

O/0431/23

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NOS. 1589809 &
1569372

IN THE NAME OF EURO GAMES TECHNOLOGY LTD.
IN RESPECT OF THE TRADE MARKS



AND

BURNING HOT

IN CLASSES 9, 28 & 41

AND

THE CONSOLIDATED OPPOSITIONS THERETO UNDER NOS. 429908 & 429909
BY NOVOMATIC AG

Background and pleadings

1. Euro Games Technology Ltd. (“the holder”) applied to protect International Trade Mark no. 1589809 designating the UK, for the mark shown on the cover page of this decision, on 20 November 2020. The International Registration (“IR 809”) holds a priority date of 27 October 2020. It was accepted and published in the Trade Marks Journal on 8 October 2021 in respect of goods and services in classes 9, 28 and 41. A full list is provided at Annex A to this decision.

2. NOVOMATIC AG (“the opponent”) partially opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The following goods and services are opposed within this opposition:

Class 9: Software; computer gaming software; computer software packages; computer software, recorded; virtual reality software; games software; entertainment software for computer games; computer game programs; computer programs for recorded games; computer application software featuring games and gaming; computer software for the administration of on-line games and gaming; computer hardware for games and gaming; computer hardware and software for gambling, gambling machines and gambling games provided via the Internet and via telecommunication network.

Class 28: Gaming machines for gambling; arcade games; gambling machines operating with coins, notes and cards; games; electronic games; slot machines [gaming machines]; LCD game machines; slot machines and gaming devices; coin-operated amusement machines; gaming equipment for casinos; apparatus for casino games; automats and gambling machines; coin-operated amusement machines and / or electronic coin-operated amusement machines with or without the possibility of gain; housings for coin-operated machines; electronic or electrotechnical gaming devices, namely, automats and machines,

coin-operated machines; gaming machines,¹ electropneumatic and electrical gambling machines (slot machines).

Class 41: Gambling; services related to gambling; gaming services for entertainment purposes; casino, gaming and gambling services; on-line gaming services; online gambling services; casino services; casino, gaming and gambling services.

3. The opponent relies upon its International Registration no. 1102743 for the mark BURNING HOT which designates the UK. The opposition was based upon all of the goods registered under the earlier mark. Following recent revocation action and a subsequent appeal, which was decided after these proceedings were launched but which takes effect from 10 May 2019, the following goods remain registered under this mark and are therefore relied upon in this opposition:

Class 9: Computer software namely for casino games, amusement arcade games and games of chance via telecommunications networks and/or the Internet.

4. By virtue of its priority date of 7 June 2011, the above mark constitutes an earlier mark in accordance with section 6 of the Act. It was granted registration in the UK on 11 April 2012.

5. The opponent argues that the respective goods and services are identical or highly similar and that the marks are highly similar. As such, the opponent argues there is a likelihood of confusion, including a likelihood of association on the part of the public.

6. The holder filed a counterstatement denying the claims made and requesting that the opponent provides proof of use of its earlier trade mark relied upon.

¹ Whilst it is missing from the initial list of opposed goods within the statement of grounds, gaming machines is included within the table of opposed goods provided within the same, and as such I take it that these goods are opposed.

7. The holder also applied to protect International Trade Mark no. 1569372 for the mark shown on the cover page of this decision, designating the UK on 21 July 2020. The International Registration (“IR 372”) holds a priority date of 27 February 2020. It was accepted and published in the Trade Marks Journal on 29 October 2021 in respect of goods and services in classes 9, 28 and 41. A full list is provided at Annex B to this decision.

8. The opponent partially opposes this trade mark on the basis of section 5(1) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The following goods and services are opposed:

Class 9: Software; computer gaming software; computer software packages; computer software, recorded; virtual reality software; games software; entertainment software for computer games; computer game programs; computer programs for recorded games; computer application software featuring games and gaming; computer software for the administration of on-line games and gaming; computer hardware for games and gaming; computer hardware and software for gambling, gambling machines, gambling games on the Internet and via telecommunication network.

Class 28: Gaming machines for gambling; arcade games; gambling machines operating with coins, notes and cards; games; electronic games; slot machines [gaming machines]; LCD game machines; slot machines and gaming devices; coin-operated amusement machines; gaming equipment for casinos; casino games; amusement and gambling machines; coin-operated gaming machines and / or electronic coin-operated gaming machines with or without the possibility of gain; electronic or electro-technical gaming devices, amusement and gaming machines, including coin-operated machines; housings for coin-operated machines, gaming equipment, gaming machines, machines for gambling; electro-pneumatic and electrical gambling machines (slot machines).

Class 41: Gambling; entertainment services related to gambling; gaming services for entertainment purposes; casino, gaming and gambling services;

gaming machine entertainment services; online gambling services; online gambling services.

9. This opposition relies upon the same earlier mark as the opposition above, namely International Registration no. 1102743 for the mark BURNING HOT designating the UK. Again, the opponent relies upon all of the goods that remain registered under this mark. By virtue of its priority date of 7 June 2011, this mark constitutes an earlier mark in accordance with section 6 of the Act within this opposition.

10. The holder filed a counterstatement denying the claims made and again requesting that the opponent provides proof of use of its earlier trade mark relied upon.

11. On 23 June 2022, the Tribunal wrote to the parties directing under Rule 62(1)(g) of the Trade Marks Rules 2008 (“the Rules”) that the proceedings would be consolidated.

12. Only the opponent filed evidence in these proceedings. This will not be extensively summarised but will be referred to the extent that it is considered appropriate throughout this decision.

13. The holder filed written submissions in lieu of attendance at a hearing, which will not be summarised but will be referred to as and where appropriate during this decision. A Hearing took place on 29 March 2023 with only the opponent in attendance.

14. Both parties are represented in these proceedings. The holder is represented by Walker Morris LLP. The opponent has been represented throughout the proceedings by Shakespeare Martineau LLP, and appointed Michael Hicks of Hogarth Chambers to represent it at the hearing.

15. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions

of the 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 EU courts.

Evidence

16. As mentioned previously, I do not intend to summarise the evidence in full at this stage. I will, however, briefly outline the statements and exhibits filed.

17. The opponent filed its evidence in the form of two witness statements drafted for these proceedings, along with a number of exhibits. The first statement was filed in the name of Alexander Roch, Head of Legal at Greentube Internet Entertainment Solutions GmbH. Whilst Mr Roch confirms he is duly authorised to make the statement on behalf of the opponent, the relationship between Greentube Internet Entertainment Solutions GmbH and the opponent is not detailed within this statement. However, the witness statement attaches 4 exhibits, namely Exhibit AR1 – Exhibit AR4. Exhibit AR1 presents a further witness statement from Mr Roch produced for previous proceedings before the Tribunal, along with further exhibits labelled Exhibit AR1 – Exhibit AR6. This statement explains that Greentube Internet Entertainment Solutions GmbH is a company in the “Novomatic Group” and since 2019 has been a direct subsidiary of the opponent. Exhibit AR2 to Mr Roch’s witness statement drafted for these proceedings provides a further witness statement from Mr Roch also originally provided for previous proceedings before the Tribunal.

18. The statement filed for the first time in these proceedings is dated 15 August 2022, whilst the witness statement attached at Exhibit AR1 is dated 16 October 2020 and the witness statement attached as Exhibit AR2 is dated 12 April 2021. The statements and exhibits provided by Mr Roch are for the purpose of showing the use of the earlier mark within the UK.

19. The second witness statement drafted for these proceedings and filed by the opponent is in the name of Julia Schachter, Deputy Head Group Legal of the opponent. The statement introduces a single exhibit, namely Exhibit JS1. This exhibit comprises a further witness statement in the name of Ms Schachter, produced for previous proceedings, which introduces six exhibits, namely Exhibit JS1 to Exhibit

JS6. The statement filed for the first time in these proceedings is dated 11 August 2022, whilst the statement introduced at Exhibit JS1 is dated 16 October 2020. These statements and exhibits set out the various formal and informal agreements relating to the use of the earlier mark by various parties, including Astra Games Limited and Greentube Internet Entertainment Solutions GmbH.

Proof of use

20. As the earlier mark was granted registration in the UK on 11 April 2012 more than five years prior to the priority date of both IR 809 and IR 372, it is subject to proof of use provisions in accordance with section 6A of the Act.

Relevant statutory provision:

21. Section 6A of the Act provides:

“(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), (b) 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) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

22. 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.”

23. 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 Bunderversammlung Kameradschaft ‘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].”

24. The burden is on the opponent to show that the earlier mark has been used within the relevant territory of the UK, within the relevant time frames of 28 October 2015 - 27 October 2020 in respect of the first opposition and between 28 February 2015 – 27 February 2020 in respect of the second opposition. It must show that the use made is genuine and that it has been made in respect of the goods relied upon.

