

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2420872
IN THE NAME OF EARLY LEARNING CENTRE LIMITED**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER No. 94746
BY ID SOFTWARE, INC.**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE OPPONENT
AGAINST A DECISION OF MR. M. FOLEY
DATED 27 MAY 2010**


DECISION

Introduction

1. On 3 May 2006, Early Learning Centre Limited (“the Applicant”) applied to register the designation TOWER OF DOOM in Class 28 for use as a trade mark in relation to:

Toys; games and playthings; playing cards; gymnastic and sporting articles; parts and fittings for all the aforesaid goods.
2. Following advertisement, the application was opposed on 30 October 2006 by Id Software, Inc. (“the Opponent”).
3. The grounds of opposition were that registration of the trade mark applied for should be refused under section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994.
4. For the purposes of section 5(2)(b) and 5(3), the Opponent relied upon its following earlier trade marks:

<u>Mark</u>	<u>Number</u>	<u>Date</u>	<u>Goods</u>
DOOM	UK 1587153	07.10.94	Computer software and computer programs, all for playing electronic games; parts and fittings for all the aforesaid goods; all included in Class 9

	UK 2005994	21.12.94	Computer programs, computer software and data carriers therefor; video and audio games; electric and electronic apparatus for playing the aforesaid games, parts and fittings for all the aforesaid goods (Class 9)
DOOM 3	CTM 003892023	10.06.04	<p>Computer software games, computer software game programs and computer game cartridges or CD-ROMs for video games for entertainment uses (Class 9)</p> <p>Manuals sold as a unit with computer software games, computer software game programs and computer game cartridges or CD-ROMS for video games for entertainment uses (Class 16)</p>

5. Under 5(4)(a), the Opponent claimed earlier rights in the unregistered trade mark DOOM in respect of the registered goods and motion picture films, board games and figurines.
6. The Applicant took issue with the grounds of opposition in a Notice of defence and counterstatement filed on 13 February 2007. In particular, the Applicant put the Opponent to proof of use of its UK registered trade marks and also its claim to reputation and goodwill.
7. Only the Opponent filed evidence and the opposition came to a hearing on 1 March 2010. Both parties attended and were represented by their trade mark attorneys, Maquire Boss and Urquhart-Dykes & Lord LLP for the Opponent and the Applicant respectively.

Hearing Officer's decision

8. Mr. Mike Foley, on behalf of the Registrar, issued his written decision on 27 May 2010 under reference number BL O/173/10.
9. His findings were, in summary:

Proof of use/reputation

- (i) The Opponent's DOOM computer/video game was launched in the early 1990s and had been singularly successful spawning further editions like DOOM 3.

- (ii) There was a continuing market in such games during the relevant period (29 July 2001 – 28 July 2006). Genuine use was established for computer/video games but not “parts and fittings for all the aforesaid goods” in 1587153, or “audio games” or “electronic and electronic apparatus for playing the aforesaid games, parts and fittings for all the aforesaid goods” in 2005994, which could not be relied on in the opposition.
- (iii) Use had also been shown in connection with a DOOM board game and movie. Although those goods were outside the Opponent’s registered specifications, use in relation to them may have increased awareness of the computer game.
- (iv) There was no evidence that “miniatures” used to play the board game were sold separately.

Section 5(2)(b)

