

O/0171/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3587075

BY HYPER DOT STUDIOS LIMITED

AND

OPPOSITION THERETO

UNDER NO. 425235

BY TAKE-TWO INTERACTIVE SOFTWARE, INC.

Background and pleadings

1. The trade mark at issue in these proceedings is trade mark application number 3587075 for the trade mark shown below (“the contested mark”):



2. The application for the contested mark was filed on 29 January 2021 (“the relevant date”), in the name of Hyper Dot Studios Limited (“the applicant”). The application was published for a range of goods and services in classes 9, 28, 35 and 41, which are set out in full in the appendix to this decision.

3. The application is opposed by Take-Two Interactive Software, Inc. (“the opponent”) under ss. 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under each of these grounds, the opposition is directed against all of the goods and services in the application.

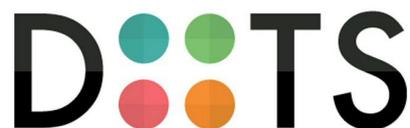
4. The opponent relies upon two earlier trade marks for its grounds under ss. 5(2)(b) and 5(3):

Trade mark	Relevant dates	Specification relied upon
UK801315456 (“the ‘DOTS & CO’ mark”) “DOTS & CO”	Priority date: 22 July 2016 Registration date: 20 March 2017	Class 9: Computer game software; computer game software for use on mobile devices
UK801179691 (“the figurative mark”) 	Priority date: 15 May 2013 Registration date: 3 June 2015	Class 9: Computer game software; computer game software for use on mobile devices

5. The opponent claims that there is a high degree of similarity between the trade marks and between the goods and services, which will give rise to a likelihood of confusion. Accordingly, it says that the application should be refused under s. 5(2)(b).

6. The opponent alleges that the earlier trade marks have a reputation for all of the goods for which they are registered. It says that the similarity between the trade marks will cause the average consumer to believe that there is an economic connection between the users of the trade marks when no such connection exists. It also claims that the contested trade mark will free ride on the reputation of the earlier mark, gaining an unfair advantage, that the reputation of the earlier marks for high quality will be damaged through tarnishing and that the distinctive character of the earlier marks will be eroded through use of the contested mark. The application should, therefore, be refused under s. 5(3).

7. In addition, the opponent claims that it has used the sign “DOTS & CO” in the UK since 20 July 2016 in respect of “computer game software, computer game software for use on mobile devices”. It says that it has used the figurative sign (“the figurative sign”) shown below for the same goods since 30 April 2013:



8. The opponent’s case is that its use of the signs has generated a protectable goodwill and that use of the contested mark will give rise to a misrepresentation, resulting in damage through loss of sales, tarnishing of the opponent’s reputation or erosion of the distinctive character of the signs. Consequently, the application should be refused under the provisions of s. 5(4)(a).

9. The applicant filed a counterstatement denying the claims. It put the opponent to proof of use of the figurative mark and to proof of its reputation and goodwill. Although the applicant accepts that some of the goods and services are identical or similar, it denies that there is any similarity between the respective trade marks. It claims that the earlier marks only have a low degree of distinctive character. Accordingly, it says that there is no likelihood of confusion or misrepresentation, nor will damage or detriment arise.

10. Both parties filed evidence. A hearing was requested and held before me, by video conference, on 25 October 2022. The applicant was represented at the hearing by

Christopher Hall of counsel, instructed by Briffa; the opponent was represented by Leighton Cassidy of Fieldfisher LLP.

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

Evidence

12. The opponent's evidence is provided by David Harris, Director and Counsel of the opponent. Mr Harris provided two witness statements, the second in reply to the applicant's evidence. Mr Harris's evidence concerns the use which has been made of the earlier marks.

13. The applicant's evidence is provided by Xinyu Qian, a director of the applicant. There is a little evidence about how the opponent uses its marks and concerning the use of "dot" and "dots" in the gaming field.

14. I have read all of the evidence and will return to it to the extent I consider necessary. Both of the witnesses included submissions in their statements. I will bear these in mind. Neither witness was cross-examined.

Proof of use

15. The relevant part of the Act reads as follows:

"6A

(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

16. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union.”

17. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

18. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*

[2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising

campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at

[39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

19. The “DOTS & CO” mark had not been registered for five years at the relevant date. The opponent does not have to prove use of this mark and may rely on the full specification. In contrast, the figurative mark is caught by the proof of use provisions. The relevant period for showing use of the figurative mark is 30 January 2016 to 29 January 2021 (“the relevant period”).

20. The opponent acquired Playdots, Inc, the previous owner of the earlier trade marks, on 4 September 2020 and the registered trade marks were assigned on the same date.¹ Playdots, Inc. was founded in 2013 or 2014 (the evidence is unclear).² No issue was taken with the chain of title or with the ownership of any goodwill, so I need not address this further. I will distinguish between the opponent and its predecessor in title only where it is necessary.

21. A game for mobile phones offered under the figurative mark was shown on the opponent’s website <http://weplaydots.com> from August 2013.³ For convenience, I will refer to this as the “Dots” game. The “Dots” game, with the figurative mark, is visible on archive prints from the replacement website, www.dots.co, in 2017 and 2018; a 2016 print is missing the image but, in view of the evidence from later in the relevant period, as well as before that period, it is likely that this is a loading error.⁴ The “Dots” game is described as a “minimalist game”. It was number 1 in the UK charts in August 2013.⁵ It is said that there have been nearly 50,000 unique visitors and 65,000 hits from the UK on www.dots.co, around 6% of the total.⁶

¹ Harris 1, §§1, 8; exhibits DH1, DH3.

² Harris 1, §4, DH6.

³ Harris 1, §12; DH4.

⁴ DH4.

⁵ Harris 1, §35; DH14.

⁶ Harris 1, §24; Harris 2, §16.

22. The “Dots” game has been available on amazon.co.uk since August 2013 and by November 2021 it had 1,271 reviews.⁷ 130 of these were in 2013 and from the UK.⁸ The figurative mark is visible on the main product page. The game was also available on both the Apple and Google Play app stores in at least 2017-2018 and in June 2020, when it was reviewed.⁹ The figurative mark is not visible on the Google Play print, which shows the game has been reviewed over 300,000 times. This does not appear to be a UK-specific site. The figurative mark can be seen on a screenshot from the game in an archive print from app.apple.com/gb in 2019, where the mark has 26 ratings.¹⁰

23. Prints from social media dated between July 2016 and August 2020 show Twitter posts from “Dots” (handle “@dots”) but no use of the figurative mark as registered.¹¹

24. There are eleven articles dated in the relevant period.¹² They are mainly about the “Dots & Co” game’s release, though most of these also reference “Dots” in passing. An article from www.forbes.com says that “Dots” is a “global phenomenon”. This appears to relate to the company rather than the brand under the figurative mark (which is not shown) but the article does say that the US and UK are its top two markets. Mr Harris says some of these articles appeared on UK gaming websites but does not specify which articles or which UK websites. An article from www.pocketgamer.com uses the UK spelling of “colour”. An article from *Mint* also uses the UK spelling but is authored from New Delhi. The remainder either use the US spelling, refer to buying add-ons in dollars or are neutral (e.g. have “.com” domain names). There is no evidence about the UK reach of any of these sites.

25. There are two articles from dots.co dated 2017 which refer to the “Dots” and “Dots & Co” games but the articles themselves are about films.¹³ The first film will be available on the opponent’s website, the second will be released in Miami. There is nothing to indicate UK showings.

⁷ Harris 1, §16; DH7. DH16 gives later figures.

⁸ Harris 2, §8.

⁹ DH4; DH7.

¹⁰ See also DH15 (dated 2022).

