apparatus for recording, transmission or reproduction of sound or images; Terminals for gaming* and *Telecommunications terminals and multimedia terminals relating to games*.

31. I find the applicant's *Virtual reality headsets; 3D glasses and spectacles; 3D spectacles for television receivers* to be similar to a low degree to the opponent's *Interactive games terminals* on the basis that the respective goods are complementary and used together and are likely to be bought as part of a single "gaming" package.

The applicant's goods in class 16

32. I find each of the applicant's goods in this class to be similar to a reasonable degree to the opponent's *Data processing software for information relating to games* as is included in its specification in class 9 and highly similar to the opponent's *Publication of books, newspapers, periodicals and electronic media on the Internet*

or telecommunications systems, relating in particular to games, competitions as is included within its class 41 specification.

The applicant's goods in class 28

33. I find the applicant's goods in this class to be highly similar to the opponent's *Interactive games terminals*; and *Terminals for gaming* as are included in its specification in class 9 and identical to the opponent's *Electronic game apparatus for use online or offline* and *Console gaming devices* as is included in its class 28 specification.

The applicant's services in class 35

34. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

35. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

36. On the basis of the European courts' judgments in *Sanco SA v OHIM*¹, and *Assembled Investments (Proprietary) Ltd v. OHIM*², upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*³, Mr Hobbs concluded, however, that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
- iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
- iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

37. In *Frag Comercio Internacional, SL, v OHIM*, Case T-162/08, the GC held that a registration for 'retail services', which did not identify the kinds of goods covered by the services, was too vague to permit a proper comparison to be made between those services and the goods covered by the later mark. It was not therefore possible to determine that the respective services and goods were similar.

¹ Case C-411/13P

² Case T-105/05, at paragraphs [30] to [35] of the judgment

³ Case C-398/07P

38. The applicant's services in this class are online retail services "in relation to the sale of video and computer game hardware and software products". Taking the above case law into account I find them similar to a reasonable degree to, at least, the opponent's *Computer game software (in particular casino games); Interactive games terminals; Telecommunications terminals and multimedia terminals relating to games (in particular casino games)* as are included within its class 9 specification.

The applicant's services in class 38

39. I find the applicant's *Provision of access to internet platforms and portals for the purpose of online gaming; providing access to computer databases in the fields of computer and video games* to be highly similar to the *Terminals for gaming (in particular for casino games); Telecommunications terminals and multimedia terminals relating to games (in particular casino games); and Computer game software (in particular casino games)* as are included in the opponent's specification in class 9 and highly similar to the opponent's *Games offered on-line on a computer network; Organisation of games via the Internet, television, radio, mobile telephone and telecommunications systems* as are included within its specification in class 41.

40. I find the applicant's *transmission of videos, movies, pictures, images, text, photos, games, user-generated content, audio content, and information via the internet* to be reasonably similar to the opponent's *Apparatus for recording, transmission or reproduction of sound or images; in class 9 and Games offered on-line on a computer network; Organisation of games via the Internet, television, radio, mobile telephone and telecommunications systems* in class 41.

41. I find the applicant's *providing online forums and instant messaging services for communication in relation to gaming and online gaming* to be highly similar to, at least, the opponent's *Games offered on-line on a computer network; and telecommunications systems, relating in particular to games* as are included in the opponent's specification in class 41.

The applicant's services in class 41

42. I find the applicant's *Video game entertainment services; providing online computer and video games, providing online interactive computer games; internet*

games (non-downloadable); providing entertainment services in the nature of computer, video and electronic games; games services provided online from a computer network; providing online entertainment in the nature of game tournaments; games services provided via computer networks and global telecommunications networks; games services provided by means of communications by computer terminals or mobile telephone; games services provided via computer networks and global communication networks to be highly similar if not identical to, at least, the opponent's Games offered on-line via a computer network; Organisation of games via the Internet, television, radio, mobile telephone and telecommunications systems as are included within its class 41 specification.

43. I find the applicant's *rental of video games; rental of electronic games equipment, machines and apparatus; rental of computer game programs; amusement arcade gaming machine rental services* to be similar to a reasonable degree to the opponent's *Computer game software (in particular casino games); and Terminals for gaming (in particular for casino games)* in class 9, and the opponent's *Providing amusement arcade services; Games offered on-line on a computer network and Organisation of games via the Internet, television, radio, mobile telephone and telecommunications systems* in class 41 and highly similar if not identical to the opponent's *Providing of facilities for casinos and bookmakers for sports betting and sports forecasting, namely rental of gaming tables, slot machines and gaming accessories including cards and tokens* also in class 41.

