

O/784/21

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3409367
AND THE REQUEST BY PLAY'N GO MARKS LTD
TO REGISTER THE TRADE MARK**

GAME OF GLADIATORS

IN CLASSES 9, 28 AND 41

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 417653
BY ADP GAUSELMANN GMBH**

Background and pleadings

1. On 25 June 2019, Play'n GO Marks Ltd. ("**the Applicant**") applied to register the plain text words "GAME OF GLADIATORS" as a UK trade mark in respect of the following goods and services:

Class 9: *Computer games and video games (software), hereunder software for slot machine games, betting and wagering games, video slot games and casino games provided online and via computer networks and playable on any type of computing device including arcade games, personal computers, handheld devices and mobile phones, on cruise ships and other physical casino locations; software for slot machine games, betting and wagering games, video slot games and casino games provided online and via computer networks and playable on any type of computing device including arcade games, personal computers and handheld devices, on cruise ships and other physical casino locations.*

Class 28: *Videogaming apparatus, hereunder slot machines for gambling, gaming machines, poker machines and other video based casino gaming machines; arcade games; gaming machines, namely, devices that accept a wager; reconfigurable casino and lottery gaming equipment, hereunder gaming machines including computer games and software therefore sold as a unit.*

Class 41: *Games services provided online (via computer networks), hereunder providing slot machine games, betting and wagering games, video slot games and casino games, playable via local or global computer networks; online gaming services; entertainment services, namely, conducting a game of chance simultaneously at multiple, independent gaming establishments; entertainment services, hereunder providing online computer games; prize draws [lotteries]; organising and conducting lotteries; all the foregoing excluding arranging sports events and televised entertainment.*

2. The application was published for opposition purposes in the Trade Marks Journal on 12 July 2019. It is opposed by adp Gauselmann GmbH ("**the Opponent**") under section 3(6) and section 5(2)(b) of the Trade Marks Act 1994 ("**the Act**").

3. Under section 5(2)(b), the Opponent opposes the application, in full and relies upon two marks, which I will refer to as Marks A and B in this decision:

Mark A



UK trade mark number 3273516

Filing date 28 November 2017

Registration date 15 June 2018

Class 9: *Coin-operated gaming mechanisms; automatic lottery machines; online games (software), in particular for online betting games, online prize games, online gambling games, online games of skill and online casino games; calculating apparatus in coin-operated machines and parts for the aforesaid goods; electric, electronic, optical or automatic apparatus, for identifying data carriers, identity cards and credit cards, bank notes and coins; software in particular for casino arcade games, for gaming machines and/or slot machines each one with or without prize payouts; gaming software that generates or displays wager outcomes of gaming machines; computer software for managing of games (game collection).*

Class 28: *Gaming apparatus (including coin-operated apparatus); coin-operated videoing gaming apparatus; casino fittings, namely roulette tables, roulette wheels; coin-operated automatic gaming machines and gaming machines, in particular for gaming arcades, with or without a prize payout; electronic or electrotechnical gaming apparatus, automatic gaming machines, gaming machines, slot machines operated by coins, tokens, banknotes, tickets or by means of electronic, magnetic or biometric storage media, in particular for commercial use in casinos and amusement arcades, with or without a prize payout; automatic gaming machines and gaming machines, in particular for commercial use in casinos and gaming arcades, with or without a prize payout; coin-operated gaming machines and/or electronic money-based gaming apparatus (machines), with or without prizes; housings adapted for gaming machines, gaming apparatus and automatic gaming machines, operated by means of coins, tokens, tickets or by means of electronic, magnetic or biometric*

storage media, in particular for commercial use in casinos and gaming arcades, with or without a prize payout; drawing apparatus for prize games and lotteries, draws or raffles; housings of metal, plastic and/or wood for coin-operated automatic machines; electropneumatic and electric pulling machines (gaming machines); gaming tables, in particular for table football, billiards, sliding games; electric, electronic or electromechanical apparatus for bingo games, lotteries or video lottery games and for betting offices, networked or unnetworked; automatic gaming machines; including all the aforesaid automatic machines, machines and apparatus operating in networks; apparatus and devices for accepting and storing money, being fittings for the aforesaid automatic machines, included in Class 28.

Mark B

GLADIATOR

EU trade mark (EUTM) number 7358203¹

Filing date 30 October 2008

Registration date 13 July 2009

Class 28: Apparatus for games (including video games), other than adapted with external screens or monitors.

4. An “earlier trade mark” is defined in section 6(1) of the Act as:

“(a) a registered trade mark, international trade mark (UK), a European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

5. Both of the trade marks relied upon by the Opponent have filing dates that predate that of the Applicant’s trade mark. The Opponents marks are therefore “earlier marks” under the Act.