¹¹ DH12.

¹² DH10B, DH20, DH21.

¹³ DH9.

26. The opponent has spent in excess of USD 3.5 million on advertising “the Dots series of games” in the UK.¹⁴ The figures are not broken down as between the marks or by year.

Use of the mark as registered or an acceptable variant

27. In terms of the form of the mark which has been used, it is apparent from the evidence that the mark as registered appeared on the opponent’s own website in the relevant period. The evidence from Amazon, Google Play and the Apple app store shows that some screenshots of the game were visible on the game’s page, which included images of the mark as registered.

28. There are some additional uses of forms of “DOTS”. On the abovementioned application sales platforms, the game was primarily identified as follows (the image is from the Apple store but is representative of all three):



29. I do not consider such use, or use of either the device or the plain word “Dots” alone, to be acceptable variant use of the registered mark. The law on use of variant forms was considered recently in *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22. The Appointed Person said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

¹⁴ Harris 1, §27.

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

30. In my view, the device of four dots which forms the “o” of the registered mark makes a significant contribution to the distinctiveness of the trade mark. Similarly, the

fact that the registered mark is a stylised representation of the word “DOTS” will not be missed by the average consumer. The omission of either the stylised letter “o” or the plain letters “D”, “T” and “S” is an alteration which changes the distinctive character of the trade mark.

31. The applicant ran an argument at the hearing that the use made by the opponent is not use as a trade mark, because the figurative mark is the title of a game. It relies principally on the Dr No case (*Danjaq LLC v OHIM*, T-435/05, EU:T:2009:226) by analogy. The argument goes that if the title of a single film, book or play cannot be use as a trade mark, by extension the name of a single game is not trade mark use either. It is not an unattractive argument but I do not accept it. There is no bar preventing the titles of games from being trade marks. It depends on the facts of the case (as indicated in *Danjaq*). The question is not whether the figurative mark could be used as a trade mark but whether the mark has in fact been used as a trade mark. I see no reason why the fact that there has only been one game under that mark means that the use does not guarantee the commercial origin of the goods. Although dots are plainly a component of the game, the mark incorporates a figurative device and I do not think the average consumer would view it as wholly descriptive of the game, denoting a characteristic of the goods rather than indicating trade origin.

Sufficient use

32. I now turn to the question of sufficiency of use. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, BL O/404/13, Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors.

The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

33. The evidence regarding the number of downloads is not satisfactory. In his first witness statement, Mr Harris said that the “Dots series of games” (i.e. “Dots”, “Two Dots” and “Dots & Co”) had been downloaded at least 80 million times by 2020.¹⁵ In reply, Mr Qian characterised the 80 million figure as “seemingly high” but “unhelpful”, as it did not show use or reputation in respect of each of the opponent’s marks. This is what Mr Harris said in response:

“I agree [...] that the number of downloads of all three of [the opponent’s] Dots games (80 million) is high, and the UK reliably represents a significant portion of the franchise’s high download numbers. From July 2018 through December 2021, the UK accounted for over 3 million downloads, over 4% of the franchise’s

¹⁵ Harris 1, §17.

global numbers, and second only to the United States. In 2021 alone, the UK accounted for over 1.5 million downloads, nearly 6% of the franchise’s more than 25 million downloads (I refer you to the table at paragraph 15 below)—and it should be noted that this figure reflects only new downloads in that period, not regular users/players. These numbers, both in terms of absolutes and percentages, clearly demonstrate the significant use, goodwill and reputation that [the opponent] enjoys in its Dots games in the UK.”¹⁶

34. The table Mr Harris is referring to is reproduced below. He prefaces it by saying that it is a response to Mr Qian questioning the absence of download figures specifically for the “Dots” game. Mr Harris says that the figures he gives are for “UK downloads and revenue per year for the Dots game”:

Year	Total UK downloads	Revenue (USD)
2018 (July-December)	200,000	725,000
2019	575,000	2,000,000
2020	875,000	2,000,000
2021	1,500,000	1,900,000
Total:	3,100,000	6,800,000

35. The difficulty is this: Mr Harris’s comments regarding UK downloads relative to global downloads appear to be concerned with the size of the UK business for all three marks/games rather than downloads for the figurative mark alone. Yet the same table is said to show download figures just for the figurative mark. The figures in the table correspond to the number of total UK downloads Mr Harris refers to four paragraphs earlier. Read in context, including Mr Qian’s comments, it seems to me inherently more likely that Mr Harris’s evidence about the UK downloads as a proportion of the global figures is concerned with all three games as he says (all of which had been released by 2018),¹⁷ not just the business attributable to the figurative mark. This is lent support

¹⁶ Harris 2, §11.

¹⁷ See Harris 1, §§11,13-14.

by the fact that Mr Harris refers a second time to UK downloads in his evidence, saying, “Since [the opponent’s] Dots games have been downloaded well over 3 million times by UK users [...]”.¹⁸ All of this suggests that the download figures included in the table are not reliable as evidence for the figurative mark alone.

36. Given the importance of the download figures in establishing genuine use, I have looked for proof to the contrary elsewhere. The figure of 80 million downloads to 2020 does not assist because there is no start date, absent which it is as likely as not that the number reflects total downloads since the first game was released in 2013. Mr Harris gives figures for UK sales and revenue of both the “Two Dots” and “Dots & Co” games. For the “Two Dots” game, they are:

Year	Total downloads	Revenue (USD)
2018	185,000	700,000
2019	545,000	2,000,000
2020	850,000	2,000,000
Total	1,585,000	4,700,000

37. The figures for the “DOTS & CO” mark are:

Year	Total downloads	Revenue (USD)
2018	20,000	24,000
2019	29,000	25,000
2020	26,000	22,000
Total	75,000	71,000

38. If Mr Harris has given accurate figures for the figurative mark, this would mean that the original version of the game outstripped the performance of later versions, very

¹⁸ Harris 2, §13.

significantly in the case of the “Dots & Co” game. That strikes me as rather surprising. However, there is some evidence that the “Dots” game was downloaded more often, in the form of a report of a single page about performance of certain mobile applications in October 2021.¹⁹ There were more downloads of the “Dots” game (the mark shown is not the figurative mark) than “Dots & Co”, whilst the “Two Dots” game was marked “inactive”. That said, the report also shows 7,000 downloads in October 2021. This appears to be a figure covering the 101 countries in which the game is available. Even if all 7,000 downloads were in the UK, downloads in the other eleven months of the year would have to be vastly greater than this to reach the 1.5 million UK downloads claimed for the game in 2021. Mr Harris’s evidence, quoted above, that the UK accounts for approximately 4-6% of the opponent’s business (which is consistent with his evidence that 6% of visitors to the www.dots.co site were from the UK) would mean that in reality in October 2021 there were, at best, only 420 downloads in the UK. Absent evidence of, for example, an advertising push, 1.5 million downloads of the “Dots” game in 2021 is improbable. There is also some conflicting evidence showing that the “Dots” game was not, at least by August 2020, the most popular game: that title is given to “Two Dots”, though once again this is not obviously a reflection of the UK position.²⁰

39. Deducting the figures given for the “Two Dots” and “DOTS & CO” games from the figures in the table at paragraph 34, above, does not assist either. The 2018 figures cannot be compared because the 2018 figures in the table at paragraph 34 are only for the half year. The figures for 2019 and 2020 are nearly the same, added together, as the figures in the table for the figurative mark. There is a discrepancy of over USD20,000 for the revenue figures but a difference of only 1,000 downloads (plus and minus) in 2019 and 2020. The download discrepancy is a tiny percentage of the total, particularly as the figures are rounded. The total revenue difference of USD47,000 is less than one percent of the total for 2019/2020, and only a slightly higher proportion in each year (1.1/1.25%). I am no mathematician but a difference of around 1% on figures which have been rounded does not strike me as particularly significant. However, if the table at paragraph 34 is taken to be the total UK figures for all three games, this would mean there were next to no downloads and no revenue at all for

¹⁹ DH5.