Form of the mark

25. Within its written submissions filed in lieu of a hearing, the holder argues that the use of the mark shown in evidence is not acceptable use of the earlier mark as registered. Within these submissions, the holder referred me to two previous decisions issued by the Tribunal within which two marks shown in evidence were not found to be acceptable variants of the marks as registered. I note that I am not bound by the

decisions of other hearing officers, and in any case the cases referred to relate to the marks ECOTEX and NORTHERN and are not in my view particularly analogous with this case. However I will, for completeness, address one of the points raised by the holder in this regard. In respect of the decision made regarding the mark ECOTEX,² the holder submits:

“[...] the Hearing Officer considered whether a stylized version of the mark ECOTEX was an acceptable variant of the word mark ECOTEX. Whilst it was considered that the use of a stylized text and colour did not alter the distinctive character of the mark per se, the fact that the stylization resulted in a change to one of the letters, thus altering the overall appearance of the mark, did alter the distinctive character. Accordingly, the mark as used was not an acceptable variant of the mark as registered. It follows that an additional word added to the mark, resulting in the mark being visually, aurally and conceptually different, will alter the distinctive character of that mark.”

26. In the case referred to by the holder above, the letter ‘T’ in the mark ECOTEX was altered so as to appear as a number 1 or 7. This was the reason that the mark shown in evidence was found not to be an acceptable variant of the registered mark. However, notably, the use of the mark with the additional wording (“a floortex brand”) was said to be acceptable use in line with *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, a case which concerned the use of one mark with, or as part of, another mark. In *Colloseum*, the Court of Justice of the European Union (“CJEU”) found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1)

² O/294/20

for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1).” (emphasis added)

27. Further, in *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He 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. 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.” (emphasis added)

28. In light of the above, I find the holder’s argument that the use of an additional word must alter the distinctive character of the mark and therefore mean that it is no longer an acceptable variant of the earlier mark, is somewhat misplaced. It is obvious from the case law in *Colloseum* that use of a mark with an additional element may continue to be considered acceptable use, so long as the mark itself continues to act as an indication of origin within the same. This was the finding in the ECOTEX decision referenced, and it was the changes made to the mark itself that were considered to alter its distinctive character, rather than its use along with other word elements. Further, as was set out in *Lactalis McLelland* the addition of descriptive or suggestive words are unlikely to change the distinctive character of a mark.

29. The marks shown in the opponent’s evidence include the following:

1. The logo features the words "BURNING" and "HOT" in a bold, yellow, 3D-style font with a black outline, stacked vertically. To the right, the number "7" is significantly larger, also in a bold, yellow, 3D-style font with a black outline, followed by an apostrophe and the letter "s". The background is a light green gradient.
2. The logo is identical to the first one, but the background is a dark, almost black, gradient.
3. The logo features the words "BURNING" and "HOT" in a bold, yellow, 3D-style font with a black outline, stacked vertically. To the right, the word "RESPIN" is written in a bold, yellow, 3D-style font with a black outline. Below "RESPIN" is a red, curved banner or ribbon. The background is a dark red gradient.
4. The logo is identical to the third one, but the background is a bright, fiery orange and yellow gradient.

30. The marks are also used in text within the evidence as below:

5. **Burning Hot™ 7's**
6. **Burning Hot™ Respin**

31. Firstly, I note the earlier mark is filed as a word mark which protects the words contained in the mark, whatever form, colour or typeface are used: see *LA Superquimica v EUIPO*, Case T-24/17, paragraph 39. I find its use in the colours and typefaces shown in the marks above to fall within the fair and notional use of the word mark as registered. In addition, it is my view that this element still acts as an indication of origin where it is used in combination with the elements '7's' and 'Respin' in the marks as shown, and I note these additional elements appear to describe a variation of the games offered under the marks. The use of the small 'TM' sign which is most often, although I note not strictly always placed after the element BURNING HOT, also helps to indicate to the consumer that this element acts as an independent sign of origin within the marks. I therefore find these marks to be acceptable variants in line with the case law set out in *Colloseum*. Further, I note in any case that as in my view the elements '7s' and 'Respin' are at least suggestive of game names, the addition of these words does not alter the distinctive character of the mark, nor does the arrow element or the other decorative features which I find to hold little if any distinctive character themselves. Overall, I find the variants of the marks shown in the evidence provided to be acceptable variants of the word mark as registered.

Use with consent of the opponent

32. In this instance, the opponent confirms that use of the mark has not been made directly by the opponent. However, it is the case that use of a trade mark with the consent of the proprietor may suffice to show genuine use of the mark. Consent may be express or implied.³ Further, it is not a requirement that the owner of the mark has effective control of the use in question.⁴

33. In this instance, the evidence shows the opponent licenses its intellectual property (including the mark relied upon) to companies within the Novomatic Group of

³ See *Makro Zelfbedieningsgroothandel CV and others v Diesel SpA*, Case C-324/08

⁴ See paragraphs 24 – 35 of *Einstein Trade Mark*, [2007] RPC 23

companies. On 1 January 2011, Novomatic UK were granted a licence from the opponent to use and to sublicense all of its intellectual property including the mark for the purpose of (broadly) remote gaming.⁵ This licence was then assigned from Novomatic UK to Astra Games by way of assignment dated 6 June 2019.

34. On 26 January 2011, Novomatic UK granted Greentube Internet Entertainment Solutions GMBH a non-exclusive and sublicensable licence to use various intellectual property rights including the marks.⁶ Pursuant to the same assignment as mentioned in the paragraph above, this licence was assigned from Novomatic UK to Astra Games on 6 June 2019,⁷ and was terminated on 6 June 2019.⁸

35. On 5 June 2019, the opponent granted Greentube Internet Entertainment Solutions GMBH a non-exclusive sublicensable licence to use its intellectual property including the mark.⁹ On 26 June 2019, the opponent provided Astra Games Limited with a licence for the purpose of formalising in writing what had previously been an informal licensing arrangement, granting a non-exclusive licence to Astra Games to use certain intellectual property rights including the mark.¹⁰

36. In January 2010 Novomatic UK purchased a majority share in Greentube Internet Entertainment Solutions GMBH and in August 2011 Novomatic UK acquired 100% of the share capital in the same.¹¹ In 2019, Greentube Internet Entertainment Solutions GMBH became a direct subsidiary of the opponent.¹² Astra Games was a subsidiary of Novomatic UK Ltd and a company within the Novomatic Group between 24 October 2014 and 1 October 2019.¹³ Mr Roch confirms in his witness statements that Greentube Internet Entertainment Solutions GMBH sublicensed the trade mark to

⁵ See paragraph 15.1 of the witness statement of Ms Schachter dated 16 October 2020 and Exhibit JS2.

⁶ See paragraph 15.2 of the witness statement of Ms Schachter dated 16 October 2020 and Exhibit JS3.

⁷ See paragraph 17 of the witness statement of Ms Schachter dated 16 October 2020 and Exhibit JS6.

⁸ See paragraph 17 of the witness statement of Ms Schachter dated 16 October 2020

⁹ See paragraph 15.3 of the witness statement of Ms Schachter dated 16 October 2020 and Exhibit JS4.

¹⁰ See paragraph 15.4 of the witness statement of Ms Schachter dated 16 October 2020 and Exhibit JS5.

¹¹ See paragraph 18 of the witness statement of Ms Schachter dated 16 October 2020

¹² See paragraph 18 of the witness statement of Ms Schachter dated 16 October 2020

¹³ See paragraph 19 of the witness statement of Ms Schachter dated 16 October 2020

Greentube Alderney Ltd, Funstage GmbH and Greentube Gibraltar Limited throughout the periods of 10 May 2014 to 9 May 2019 and 1 May 2015 to 30 April 2020 (the relevant periods for the previous actions)¹⁴ as well as throughout the period of May 2020 – October 2020.¹⁵

37. Ms Schachter's October 2020 statement provided at Exhibit JS1 to the most recent statement confirms that as a result of the formal and informal agreements outlined, use of the mark in the UK by Novomatic UK, Astra Games Limited, Greentube Internet Entertainment Solutions GMBH and their respective sublicensees (during the periods relevant to the previous opposition) was use with the consent of the opponent. Ms Schachter's statement filed for the purpose of these proceedings also confirms that the licences described in her October 2020 statement remained in place for the duration this subsequent period and that the use described by Mr Roch in his most recent statement was use with the opponent's consent.

38. I accept that by virtue of the above arrangements and the economic relationships in place above, the use of the trade mark in the UK by Novomatic UK, Astra Games Limited, Greentube Internet Entertainment Solutions GMBH and their subsidiaries and sublicensees (which I note from Mr Roch's statements include Greentube Alderney Limited, Funstage GmbH and L&L Europe Ltd) within the referenced periods will constitute use of the mark with the consent of the opponent and may therefore contribute to the genuine use of the mark as filed.

Use of the mark

39. With his witness statement dated 16 October 2020, Mr Roch sets out that the mark is used as the name of an online slot machine (also known as a fruit machine) game.¹⁶ He states the online game mimics a physical slot machine, in that the consumer tries to win money or points by putting virtual coins into the machine and operating it by clicking.¹⁷ He explains there are two versions of the game, those being 7s and Respin.