- (v) It was important to judge the overall impression of the marks to the average consumer who was the public at large but probably more at the younger end bearing in mind the British Board of Film Classification’s rating of 18 in relation to the Opponent’s computer/video games.
- (vi) The Opponent’s earlier trade marks were all DOOM marks, which was an ordinary English word that would be known to the average consumer. Although the mark alluded to the nature of the computer/video game it was distinctive. Moreover its distinctiveness had been enhanced through use such that it had a strong reputation for computer/video games and software.
- (vii) DOOM was the dominant element in the Opponent’s marks. TOWER OF DOOM in the Applicant’s mark hung together so that there was no dominant distinctive element.
- (viii) To the extent that the earlier marks and the mark applied for had DOOM in common there was some visual similarity but this was insufficient for the marks to be regarded as similar. Likewise the common DOOM element produced an aural identity but that was dissipated by the words TOWER OF... in the Applicant’s mark when pronounced as a whole.
- (ix) There was some conceptual similarity between the marks. Although the Applicant’s mark hung together and brought to mind a tower, the words “of doom” created the same aura of fear, dread etc. as the Opponent’s mark.
- (x) Nevertheless, the differences easily outweighed the similarities. Whilst there was some similarity the respective marks could not be considered similar.
- (xi) There was no evidence to show how the trade classified such items but in the Hearing Officer’s view, toys, playthings, gymnastic and sporting articles (and presumably playing cards) in the Applicant’s mark were not similar to computer/video games software, carriers for such software or manuals for their use in the Opponent’s marks.

- (xii) However, the Applicant's games in Class 28 were similar to the Opponent's goods in Class 9. Although the price of computer games software might be reasonably low (around £16 according to an exhibit from the Amazon website), computer games had a cachet and care needed to be expended to ensure compatibility. The purchase act would be observant and circumspect.
- (xiii) The Opponent was unsuccessful in arguing a family of DOOM marks. Instead, the consumer would view the Opponent's uses as being of different versions of the same mark. That would not have led to the scenario that any use of DOOM even for computer/video games and software would inevitably be associated with the Opponent, which would depend on factors such as the manner in which the word was used and could not simply be supposed from imperfect recollection.
- (xiv) Employing the requisite global assessment:

“... notwithstanding the commonality in the use of the word DOOM, the potential similarity in respect of “games” and the connected “notional” circumstances of the manufacture, market and consumer, for the reasons I have given, in particular the difference in the respective marks, use of the mark applied for will not lead to confusion. The opposition under section 5(2)(b) therefore fails”.

Section 5(3)

- (xv) Although the Hearing Officer's finding that the marks were not similar effectively ended the matter, all the circumstances under the section 5(3) ground would be considered.
- (xvi) The Opponent had a strong reputation in its DOOM marks for computer/video games and software, which inevitably would have washed-over into carriers and manuals for use with such software.
- (xvii) Dissimilar (toys, playthings, gymnastic and sporting articles) and similar (games) goods were involved but the evidence gave the Hearing Officer no reason to suppose that the consumer on seeing the Applicant's mark would make the leap to connect it with the Opponent's marks let alone one that would effect their economic behaviour (*Electrocoin Automatics Ltd v. Coinworld Ltd* [2005] FSR 79). The opposition under section 5(3) also failed.

Section 5(4)(a)

- (xviii) The evidence was wanting as to the extent of goodwill existing or continuing at the application date.
- (xix) Even assuming protectable goodwill and use on similar goods, there would be neither misrepresentation nor damage because of the Hearing Officer's prior finding that notwithstanding some similarity between DOOM and TOWER OF DOOM, the marks could not be considered similar. The section 5(4)(a) ground was not made out.

Costs

(xx) Subject to appeal, the Opponent would be ordered to pay the Applicant £2,250 towards its costs of the failed opposition.

