

**O-063-21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
UK TRADE MARK REGISTRATION NO. 3365957  
IN THE NAME OF HONG KONG NETEASE INTERACTIVE ENTERTAINMENT  
LIMITED:**

# **Rangers of Oblivion**

**IN CLASSES 9 AND 41  
AND  
AN APPLICATION FOR A DECLARATION OF INVALIDITY  
UNDER NO. 503025 BY ZENIMAX MEDIA, INC.**

## **Background and pleadings**

1. Trade mark registration number 3365957 **Rangers of Oblivion** (“the contested mark”) stands registered in the name of Hong Kong NETEASE Interactive Entertainment Limited (“the proprietor”). The application for the trade mark was filed on 10 January 2019 and the mark was registered on 3 May 2019 in respect of the following goods and services:

Class 9: Computer game software; Computer game discs; Downloadable computer game programs; Computer game software downloadable from a global computer network; Electronic game software for wireless devices; Interactive multimedia computer game programs; Recorded computer game programs; Electronic game software for hand-held electronic devices; Virtual reality game software; Augmented reality game software; Electronic game software for mobile phones; Animated cartoons; excluding game programs and software for games principally featuring vehicles.

Class 41: Entertainment services, namely, providing on-line computer games; Providing computer games that may be accessed via a global computer network; Providing information on-line relating to computer games and computer enhancements for games; Electronic games services provided by means of the internet; Organization of competitions [education or entertainment]; Providing on-line electronic publications, not downloadable; Providing online entertainment in the nature of game shows; Game services provided on-line from a computer network or mobile phone network; Game services provided by means of communications by computer terminals or mobile telephone; Information relating to computer gaming entertainment provided online from a computer database or a global communication network; Providing online virtual reality games; Providing online augmented reality games; excluding services related to games principally featuring vehicles.

2. On 7 February 2020, ZeniMax Media, Inc. (“the applicant”) filed an application for a declaration of invalidity under the provisions of s. 47 and s. 5(2)(b) of the Trade Marks

Act 1994 (“the Act”). The applicant relies upon its European Union trade mark number 14914162 **OBLIVION**. The trade mark was filed on 16 December 2015 and was registered on 22 April 2016 in respect of the following goods, all of which are relied upon:

Class 9: Pre-recorded cd's, audio cassettes, video tapes, laser disks and dvd's featuring fantasy games; pre-recorded cd's, audio cassettes, video tapes, laser disks and dvd's featuring music; motion picture films; computer game programs downloadable from a global computer network; computer game software for use with computers and video game consoles; downloadable computer game software offered via the internet and wireless devices; computer game software for use with on-line interactive games.

3. The applicant claims under s. 5(2)(b) that the contested mark is similar to the earlier mark because the similarity between the marks and the identity or similarity between the respective goods and services will lead to a likelihood of confusion, including the likelihood of association.

4. The proprietor filed a counterstatement denying the grounds of invalidation. In particular, it denies that the marks are similar.

5. Given its date of filing, the applicant’s trade mark qualifies as an earlier mark in accordance with s. 6 of the Act.<sup>1</sup> As it had not completed its registration procedure more than 5 years before the date of the application for invalidation, the applicant’s trade mark is not subject to the proof of use provisions contained in s. 47(2A) – (2E) of the Act. That being the case, the applicant may rely upon all of the goods identified without showing that its trade mark has been used.

6. Neither party filed evidence, though both parties filed submissions during the evidence rounds, which I will bear in mind and refer to as appropriate. A hearing was held before

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<sup>1</sup> Although the UK has left the EU and the EUTM relied upon by the applicant now enjoys protection in the UK as a comparable trade mark, the EUTM remains the relevant right in these proceedings. That is because the application was filed before the end of the Implementation Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the application on the basis of the rights as they existed at the date on which invalidation proceedings were launched.

my, by videoconference, on 14 December 2020, at which the applicant was represented by Charlotte Blythe of counsel, instructed by DLA Piper UK LLP. The proprietor, who is represented by Urquhart-Dykes & Lord LLP, chose not to attend the hearing.