6. Since the Opponent’s Mark B had been registered for more than five years when the contested mark was applied for, it is subject to the use provisions under section

¹ EUTMs are still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – see Tribunal Practice Notice 2/2020 for further information.

6A of the Act. The Opponent has duly provided a statement of use in respect of the goods that it relies upon under Mark B and has submitted evidence in support of this.

7. The opposition under section 3(6) of the Act was added late in these proceedings, following the filing of Form TM7G by the Opponent and leave being granted by the tribunal. The section 3(6) claim is partial, being against the Applicant's goods in Class 28 only.

The Opponent's case

8. In its statement of grounds, the Opponent submits that under section 5(2)(b) the mark applied for is similar to its marks, with the goods and services applied for being identical and/or similar to the goods covered by the Opponent's marks. As a result, the Opponent submits that there will be a likelihood of confusion between the marks.

9. Under section 3(6), the Opponent submits that the Applicant did not have a bona fide intention to use the trade mark applied for in relation to the goods in Class 28 of its application. The Opponent submits that the application was therefore made either with the intention of undermining the interests of third parties and/or of obtaining an exclusive right for purposes other than those consistent with the functions of a trade mark.

The Applicant's case

10. In its defence and counterstatement, the Applicant puts the Opponent to proof that it has used Mark B. The Applicant denies that the Opponent's registrations are confusingly similar to its mark and highlights that the respective marks contain a different number of letters and words. The Applicant contends that the first words in a mark are dominant, with the first word in the Opponent's mark being "Gladiator(s)", compared to "Game" in the Applicant's mark. The Applicant refers to the figurative elements in the Opponent's mark, stating that such elements lower the distinctive character of the word component in the Opponent's mark. The Applicant concludes that the respective marks are visually, aurally and conceptually different and therefore the relevant public will be able to distinguish the marks.

11. In respect of the claim under section 3(6), the Applicant denies that the application was filed in bad faith and puts the Opponent to strict proof of the claim.

Representation and papers filed

12. In these proceedings, the Opponent is represented by Greaves Brewster LLP; the Applicant is represented by Appleyard Lees IP LLP. During the evidence rounds, both parties filed evidence in chief, with the Applicant filing submissions at this stage. The Opponent filed evidence in reply, including submissions, at which point the section 3(6) ground was introduced. Both parties submitted evidence in chief and submissions in respect of the claim under section 3(6). During the evidence rounds, the Applicant also submitted a copy of a decision of the EU Intellectual Property Office (EUIPO) in respect of related proceedings between the parties.

13. No hearing was requested and so this decision is taken following a careful perusal of the papers, which include submissions in lieu of a hearing, filed by both parties.

The Evidence

The Opponent's evidence in chief

14. The Opponent's evidence in chief in respect of the section 5(2)(b)² claim comprises the witness statement of Mr Wolfgang Schröder, Chief of the Patent Department of adp Gauselmann GmbH, dated 29 January 2020, together with Exhibits WS1 to WS18. This evidence includes applications made by the Opponent for the approval of its gambling devices in Germany and details of the packages of games software that include the Opponent's "Gladiators" game. This is supported by details of the Opponent's turnover and advertising activities in respect of its game packages. Lastly in this round of evidence, the Opponent provides four exhibits in support of its claim that manufacturers of gaming software also frequently produce gaming equipment.

² The claim under section 5(3) was subsequently withdrawn from the proceedings.

The Applicant's evidence in chief

15. The Applicant's evidence in chief in respect of the section 5(2)(b) claim comprises the witness statement of Mr Johan Törnqvist, Director of Play'n GO Marks Ltd, dated 18 September 2020, and a witness statement of Mr Christopher Owen Thomas, solicitor at Appleyard Lees IP LLP, dated 15 September 2020. Mr Törnqvist introduces Exhibits JT1 to JT9, through which he seeks to provide information about:

- (a) his background and that of the Applicant company;
- (b) the media profile under the GAME OF GLADIATORS mark;
- (c) the specialist nature of the gambling market;
- (d) the differences between the Applicant's and Opponent's goods;
- (e) the level of circumspection attributable to the average consumer of gambling games.

16. Mr Thomas introduces Exhibits COT1 and COT2. Exhibit COT1 is provided to support the Applicant's contention that the term "Gladiator(s)" lacks distinctive character in respect of games. Exhibit COT2 consists of the Wikipedia entry for "Gladiator", which is provided to support Applicant's view of the conceptual difference of "Gladiator(s)" and "GAME OF GLADIATORS".