The appeal

10. On 24 June 2010, the Opponent filed Notice of appeal to the Appointed Person under section 76 of the Act.
11. The grounds of appeal were as follows:
 - “4. It is contended that the Hearing Officer erred in law by not taking the nature of the goods applied for into account in his consideration of the distinctive and dominant components of the respective trade marks. At no point in the Decision does the Hearing Officer acknowledge that the word TOWER may be entirely descriptive of, for instance, play-sets consisting of towers, or games comprising or featuring towers.
 5. It is contended that in respect of the s. 5(2)(b) grounds the Hearing Officer erred in law by holding at Para. 31 of the Decision that where certain similarities were deemed to “outweigh” others the conclusion must be that the respective trade marks “cannot be considered similar” – in effect a “threshold” test for similarity – rather than determining the relative *degree* of similarity, as required by, inter alia, the practice guidelines set out at PAN 8/07.
 6. It is contended that the Hearing Officer erred in law by relying on the “threshold” test for similarity set out by the Chancery Division of the High Court of Justice in *Esure Insurance Limited v. Direct Line Insurance plc* [2007] EWHC 1557 (CH), when the Court of Appeal has confirmed that no such test exists (*Esure Insurance Limited v. Direct Line Insurance plc* [2008] RPC 34).
 7. It is contended that the Hearing Officer erred in law by not giving due consideration to the notional use by the Applicant in respect of, for instance, play-sets or board games featuring towers.
 8. In the light of his comment that “there is no evidence that the opponents have used DOOM in a similar way to that of the applicants” it is contended that the Hearing Officer has not given due consideration to Paragraph 11 of “Attachment C” of the Form TM7 Statement of Grounds, and has thereby erred in law by not giving the Opponent a proper hearing.
 9. It is contended that the Hearing Officer erred in law by failing to make a proper global appreciation of the likelihood of confusion by not allowing for the fact that the degree of similarity between the marks may be offset by other factors”.

12. The Opponent's skeleton argument confirmed that the appeal was limited to section 5(2)(b) (although the 5(4)(a) ground was likely to have followed the outcome under 5(2)(b)) and largely repeated the above grounds which were stated to set out with "commendable precision" the alleged errors relied upon.
13. I mention this because at the hearing before me, Dr. Peter Colley, the Opponent's Counsel, appeared at various points to stray from those grounds, seeking additionally to challenge the Hearing Officer's conclusions regarding *inter alia* the relevant purchaser and the similarity (or otherwise) of the goods. In the absences of: (a) any application to amend the grounds of appeal; and (b) the Applicant who had signified its decision not to attend/be represented, I refused to permit any such departures from the grounds of appeal as originally filed.

Standard of review

14. This appeal is by way of review and not re-hearing and the approach I should follow was set out by Robert Walker L.J. in *REEF Trade Mark* [2003] RPC 109 – 110:

"In this case the hearing officer had to make what he himself referred to as a multi-factorial comparison, evaluating similarity of marks, similarity of goods and other factors in order to reach conclusions about likelihood of confusion and the outcome of a notional passing-off claim. It is not suggested that he was not experienced in this field, and there is nothing in the Civil Procedure Rules to diminish the degree of respect which has traditionally been shown to a hearing officer's specialised experience. ... On the other hand the hearing officer did not hear any oral evidence. In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

The appellate court should not treat a judgment or written decision as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed. ...".

Merits of the appeal

15. I start with a couple of points Dr. Colley made on the evidence. First, he said that the Hearing Officer wrongly took into account that the BBFC rating for the Opponent's products was 18 rather than 15 years.
16. Exhibit A to the witness statement of Todd S. Hollenshead, Chief Executive Officer of ID Software, Inc., dated 23 October 2007, contained copy print outs from the amazon.co.uk website showing the Opponent's computer software games being offered for sale. The first four pages of DOOM 3 products gave BBFC ratings of 18 years whilst the following seven pages of DOOM products carried ratings of 15 years (and in one case 11 years).