### **Preliminary issue**

7. The applicant initially relied upon three earlier trade marks but dropped its reliance on two of them in the course of proceedings.<sup>2</sup> All of the goods and services of the contested mark were subject to attack under the three marks together but, insofar as the application for invalidation was based upon EU14914162, the form TM26(I) indicates that the challenge was directed only at the goods in class 9 of the registration. In her skeleton argument and at the hearing, Ms Blythe stated that the applicant had intended to continue to challenge the totality of the contested mark's specification, despite dropping its reliance on the other trade marks originally pleaded. Consequently, the applicant sought amendment of the pleadings to indicate that the application under EU14914162 was directed against all of the goods and services in the contested trade mark's specification. In Ms Blythe's submission, it appeared that the proprietor had "like the Cancellation Applicant, [been] operating under the mistaken belief that the cancellation continued to relate to the totality of the Contested Goods and Services".<sup>3</sup> In support, she pointed to the proprietor's written submissions and its comments on the comparison of goods and services, which refer to the services in the "Challenged Registration".<sup>4</sup> Further, Ms Blythe noted that her skeleton argument had been served on the proprietor on 10 December 2020 and that the proprietor had not objected to the requested amendment in the intervening period.

8. Whilst it was very late in proceedings for a request to expand the scope of the invalidation, there was no request from the applicant to file any evidence. The applicant's submissions of 28 July 2020, in which reliance on the other two marks was dropped, include submissions on the comparison between its goods in class 9 and the proprietor's

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<sup>2</sup> Applicant's submissions dated 28 July 2020; see also applicant's skeleton argument §4.

<sup>3</sup> Skeleton argument, §5.

<sup>4</sup> Proprietor's submissions, §4.

services in class 41, whilst the proprietor's written submissions of 28 September 2020 also offer its views on the similarity of its services in class 41 to the earlier goods: it does indeed appear that both parties were operating under the same misapprehension throughout the proceedings. Further, the proprietor had a full working day between receipt of the skeleton argument on a Thursday and the hearing the following Monday had it wished to object or request a further opportunity to file additional submissions, either in writing or by arranging to attend the hearing to voice its concerns. It did not do so. In the particular circumstances of this case, where no material prejudice to the proprietor had been identified and taking into account the desirability of avoiding multiple proceedings, I considered it reasonable to allow the amendment.

### **Section 5(2)(b)**

9. Section 5(2)(b) of the Act reads as follows:

“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”.

10. Although the UK has left the EU, section 6(3)(a) of the European (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 make reference to the case law of the EU courts on trade mark matters. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case

C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*, Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

(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 will wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

11. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

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

(a) The respective uses of the respective goods or services;

- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

13. 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”.



14. A further factor which must be taken into account is whether there is a complementary relationship between the respective goods and/or services. In *Kurt Hesse v OHIM*, Case C-50/15 P, EU:C:2016:34, it was explained by the CJEU 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, EU:T:2009:428, the General Court (“GC”) stated that “complementary” means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

15. It is also clear that there may be a complementary relationship between goods on the one hand and services on the other, even where the nature and purpose of the respective goods and services is very different: *Sanco SA v OHIM*, Case T-249/11.

16. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the 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 where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

## Class 9

*Computer game software; Downloadable computer game programs; Computer game software downloadable from a global computer network; Electronic game software for wireless devices; Interactive multimedia computer game programs; Recorded computer game programs; Electronic game software for hand-held electronic devices; Virtual reality*

*game software; Augmented reality game software; Electronic game software for mobile phones; excluding game programs and software for games principally featuring vehicles*

17. These goods are identical to the earlier “computer game software for use with computers and video game consoles”, “downloadable computer game software offered via the internet and wireless devices” and/or “computer game software for use with on-line interactive games”, either because they are different terms for the same goods or on the basis of the inclusion principle outlined in *Meric*.

*Computer game discs; excluding game programs and software for games principally featuring vehicles*

18. The earlier specification includes “pre-recorded laser disks and dvd’s featuring fantasy games”. These goods are identical under *Meric*.