²⁰ DH10A, p. 86.

the figurative mark in either 2019 or 2020. Conversely, if the table at paragraph 23 is correct, then total sales for all three games would be almost 1.5 million higher by 2021 than claimed (even taking just the 2019 and 2020 numbers for the “Two Dots” and “Dots & Co” games). That begs the question why, if that were indeed the position, did Mr Harris not give that figure on the two occasions he referred to total UK downloads of the three games. The 2021 figure on its own is of limited assistance to the opponent in any event, given that the relevant period only runs to 29 January 2021.

40. I bear in mind that there was no cross-examination and that the applicant did not raise this particular issue. However, the applicant’s position is that the download figures are not sufficiently proven for a number of reasons, including a lack of evidence to corroborate the high download figures from 2018. Bearing in mind the obvious inconsistency in Mr Harris’s evidence and all of the above, I do not think it would be safe for me to rely upon Mr Harris’s evidence regarding the downloads and revenue for the figurative mark contained in the table at paragraph 34 above. That is not, of course, the end of the matter: genuine use can be shown in other ways and the relevant period covers a period starting before 2018.

41. On the basis that the figures at paragraph 34 above are in fact total UK downloads, deducting the “Two Dots” and “Dots & Co” figures means there were at most 1,000 UK downloads of the “Dots” game in 2019, none in 2020 and no discernible revenue. It is impossible to ascertain what the figures for 2018 and 2021 may have been. The evidence is that there were 50,000 unique visitors and 65,000 hits from the UK on the opponent’s www.dots.co website but it is not clear whether this figure relates only to the relevant period. In particular, there is nothing to show when the [dots.co](http://www.dots.co) website replaced the previous version. The first print from www.dots.co is dated August 2016; the last print from the weplaydots.com website is dated July 2014. The www.dots.co website could therefore have been created at any point in the period between July 2014 and August 2016. The evidence therefore does not show how many of the 50,000 unique visitors visited the website during the relevant period, as distinct from beforehand. Whilst website hits form part of the picture, they are not conclusive and in this case the numbers of hits are modest, even if they were all in the relevant period. As regards the reviews on the application platforms, only 156 reviews are clearly from the UK/UK sites, and of those 130 were before the relevant period. Even if I were to

assume that 6% of the Google Play or Apple store reviews were from UK users, there is no way to determine how many were in the relevant period.

42. Similar problems beset the evidence of advertising. It is not clear how much of the total given was spent in the relevant period on advertising the “Dots” game in particular. Promotional spend for any new product is typically concentrated around its first launch, which was before the relevant period. Of course, businesses may relaunch a product or have an advertising push after launch but there is no clear evidence of any advertising which the opponent carried out in the UK. It would plainly have been in the opponent’s gift to provide details of any advertising (e.g. website banners, pop-ups, print advertisements) but it has not done so.

43. Mr Harris includes evidence that around 6.2 million owners of mobile phones in the UK played games daily.²¹ Mr Harris says that because the opponent’s games have been downloaded over 3 million times in the UK, this means a market penetration of 50% of the UK’s daily mobile gamers and at least 16% of all phone gamers. I do not accept that analysis. First, the figure of 3 million downloads relates to all three of the opponent’s games so does not assist in assessing the use of the two marks which are actually relied upon in these proceedings. Second, the period over which the three games were downloaded 3 million times is not given, so it would be wrong to conclude that by March 2022 (the date of the article, which is also after the relevant date) half of all daily gamers and 16% had downloaded the opponent’s games. That would require an assumption that the gaming population is static (over an indeterminate period, possibly as long as eight years), for which there is no basis in the evidence.

44. I found above that use of the plain word “Dots” is not use of the figurative mark. I recognise, however, that when referring to the game third parties are unlikely to reproduce the trade mark as registered, particularly when the references are incidental, as is the case for most of the articles from the relevant period. I do not discount this evidence simply on the basis that the figurative mark is not shown. Nevertheless, my view is that the evidence discloses very little use of the figurative mark in the relevant period which is clearly directed at the UK consumer. I accept that the opponent has made available a game for mobile phones which is identified by the

²¹ Harris 2, §13;

figurative mark and that this game was both shown on its own website and on various other platforms in the relevant period. However, the evidence falls down in proving use in the UK during the relevant period. The case law is clear that simply any use at all will not do: the use must “be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services”. There is no evidence of sales or advertising which is specific to the UK and the references to the “Dots” game in articles are inconsequential, being primarily about the newer games and only mentioning the original in the context of the game studio having created the “Dots” game before. I recognise that the “Dots” game clearly was popular in the UK in 2013 when it was number 1 in the charts; there is a reasonable amount of evidence from 2013 and 2014 which shows that the game was popular at that time.²² However, all of this predates the relevant period. Although such evidence may have some bearing on how the evidence from the relevant period is construed, this strikes me as a field where the sudden rise and fall of games is commonplace. That makes it all the more important, in my view, that there is clear evidence of the use which has taken place during the relevant period. On the evidence before me, the opponent did not make genuine use of the figurative mark in the relevant period. The figurative mark may not be relied upon for the opposition based upon either s. 5(2)(b) or s. 5(3).

Section 5(2)(b)

45. Section 5(2)(b) of the Act is 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”.

46. Section 5A of the Act is also relevant and reads:

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

²² See, for example, Harris 1, §§34, 40; DH8, DH10A, DH11, DH12, DH13.

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

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

Comparison of goods and services

48. It is settled case law that the comparison of the goods and services must be made on the basis of all relevant factors. These may include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. Goods and services are complementary when,

“[...] 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.”²³

49. In *Gérard Meric v Office for Harmonisation in the Internal Market*, T-133/05, EU:T:2006:247, the GC held that, where goods or services in the specification of the contested mark are included within a more general category designated by the goods/services of the earlier mark, or vice versa, such goods and services can be considered identical.

50. 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.”

Class 9

Computer game software; computer games entertainment software; downloadable computer game programs; downloadable video game programs; computer game software for use on mobile and cellular phones; media content

51. The applicant accepts that “computer game software” and “computer game software for use on mobile devices” are identical to goods in the earlier mark’s specification. The term used by the applicant in its counterstatement is not the one

²³ *Boston Scientific Ltd v OHIM*, Case T-325/06 at [82].

contained in the contested specification. However, “mobile and cellular phones” are obviously types of mobile device so I proceed on the basis that the applicant accepts identity for “computer game software for use on mobile and cellular phones”. I would have so found in any event. I also find that the contested “computer games entertainment software”, “downloadable computer game programs” and “downloadable video game programs” are identical to “computer game software”, as the various terms are different ways of describing the same goods. “Media content” is an extremely broad term and includes anything that could be included on any type of media. I see no reason why this would not include computer game software. These goods are also identical.

Interactive multimedia computer game programs; interactive multimedia computer programs; virtual reality software; virtual reality game software; computer programmes

52. These goods are included within “computer game software” or vice versa and are identical on the basis outlined in *Meric*.

Computer software development tools

53. The nature, purpose and method of use of software development tools are different from the software which results. Users and channels of trade may overlap and there is potentially some competition between the goods: a user may purchase the tool to create their own computer game software rather than the finished game. There may also be a complementary relationship. These goods are similar to a medium degree.