44. The applicant's *providing information relating to online computer and video games; providing information online relating to computer games and computer enhancements for games; providing online information to game players about the ranking of their scores; providing online information on computer and video game strategies* I find to be reasonably similar at least to the opponent's *Consultancy and information relating to games, casino game competitions...entertainment, competitions; and Providing of assistance to players in the field of games* as are included with the opponent's specification in class 41.

45. I find the applicant's *provision of an online magazine featuring information in the field of computer games; and providing newsletters in the field of computer games via e-mail* to be identical to the opponent's *Publication of books, newspapers, periodicals and electronic media on the Internet or telecommunications systems, relating in particular to games* as is also included in its class 41 specification.

46. I find the applicant's *video game arcade services* to be included within and therefore identical to the opponent's *Providing amusement arcade services* in the same class.

47. I find the applicant's *computer and video game software publishing services* to be highly similar to the opponent's *Computer game software (in particular casino games); Computer program in class 9 and Publication of...electronic media on the Internet or telecommunications systems, relating in particular to games, competitions* as is included within the opponent's specification in class 41.

The applicant's services in class 42

48. Each of the applicant's services in this class I find to be at least reasonably similar to the opponent's *Computer game software (in particular casino games); Data processing software for information relating to games; Computer program; Telecommunications terminals and multimedia terminals relating to games (in particular casino games)* in class 9 and *Games offered on-line on a computer network* as is included in the opponent's specification in class 41.

The applicant's services in class 45

49. Each of the applicant's services in this class I find to be at least reasonably similar to the opponent's *Computer game software (in particular casino games); Data processing software for information relating to games; Computer program; Telecommunications terminals and multimedia terminals relating to games (in particular casino games)* in class 9 and *Games offered on-line on a computer network* as is included in the opponent's specification in class 41.

The average consumer and the nature of the purchasing process

50. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

51. 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.”

52. For most of the respective goods and services the average consumer will be a member of the public though some, such as *Providing of facilities for casinos and bookmakers* will clearly be bought by businesses in those fields. Yet others may be used by members of the public or businesses e.g. augmented reality software. Whether bought by members of the public or businesses, the goods and services are such as will be bought with an average degree of care. The goods and services are likely primarily to be a visual purchase, particularly those bought online, though the other aspects must not be ignored.

Comparison of the respective marks


53. 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.”

It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them.

54. The respective trade marks are shown below:

The earlier mark	The applications
	ROYAL CIRCUS (3176894) ROYAL CIRCUS GAMES (3176886)

55. Whilst the tittle of the letter “i” within it is presented in a contrasting colour to the remainder which adds to its distinctiveness and whilst the whole is presented in a slightly stylised font, the earlier mark clearly consists of the word CIRCUS presented in title case. This word forms the second of the two words making up application 3176894 and is preceded by the word ROYAL with both presented in plain block capitals. Application 3176886 has the additional, descriptive word GAMES as the third word making up the mark.

56. Referring to the stylisation in the earlier mark, the applicant submits that the respective marks are visually dissimilar. On an aural comparison, it submits “there is as much difference...as similarity” between the opponent’s mark and the applicant’s

mark ROYAL CIRCUS. In respect of its mark ROYAL CIRCUS GAMES it submits “there is an additional syllable of dissimilarity”.

57. The presence in each of the respective marks of the word CIRCUS leads to a degree of visual and aural similarity between them. There are also visual and aural differences between them due to the presence of the words ROYAL and, in the case of 3176886, the word GAMES which are absent from the earlier mark. Despite the presence of the additional word GAMES in one of the applicant’s marks, when considered as wholes, I find there is a medium degree of visual and aural similarity between each of the respective marks.

58. The applicant submits that each of its marks:

“will be read as a unit, which conveys the overall meaning of each mark. In this context, the word “ROYAL” has a dominant and distinctive role, signifying something “fine” or “excellent”. The average consumer will understand “ROYAL CIRCUS” in connection with computer games to mean first-rate computer game entertainment and amusement. The addition of the purely descriptive word “GAMES” does not change that conceptual comparison and the average consumer will understand “ROYAL CIRCUS GAMES” in the same way”.