¹⁴ See paragraph 22 of the witness statement of Mr Roch dated 16 October 2020

¹⁵ See paragraph 15 of the witness statement of Mr Roch dated 15 August 2022

¹⁶ See paragraph 23 of the witness statement of Mr Roch dated 16 October 2020

¹⁷ See paragraphs 24 & 25 of the witness statement of Mr Roch dated 16 October 2020

The 7s game includes a double 7 symbol which holds a particularly high winning value, and the Respin game includes a feature that allows a further spin to be triggered if the initial spin is unsuccessful.¹⁸

40. Mr Roch explains that Greentube Internet Entertainment Solutions GMBH has three channels through which it supplies its products and services, stating at paragraph 6 of his October 2020 statement:

“The UK business of Greentube is twofold. First, there is the field of business-to-business, where casino games are licensed to online casino operators in the UK who themselves make those games available to players. Secondly there is the field of business-to-consumer, which is itself split into (i) traditional casino games made available directly to UK consumers online for real money and (ii) “social” online games played with credits, which can be purchased with real money.”

41. In respect of the online casino model, Mr Roch explains that the Burning Hot 7s game has been available in the UK via Admiral Casino (an online casino operated by its subsidiary and sub-licensee Greentube Alderney Limited¹⁹) since January 2015.²⁰ He confirms that Admiral Casino is a UK based offering, which operated through the UK website www.admiralcasino.uk/en and, until 15 May 2018, via the website PlayBFC.co.uk.

42. Under the business-to-business model Mr Roch explains Greentube Alderney Limited licence the use of the mark to online casino operator L&L Europe Ltd which offers online casino services in various territories including the UK.²¹ Invoices between Greentube Alderney Limited and L&L Europe Ltd are provided as Exhibit AR5 to Mr Roch’s October 2020 witness statement. Mr Roch confirms these invoices arose out of the license agreement in the UK. The invoices show royalty payments being made between the parties between April 2019 – September 2020. I note the payments are not broken down by mark, however, Exhibit AR6 to this statement provides a table

¹⁸ See paragraphs 26 – 28 of the witness statement of Mr Roch dated 16 October 2020

¹⁹ See paragraph 11, 15 & 22 of the witness statement of Mr Roch dated 16 October 2020

²⁰ See paragraph 31 of the witness statement of Mr Roch dated 16 October 2020

²¹ See paragraph 10 of the witness statement of Mr Roch dated 16 October 2020

setting out the total gross revenue of sales by L&L Europe Ltd under licence in the UK in respect of the Burning Hot Respin game between April 2019 – August 2020. This shows a sales revenue of 10,987.39 Euros for this period, with 8,843.97 Euros of that being from prior to February 2020.

43. Under the ‘social’ model, and Mr Roch explains that Funstage GmbH (a wholly owned subsidiary and sub-licensee of Greentube Internet Entertainment Solutions and a virtual social casino operation²²) has been offering the game since February 2015.²³ Funstage GmbH is said to offer synchronous play within mobile apps, social networks and other web-based technologies for players around the world, including in the UK.

44. Pages from the internet archiving website the Wayback Machine are provided at Exhibit AR4 to Mr Roch’s October 2020 statement. These show the use of the mark on the website www.gametwist.com/casino dating from March 2015 and April 2015, and on gametwist.com/en/games/slots dating from June 2017, October 2017, April 2018, and June 2018. Exhibit AR3 to this statement shows the Respin game under the mark on a ‘top and new’ list also on the gametwist.com/en website on 12 May 2017 via the Wayback Machine. Mr Roch explains in his statement the GameTwist website is Funstage GmbH’s flagship online platform for traditional casino games.²⁴ It can be used either online or via a phone or tablet using a mobile software app. Games on the site are played using credits which can be purchased using real money or won or received within the game.

²² See paragraphs 14 – 17 & 22 of the witness statement of Mr Roch dated 16 October 2020

²³ See paragraph 31 of the witness statement of Mr Roch dated 16 October 2020

²⁴ See paragraph 15 of the witness statement of Mr Roch dated 16 October 2020

45. Within his October 2020 witness statement, Mr Roch has provided three tables showing the total active players and total games played in respect of Burning Hot 7's and Burning Hot Respin. This are set out below:

39. The following table represents a consolidated breakdown of the total number of active players of the Burning Hot™ 7s and Burning Hot™ Respin games and the total number of games played (i.e. bet and spins) during the Relevant Period under the online casino model through Admiral Casino:

Period (inclusive)	Total Active Players	Total Games Played
January 2015 to December 2015	38	598,725
January 2016 to December 2016	2	1,546
January 2017 to December 2017	0	0
January 2018 to December 2018	6,002	536,889
January 2019 to December 2019	4,286	346,749
January 2020 to April 2020	2,693	268,140
Total during Relevant Periods	8,735	1,752,049

40. The following table represents a consolidated breakdown of the total number of active players of the Burning Hot™ 7s and Burning Hot™ Respin games and the total number of games played (i.e. bet and spins) during the Relevant Period under the business-to-business model:

Period (inclusive)	Total Active Players	Total Games Played
January 2015 to December 2015	0	0
January 2016 to December 2016	0	0
January 2017 to December 2017	0	0
January 2018 to December 2018	932	75,570
January 2019 to December 2019	1562	108,745
January 2020 to April 2020	414	36,499
Total during Relevant Periods	2,908	220,814

41. The following table represents a consolidated breakdown of the total number of active players of the Burning Hot™ 7s and Burning Hot™ Respin games and the total number of games played (i.e. bet and spins) during the Relevant Period under the social model through Funstage under the GameTwist brand:

Period (inclusive)	Total Active Players	Total Games Played
January 2015 to December 2015	38,015	9,769,829
January 2016 to December 2016	46,659	3,921,048
January 2017 to December 2017	46,240	4,271,613
January 2018 to December 2018	37,980	4,031,639
Period (inclusive)	Total Active Players	Total Games Played
January 2019 to December 2019	30,975	2,917,752
January 2020 to April 2020	12,587	959,103
Total during Relevant Periods	212,456	25,870,984

46. I note it is not referenced on the tables themselves (or in the explanation directly above the same) that all of the total active players are located within the UK. I also note both the business-to-business offerings and the social offerings appear to be

available to players both in the UK and elsewhere. However, at the hearing, Mr Hicks highlighted that these tables fell under a previous heading stating “Availability of the Burning Hot games in the UK” at paragraph 30 of Mr Roch’s October 2020 witness statement and submitted that a fair reading of the evidence is that these figures relate to UK users. Noting the heading referred to by Mr Hicks and considering the sum of the evidence provided relating the games availability in the UK which shows its consistent presence on the /en webpage, I accept that a fair reading of the evidence indicates that the number of active players relates to the number of UK active players. However, if I am wrong, I consider it reasonable to assume from the sum of the evidence that at least a portion of these will be from the UK in respect of each of the channels provided. Further, it is clear that at least in respect of the active players engaging in the games the .co.uk offering Admiral Casino, this will comprise primarily if not solely UK consumers.

47. Within his witness statement of 15 August 2022, Mr Roch supplemented the evidence above to cover the period of May 2020 – October 2020.

48. He confirmed that during this time the use of the earlier trade mark continued to be sub-licensed to Greentube Alderney Ltd, Funstage GmbH and Greentube Gibraltar Ltd and offered via the same channels, namely business-to-business, online casino and social.²⁵ He explains that under the business-to-business model L&L Europe Ltd continued to offer the same two games under the same variants of the marks to the UK public during this period.²⁶ Invoices for royalty payments arising out of the UK licensing arrangement are provided at Exhibit AR3. Three invoices are provided for this period, each for several thousand Euros, but I note again these are not broken down by mark. However, Mr Roch also provides a table outlining the total gross revenue of sales in respect of “Burning Hot Respin” in the UK for the invoice period “October 2020”. The total is given as 1,544 Euros.²⁷

49. Mr Roch goes on to confirm that under the online casino model the use of the mark has continued to be licensed to Greentube Alderney Limited who offer the games under the acceptable variants of the mark in the UK on www.admiralcasino.co.uk/en

²⁵ See paragraph 15 of the witness statement of Mr Roch dated 15 August 2022

²⁶ See paragraph 18 of the witness statement of Mr Roch dated 15 August 2022

²⁷ See paragraph 20 of the witness statement of Mr Roch dated 15 August 2022

during this time.²⁸ He provides that the total number of active players of the games under the marks through Admiral Casino from May to July 2020 was 1,536 and the total number of games played during that period was 275,320.²⁹

50. Under the social model, Mr Roch states that Funstage GmbH has continued under licence to offer the games under the acceptable variants of the marks in the UK under the “GameTwist brand” during this period.³⁰ Exhibit AR4 to this statement provides print outs dated by the web archiving site the Wayback Machine showing the use of the acceptable variants of the mark on www.gametwist.com/en dated 19 September 2020. The number of active players and games played under the marks on this site for this period are given as below:

Period (inclusive)	Total Active Players	Total Games Played
May 2020	9,757	5,532,404
June 2020	8,023	4,287,937
July 2020	8,134	4,067,060
August 2020	8,016	3,915,355
September 2020	7,876	3,996,183
October 2020	8,045	4,150,789
Totals during Subsequent Period	49,851	25,949,728

51. I note the figures provided in this statement follow the Mr Roch’s statement that he had *“arranged for a search to be carried out of Greentube’s internal company records to determine the usage of the Burning Hot 7s and Burning Hot Respin games in the UK during the Subsequent Period and discovered as follows”*.³¹ Again, I accept that a fair reading of the evidence suggests that these figures are therefore intended to relate to UK based active players. However, if I am wrong, it is again the case that the games are offered on a ‘/en’ site during this period and it is reasonable to assume a portion of these players will be based in the UK.