Memory devices; computer memory devices; data storage media; data storage devices

54. These goods are different in nature and purpose from the earlier mark’s computer game software. There is no competition between these goods but users may be the same and they may be sold in the same shops, though probably in separate sections. It seems to me likely that computer games will require computer memory and that it is therefore likely that external storage will often be used with computer games. I have no evidence on whether it is typical for the providers of computer games also to sell storage media for use with the games. The opponent does not appear to but the

position may well be different for mobile game applications than for PC console systems and games. I have no experience of my own as an average consumer of such goods to draw upon. However, it seems likely to me that gaming equipment, including additional storage for games, and software will be sold by the same companies, or at least that the average consumer may consider that the responsibility for such goods lies with the same undertakings. I conclude that there is a degree of complementarity. The goods are similar to a medium degree.

Headphones; helmet communications systems; headsets

55. These goods strike me as computer accessories which are likely to be used by gamers. They differ in nature and method of use from computer games. Their purpose is also different: the software provides the game and entertainment, whilst these accessories enable the player to hear or see the game and/or other players. Their users will intersect and there may be some overlap in channels of trade, though they are likely to be on different shelves in retail premises and in different sections of retail websites. The contested goods are not indispensable to games software but they are commonly used together. Moreover, the responsibility for the goods may be perceived as belonging to the same undertakings. These goods are similar to a fairly low (i.e. between low and medium) degree.

Earphones; eyewear

56. Unlike headphones and headsets, “earphones” is a term for speakers worn in the ear. It also seems to me to be a stretch of the natural meaning of “eyewear” to conclude that it would include virtual reality headsets: the term usually means glasses and sunglasses.²⁴ Consequently, whilst the user of these goods will be the general public, as it is for computer game software, the competing goods are unlikely to be used routinely together and will not be produced by the same undertakings. Though they may be sold by the same shops, they are unlikely to be sold in the same areas. There is no similarity in nature or purpose between the respective goods and their methods of use are obviously different. These goods are not similar.

²⁴ *Collins* online defines eyewear (in British English) as “glasses, esp when regarded as an item of fashion”: <https://www.collinsdictionary.com/dictionary/english/eyewear> [accessed 28 January 2023].

Animated cartoons; animated cartoons in the form of cinematographic films; animated films

57. 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”.²⁵ 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 player interaction. Consequently, although both are viewed on screen there is a difference in their methods of use. There is similarity in nature because both are in digital form and computer games, especially though not exclusively games for children, may be very similar in appearance 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.

Downloadable music files; downloadable image files

58. The purpose of a computer game differs from that of individual music or image files, because while the goods are intended for entertainment in a very broad sense the user’s experience is very different. Computer games software will undoubtedly incorporate images and music but the overall nature of the goods is not the same. There is complementarity but no directly competitive relationship. Channels of trade may overlap. There is a low degree of similarity.

Laptop carrying cases; cell phone cases; cases for telephones; decorative magnets; eyewear cases; mouse pads; speech recognition apparatus; video tapes

59. None of the above goods is obviously used in connection with computer games. Whilst some of them (e.g. laptop cases and mouse pads) may be sold in the same stores as computer games, the respective goods will be sold in distinct sections of

²⁵ <https://www.collinsdictionary.com/dictionary/english/animated-cartoon> [accessed 28 January 2023].

such stores. The shared average consumer (the general public) is at too high a level of generality to engage similarity on its own. There is no similarity between these goods and computer games.

Class 28

Arcade games; arcade video game machines; gaming machines for gambling; video game machines; stand-alone video game machines

60. These goods differ in nature from computer game software but game software is likely to be an integral part of the games themselves and the goods will be perceived as the responsibility of the same undertakings: they are complementary goods. Users and channels of trade will overlap and there is similarity of purpose, both being for entertainment in the nature of video games. There is potential for competition. These goods are similar to a reasonably high degree.

Controllers for game consoles

61. These goods are different in nature from computer game software. Their purpose is not the same but it is connected. The goods are likely to be used together in such a way that they are complementary according to the meaning given in the case law. Their users will intersect, as will their channels of trade. These goods are similar to a medium degree.

Electronic toys

62. In *Collins* online, “toys” are defined as “an object designed to be played with” (*Collins English Dictionary*) and “a toy is an object that children play with, for example a doll or a model car” (*Collins COBUILD Advanced learner’s Dictionary*).²⁶ Whilst I accept that some electronic toys may require software to function, I do not consider that the natural meaning of “toys” would include computer games or hand-held games; rather, these goods are “games”. The nature of the goods differs. The purpose overlaps, as both are for entertainment, though there are significant differences in the way the respective goods entertain. The market sectors

²⁶ <https://www.collinsdictionary.com/dictionary/english/toy> [accessed 30 January 2023].

and trade channels are usually distinct; any overlap in channels of trade is likely to be limited. The goods are not complementary, nor, given that toys are likely to be aimed at younger children than computer software, is there a clear competitive relationship. These goods are not similar; if that is not right, any similarity is weak.

Action figure toys; articles of clothing for toys; balloons; balls for games; bath toys; battery operated action toys; board games; sleds (recreational equipment); bubble making wand and solution sets; card games; Christmas tree ornaments; dolls; plush toys; ice skates; infant toys; inflatable toys; in-line roller skates; kite reels; kites; mechanical toys; musical toys; parlor games; paper party favours; party games; pinball machines; hand-held pinball games; protective padding for sports; puppets; roller skates; toys made of rubber; sailboards; sandbox toys; skateboards; skating boots with skates attached; action skill games; skis; snowboards; squeeze toys; surf boards; swings; dice games; talking dolls; talking toys; toy masks; toy snow globes; toy vehicles; water toys; wind-up toys; plastic toys; jigsaw puzzles; magic tricks; electric action toys; body boards; boxing gloves; marbles for games; portable games with liquid crystal displays; rackets; ski bindings.

63. The opponent submitted that video games and software are often used with toys and urged me to take judicial notice of that fact. I have accepted that it is obvious that some of the contested goods in class 28 will incorporate or be used in conjunction with computer game software but I am not prepared to find, absent evidence, that it is often or always the case for the goods listed above. None of the above goods is clearly something that would be used in such a way.

64. I cannot see any similarity between any of the above goods and the opponent's computer game software. The overlap in user (the general public) is so general it is not meaningful. The opponent argues that the goods are similar in purpose because they are all for the enjoyment of the consumer. That is true but it is, in my view, far too superficial to lead to a finding of similarity. These goods are not similar.

Class 35

Retail services in relation to games; wholesale services in relation to games

65. The applicant accepts that these services are similar to a low degree. The opponent pitches it at medium. There is a difference in both nature and purpose between the respective goods and services, and no competition. However, there is a reasonably strong complementary relationship and users are identical. I find that there is a medium degree of similarity.

Retail services in relation to computer hardware; retail services in relation to information technology equipment; wholesale services in relation to information technology equipment; retail services in relation to audio-visual equipment; wholesale services in relation to audio-visual equipment

66. The applicant accepts that there is a low degree of similarity between “retail services in relation to information technology equipment; wholesale services in relation to information technology equipment” and the goods of the earlier mark, whilst the opponent says that there is a medium degree of similarity. I can see no material difference between “computer hardware” and “information technology equipment”: both, to my mind, include computers and their constituent parts (e.g. computer towers and monitors). Computers are undoubtedly information technology equipment and may be used for the playing of computer games. It is commonplace to find computers and computer games sold in the same premises, or their online equivalents. They may be bought by the same users, though as I have indicated this is of limited materiality given the width of the category. However, I am not persuaded that computer game software is important or essential for the sale of information technology equipment to the extent required for a complementary relationship. These goods and services are similar to a low degree.