59. The word CIRCUS is an ordinary dictionary word with a well-known meaning which will be brought to mind on seeing the earlier mark. In both of the applicant’s marks this same word is preceded by the word ROYAL. I see no reason why the average consumer would see this as “signifying something “fine” or “excellent””. Rather, the word is likely to be seen adjectively as referring in some way to monarchy. I consider the mark will bring to mind a circus with a connection to monarchy. To the extent that each of the respective marks bring to mind a circus, there is a medium degree of conceptual similarity between them.

The distinctiveness of the earlier EUTM

60. 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).”

61. Whilst the opponent has filed evidence, none of it refers to its use of the earlier mark. That being so, I have only its inherent distinctiveness to consider.

62. The applicant submits:

“...the word CIRCUS is ...very common in trade mark registrations with effect in the United Kingdom in relation to computer games and related goods and services and as such is of low inherent distinctiveness in relation to such goods and services. Presumably, this is a result of the fact that (as the Opponent correctly notes...) the word CIRCUS “evokes” “entertainment and amusement” and that games and gaming are also forms of entertainment and amusement.”

63. In support of these submissions, the applicant has filed evidence in the form of exhibit CN1 to the witness statement of Mr Campbell Newell who is a partner of Marks & Clerk, the applicant's professional representatives in these proceedings. The exhibit consists of what Mr Newell states is the result of a search carried out by him of the UKIPO, EUIPO and WIPO databases and takes the form of printouts from the various registers. This is "state of the register" evidence which does not assist for the reasons given in *Zero Industry Srl v OHIM*, Case T-400/06, where the GC stated:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71)."

64. At CN2, the applicant exhibits a number of printouts of pages from the website ebay.co.uk as evidence of what it claims is "the widespread use of the word "CIRCUS" in connection with computer games" and submits that:

"Consumers ... are used to seeing such goods and services being offered by different undertakings under various trade marks incorporating the weakly distinctive element "CIRCUS"; and to distinguishing such goods and services from one another based on the additional distinguishing features of the respective marks".

65. Each of the sixteen printouts advertise the sale of various computer games and date from April 2017 which is after the relevant date. The games shown, are each stated to be used which indicates they are second-hand sales. I do not consider this evidence assists the applicant either.

66. The fact that the opponent's mark has been registered means that it must be considered to have a least some distinctive character (see: *Formula One Licensing BV v OHIM C-196/11P*). As I indicated above, the earlier mark consists of an ordinary dictionary word, presented in a slightly stylised font and with the title of the letter "i" in a contrasting colour. For some of the goods and services, e.g. *Mechanisms for coin-operated apparatus* the word has no meaning and is of average distinctiveness. For others, e.g. *Production of films, television programmes and reports (entertainment), in particular in the field of sports, games, competitions, lotteries, sports betting and sports forecasting*, which, given that the use of "in particular" does limit the services to the particular areas specified, would include the production of films and television programmes etc. relating to circuses, the earlier mark would have a low degree of inherent distinctiveness.

The likelihood of confusion

67. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. 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. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the earlier trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and 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 he has retained in his mind.

68. Earlier in this decision I found:

- Each of the applicant's goods and services to be at least similar to the goods and services of the earlier mark;

- The average consumer for the goods and services will be a member of the public, or a business or both;
- The purchase of the goods and services will be primarily a visual one, particularly where bought online, though the other aspects must not be ignored;
- There is a medium degree of visual, aural and conceptual similarity between each of the respective marks;
- The inherent distinctiveness of the earlier mark varies from low to average depending on the goods and services concerned. There is no evidence that the inherent distinctiveness of the earlier mark has been enhanced through its use.

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

70. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. 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 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).”

71. I do not consider the average consumer, on seeing the respective marks, would directly confuse them. I do consider, however, that there is a likelihood of indirect confusion, the word ROYAL being likely to be seen as a specific sub-brand having a certain style or as a brand extension. That being the case, the opposition succeeds in respect of all goods and services for which the application was made.

Summary

72. The opposition succeeds in full.

Costs

73. The opponent, having succeeded, is entitled to an award of costs in its favour. Taking into account these are consolidated proceedings, I make the award on the following basis:

For preparing the notices of opposition and considering the counterstatements:	£300
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Evidence:	£500
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Preparations for and attendance at the hearing:	£500
Fees:	£200
Total:	£1500

74. I order Royal Circus Limited to pay Circus Belgium SA the sum of £1500. This sum is to be paid with fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of September 2017

Ann Corbett

For the Registrar

The Comptroller-General