52. In this instance, the goods relied upon within this opposition comprise solely *computer software namely for casino games, amusement arcade games and games*

²⁸ See paragraph 21 of the witness statement of Mr Roch dated 15 August 2022

²⁹ See paragraph 22 of the witness statement of Mr Roch dated 15 August 2022

³⁰ See paragraph 23 of the witness statement of Mr Roch dated 15 August 2022

³¹ See paragraph 16 of the witness statement of Mr Roch dated 15 August 2022.

of chance via telecommunications networks and/or the Internet. Further explanation regarding the offering of the games above as downloadable goods is provided at Annex AR2 to Mr Roch's most recent statement, within his second witness statement provided for the previous proceedings before the Tribunal dated 12 April 2021. This statement explains:

- When accessing the games via the website, a copy of the games is temporarily downloaded onto the players computer, and subsequently deleted automatically at the end of the gaming session;
- Where the games are available via the mobile software application (app) the players would have downloaded the app from the Apple store or Google store. The game remains installed on the app ready to play again;
- In both cases above the number generation would have been carried out remotely on the servers of the provider of the game;
- In the business-to-business model the games were made available to players via L&L Europe Ltd both via their website and through their app;
- In the online casino model the games were made available to players both via the website www.admiralcasino.co.uk/en and www.playbfc.co.uk and through the Admiral Casino app;
- The social uses of the games were made available to players via the Funstage app;
- All players of the games would therefore have downloaded those games into their desktop computers or mobile devices.

53. In the appeal decision BL O/243/22 discussing the opponent's goods, Geoffrey Hobbs Q.C. (as he then was) sitting as the appointed person considered whether the use in respect of the games shown in the evidence (which has been refiled in these proceedings) constituted use in relation to computer software goods as filed in class 9. He stated:

"16. As noted in paragraphs [129] and [130] of the Judgment of Arnold J (as he then was) in *Sky Plc v SkyKick UK Ltd* [2018] EWHC 155 (Ch), the term "computer software" appeared in the explanatory note to Class 9 in the 8th Edition (1 January 2002) and 9th Edition (1 January 2007) of the Nice

Classification before subsequently being included in the Class Heading to Class 9 in the 10th Edition (1 January 2012). The explanatory note stated that Class 9 is the correct class for “all computer programs and software regardless of recording media or means of dissemination, that is, software recorded on magnetic media or from a remote computer network.”

17. The correct approach continues to be as stated at paragraph 6.25 of Annex 6 to the EUIPO Trade Mark Guidelines (Part B Examination, Section 3 Classification) (01.03.2021): “All material that is downloadable is proper to Class 9. This includes publications, music, ring tones, pictures, photographs, films or film extracts and digitalised information in general. Downloaded material is saved onto a memory unit or computer drive, telephone, tablet or other wearable device. It can then be used independently of its source. These goods can also be called virtual goods. All these downloadable goods can be retailed.”

18. For validation of that approach, it is sufficient to refer to the Judgment of the Court of Justice in Case C-410/19 The Software Incubator Company Ltd v Computer Associates (UK) Ltd EU:C:2021:742 at paragraphs [34] to [36] and [38]:

“[34] In the first place, as regards the term ‘goods’, according to the Court’s case-law, that term that term is to be understood as meaning products which can be valued in money and which are capable, as such, of forming the subject of commercial transactions (see, to that effect, ... Commission v Greece, C65/05 ... paragraph 23 and the case-law cited).

[35] It follows that that term, as a result of its general definition, can cover computer software, such as the software at issue, since computer software has a commercial value and is capable of forming the subject of a commercial transaction.

[36] Furthermore, it must be stated that software can be classified as ‘goods’ irrespective of whether it is supplied on a tangible medium or, as in the present case, by electronic download. ...

[38] ... the Court has already held that, from an economic point of view, the sale of a computer program on CD-Rom or DVD and the sale of such a program by downloading from the internet are similar, since the online transmission is the functional equivalent of the supply of a material medium (... UsedSoft, C-128/11 ... paragraph 44).”

19. A “computer software” product in Class 9 is bought and sold for what it does; and what it does is regarded as a defining characteristic of what it is. This is recognised in paragraph [51] of the Judgment of the General Court in Case T-204/20 Zoom KK v EUIPO EU:T:2021:391:

“51. As the applicant states, in essence, in paragraph 28 of the application, software consists of programs which control the operation of a machine, especially a computer, and enable it to perform a desired sequence of operations. It follows that a program must be understood in relation to the operations which it carries out and therefore in relation to its function. Thus, the consumer will be guided primarily by the specific function of the product rather than by its nature.”

20. The combined effect of the considerations noted above is to require “computer software” in Class 9 to be assimilated with and to the functionality it possesses in the hands of end users to whom it is delivered, irrespective of the way in which it is delivered to them. That appears to me to be reflected in the prevailing approach to interpretation of the term “software” in the context of Class 9. For example:

(i) “In so far as the heading under class 9 contains the term ‘software’, the goods covered by the earlier mark are necessarily identical to computer game software for personal computers and home video games consoles covered by 7 Burning Hot Trade Mark the mark applied for”: Case T-717/13 Chair Entertainment LLC v OHIM EU:T:2015:242 at paragraph [33].

(ii) In Case T-588/19 Novomatic AG v EUIPO EU:T:2021:157 at paragraphs [39], [40] the General Court stated in the course of examining the evidence submitted by the trade mark proprietor in answer to a claim for non-use of its trade mark for “casino games” in Class 28 that: “... the evidence provided only shows the contested mark on the screen of the casino gaming machines, which demonstrates, as well as the Board of Appeal found, that it is used to refer to a gaming computer program that materialises on the screen of casino devices. The Board of Appeal therefore rightly considered that the software and the game, as visible on the screen, were the same. Consequently, the applicant has not proved the use of the contested mark for a virtual product other than game software falling within class 9.” [machine translation]

(iii) In Case T-56/20 Bezos Family Foundation v EUIPO EU:T:2021:103 at paragraphs [25], [33] the General Court proceeded on the basis that the Fifth Board of Appeal of the EUIPO had correctly found that: “... the ‘computer software’ and ‘mobile applications’ designated by the earlier trade mark included ‘computer software, namely a mobile application for providing information and learning and educational activities and games in the field of early child development and early childhood education’, covered by the mark applied for, and, as a result, those goods were identical”.

21. Looking at the matter commercially in terms of the wants and needs of consumers in the market place, there does not appear to me to be any real or meaningful distinction to be drawn between an interactive computer game and the computer software which brings the gameplay to life at the user interface. I regard that as sufficient (there being no need in the present case to address the subject of consumer perception in relation to the functionality of computer software more generally) to justify the first instance finding and also the further wording properly conceded by Euro Games on this appeal to the overall effect that there was genuine use of the trade mark BURNING HOT within the relevant 5 year period for: “Computer software namely for casino games, amusement

arcade games and games of chance via telecommunications networks and / or the internet” in Class 9.”

54. Considering the sum of the evidence filed within these proceedings, it is my view that the opponent has established that there has been use of the mark or an acceptable variant within the UK and across both of the relevant time periods. Further, I consider that the use shown is, for the reasons set out by Geoffrey Hobbs Q.C. (as he then was) above, use of computer software goods in class 9.

55. Mr Hicks stated at the hearing that he acknowledged I am not bound by the previous first instance and appointed person’s decisions issued in a corresponding case, but he submitted that I should see these as persuasive. I note that considering near identical evidence to that I have considered within this decision, the previous hearing officer found that the protection afforded under the opponent’s mark should be limited to *computer software namely for casino games via telecommunications networks and/or the Internet* as use had been found in relation to online casino games only and had not been found in respect of the other categories of goods which were at the time, subject to revocation. This decision was altered on appeal as a result of a concession made by the applicant rather than due to an alternate finding by the appointed person. Whilst I note the use of Mr Hobbs Q.C.’s (as he then was) expression that the additional goods were “properly conceded”, it is not entirely clear whether he would have also come to this decision independently based on the evidence presented. However, I note Mr Hicks argues for the opponent that it has nonetheless evidenced genuine use for the goods shown within the broader specification ultimately maintained and relied upon within this opposition, namely *computer software namely for casino games, amusement arcade games and games of chance via telecommunications networks and/or the Internet*.

56. This case must be determined on its own merits. I therefore consider afresh whether the use shown is use falling within all of the categories relied upon. It is my view that the use of the mark is clearly use in respect of online casino games which may be played via the internet or on a mobile phone, which fall squarely within the opponent’s goods *computer software namely for casino games via telecommunications networks and/or the Internet*. Further, I consider that the online

games shown in the evidence are also games of chance and therefore fall within the of category *computer software namely for games of chance via telecommunications networks and/or the Internet* as relied upon.