67. The same applies to the retail and wholesale of audio-visual equipment. The terms include headphones and headsets which are commonly also sold by vendors of computer games software and bought by the same consumers. There is a low degree of similarity.

Retail services in relation to toys; wholesale services in relation to toys

68. The opponent says that these services overlap with the computer games software covered by the earlier mark and that there is a medium degree of similarity. For the reasons given above, I do not consider that the natural meaning of “toys” would include computer games or hand-held games. The nature and purpose of the goods and services are different and toys and computer games are in distinct market sectors, with the providers of the services not usually involved in the production or provision of computer game software. There is no complementarity: computer game software is neither necessary nor important for the retail or wholesale of toys and the consumer would not expect a vendor of toys to produce own-brand computer software. These goods and services are not similar.

All of the remaining retail and wholesale services in the specification

69. I do not think that there is any similarity between the remaining retail and wholesale services and computer games software. There is no possible point of overlap apart from the user, which is too superficial to lead to a finding of overall similarity. The goods of the earlier mark and the goods to which the contested mark’s retail and wholesale services relate are entirely dissimilar.

Presentation of goods on communication media, for retail purposes; advertising; marketing; organization of exhibitions for commercial or advertising purposes; publication of publicity texts; sales promotion (for others); advertising agencies; business management of performing artists; import-export agencies; compilation of information into computer databases; direct mail advertising; business management of hotels; marketing services; outdoor advertising; personnel recruitment; publicity agencies; radio advertising; television advertising; on-line advertising on a computer network; procurement services for others (purchasing goods and services for other businesses); rental of advertising time on communication media; office machines and equipment rental; rental of vending machines; production of television commercials; rental of advertising space

70. I cannot see any meaningful point of similarity between the above services and the earlier “computer game software”. They are different in nature and purpose, will not

share channels of trade and are not in competition. Nor are the goods and services complementary. In most cases, the user is different, because the above services are used by businesses rather than the general public. Even where there is an overlap in end consumer (e.g. television advertising), there will be no expectation that a provider of the above services would also manufacture computer game software. These services are not similar to the goods of the earlier mark's specification.

Entertainment services; on-line gaming services; providing games; providing on-line computer games

71. These services differ in nature from computer game software but the respective goods and services both involve the entertainment of the consumer by means of video games, so there is an overlap in purpose. The goods and services may be provided via the same trade channels, are in competition and are complementary. These goods and services are similar to a high degree.

Animation production services

72. The nature of computer games and animation services is different. Although animation may play a part in a computer game, their purpose is also different: a game's function is entertainment per se, whilst an animation service creates one (visual) aspect of the total product. The users may intersect and the goods and services may both be provided by the same company, resulting in complementarity. There is a medium degree of similarity.

Audio production; production of sound recordings

73. The nature and purpose of computer games are very different from the above services but it is likely that computer games will include some sounds and music. This will require some level of audio/sound production. The production services will be directed at professionals creating game software, rather than the end consumer of the software and channels of trade will differ. However, as with animation, it is likely that the services may be carried out in-house as well as being contracted out and there is a complementary relationship. There is a medium degree of similarity.

Production of animated cartoons; production of a continuous series of animated adventure shows

74. The nature of the goods and services is different. There is an overlap in purpose at a very general level: both result in an entertainment product, though there are significant differences in that product, as considered above. Cartoons and software share end user, though production services are likely to be targeted at industry professionals in the first instance. There is no competition. The production of a cartoon is not important or essential to a computer game: they are not complementary. It seems unlikely that computer game studios would also produce cartoons, or vice versa. If there is any similarity, it is very low.

Film production; production of radio and television programs; production of motion pictures; video production services; video recording services; production of TV shows

75. The opponent says that “production of motion pictures” is a requirement for the development of computer games. I disagree. A “motion picture” is a term of art for a film and is not simply any image which moves.²⁷ The creation of a visual environment plainly has a role in a computer game. However, the above films, television programmes and videos are all stories intended to be shown at cinemas or on television, unlike computer games, which are designed to be played on computers and portable electronic apparatus. The services are targeted at individuals in the media and entertainment industry, unlike computer games. The skills and knowledge required for the creation of films and television programmes etc. will differ considerably from that for computer games and it is unlikely that an average consumer would think that a computer game was produced by the providers of the above services. Channels of trade will not intersect and there is no competition. These goods and services are not similar.

Organising competitions; organisation of tournaments

76. These services are wide enough to include competitive computer game events. The nature of these services differs from computer games software, as does their

²⁷ See, for example, <https://www.collinsdictionary.com/dictionary/english/motion-picture> [accessed 30 January 2023].

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.

Amusement park and theme park services; live comedy shows; live music performances; live show production services; entertainment in the nature of theater productions; live entertainment; providing entertainment information via a website; electronic publishing; music publishing; magazine publishing; book publishing; newspaper publishing; rental of motion pictures; rental of sound recordings; entertainment provided by telephone; film distribution

77. I cannot see any similarity between the above services and computer games. The opponent has submitted that they are similar because their purpose is to entertain the consumer. I consider that to be far too superficial to engage similarity on its own. None of the above has any obvious connection to computer game software at all. In the absence of any good reason for similarity, I find that these goods and services are dissimilar.

The average consumer and the nature of the purchasing act

78. 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 and services in question: *Lloyd Schuhfabrik*.

79. The applicant submitted that the average consumer will primarily be the general public, who will pay an average degree of attention.²⁸ The opponent accepts that most of the goods and services are everyday purchases but submitted that computer

²⁸ Counterstatement, §24.

software, gaming software and computer accessories are more specialist and will attract slightly more care. I agree that the average consumer for many of the goods and services will be the general public and that a medium degree of attention will be paid: the majority of the goods at issue strike me as relatively frequent purchases which will not require an elevated degree of care. I accept that some goods will be bought less frequently, be more expensive and may require consideration of their technical capabilities, resulting in an above average level of care. Computer software at large may fit into this category but I do not think that computer game software or computer accessories do: they are not particularly expensive, are likely to be purchased with some regularity and there are limited consequences if a mistake is made. They will be bought with an average level of attention.

80. The average consumer will also include, or in some cases exclusively be (e.g. wholesale services and animation production services), business users or professionals. The professional or business consumer is likely to pay an above average degree of attention, purchasing goods in greater quantities or under longer contracts and potentially considering the reputation of the provider with more care than the general public.

81. The selection of the goods and services is likely to be mainly a visual process, with the consumer selecting the goods and services from shelves in retail or wholesale premises, their online equivalents, on websites and in catalogues, both physical and online. There may also be an aural element to the purchase for both groups of consumer, arising for example from word of mouth recommendations.

Distinctive character of the earlier trade mark

82. In *Lloyd Schuhfabrik*, 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)".

83. The words "DOTS & CO" which form the earlier mark will be read as an entire phrase. Ordinarily, the "& Co" format is seen with a personal name, usually a surname, before "& Co" and the balance of distinctiveness is often in favour of that name. In this case, it is an unusual feature of the mark that the first part is not a personal name. Given that computer games may feature dots, as indeed the opponent's games do, "DOTS" alone is not distinctive of the goods. Further, as "DOTS" are objects, the usual assumption that "& CO" is a reference to unnamed partners does not hold good. The average consumer will probably not think too hard about what "& CO" signifies but will assume that it means other unspecified objects, perhaps more dots or other shapes. As a result, I do not think that "DOTS" is the dominant distinctive element of this mark; on the contrary, both parts will be noticed and contribute to the overall impression. Bearing in mind the non-distinctiveness of "DOTS" but also allowing for the unusual combination of elements, my view is that the mark as a whole is distinctive to a lower than average degree.