17. Dr. Colley was I believe trying to advance a point that the relevant consumer was young children to whom the Applicant's (Early Learning Centre) products were directed.
18. The same point was put to and dismissed by the Hearing Officer because: (a) there was no such limitation in the Applicant's specification; and (b) the relevant comparisons for section 5(2)(b) must be made according to the goods as specified (see, for example, Case T-364/05 *Saint-Gobain Pam v. OHIM* [2007] ECR II-757, para. 89). Accordingly, he correctly decided that the relevant consumer was the public at large.
19. I agree that the Hearing Officer appeared to miss the subsequent BBFC ratings. However, I do not believe that this had any effect on his decision under section 5(2)(b) for the reasons mentioned above.
20. Second, Dr. Colley said that the Hearing Officer was wrong in finding that there was no evidence of miniatures being sold separately from the board game. He took me to Exhibit D of Mr. Hollenshead witness statement, which contained a print out from an address <http://okapi.andrew.cmu.edu> with a post that the writer had been sent pictures of miniatures available for sale produced by Reaper (the Opponent's licensee). The print out is dated 22 October 2007 (that is, after the relevant date) and does not confirm one way or the other whether the miniatures were sold with the board game or separately to it (although the latter is one interpretation of the post).
21. In any event, I cannot see it makes any difference to the 5(2)(b) ground. The Hearing Officer willingly acknowledged that awareness of the Opponent's computer/video games (the registered goods) would have been heightened by the DOOM board game and movie and he accepted that the DOOM trade marks enjoyed enhanced distinctive character through use.
22. Third, Dr. Colley contended that the Hearing Officer wrongly stated that there was no evidence that the Opponent had used DOOM in a similar way to the Applicant (decision, para. 42).
23. It seems to me that here the Hearing Officer was distinguishing between the Opponent's uses of different versions of the DOOM marks (for example DOOM II: Hell on Earth) as opposed to a family of DOOM marks, and the Applicant's use of TOWER OF DOOM as a trade mark.
24. Dr. Colley referred me to paragraph 11 of Attachment C of the Statement of Grounds of Opposition, which read:

“It is noted, incidentally, from the Applicant's web site www.elc.co.uk that one of the accessories sold with the Applicant's TOWER OF DOOM play-set is a minotaur figure similar to that which appears on the cover of the Opponent's DOOM II computer game (see “Attachment B”).”

25. Attachment B contained a picture of the Opponent's product but not the Applicant's product.
26. With respect, I again see no significance in the point and anyway believe that the Opponent misinterpreted the Hearing Officer's comment under scrutiny.
27. It became apparent at least at the hearing before me that the Opponent's main complaints were that the Hearing Officer failed to: (a) appreciate the significance of DOOM in the Applicant's mark which he should have found to be the dominant and distinctive element; and (b) recognise that TOWER in the Applicant's mark was descriptive when applied to games featuring or including towers.
28. Dr. Colley accepted that both of those arguments were made at the hearing below. Moreover, the Hearing Officer specifically referred to the Opponent's descriptiveness argument in his comparison of the marks as follows:

“28. As I have said, the opponent's marks are essentially the word DOOM, albeit in one case with a single and separated numeral 3 as a suffix. As the only significant element of the marks there can be little doubt that DOOM is what the consumer's eye will record. In the applicant's mark the word DOOM is at the end of a three-word description TOWER OF DOOM. Mr. Tate asserted that the word “TOWER” is wholly descriptive of the product for which the applicants use the mark. There can be no dispute that in this mark DOOM has a visual significance, but with the preposition leading the eye to the relation of a TOWER the mark hangs together with no dominant distinctive element. To the extent that the earlier mark and the mark applied for have DOOM in common it is reasonable to say that there must be some visual similarity, but in a comparison of the marks in their totality, this is not enough to say that the respective marks should be regarded as similar. The mark DOOM 3 cannot be any closer in terms of similarity.

29. Again, as both of the respective marks either consist of, or include the word DOOM it is reasonable to say that to this extent there will be some identity in their sound. The words “TOWER OF ...” clearly create a difference that is not outweighed by the identity in the word DOOM. In the case of DOOM 3, I consider that the consumer will say it as they see it; word and number. So whilst there is aural identity in DOOM this dissipates when the marks are taken as a whole.