*Animated cartoons; excluding game programs and software for games principally featuring vehicles*

19. Ms Blythe submitted that these goods are at least complementary to computer games, as computer games often have, for example, computer-animated landscapes and characters. Further, she submitted that an animated cartoon for, for example, a DVD would be considered the responsibility of the same undertaking. The proprietor pointed to “animated films” as goods which might be distinguished.

20. The *Collins English Dictionary* defines an animated cartoon as “a film produced by photographing a series of gradually changing drawings, etc, which give the illusion of movement when the series is projected rapidly”.<sup>5</sup> That accords with my own understanding of the term. There is, therefore, a difference in purpose between animated cartoons and computer games because while both are intended for entertainment in the broadest sense, one would typically present a complete story and the other is designed for interaction from the player. Consequently, although both are viewed on screen there is a difference in their methods of use. There is some similarity in nature because both

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<sup>5</sup> <https://www.collinsdictionary.com/dictionary/english/animated-cartoon> [accessed 15 January 2021].

are in digital form and computer games, especially though not exclusively games for children, may be very similar in appearance, if not function, to a cartoon. Users may also intersect. The goods are not in competition and any overlap in channels of trade is likely to be superficial: the goods are likely to be in different areas of physical premises or different categories online. As to complementarity, whilst animation may be important or essential to a computer game, an animated cartoon is not: they are not complementary. These goods are similar to a low degree overall.

#### Class 41

*Entertainment services, namely, providing on-line computer games; Providing computer games that may be accessed via a global computer network; Electronic games services provided by means of the internet; Game services provided on-line from a computer network or mobile phone network; Game services provided by means of communications by computer terminals or mobile telephone; Providing online virtual reality games; Providing online augmented reality games; excluding services related to games principally featuring vehicles*

21. These services are different in nature from the earlier “computer game programs downloadable from a global computer network” and/or “downloadable computer game software offered via the internet and wireless devices”. There is, however, a significant similarity of purpose because both enable the customer to play computer games. There may be some difference in method of use, insofar as the way of delivering the games platform (via disc or by download/stream) is different, though the game play itself will be the same. Users are identical, the goods and services may be in competition (i.e. there may be a direct purchasing choice between a physical copy of the game and the online service) and there is likely to be an overlap in channels of trade. Further, the relationship between computer games and the service which makes them available digitally to users is a complementary one in the sense defined in the case law: computer games are essential for the provision of an online gaming service and the user may think that the goods and services are provided by the same undertaking. These goods and services are similar to a high degree.

*Providing information on-line relating to computer games and computer enhancements for games; Information relating to computer gaming entertainment provided online from a computer database or a global communication network; Providing on-line electronic publications, not downloadable; excluding services related to games principally featuring vehicles*

22. Ms Blythe submitted that computer games provided online are commonly, if not always, accompanied by the provision of information about the game, such as how it works, the rules and the controls. There is no evidence to that effect but I accept that a provider of computer games/game software may at least make available information regarding, for example, how points or weapons are accumulated or what the user must do to deploy them in a user guide, however brief. Whilst the goods and services differ in nature and purpose and there is no competition, there is potential for an overlap in both users and channels of trade. There is also a degree of complementarity, as the nature of the relationship between computer games/software and the provision of information and publications regarding those goods is sufficiently close that the consumer may consider the goods and services to be the responsibility of the same undertaking. These goods and services are similar to a medium degree.

*Organization of competitions [education or entertainment]; excluding services related to games principally featuring vehicles*

23. The above services are wide enough to include competitive computer game events. The nature of these services differs from computer games programs/software, as does their exact purpose: although both are for entertainment, a computer game is for playing by the consumer, whilst a competition is organised for entertainment understood more broadly. The goods and services are not competitive but users may overlap and there may be complementarity, games being important for the competitions and potentially being perceived as the responsibility of the same undertaking. These goods and services are similar to a medium degree.