57. That leaves *computer software namely for amusement arcade games via telecommunications networks and/or the Internet*. I consider whether a slot machine game falls within the category of amusement arcade games. It is my view that amusement arcades differ to casinos, with casinos providing gambling games for over 18's in which money can be won, whereas amusement arcades are often provided primarily for entertainment for a variety of age groups. However, I consider that amusement arcades will come in different forms, with some focused more on younger children and family fun, and some being of a more adult nature, and that the latter will often include machines for modest gambling, such as slot machines. Further, I note that the slot machine games offered via the opponent's 'social' channel are primarily for entertainment purposes, with credits being used and won rather than cash and cash prizes, and so the games are not always for gambling purposes. Whilst I note that Wikipedia pages are not always reliable as they may be edited by members of the public, I do also note that the Wikipedia pages filed in evidence at Exhibit AR1 of AR1 and dated 13 October 2020 reinforce my view that slot machines may feature in amusement arcades, stating:

Category C

Category C games are often referred to as **fruit machines, one-armed bandits** and **AWP (amusement with prize)**. Fruit machines are commonly found in pubs, clubs, and arcades. Machines commonly have three but can be found with four or five reels, each with 16–24 symbols printed around them. The reels are spun each play, from which the appearance of particular combinations of symbols result in payment of their associated winnings by the machine (or alternatively initiation of a subgame). These games often have many extra features, trails and subgames with opportunities to win money; usually more than can be won from just the payouts on the reel combinations.

58. Earlier in this exhibit, it explains that a 'Category C' slot machine or fruit machine is one with lower stakes and prizes than Category A and B machines.

59. Considering the above, I therefore find the opponent has shown use for online games falling within all of the categories relied upon within this opposition. When considering if I find this use to constitute genuine use, I note the opponent has not provided me with evidence relating to the size of the market for these goods, and it is

my view that this will be large. I note that the number of users and the revenue figures provided will likely be small when compared to the size of the market for the type of games offered. However, use of the mark need not always be quantitatively significant for it to be deemed genuine. Considering the sum of the evidence, including the evidence of the consistent use across the relevant periods, is my view that the use of the mark in this instance has neither been token nor trivial. Rather, it appears to be a genuine attempt to create and maintain a market for the goods. I therefore consider the use of the mark shown by the opponent in respect of goods falling within the categories of *computer software namely for casino games, amusement arcade games and games of chance via telecommunications networks and/or the internet* is genuine.

Fair specification

60. I note the opponent's goods *computer software namely for casino games, amusement arcade games and games of chance via telecommunications networks and/or the internet* will cover a broader range of online games than the type of slot machine game that has been offered under the mark. I, therefore, consider if the full specification covering these categories of goods as relied upon is justified in the circumstances.

61. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

62. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

63. I note that the opponent has shown use only for virtual slot machine games. However, considering the case law above, I do not consider it would be appropriate to narrow the opponent's protection only to the specific goods for which the use has been shown. It is my view that the consumer would consider the *computer software namely for casino games, via telecommunications networks and/or the internet* to be a fair description of the goods for which genuine use has been shown. I also consider that *computer software namely for games of chance via telecommunications networks and/or the internet* would be considered to fairly describe the same.

64. However, I consider that the term *amusement arcade games* covers a very broad range of games. It will cover games of skill, including those such as combat games and driving games, games of chance such as the slot machine type games covered by the opponent, and two or more player competitive games such as table football or air hockey. It is my view that *computer software namely for amusement arcade games, via telecommunications networks and/or the internet* will also cover this broader range of games (albeit played virtually) and may therefore be broken down into a number of subcategories. Whilst it is not appropriate to narrow the protection down only to the specific goods shown, it is my view that *computer software namely for amusement arcade games of chance, via telecommunications networks and/or the internet* would be considered a fair description in this respect. Overall, I consider the following to be an appropriate and fair specification:

Computer software namely for casino games and games of chance including amusement arcades games of chance, all via telecommunications networks and/or the internet.

Decision

Section 5(1)

65. I will begin by considering the opponent's opposition based on section 5(1) of the Act. This reads as follows:

5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

Identity of the marks

66. Under this ground, the marks for comparison are as follows:

Earlier mark	Contested mark (IR 372)
BURNING HOT	BURNING HOT

67. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the CJEU held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

68. Both the earlier mark and IR 372 comprise the same words BURNING HOT in standard font. If it is considered that there is any difference in the font used in the marks above, it is my view this is so insignificant that it will go unnoticed by the average consumer. It is my view that these marks may be considered identical.

Comparison of the goods and services

69. Goods and services may be considered identical where they are worded identically, or where they are worded differently but both terms refer to the same goods or services. Further, in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

70. 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.”

71. The goods and services to be compared under section 5(1) of the Act are as follows:

Earlier goods	Contested goods
Class 9: <i>Computer software namely for casino games and games of chance including amusement arcades games of chance, all via telecommunications networks and / or the internet.</i>	Class 9: <i>Software; computer gaming software; computer software packages; computer software, recorded; virtual reality software; games software; entertainment software for computer games; computer game programs; computer programs for recorded games; computer application software featuring</i>

	<p><i>games and gaming; computer software for the administration of on-line games and gaming; computer hardware for games and gaming; computer hardware and software for gambling, gambling machines, gambling games on the Internet and via telecommunication network.</i></p> <p><i>Class 28: Gaming machines for gambling; arcade games; gambling machines operating with coins, notes and cards; games; electronic games; slot machines [gaming machines]; LCD game machines; slot machines and gaming devices; coin-operated amusement machines; gaming equipment for casinos; casino games; amusement and gambling machines; coin-operated gaming machines and / or electronic coin-operated gaming machines with or without the possibility of gain; electronic or electro-technical gaming devices, amusement and gaming machines, including coin-operated machines; housings for coin-operated machines, gaming equipment, gaming machines, machines for gambling; electro-pneumatic and electrical gambling machines (slot machines).</i></p>
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	<p>Class 41: <i>Gambling; entertainment services related to gambling; gaming services for entertainment purposes; casino, gaming and gambling services; gaming machine entertainment services; online gambling services; online gambling services.</i></p>
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72. The opponent's goods are essentially computer software goods for casino games and games of chance (including amusement arcade games of chance) that are played on the internet, for example on computers or tablet devices, or via telecommunication networks, for example on mobile phones. I consider that the opponent's goods fall within the following categories covered by the holder. I therefore find the following goods to be identical in line with the principles set out in *Meric*:

Software; computer gaming software; computer software packages; computer software, recorded; games software; entertainment software for computer games; computer game programs; computer programs for recorded games; computer application software featuring games and gaming; computer software for the administration of on-line games and gaming; computer software for gambling, gambling machines, gambling games on the Internet and via telecommunication network.

73. I do not consider there to be identity with the earlier goods and any of the remaining goods relied upon. At the hearing, I note Mr Hicks argued for the opponent that *virtual reality software* is (or at least includes) a type of games software. Therefore, it was submitted that it includes (or is at least highly similar to) the class 9 goods covered by the earlier mark. However, it is my view that virtual reality software is a specific type of software for enabling an experience in another reality. Whilst this may be used to play certain types of games, I have no evidence that this software will include computer software for casino games or games of chance including amusement arcade games of chance via telecommunications networks and/or the Internet, and in my view the ordinary and natural meaning of virtual reality software does not include these goods (or vice versa). I therefore do not consider these goods to be identical.

74. Where both the marks are identical and the goods are identical, the opposition under section 5(1) of the Act succeeds. IR 372 is therefore refused in respect of all of the identical goods. However, as it is a requirement of section 5(1) of the Act that the goods (or services) be identical, the opposition fails under this ground in respect of the following goods and services:

Class 9: Virtual reality software; computer hardware for games and gaming; computer hardware for gambling, gambling machines, gambling games on the Internet and via telecommunication network.

Class 28: Gaming machines for gambling; arcade games; gambling machines operating with coins, notes and cards; games; electronic games; slot machines [gaming machines]; LCD game machines; slot machines and gaming devices; coin-operated amusement machines; gaming equipment for casinos; = casino games; amusement and gambling machines; coin-operated gaming machines and / or electronic coin-operated gaming machines with or without the possibility of gain; electronic or electro-technical gaming devices, amusement and gaming machines, including coin-operated machines; housings for coin-operated machines, gaming equipment, gaming machines, machines for gambling; electro-pneumatic and electrical gambling machines (slot machines).

Class 41: Gambling; entertainment services related to gambling; gaming services for entertainment purposes; casino, gaming and gambling services; gaming machine entertainment services; online gambling services; online gambling services.

Section 5(2)(b)

75. 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”.

Section 5A

76. Section 5A of the Act is as follows:

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

Likelihood of confusion (standard case law)

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

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of goods and services

78. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

79. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

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

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

Comparison of goods and services in respect of IR 372

80. With the above case law in mind, the goods and services for comparison in respect of IR no. 372 are set out again below:

Earlier goods	Contested goods (IR 372)
<p><i>Class 9: Computer software namely for casino games and games of chance including amusement arcades games of chance, all via telecommunications networks and / or the internet</i></p>	<p><i>Class 9: Software; computer gaming software; computer software packages; computer software, recorded; virtual reality software; games software; entertainment software for computer games; computer game programs; computer programs for recorded games; computer application software featuring games and gaming; computer software for the administration of on-line games and gaming; computer hardware for games and gaming; computer hardware and software for gambling, gambling machines, gambling games on the Internet and via telecommunication network.</i></p> <p><i>Class 28: Gaming machines for gambling; arcade games; gambling machines operating with coins, notes and cards; games; electronic games; slot machines [gaming machines]; LCD game machines; slot machines and gaming devices; coin-operated</i></p>

	<p><i>amusement machines; gaming equipment for casinos; casino games; amusement and gambling machines; coin-operated gaming machines and / or electronic coin-operated gaming machines with or without the possibility of gain; electronic or electro-technical gaming devices, amusement and gaming machines, including coin-operated machines; housings for coin-operated machines, gaming equipment, gaming machines, machines for gambling; electro-pneumatic and electrical gambling machines (slot machines).</i></p> <p><i>Class 41: Gambling; entertainment services related to gambling; gaming services for entertainment purposes; casino, gaming and gambling services; gaming machine entertainment services; online gambling services; online gambling services.</i></p>
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Class 9

81. In my comparison under section 5(1) of the Act, I found previously that the contested goods set out in paragraph 72 are identical to those covered by the opponent.