84. As to enhanced distinctiveness, the game "Dots & Co" was launched in the UK on 21 July 2016.²⁹ It is said to have become quickly a "top 5" game in over 100 countries but the countries are not named.³⁰ The game was included on the dots.co website

²⁹ Harris 2, §10.

³⁰ Harris 1, §§, 14, 35; DH6.

from August 2016 to May 2018 under the mark shown below and was available at that time for download on the Apple and Google Play app stores:³¹



85. There are six articles about the release of “Dots & Co” dated 2016, including two articles from uk.pcmag.com and uk.news.yahoo.com.³² The game is mentioned incidentally in several other articles, including those discussed above to which the same points regarding the UK reach of those articles apply.

86. The words “Dots & Co: A Puzzle Adventure” are the plain text title on prints from Google Play.³³ It has a 2021 copyright date but the app was last updated in November 2019. It has been reviewed 92,310 times. A 2019 print from the Apple store is from the address apps.apple.com/us. Prints from apps.apple.com/gb include reviews dated 2019 and 2020.³⁴ A print from YouTube GB shows a trailer for the “Dots & CO” game uploaded on 20 July 2016.³⁵ The words “Dots & Co” are in the plain text title and in the stylised form shown above in the video. There are Twitter posts under the name “Dots & Co”, from the handle “dotsandco”, between 2016 and 2018, some of which are challenges connected with the game.³⁶ Facebook posts from 2016 and 2018 also promote the game. The “Dots & Co” game won a Webby Award in 2017.³⁷

87. I accept that there has been some use of the mark, both in the form as registered and the figurative form shown above. The figurative mark is capable of enhancing the distinctiveness of the words “DOTS & CO”, since those words remain dominant in the device mark. However, I am not persuaded that the use in the UK has been sufficient for the mark to acquire distinctive character. Advertising figures are mentioned but are not specific to this mark and there is no evidence of how the mark was advertised to the public. The press articles are limited in number and do not make the game’s popularity in the UK clear. In the UK there were around 75,000 downloads between

³¹ DH4.

³² DH10B; DH21.

³³ DH7.

³⁴ DH17.

³⁵ DH8.

³⁶ DH12.

³⁷ DH11.

2018 and 2020 and revenue of around USD71,000 in the same period. Those figures are not substantial. There is no enhancement of distinctive character for this trade mark.

Comparison of trade marks

88. 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”.

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

90. The marks to be compared are:

Earlier mark	Contested mark
DOTS & CO	● hyper dot

91. I have already held that the “DOTS & CO” mark will be seen as a totality and that no single element dominates the overall impression.

92. The contested mark consists of a solid circle device and, to its right, the conjoined word “hyperdot”. The “dot” element of the mark is in bold font; the word “hyper” is not. The word “hyperdot” dominates the overall impression of the mark. The circle device is banal and plays only a weak role.

93. “DOT” appears in both marks, at the beginning of the earlier mark in the plural, and at the end of the contested mark in the singular. There are other elements in both trade marks which are significant. There is a medium degree of visual similarity.

94. The earlier mark will be verbalised in full, the ampersand being pronounced as the word “and”. The contested mark will be articulated as “hyper-dot”. Bearing in mind the additional syllable in the earlier mark and the position of the word “dots”/“dot” in each, there is a lower than average degree of aural similarity.

95. There is a dispute over how the contested mark will be understood. Mr Cassidy submitted that “hyper” introduces concepts of hyperactivity or too much of a quality and that it describes the “dot” element, creating the idea of a hyperactive dot.³⁸ Mr Hall submitted that the “hyper” element “leads to the concept of hyperlinks, modern technology and the Internet”.

96. I prefer Mr Cassidy’s submissions. The dictionary definitions he relies upon are not in evidence but are meanings which the average consumer would bring to mind. In the context of the phrase “hyperdot”, it is likely that the average consumer will perceive the mark as meaning a dot or dots which move around a lot or quickly. Although “hyper” may mean many, given that “dot” is in the singular, this is a possible but less likely perceived meaning of the phrase. In contrast, there is no evidence (or dictionary definition) that “hyperlink” is commonly abbreviated to “hyper” alone. In my experience, it is not. In the absence of anything else in the trade mark which would suggest a meaning connected to hyperlinks, I reject Mr Hall’s submission. Both marks therefore refer to the concept of a dot or dots but one is a dot with particular characteristics. The earlier mark’s “& CO” suggests other unspecified objects. There is a medium degree of conceptual similarity.

³⁸ *Cambridge Dictionary* definitions are provided at [31], fn. 1 and 2 of his skeleton argument.

Likelihood of confusion

97. 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*), 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*). The factors considered above have a degree of interdependency (*Canon*): 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.

98. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *LA Sugar Limited v By Back Beat Inc.*, BL O/375/10, where Iain Purvis Q.C., sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This

may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

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

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

99. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ underscored that the above examples are not exhaustive. He also pointed out that referred there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

100. The distinctiveness of the common element in the competing trade marks must also be borne in mind. This was addressed by Iain Purvis Q.C., again as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O/075/13. He said:

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

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

101. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask "in what does the distinctive

character of the earlier mark lie?” Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

102. Where there is no similarity between goods and services, there can be no confusion.³⁹ The opposition under s. 5(2)(b) against goods and services not similar to the earlier goods is dismissed accordingly.

103. At the hearing, much was made of the success of the opponent’s “Two Dots” game. However, this mark/sign has not been formally relied upon, either individually or as part of a family of marks (which must be distinctly pleaded). That being the case, the mark/sign and any success it may have had is irrelevant.

104. I have found that there is a medium degree of visual similarity and a lower than average degree of aural similarity between the trade marks. The purchasing process will be predominantly visual. The earlier mark is, as a whole, distinctive to a lower than average degree. However, the common element “dot” is not distinctive for the goods of the earlier mark; it is more distinctive for some of the contested goods and services than others (i.e. it is of little or no distinctiveness where the goods and services are or are related to computer games). My view is that there is no likelihood of confusion for goods and services which are or are related to computer games, even where they are identical, because the common element is not distinctive and its use will be attributed to coincidence rather than an economic connection. However, even where the goods and services are not related to computer games (and I note that there is no more than a medium degree of similarity here), the evolution from “DOTS & CO” to a figurative mark featuring the word “hyperdot”, or vice versa, is not, in my view, a logical progression from a brand to sub-brand. Nor is the common element sufficiently distinctive, even where it has some distinctive character, to cause the consumer to believe that there is an economic connection between the entities using the competing trade marks. I find that there will be no confusion, whether direct or indirect, for any of the goods or services.

³⁹ *Waterford Wedgwood plc v OHIM*, C-398/07 P.

Section 5(3)

105. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

106. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

107. As the “DOTS & CO” trade mark is a comparable mark, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads:

“10.— (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom include the European Union.”

108. The relevant case law can be found in the following judgments of the CJEU: *General Motors*, C-375/97, EU:C:1999:408; *Intel Corporation Inc. v CPM United Kingdom Ltd*, C-252/07, EU:C:2008:655; *Adidas-Salomon & Anor v Fitnessworld*

Trading Ltd, C-408/01, EU:C:2003:582; *L’Oreal v Bellure*, C-487/07, EU:C:2009:378); and *Marks and Spencer v Interflora*, C-323/09, EU:C:2011:604. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered: *General Motors*, paragraph 24;

b) The trade mark for which protection is sought must be known by a significant part of that relevant public: *General Motors*, paragraph 26;

c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind: *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63;

d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness: *Intel*, paragraph 42;

e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors: *Intel*, paragraph 79;

f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future: *Intel*, paragraphs 76 and 77;

g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character: *Intel*, paragraph 74;

h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark: *L'Oreal v Bellure NV*, paragraph 40;

i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Reputation

109. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

110. I found at paragraphs 84 to 87, above, that the "DOTS & CO" mark had not acquired distinctive character through use. For essentially the same reasons, I find that the use which has been made of the mark is insufficient to establish a reputation for an objection under s. 5(3) of the Act: in my judgement, such use as there has been is not extensive enough to meet the threshold for a reputation. The opposition under this ground is dismissed accordingly.