30. The message from the opponent's marks can only be derived from the word DOOM, the meaning of which will be known to the consumer, or at least the essence or feeling of it will. Used in connection with the goods the numeral 3 will simply indicate that this is the third version. I have already said that I consider the elements of the applicant's mark to hang together, so whilst it brings to mind a tower, the words “of doom” creates the same aura of fear, dread etc., as the opponent's mark. This leads to the conclusion that whilst the

respective marks may, in totality have differences, they should nonetheless be regarded as having some conceptual similarity.

31. Balancing of these assessments I consider the differences to easily outweigh the similarities such that whilst there is some similarity the respective marks cannot be considered similar.”

29. Those were matters of evaluation and assessment by the Hearing Officer with which in the absence of a distinct and material error of principle I am unable to interfere.
30. The Opponent contended that the error of principle was that the Hearing Officer applied a threshold test to the similarity of marks.
31. That is nowhere apparent from his deliberations under section 5(2)(b) which commenced with the usual recitation of guiding principles extracted by the Registry from the case law of the Court of Justice of the European Union recently applied by Floyd J. in *Hasbro Inc v. Nahrmittel GmbH* [2011] EWHC 199 (Ch), para. 195, referring to *Och-Ziff Management Europe Ltd v. OCH Capital LLP* [2010] EWHC 2599 (Ch), Arnold J. at paras. 72 – 74.
32. However, in connection with the section 5(3) ground (which was not appealed by the Opponent), the Hearing Officer did cite passages from the judgment of Lindsay J. in *Esure* (paras. 94 – 97 and 45 – 46) where the judge said that in his view there was some sort of threshold test for the similarity of marks under section 5(2)(b) and 5(3) of the Act albeit a low one.
33. I have no idea why the Hearing Officer saw fit to quote this passage from the judgment of Lindsay J. It was possibly because he was unsure whether his finding under section 5(2)(b) that the marks could not be considered similar precluded him from considering the circumstances under section 5(3).
34. In *Esure*, Lindsay J. overturned the Hearing Officer’s finding of likelihood of confusion for section 5(2)(b) because of dissimilarities in the marks but went on to uphold the Hearing Officer’s decision that the conditions of section 5(3) had been satisfied. That was, however, because for evidential reasons he felt able to interfere with the Hearing Officer’s decision under section 5(2)(b) but not section 5(3).
35. Subsequently in the Court of Appeal in *Esure*, Arden L.J. inclined to the view that there was no threshold condition of similarity but since it made no difference in that case did not decide the point. Jacob L.J. felt that a threshold albeit low test complicated matters unnecessarily. Kay L.J. expressed himself in agreement with both the judgments of Arden and Jacob L.J.J.
36. The Court of Appeal held that Lindsay J. had been wrong (according to the *REEF* standard of review) to interfere with the Hearing Officer’s decision under section 5(2)(b) thus reconciling the outcomes under both 5(2)(b) and 5(3).

37. As I have said, the Opponent did not appeal against the Hearing Officer's decision under section 5(3). The Hearing Officer did in fact examine the circumstances of reputation, link and damage under section 5(3) in the same way as he had previously examined the conditions of similarity of marks, similarity of goods and likelihood of confusion for section 5(2)(b).
38. In my judgment, the Hearing Officer did not apply a threshold test (but even if he did it made no difference because he went on to consider the other factors). The Opponent complained over the Hearing Officer's finding that the marks could not be considered similar.
39. However, that is not a material error of principle. There have been several examples of cases before the supervising courts in Luxembourg where despite marks containing a common element the courts considered that the differences resulted in the marks not being similar (see, for example, most recently Case C-552/09 P, *Ferrero SpA v. OHIM*, 24 March 2011).

Conclusion

40. Accordingly in my judgment the appeal under section 5(2)(b) fails. The Applicant did not attend the appeal hearing and made no written submissions. I will therefore make no order for costs in relation to the appeal.

Professor Ruth Annand, 6 May 2011

Dr. Peter Colley of Counsel instructed by Maguire Boss appeared on behalf of the Opponent/Appellant

The Applicant/Respondent did not appear and was not represented