82. Next, I consider the similarity of the contested *virtual reality software* in class 9 with the opponent's earlier goods. For the reasons previously set out, I do not consider these goods to be identical. As mentioned, it is my view that virtual reality software is software for enabling an experience in another reality. This may be used to play various types of computer games, although I note I have no evidence that this will

include software for playing casino games or games of chance including arcade games of chance via telecommunications networks and/or the internet as such. I consider there will be an overlap in terms of nature, user and purpose, in that these are all software goods which may be used by the general public for entertainment and gaming purposes. However, I do not consider the specific purpose of the goods, one being for the provision of casino or chance games via telecommunication networks or the internet, and one enabling a virtual reality experience (possibly within a game), to be shared. I do not consider that the trade channels will be shared, and without evidence to the contrary I find it unlikely the goods will be offered by the same entity. I do not consider the goods to be complementary. Whilst I acknowledge both may be used by the general public for entertainment and gaming purposes, I do not consider there will be a pronounced competitive relationship between the same. Overall, considering all of these factors, I consider that the contested goods *virtual reality software* to be similar to the opponent's goods only to a low degree.

83. Next, I consider the contested goods *computer hardware for games and gaming*. Keeping in mind the terms ordinary and natural meaning, I consider these goods may include items such as the computer parts for making games and games consoles and computer parts for gaming machines, although I do not consider it will include full games consoles or gaming machines which themselves fall within class 28. I note that at a very high level, there may be some overlap in purpose in that both the computer hardware and the opponent's goods might ultimately be for the purpose of enabling the user to play a sort of computer game. However, I find their specific purpose, one being to provide or contribute towards the functioning of a physical machine or piece of apparatus and one to provide an online game to the user will differ. I consider that the nature of the goods will also differ, with one being hardware and one being software. Further, I consider that the method of use will differ. There may be a basic overlap with regards to users, in that members of the general public may technically use the computer hardware for games and gaming in addition to the opponent's software goods. Whilst I note it may be that some computer parts and specific computer hardware for games and gaming is required to enable the consumer to engage in the opponent's games via the internet or telecommunications networks, I do not find the consumer would believe the goods would derive from the same entity. I therefore do not find these particular goods complementary, or in competition.

Overall, considering all of the factors, and in the absence of evidence to the contrary, it is my view that the goods are dissimilar.

84. The contested application also covers *computer hardware for gambling, gambling machines, gambling games on the Internet and via telecommunication network*. I note this term may include, for example, computer parts for physical gambling machines, or computer hardware for the servers used for the internet gambling games for example. On this basis, I consider there may again be a high-level overlap between the purpose of the contested goods and the opponent's goods on the basis that they will both include those for the ultimate purpose of providing online casino games and games of chance. However, again the specific purpose will differ. Again, the nature of these goods differs from the opponent's goods. Further, the method of use will differ. Whilst I note that end users may be shared, in that consumers playing an online casino game offered by the opponent may also technically be using the computer hardware responsible for assisting with the functioning of the game, it is my view that the consumers purchasing the hardware goods will instead likely be those professionals requiring servers or machines parts. I consider that the consumer is unlikely to assume that the entity offering an online casino game will also provide computer parts for physical gambling machines or for computer servers. I therefore do not consider the goods to be complementary. The goods will not be in competition with one another. Overall, it is my view that the very general overlap in purpose and small overlap in end users will not be sufficient to render the goods similar.

Class 28

85. The contested application covers the following goods in class 28:

Gaming machines for gambling; arcade games; gambling machines operating with coins, notes and cards; games; electronic games; slot machines [gaming machines]; LCD game machines; slot machines and gaming devices; coin-operated amusement machines; gaming equipment for casinos; casino games; amusement and gambling machines; coin-operated gaming machines and/or electronic coin-operated gaming machines with or without the possibility of gain; electronic or electro-technical gaming devices, amusement and gaming

machines, including coin-operated machines; electro-pneumatic and electrical gambling machines (slot machines).

86. The above goods are all types of gaming machines and devices that will include either casino games or games of chance including amusement arcade games of chance. These will be the physical version of the goods, rather than the software for playing the games online, and so the nature will be different. However, both will share a purpose of being used to gamble or play a game of chance for entertainment. End users of the goods will be shared by way of members of the general public; however, consumers will differ on the basis that the machines themselves will likely be purchased by businesses looking to provide these within their establishment. The end user may consider playing an online version of a game, or playing the physical version of the same game, and to that extent there may be some competition between the same, however, I do not consider the goods to be complementary. It is my view that these machines themselves are not important to the opponent's software for playing the online games offered and the online games are not important for the use of the machines. Whilst I do not doubt the machines may require some sort of computer software to function, the opponent's goods are limited to computer software for playing the games on the internet and via telecommunication networks, and in my view are not (and should not be following my assessment of genuine use) so broad as to cover computer software used for the functioning of physical gambling machines. In addition, I find it unlikely that those providing games for playing via the internet or telecommunications networks would also provide machines for playing games within physical establishments, or that the consumer would assume as such. The trade channels will likely differ, with the software goods being available for download via an app store or accessed via a website, and the physical goods likely being sold via different physical or online retail stores or brochures and catalogues. Overall, considering the similarities and the differences between the goods, it is my view they will be similar to a low degree.

87. Next, I consider the contested goods *housings for coin-operated machines, gaming equipment, gaming machines, machines for gambling*. Within his skeleton arguments, Mr Hick's stated:

“These are similar goods to Novomatic’s “Computer software for ... amusement arcade games”.

An arcade machine can be upgraded by installing new software. The “housings” are merely the container in which the computer equipment and software are stored. The same purchasers and users would be interested in both.”

88. At the hearing, I reminded Mr Hick’s that the term upon which the opponent was seeking to rely was not simply computer software for amusement arcade games, but computer software for amusement arcade games *via telecommunications networks and/or the Internet*. I highlighted that this, in my view, has a slightly different meaning. I note of course that this term is now slightly more limited within this opposition.

89. Mr Hick’s stated that whilst the user of the housings will not be a member of the general public but rather a someone wanting to build a coin-operated machine, these were still sufficiently similar to virtual machines for section 5(2) to be triggered. He also stated that the opponent stands by the reasoning for the similarity of these goods set out in the statement of grounds. I note also there is no specific reasoning given as to why housings for coin-operated machines should be considered similar to the earlier goods within the statement of grounds filed. However, in any case I consider the nature of the goods will differ, as will the purpose, method of use, and the user of the goods, with these being for professionals and businesses requiring housings for gaming equipment, rather than the users of the online games or operators of online services. I do not consider the goods to be in competition, or that they are complementary. I find it unlikely the goods will share trade channels. Overall, I consider the goods to be dissimilar.

Class 41

90. The contested goods include *online gambling services* twice. Whilst I note that these goods are included in the specification of goods under this mark for the second time following the term ‘provision of’, I find this makes no material difference to the comparison I am required to make. I consider these services will include services for providing online gambling within which the consumer may engage in various casino

games and services. Whilst the nature of the earlier goods and these services will inevitably differ, I consider that the purpose will overlap, with both the goods and services being for the purpose of enabling the consumer to engage with gambling online, and there may be an overlap in trade channels. I consider that computer software for playing online casino games via the internet will be important if not essential to the running of an online casino, and the same entity may well be responsible for offering both online gambling services and the computer software casino games for playing on the internet or via telecommunication networks, and it is likely the consumer would believe as such. I therefore find there will be complementarity between these goods and services. Overall, I consider these services to be similar to the opponent's earlier goods to a medium degree.

91. The contested services also include:

gaming services for entertainment purposes; gaming [...] services

92. It is my view these will primarily comprise services offered online for the purpose of playing games, including the types of games covered by the opponent's specification. For the same reasons as set out in the paragraph above, I find these services to be similar to the opponent's goods to a medium degree.

93. The contested services also include those outlined below:

Gambling; entertainment services related to gambling; casino [...] and gambling services

94. I note that all of the categories of services set out above will, in my view, include the online version of the services listed. It is my view that the reasoning I have set out in respect of *online gambling services* will therefore apply to these broader services, and to this extent, the services are similar to the earlier goods to a medium degree.