*Providing online entertainment in the nature of game shows; excluding services related to games principally featuring vehicles*

24. Ms Blythe submitted that these services encompass the provision of “a game show by way of an online computer game”. The difficulty I have with this submission is that a “game show” is typically a television programme in which contestants play against one another, often for a prize.<sup>6</sup> The competition may take different guises, such as a quiz or a physical challenge, or both, but it does not seem to me that a game show would ordinarily have any connection to computer games. Nor does it seem likely to me that an online computer game would be understood by the average consumer as a game show. On that construction, the only point of similarity, and it is a superficial one, is users. These goods and services are not similar. As there must be some similarity between the goods and services for there to be confusion,<sup>7</sup> the application for invalidation is dismissed insofar as it concerns “Providing online entertainment in the nature of game shows; excluding services related to games principally featuring vehicles”.

**The average consumer and the nature of the purchasing act**

25. It is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: *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) at [60]. For the purposes 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/services in question: *Lloyd Schuhfabrik*.

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<sup>6</sup> The definition in *Collins* accords with this understanding: see <https://www.collinsdictionary.com/dictionary/english/game-show> [accessed 18 January 2021]

<sup>7</sup> *Waterford Wedgwood plc v OHIM*, C-398/07 P, EU:C:2009:288 at [34].

26. I have no submissions from the proprietor regarding the average consumer. Ms Blythe submitted that the average consumer is the public at large, who will pay a moderate level of attention to detail, and that both visual and aural considerations will play a role.

27. The goods and services are ordinary consumer items for whom the average consumer is a member of the general public. Whilst not everyday purchases, the goods and services may be bought or used with some frequency. The consumer will be careful to select, for example, the correct title, or may be attentive to factors such as age restrictions and compatibility with his/her particular game system. I acknowledge Ms Blythe's submission that computer games may be available on a "freemium" pricing structure, where the game or app is cheap or free but additional characters and bonus features can be purchased. However, this will not apply across the board, nor will it negate the other considerations already identified; the goods and services are, however, unlikely to be particularly expensive. The average will pay a medium degree of attention to the selection of the goods and services.

28. For all of the goods and services, visual considerations will dominate. Goods are likely to be selected after a visual inspection of the product on shelves in retail premises or their online equivalents. Consideration of websites is likely to play a major part in the selection of the services at issue; the consumer may also be exposed to the marks by way of advertising material in print or online. There may be an aural element to the purchase of the goods and services, which may be chosen following oral recommendations or, as Ms Blythe points out, with the consumer having heard the goods/services discussed in reviews.

### **Comparison of trade marks**

29. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel* (particularly paragraph 23). *Sabel* 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 *Bimbo*, 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”.

30. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

<b>Earlier mark</b>	<b>Contested mark</b>
OBLIVION	Rangers of Oblivion

31. The earlier mark consists of the word “OBLIVION”. The overall impression of the mark is contained in the single word “OBLIVION” of which it consists.

32. The contested mark consists of the words “Rangers of Oblivion”. Whilst I acknowledge the applicant’s position that “Oblivion” is the most distinctive element, my view is that no one element of the mark is dominant over the others and the words form a grammatically correct phrase which will be perceived as a unit. The overall impression resides in the unit.

33. The proprietor submits that there is no overall similarity between the respective trade marks and referred me to an earlier decision of this tribunal concerning the mark “DOOM”

on the one hand and “TOWER OF DOOM” on the other.<sup>8</sup> In that decision, the hearing officer held that despite there being some visual similarity there was no overall similarity between the marks, a finding which was not reversed on appeal. However, whilst I have read both decisions, previous decisions of this tribunal are not binding on me, nor are they of particular persuasive value. Nor does the upholding of a finding of fact by the Appointed Person mean that I am obliged to find that there is no similarity between the marks at issue in the instant proceedings: I must carry out my own analysis of the marks, bearing in mind all of the relevant factors.

34. In the instant case, both marks share the word “Oblivion”, which is the whole of the earlier mark and the third word of the contested mark. The presence of the words “Rangers of” in the contested mark are an obvious point of both visual and aural difference. Whilst the identical word is at the end of the contested mark, typically a position of lesser impact, the construction is such that the words “Rangers of” qualify the word “Oblivion” and, at eight letters and four syllables, “Oblivion” is a relatively long word which remains significant in the context of the mark as a whole. The differences in case in the respective marks are not relevant because both trade marks are registered as word marks and, accordingly, may be presented in upper, lower or title case in the course of normal and fair use. I find that the marks are both visually and aurally similar to a medium degree.