Section 5(4)(a)

111. Section 5(4)(a) states:

"(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

112. Subsections 5A, quoted above, and (4A) are also relevant. The latter reads:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

113. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341 HL, Lord Oliver of Aylmerton described at [406] the ‘classical trinity’ that must be proved in order to reach a finding of passing off:

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”

114. Although use before the relevant date can be relevant in a passing off action, there is no evidence of any use by the applicant.⁴⁰ That being the case, the relevant date under this ground is also the filing date of the contested application.

Goodwill

115. In *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), goodwill was described as follows:

⁴⁰ *Maier & Anor v Asos & Anor* [2015] EWCA Civ 220 at [165]. See also *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11.

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

116. Goodwill which is protectable under the law of passing off must be more than trivial. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) concluded at [62] that references in earlier cases to a “significant reputation” meant that “one is looking for more than a minimal reputation”.

117. More recently, in *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC, as the Appointed Person, reviewed the authorities about the establishment of goodwill for the purposes of passing-off, namely *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“[...] a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

118. However, the case law also shows that a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off, even though its goodwill and reputation may be small. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, the Court of Appeal in England and Wales held that the defendant had passed off its LUMOS nail care products as the claimant’s goods. The claimant had been selling “LUMOS” anti-ageing products since 2007. The goods retailed at prices between £40 and £100 per bottle. The Claimant's sales were small, of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the trade, including salons, clinics and a market. There

was evidence of repeat purchases. Although the number of customers was small, or, as the judge at first instance put it, “very limited”, the claimant’s goodwill was found to be sufficient to entitle it to restrain the defendant’s trade under “LUMOS”. In *Stannard v Reay* [1967] F.S.R. 140, a mobile fish and chip van had been trading for three weeks, generating around £130 per week, which was held to be sufficient for an interlocutory injunction to prevent the defendants using the same sign (“MR CHIPPY”). The facts were unusual because of the very localised nature of the case.

119. Although the evidence of the use of the “DOTS & CO” sign, which I have discussed above, is not extensive, there were 75,000 downloads of the game in the UK between 2018 and 2020 generating USD71,000 in revenue. There is also evidence of social media activity between 2016 and 2018, and the game appears to have been available for download on various platforms, including on Google Play from 2016 to 2021. The Webby Award (which is sponsored by YouGov and therefore probably a UK award) is from 2017; most of the press is from 2016 and not clearly directed at the UK public. Nevertheless, I am prepared to accept that the opponent’s business in computer game software for use on mobile devices was sufficient to have created a small but protectable goodwill of which the “DOTS & CO” sign was distinctive at the relevant date.

120. Turning to the figurative sign, for the reasons I gave above I do not consider it safe to rely on the figures provided of over 3 million downloads between 2018 and 2021, and my view is that the use of the figurative sign in the period between 2016 and 2021 was very slight. I do not consider that the use in this period is sufficient to have generated a protectable goodwill of which the figurative sign was distinctive. However, residual goodwill may apply, in particular because it is apparent that the figurative sign was used in relation to a mobile phone game which was number 1 in the UK charts, and therefore obviously popular at least among a part of the relevant public, in August 2013.

121. In *Ad Lib Club Limited v Granville* [1971] FSR 1 (HC), Vice Chancellor Pennycuick said:

“It seems to me clear on principle and on authority that where a trader ceases to carry on his business he may nonetheless retain for at any rate some period

of time the goodwill attached to that business. Indeed it is obvious. He may wish to reopen the business or he may wish to sell it. It further seems to me clear in principle and on authority that so long as he does retain the goodwill in connection with his business he must also be able to enforce his rights in respect of any name which is attached to that goodwill. It must be a question of fact and degree at what point in time a trader who has either temporarily or permanently closed down his business should be treated as no longer having any goodwill in that business or in any name attached to it which he is entitled to have protected by law.

In the present case, it is quite true that the plaintiff company has no longer carried on the business of a club, so far as I know, for five years. On the other hand, it is said that the plaintiff company on the evidence continues to be regarded as still possessing goodwill to which this name AD-LIB CLUB is attached. It does, indeed, appear firstly that the defendant must have chosen the name AD-LIB CLUB by reason of the reputation which the plaintiff company's AD-LIB acquired. He has not filed any evidence giving any other reason for the selection of that name and the inference is overwhelming that he has only selected that name because it has a reputation. In the second place, it appears from the newspaper cuttings which have been exhibited that members of the public are likely to regard the new club as a continuation of the plaintiff company's club. The two things are linked up. That is no doubt the reason why the defendant has selected this name."

122. Though Mr Harris's evidence that there were 50,000 unique visitors to the www.dots.co website appears to be up to the date of his first statement (17 January 2022) rather than the relevant date, the figurative sign was already in use by the time that website was launched. It is likely that the bulk of the visitors were before the relevant date, though it is impossible to know whether they were concentrated at particular points, especially whether the traffic was heaviest around the launch dates of the various games between 2013 and 2016, i.e. several years before the relevant date. There are a number of press articles which mention the "Dots" game. The majority of these are in the period before December 2016. The 2017 article from *Forbes* is not clearly about the game under the figurative sign. The two articles from

dots.co in the same year promote the company rather than a specific product but do mention the “Dots” game. However, whether these had any meaningful distribution in the UK is doubtful, given that they relate to films to be shown only on the opponent’s website or in the US. The latest articles which mention “Dots” are dated August 2020, from techcrunch.com and Alliance Global. They are about the acquisition of Playdots, Inc. rather than promotion of any game under the sign.

123. The figurative sign is not used in the articles. As I mentioned earlier, it is not unusual for figurative signs to be rendered as plain text so I do not discount the articles simply on that basis. However, the extent to which, if at all, these articles were distributed among the relevant UK public is not clear. My view is that the references to the “Dots” game are too few, too incidental and too long before the relevant date to have kept the goodwill associated with the figurative sign alive by 29 January 2021. In the absence of reliable figures for downloads, I conclude that the figurative sign was not distinctive of the opponent’s business connected with computer games for mobile devices. The opposition under s. 5(4)(a) based on this sign fails accordingly.

Misrepresentation

124. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’[product]”

The same proposition is stated in *Halsbury’s Laws of England* 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden’s Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“[...] for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court’s reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

125. I do not consider that the relevant public faced with the contested mark will believe that there is a connection between the user of that mark and the user of the “DOTS & CO” sign. The differences between the marks are too great, when combined with the weak distinctiveness of the word “DOTS” for computer games software and what I do not consider to be a logical progression from one mark to the other, to give rise to a misrepresentation. Where the goods and services are further removed, it is even less likely that there will be any deception. The opposition based upon s. 5(4)(a) fails.

126. For completeness, I will briefly comment on the figurative sign. Had I found that the figurative sign was distinctive of the opponent’s goodwill, its reputation would have been weak. The distinctiveness of the figurative sign is not contained in the word “DOTS” alone which, for the computer games which are the opponent’s business, is not inherently distinctive. Whilst I accept that “DOTS” plays a part in the sign, the stylised presentation makes a significant contribution to its overall distinctive character. Bearing all of that in mind, I do not think that the relevant public would believe that the contested mark is another mark used by, or otherwise economically connected to, the opponent. The differences between the marks and what would be an unexpected development from a sign which makes use of the figurative device to a single dot next to the word “hyperdot” may cause the public to wonder if there is a connection between the entities which use marks containing “dot” but there would not be a misrepresentation. Consequently, the opposition under s. 5(4)(a) based on the figurative sign would also have failed.