95. The contested goods also include *gaming machine entertainment services*. I consider these to be in person services. I note the method of use of the services and the earlier goods will be very different, as will the nature of the services when

compared with the same. I find it unlikely the trade channels will be shared, and I find providers of physical establishments such as arcades unlikely to also offer computer software for playing online games of chance on the internet or via telecommunication networks, which will require a very different set of expertise. I do not consider the goods and services to be complementary to this extent. I note there may be a small element of competition, with consumers possibly choosing to engage with the computer software for playing games on the internet or telecommunication networks instead of engaging with the in-person services, but I do not consider the competition to be particularly pronounced on the basis that the offerings will generally be quite different. Users will be shared only to the extent that both the goods and services may be used by the general public. Whilst there will also be a broad overlap in purpose, with both the earlier goods and these services providing the consumer with access to gaming, the more specific purpose, for allowing the consumer to play downloadable online casino games and games of chance on their phone or tablet for example, and for providing the consumer with physical in person services related to gaming machines will differ. Considering all these factors, I note here that I do not find the very general similarities between the goods and the in-person gaming services to be such that they should be classed as similar.

Comparison of the goods and services in relation to IR 809

96. Where the contested goods and services under this mark are shared with those listed under IR 372, the same findings will apply. However, the contested specification under this mark differs in respect of some of the goods in class 28 and some services in class 41. In class 28, the following additional goods are included in the specification under this mark and therefore require comparison with the earlier goods:

Class 28: apparatus for casino games; automats and gambling machines; electronic or electrotechnical gaming devices, namely, automats and machines, coin-operated machines; gaming machines

97. In class 41, the following additional services require comparison with the earlier goods:

Class 41: *on-line gaming services; casino services;*

98. In respect of the class 28 goods above, I consider that my findings made in respect of those goods outlined at paragraph 86 apply. I therefore consider these goods to be similar to the earlier goods covered by the opponent to a low degree.

99. In respect of on-line gaming services in class 41, it is my view that these will be included within gaming services generally, and my findings in respect of these services will be the same as those outlined in respect of the gaming services at paragraph 92 of this decision. I find these services similar to the earlier goods to a medium degree.

100. Further, I find that *casino services* above are incorporated within the services *casino [...] and gambling services* previously compared at paragraph 94, and as such my findings in respect of these services apply here.

Comparison of marks

101. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

102. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks

and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

103. The respective trade marks are shown below:

Earlier trade mark	Contested trade marks
BURNING HOT	BURNING HOT (IR 372)
	 (IR 809)

104. The earlier mark comprises the two words BURNING HOT. These elements hang together and both make a roughly equal contribution to the overall impression of the mark.

105. IR 372 also comprises the two words BURNING HOT. Again, these elements hang together and both make a roughly equal contribution to the overall impression of the mark.

106. IR 809 comprises a number of elements. The wording BURNING HOT is placed in the lower section of the mark. However, it is relatively large, and whilst placed in a less central position to the large four-leaf clover device, I consider the wording BURNING HOT to be the most distinctive element within this mark. I find both these elements to contribute to the overall impression of the mark itself. The smaller images of the fruits and a bell, in addition to the large green square all appear to play a largely decorative role within the mark, and whilst they are not negligible, they play a lesser role in the overall impression of the same.

IR 372

107. As outlined previously in respect of section 5(1) of the Act, I consider this mark to be identical to the earlier mark.

108. I note here for completeness that an opposition based on section 5(2)(b) requires only that a mark be found similar to an earlier mark, and not that it be found identical. However, in my view it would be artificial to find that because the marks are identical in this instance, there is no similarity between them and as such the opposition must fail. Instead, I consider that the marks are similar to the highest level in all respects. It is unnecessary for me to invite the opponent to amend its pleadings at this stage on the basis that it has exceeded the requirements (in respect of the similarity of marks) for an opposition based on its chosen grounds. I will therefore continue to assess the opposition based on section 5(2)(b) of the Act and on the basis that IR 372 is similar to the earlier mark to the highest level possible.

IR 809

Visual comparison

109. This mark coincides visually with the earlier mark by way of the two word elements BURNING HOT. These elements comprise the whole of the earlier mark and also feature as a dominant and the most distinctive element of the contested mark. However, there are several other visual elements, including the dominant four-leaf clover device and the decorative fruit and bell devices and green square which are not present in the earlier mark, all of which act as points of visual difference. Overall, I find the marks to be visually similar to a medium degree.

Aural comparison

110. The only verbal elements present in each mark are identical, those being the two words BURNING HOT, which will be pronounced in the normal way.

Conceptual comparison

111. The earlier mark comprises the two words BURNING HOT. It is my view that this will hang together to convey the concept of something with a very hot temperature that is scalding to the touch. This will be true for the wording across both of the marks. This is the only concept conveyed by the earlier mark. In contrast, the later mark also contains a large four-leaf clover device and the less dominant fruit and bell images, all of which may be conceptualised. The clover device will of course convey the primary concept of a four-leaf clover but will in my view be considered by the consumer as a symbol of luck and will also convey this meaning to the consumer. The concept created by this symbol of luck will be fairly weak in the context of the goods and services. The smaller images of fruit and a bell may only convey the concept of the items themselves to the consumer, although they are likely, in the context of the goods and services, to also be considered by the consumer as depicting images found on slot machines. Overall, it is my view that due to the strong shared identical concept created by the use of BURNING HOT across both marks, the marks are conceptually similar to a fairly high degree.

Average consumer and the purchasing act

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

113. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words

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

114. In this instance, the average consumer of the goods and services will vary. In respect of the many of the goods and services for gaming and entertainment, the average consumer will primarily comprise members of the general public. In respect of the goods and services related specifically to gambling, consumers will generally comprise members of the general public over the age of 18. I note there may also be a group of professional consumers, such as businesses responsible for the running of an online casino or gaming website, who may purchase the goods, such as the opponent’s computer software goods in class 9, for the purpose of populating these sites. Further, professional consumers will also be the primary consumer group in respect of many of the class 28 goods such as the gaming machines for gambling which may be purchased by professionals to put in casinos or arcades, with the general public being the end user of the same.

115. The level of attention paid towards the goods is likely to vary depending on the goods and services and the consumer. In respect of the class 9 goods, where the consumer will be gambling their own money, they may consider factors such as the stakes and pay outs available from the games, as well as the type of game offered, and a medium degree of attention is likely to be paid in respect of the same. Where the class 9 goods are not gambling related, the consumer may pay a lower degree of attention on the basis that these may be freely available to download and they may be engaged with more frequently without risking their own money, although they may still consider factors such as the type of game offered and its entertainment value. In these instances the general public will likely pay from a low to medium level of attention to these goods. Where professionals are purchasing the class 9 goods for the purpose of populating their sites, the level of attention will be higher, that being at least medium or above, on the basis that the games offered will likely be fundamental to the success of the platform and services offered.

116. In respect of the class 28 goods such as gaming machines for gambling, whilst the price will vary, these are unlikely to be low cost, frequently purchased items. Further, due to the impact these might have on a business being run by a professional

consumer, and the various considerations they will need to make, in terms of the likely popularity and profitability of the game, it is my view that they will pay at least an above medium level of attention in respect of the same. In respect of the goods such as 'gaming devices' these may also be purchased both by professionals and by the general public. Again, these are unlikely to be low cost, every day items and the consumer will consider factors such as the cost, useability, and compatibility with certain games, and it is my view a medium level of attention will be paid towards the same by the general public, which will increase to above medium where professional consumers are involved.

117. Finally, in respect of the gambling and entertainment services in class 41, the average consumer is likely to primarily comprise members of the general public. These consumers will likely consider factors such as the variety of the services offered and the facilities provided, and it is likely a medium degree of attention will be paid towards the same.

118. The relevant class 9 goods are likely to be purchased via websites or app stores, and the purchasing process will be primarily visual. The services will likely also be selected visually via websites and visual advertisements. The class 28 goods primarily purchased by professionals are again likely to be selected visually via catalogues or from wholesale stores, and where the general public is purchasing these goods, they are likely to be selected visually from online or physical retail stores. However, in all cases the goods and services may be recommended verbally, and so I cannot completely discount the aural comparison.

Distinctive character of the earlier trade mark

119. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular

undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

120. The earlier mark comprises the wording BURNING HOT only. I do not consider this term to be descriptive or allusive of the goods or services, nor do I consider it to be laudatory. I note it is a well-known English expression, and in my view it does not hold the highest level of distinctive character inherently such as an invented word. Overall, I consider the earlier mark to be inherently distinctive to a medium degree.

121. The opponent has filed evidence of use of its mark within these proceedings, and so it is incumbent on me to consider if the distinctiveness of the earlier mark has been raised by virtue of the same. However, it is my view that whilst the use of the mark shown is sufficient for the purpose of showing genuine use, it is not particularly extensive. I have not been provided with details of the total turnover figures generated from use of the mark, and the numbers of active players are relatively modest. No detail of advertising spend or significant promotional material has been provided. Whilst I have not been provided with information regarding the market size for the goods, this will likely be large, and it is my view that the opponent's share of the same under the mark will be small. Considering the evidence as a whole, I do not consider it sufficient to show that the distinctiveness of the opponent's mark has been enhanced above its inherent level by virtue of the use of the same.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

122. My conclusions on section 5(1) of the Act are set out previously within this decision. IR 372 will be refused in respect of the following goods only under this ground:

Class 9: Software; computer gaming software; computer software packages; computer software, recorded; games software; entertainment software for computer games; computer game programs; computer programs for recorded games; computer application software featuring games and gaming; computer software for the administration of on-line games and gaming; computer software for gambling, gambling machines, gambling games on the Internet and via telecommunication network.