35. The parties are agreed that “oblivion” may mean:

- (a) The state of not being aware of what is happening around you, for example because you are asleep or unconscious;
- (b) The state of having been forgotten or of no longer being considered important;
- (c) In the context of something blasted or bombed into oblivion, completely destroyed.<sup>9</sup>

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<sup>8</sup> BL O/173/10 and appeal decision O/168/11.

<sup>9</sup> Counterstatement, §6 and skeleton argument §16, citing <https://www.collinsdictionary.com/dictionary/english/oblivion>.



36. There is also no real disagreement between the parties as to the meaning of the contested mark: the applicant submits that it will “bring to mind the idea of an armed soldier patrolling or policing an area that has been forgotten or destroyed”; the proprietor submits that it “would most likely be understood to reference a troop or protector defending against a place being attacked or destroyed completely”. My view is that the applicant’s interpretation is marginally to be preferred, as “Rangers of Oblivion” more naturally reads as the troops being from, or intent on, “oblivion” rather than protecting somewhere from falling into such a state. The contested mark includes the concept of troops or soldiers which is absent from the earlier mark but both contain the concept of “oblivion”. The marks are conceptually similar to a medium degree.

### **Distinctive character of the earlier trade mark**

37. 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 *WindsurfingChiemsee 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)".

38. As there is no evidence, there is only the inherent position to consider. The applicant submits that the earlier mark is highly distinctive. Whilst I accept that "OBLIVION" is a word without connection to the goods for which the mark is registered and that it is not perhaps a word used every day, it remains a normal English word whose meaning will be well known. It is inherently distinctive to a medium degree.

### **Likelihood of confusion**

39. In determining whether there is a likelihood of confusion, all of the above factors need to be borne in mind. They must be considered globally (*Sabel* at [22]), from the perspective of the average consumer. In making my assessment, I must keep in mind 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 (*Lloyd Schuhfabrik* at [26]). The factors considered above have a degree of interdependency (*Canon* at [17]): for example, 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.

40. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the

later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

41. In *Eden Chocolat Trade Mark*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. This is mere association not indirect confusion.

42. There are significant visual, aural and conceptual differences between the trade marks which are sufficient to avoid any risk of direct confusion, irrespective of the level of similarity between the goods and/or services. However, even though the average consumer will notice the differences, there is a likelihood of indirect confusion. The construction of the contested mark is such that “Oblivion” is an important part of the trade mark, even if it is not the single dominant element, which is qualified by the additional words. This and the resulting levels of similarity between the marks, taken with the distinctiveness of the earlier mark, will lead to a likelihood of indirect confusion even where there is only a low degree of similarity between the goods and/or services: the average consumer is likely to think that the contested mark is a brand extension of the earlier mark and that its use is by the applicant or by an economically connected undertaking.

43. The applicant also relied on the principle derived from *Medion* that there would be a likelihood of confusion on the basis that “Oblivion” is an independent distinctive element in the later mark. It will not improve the applicant’s case if I consider this alternative basis as *Medion* is no remedy for a lack of confusion because of dissimilarity between goods and services. I decline to do so.

## **Conclusion**

44. The application for invalidation has succeeded in part. The trade mark is declared invalid with effect from 10 January 2019 for all of the goods and services for which it is registered, save “providing online entertainment in the nature of game shows; excluding services related to games principally featuring vehicles” in class 41, for which the registration stands.

## **Costs**

45. The applicant has been largely successful and is entitled to an award of costs. I see no reason to depart from the normal Registry scale, contained in Tribunal Practice Notice 2/2016. I award costs to the applicant as follows:

Official fee:	£200
Filing the application and considering the counterstatement:	£200
Preparation for and attendance at a hearing:	£600
Total:	£1,000

46. I order Hong Kong NETEASE Interactive Entertainment Limited to pay ZeniMax Media, Inc. the sum of **£1,000**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 27<sup>th</sup> day of January 2021**

**Heather Harrison  
For the Registrar  
The Comptroller-General**