Conclusion

127. The opposition has failed and the application will proceed to registration.

Costs

128. The applicant has been successful and is entitled to an award of costs. The applicant seeks costs on the scale contained in Tribunal Practice Notice 2/2016. However, Mr Hall requested that costs be awarded at the top of the scale to compensate the applicant for what he described as an over-broad opposition, totally without merit. I agree that the opposition against a good number of the services in class 35, such as retail services of foodstuffs or sanitation equipment, was unreasonable under any of the grounds. So different are the goods and services that a mark with a much bigger reputation than that of the opponent would have faced an uphill battle. However, I do not agree that the case was otherwise unreasonably brought, even though it has failed. Bearing that in mind, I award costs to the applicant as follows:

Considering the notice of opposition and filing the counterstatement:	£500
Preparing evidence and considering the other party's evidence:	£1200
Preparing for and attending the hearing:	£800
Total:	£2,500

129. I order Take-Two Interactive Software, Inc. to pay Hyper Dot Studios Limited the sum of **£2,500**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of February 2023

Heather Harrison

For the Registrar

The Comptroller-General

APPENDIX

UK 3587075: specification

Class 9: Computer software development tools; laptop carrying cases; cell phone cases; cases for telephones; computer game software; computer games entertainment software; decorative magnets; memory devices; computer memory devices; data storage media; downloadable music files; downloadable image files; downloadable computer game programs; downloadable video game programs; earphones; eyewear cases; eyewear; headphones; interactive multimedia computer game programs; interactive multimedia computer programs; mouse pads; speech recognition apparatus; virtual reality software; virtual reality game software; helmet communications systems; headsets; computer game software for use on mobile and cellular phones; animated cartoons; animated cartoons in the form of cinematographic films; computer programmes; media content; data storage devices; animated films; video tapes.

Class 28: Action figure toys; arcade games; arcade video game machines; articles of clothing for toys; balloons; balls for games; bath toys; battery operated action toys; board games; sleds (recreational equipment); bubble making wand and solution sets; card games; Christmas tree ornaments; dolls; plush toys; gaming machines for gambling; controllers for game consoles; ice skates; infant toys; inflatable toys; in-line roller skates; video game machines; kite reels; kites; mechanical toys; musical toys; parlor games; paper party favours; party games; pinball machines; hand-held pinball games; protective padding for sports; puppets; roller skates; toys made of rubber; sailboards; sandbox toys; skateboards; skating boots with skates attached; action skill games; skis; snowboards; squeeze toys; stand-alone video game machines; surf boards; swings; dice games; talking dolls; talking toys; toy masks; toy snow globes; toy vehicles; water toys; wind-up toys; electronic toys; plastic toys; jigsaw puzzles; magic tricks; electric action toys; body boards; boxing gloves; marbles for games; portable games with liquid crystal displays; rackets; ski bindings.

Class 35 Retail services in relation to computer hardware; retail services in relation to chocolate; retail services in relation to sorbets; retail services in relation to coffee; retail services in relation to lubricants; retail services in relation to threads; retail services in

relation to vehicles; retail services in relation to toys; retail services in relation to games; retail services in relation to furniture; retail services in relation to desserts; retail services in relation to confectionery; retail services in relation to furnishings; retail services in relation to fuels; retail services in relation to tableware; retail services in relation to foodstuffs; retail services in relation to horticulture equipment; retail services in relation to cleaning articles; retail services in relation to musical instruments; retail services in relation to printed matter; retail services in relation to sanitation equipment; retail services connected with stationery; retail services relating to food; retail services in relation to headgear; retail services in relation to fabrics; retail services in relation to cocoa; retail services in relation to jewellery; retail services in relation to footwear; retail services in relation to lighting; retail services in relation to luggage; retail services in relation to bags; retail services in relation to umbrellas; retail services in relation to toiletries; retail services in relation to clothing; retail services in relation to cookware; retail services in relation to metal hardware; retail services in relation to educational supplies; retail services in relation to art materials; retail services in relation to recorded content; retail services in relation to sporting equipment; retail services in relation to festive decorations; retail services in relation to wall coverings; retail services in relation to sewing articles; retail services in relation to baked goods; retail services in relation to dairy products; management of a retail enterprise for others; retail services in relation to cleaning preparations; retail services in relation to ice creams; retail services in relation to food cooking equipment; retail services in relation to non-alcoholic beverages; retail services in relation to information technology equipment; retail services in relation to audio-visual equipment; retail services in relation to works of art; presentation of goods on communication media, for retail purposes; wholesale services in relation to computer hardware; wholesale services in relation to chocolate; wholesale services in relation to sorbets; wholesale services in relation to coffee; wholesale services in relation to lubricants; wholesale services in relation to threads; wholesale services in relation to vehicles; wholesale services in relation to toys; wholesale services in relation to games; wholesale services in relation to furniture; wholesale services in relation to desserts; wholesale services in relation to confectionery; wholesale services in relation to furnishings; wholesale services in relation to fuels; wholesale services in relation to tableware; wholesale services in relation to foodstuffs; wholesale services in relation to horticulture equipment; wholesale services in relation to cleaning articles; wholesale services in relation to

printed matter; wholesale services in relation to sanitation equipment; wholesale services in relation to stationery supplies; wholesale services in relation to headgear; wholesale services in relation to fabrics; wholesale services in relation to cocoa; wholesale services in relation to jewellery; wholesale services in relation to footwear; wholesale services in relation to lighting; wholesale services in relation to luggage; wholesale services in relation to bags; wholesale services in relation to umbrellas; wholesale services in relation to toiletries; wholesale services in relation to clothing; wholesale services in relation to cookware; wholesale services in relation to metal hardware; wholesale services in relation to educational supplies; wholesale services in relation to art materials; wholesale services in relation to sporting equipment; wholesale services in relation to festive decorations; wholesale services in relation to wall coverings; wholesale services in relation to sewing articles; wholesale services in relation to baked goods; wholesale services in relation to dairy products; wholesale services in relation to cleaning preparations; wholesale services in relation to ice creams; wholesale services in relation to food cooking equipment; wholesale services in relation to non-alcoholic beverages; wholesale services in relation to information technology equipment; wholesale services in relation to audio-visual equipment; wholesale services in relation to works of art; advertising; marketing; organization of exhibitions for commercial or advertising purposes; publication of publicity texts; sales promotion (for others); advertising agencies; business management of performing artists; import-export agencies; compilation of information into computer databases; direct mail advertising; business management of hotels; marketing services; outdoor advertising; personnel recruitment; publicity agencies; radio advertising; television advertising; on-line advertising on a computer network; procurement services for others (purchasing goods and services for other businesses); rental of advertising time on communication media; office machines and equipment rental; rental of vending machines; production of television commercials; rental of advertising space.

Class 41: Entertainment services; amusement park and theme park services; animation production services; film production; organising competitions; live comedy shows; live music performances; live show production services; entertainment in the nature of theater productions; live entertainment; providing entertainment information via a website; electronic publishing; music publishing; magazine publishing; book publishing; newspaper publishing; on-line gaming services; organisation of

tournaments; audio production; production of radio and television programs; production of sound recordings; production of motion pictures; rental of motion pictures; providing games; rental of sound recordings; video production services; video recording services; production of TV shows; production of animated cartoons; production of a continuous series of animated adventure shows; providing on-line computer games; entertainment provided by telephone; film distribution.