123. Prior to reaching a decision under 5(2)(b) of the Act, I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 77 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I must remember that the distinctiveness of the common elements is key.³² I must keep in mind that in respect of section 5(2)(b) of the Act, a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid

³² See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

by the average consumer and how the goods or services are obtained will have a bearing on how likely the consumer is to be confused.

124. There are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.³³

125. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

IR 372

126. I found this contested mark to be visually, aurally and conceptually identical to the earlier mark, meaning it is similar to the earlier mark to the highest possible degree. I found the goods to range from identical to dissimilar. I found the earlier mark to be inherently distinctive to a medium degree, but that the distinctiveness of the earlier mark has not been enhanced through use. I found the average consumer will vary across the goods and services, with the level of attention paid ranging from low to medium to at least above medium. I found the purchasing process will be primarily visual, although aural considerations cannot be completely ignored.

127. Considering all of these factors, and taking into account the interdependency principle, it is my view that there will be a likelihood of direct confusion between these marks where there is a minimum of a low level of similarity or above between the goods and services, with the consumer likely to mistake one trade mark for the other.

³³ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

128. IR 372 may therefore proceed in the UK in respect of the following goods and services only:

Class 9: Computer hardware for games and gaming; computer hardware for gambling, gambling machines, gambling games on the Internet and via telecommunication network.

Class 28: Housings for coin-operated machines, gaming equipment, gaming machines, machines for gambling.

Class 41: Gaming machine entertainment services.

IR 809

129. I found this mark to be visually similar to the contested mark to a medium degree, conceptually similar to a fairly high degree, and aurally identical. Again, I found the goods and services to range from identical to dissimilar, and I found the earlier mark to hold a medium degree of inherent distinctive character which has not been enhanced through use. My findings in relation to the average consumer of the goods outlined in relation to IR 372 also apply in relation to this mark, including that degree of attention paid will range from low to medium to above medium and that the purchasing process will be primarily visual, although aural considerations cannot be completely discounted.

130. I note in this instance, the words BURNING HOT are the most distinctive element within the contested mark and comprises the whole of the earlier mark. This element plays a significant role within the overall impression of the contested mark. It also creates the strongest concept in the contested mark, and the only concept in the earlier mark. It is my view that all of these factors will help this element to stick in the mind of the consumer, who may easily remember this as a 'BURNING HOT' mark, forgetting or misremembering the decorative elements and the addition of a lucky four-leaf clover. It is my view that on this basis, and keeping in mind all of the relevant factors, the consumer is likely to directly confuse one mark for the other in all instances where there is at least a low level of similarity or above between the goods and services.

131. However, in case I am wrong, I will also consider whether there will be a likelihood of indirect confusion between the marks. In *L.A. Sugar* Mr Iain Purvis Q.C. (as he then was), as the Appointed Person set out three examples of when indirect confusion may occur as below:

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).”

132. I note that the examples above were intended to be illustrative and are not exhaustive. Further, in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark

contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

133. Whilst I do not find this mark to fall directly within any of the categories as set out in *L.A. Sugar*, it is my view that the element BURNING HOT in the contested mark maintains an independent distinctive role in the contested mark in this instance. I consider again all of the factors outlined previously, including the medium degree of distinctive character held in BURNING HOT. Further, I note again that the additional elements appear to be largely decorative or to be less distinctive than this element in

the mark. It is my view that should the consumers notice the differences between the marks, they would consider the element BURNING HOT used across both marks as an indicator that the goods and services derive from the same economic undertaking where there is at least a low level of similarity between the same, with the contested mark simply being use of a full logo version of the earlier mark. On this basis, I find there will be a likelihood of indirect confusion in respect of these goods and services. It is my view that IR 809 may therefore proceed in respect of the following opposed goods only:

Class 9: Computer hardware for games and gaming; computer hardware for gambling, gambling machines, gambling games provided via the Internet and via telecommunication network.

Class 28: Housings for coin-operated machines.

Final Remarks

134. Both oppositions have been partially successful, and subject to any successful appeal, the two International Registrations will be refused in the UK in respect of all of the opposed goods and services other than those outlined above. As these were only partially opposed, they will also proceed to registration in respect of all of the unopposed goods and services.

COSTS

135. The opponent has achieved a greater measure of success within these oppositions and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1840 as a contribution towards the cost of the proceedings. This figure includes a 20% reduction to account for the holder's partial success. The sum is calculated as follows:

Prior to consolidation

Official fee:

£100 x 2 = £200

Preparing and filing the TM7 and considering
the counterstatement: £ 300 x 2 = £600

After consolidation

Preparing and filing the evidence:	£800
Preparing for and attending the hearing:	£700
20% reduction for holder's partial success:	-£460
Total:	£1840

136. I therefore order Euro Games Technology Ltd. to pay NOVOMATIC AG the sum of £1840. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 9th day of May 2023

**Rosie Le Breton
For the Registrar**

Annex A

Class 9: Software; computer gaming software; computer software packages; computer operating system software; computer software, recorded; software drivers; virtual reality software; games software; entertainment software for computer games; computer programs for network management; operating computer software for main frame computers; monitors (computer hardware); computer hardware; apparatus for recording images; monitors (computer programs); computer game programs; computer programs for recorded games; apparatus for recording, transmission or reproduction of sound or images; communications servers [computer hardware]; electronic components for gambling machines; computer application software featuring games and gaming; computer software for the administration of on-line games and gaming; computer hardware for games and gaming; computer hardware and software for gambling, gambling machines and gambling games provided via the Internet and via telecommunication network.

Class 28: Gaming machines for gambling; chips for gambling; mah-jong; arcade games; gambling machines operating with coins, notes and cards; games; electronic games; parlor games; gaming chips; gaming tables; slot machines [gaming machines]; LCD game machines; slot machines and gaming devices; coin-operated amusement machines; roulette chips; poker chips; chips and dice [gaming equipment]; gaming equipment for casinos; roulette tables; gaming roulette wheels; apparatus for casino games; automats and gambling machines; coin-operated amusement machines and / or electronic coin-operated amusement machines with or without the possibility of gain; boxes for coin-operated games machines and slot machines; electronic or electrotechnical gaming devices, namely, automats and machines, coin-operated machines; housings for coin-operated machines; gaming machines, electropneumatic and electrical gambling machines (slot machines).

Class 41: Gambling; services related to gambling; gaming services for entertainment purposes; casino, gaming and gambling services; training in the development of software systems; provision of equipment for gambling halls; providing casino equipment [gambling]; on-line gaming services; providing casino facilities [gambling]; providing entertainment services in the halls with gaming machines; amusement

arcade services; games equipment rental; rental of gaming machines; providing amusement arcade services; rental of gaming machines with images of fruits; editing or recording of sounds and images; sound recording and video entertainment services; hire of sound reproducing apparatus; provision of gaming equipment for casinos; providing casino facilities; online gambling services; casino services; casino, gaming and gambling services.

Annex B

Class 9: Software; computer gaming software; computer software packages; computer operating system software; computer software, recorded; software drivers; virtual reality software; games software; entertainment software for computer games; computer programs for network management; operating computer software for main frame computers; monitors (computer hardware); computer hardware; apparatus for recording images; monitors (computer programs); computer game programs; computer programs for recorded games; apparatus for recording, transmission or reproduction of sound or images; communications servers [computer hardware]; electronic components for gambling machines; computer application software featuring games and gaming; computer software for the administration of on-line games and gaming; computer hardware for games and gaming; computer hardware and software for gambling, gambling machines, gambling games on the Internet and via telecommunication network.

Class 28: Gaming machines for gambling; chips for gambling; mah-jong; arcade games; gambling machines operating with coins, notes and cards; games; electronic games; parlor games; gaming chips; gaming tables; slot machines [gaming machines]; LCD game machines; slot machines and gaming devices; coin-operated amusement machines; roulette chips; poker chips; chips and dice [gaming equipment]; gaming equipment for casinos; roulette tables; gaming roulette wheels; casino games; amusement and gambling machines; coin-operated gaming machines and / or electronic coin-operated gaming machines with or without the possibility of gain; boxes for coin-operated machines, slot machines and gaming machines; electronic or electro-technical gaming devices, amusement and gaming machines, including coin-operated machines; housings for coin-operated machines, gaming equipment, gaming machines, machines for gambling; electro-pneumatic and electrical gambling machines (slot machines).

Class 41: Gambling; entertainment services related to gambling; gaming services for entertainment purposes; casino, gaming and gambling services; training in the development of software systems; provision of equipment for gambling halls; providing casino equipment [gambling]; gaming machine entertainment services; providing

casino facilities [gambling]; providing halls with gaming machines; amusement arcade services; games equipment rental; rental of gaming machines; providing amusement arcade services; rental of gaming machines with images of fruits; editing or recording of sounds and images; sound recording and video entertainment services; hire of sound reproducing apparatus; provision of gaming equipment for casinos; providing of casino facilities; online gambling services; provision of casino services; provision of gaming establishments, gaming halls, internet casinos, online gambling services.