The Opponent's evidence in reply

17. The Opponent's evidence in reply comprises a second witness statement of Mr Schröder, dated 17 November 2020, together with the witness statement of Ms Corinna Hiscox, Chartered Trade Mark Attorney at Greaves Brewster LLP, dated 19 November 2020. Ms Hiscox's witness statement is provided to confirm the accuracy of the translation of Mr Schröder's witness statement. In his second witness statement, Mr Schröder provides information about:

- (a) the relationship between the Opponent company and Spiel Tech 13 GmbH, Spiel Tech 17 GmbH and Merkur Freizeit GmbH which are referred to in the first set of evidence filed;
- (b) the "My Top Game" terminal;

- (c) the nature of the gaming and gambling industry;
- (d) the level of care and attention paid by the average consumer.

The Opponent's second evidence in chief

18. The Opponent's evidence in chief in respect of the claim under section 3(6) comprises a second witness statement of Ms Hiscox, dated 18 March 2021, together with Exhibits CH2 to CH5. The Opponent's evidence includes information on the nature of the Applicant's business, with Ms Hiscox's witness statement highlighting text that describes the Applicant as being a provider of software. Exhibit CH5 consists of a table listing the Applicant's 141 live UK trade marks, applied for since 2017. In her witness statement, Ms Hiscox highlights that the majority of the 141 UK trade marks have been applied for in the same three classes – 9, 28 and 41 – for the same specification of goods and services.

The Applicant's second evidence in chief

19. The Applicant's evidence in chief in respect of the section 3(6) claim comprises of the witness statement of Ms Sissel Weitzhandler, Chief Risk and Compliance Officer at Play'n GO Marks Ltd, dated 18 May 2021, together with Exhibits SW1 to SW4. Ms Weitzhandler describes the development of the Applicant's "GAME OF GLADIATORS" online slot game and how games, including in the market of online slot games, frequently draw on historical themes such as gladiators to provide the player with a diversion from real life. Exhibits SW2 to SW4 show use of gladiators in relation to entertainment in broad terms and specifically in the market for online slot games.

20. Ms Weitzhandler goes on to explain the Applicant's commercial interest in utilising the theme of gladiators in the Roman Empire for its game and disputes that the game was developed, and trade mark consequently applied for with "*ill intentions to stop the Opponent from building its presence under its Gladiators games*", or "*with the purpose of stopping others from trading under its mark in relation to gambling goods and services*".

21. While this second bundle of evidence in chief is provided by the Applicant in response to the section 3(6) claim, I consider it to speak to the distinctive character of “GLADIATORS” in the market for gaming and will also turn to this in my assessment of section 5(2)(b).


22. I have taken account of all the evidence and submissions filed.

23. In respect of the UK’s departure from the EU, it should be noted that 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 Trade Marks Act 1994 relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Opposition under section 5(2)(b)

24. It is convenient to start by examining the opposition to the Applicant’s mark under section 5(2)(b), which concerns similar marks and similar or identical goods and services.

25. The Opponent relies on two earlier marks, which are set out in the table below, alongside the Applicant’s mark:

Applicant’s mark	Opponent’s marks
GAME OF GLADIATORS	<u>Mark A:</u> 
	<u>Mark B:</u> Gladiator

26. Due to the coincidence of the plural form “GLADIATORS” in the application and the Opponent’s Mark A, the limited impact of the figurative ribbon device in Mark A, the broader specification relied upon under Mark A and the fact that there are questions over the evidence of use filed in support of the Opponent’s Mark B, I have chosen to begin my assessment of 5(2)(b) based upon Mark A. In choosing this approach, I have also noted that the goods relied upon under Mark B “*Apparatus for games (including video games), other than adapted with external screens or monitors*” are wholly subsumed within the list of goods in Mark B.³ As Mark A had not been registered for a period of five years at the date the Applicant applied for the contested mark, the use conditions under section 6A of the Act do not apply.

Section 5(2)(b) states:

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

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

27. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“**the CJEU**”) 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.

³ See *Gaming apparatus (including coin-operated apparatus)* in Mark A.

(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 greater degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of the goods and services

28. In considering the extent to which there may be similarity between the goods and services, I take account of the guidance from relevant case law. Thus, in Canon the CJEU stated that:

*“In assessing the similarity of the goods or services concerned, ... 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”.*⁴

29. The relevant factors identified by Jacob J. (as he then was) in the Treat⁵ case 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;

⁴ Case C-39/97, at paragraph 23.

⁵ British Sugar PLC v James Robertson & Sons Ltd., 1996 R.P.C. 281.

(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.

30. I also bear in mind that terms used to specify services should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.⁶

31. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, the General Court of the European Union stated that goods can be considered as identical when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (and vice versa).⁷

32. The Opponent relies on all of its goods under Mark A and opposes all of the goods and services in the Applicant's mark.

33. The opposition is directed against the following goods in Class 9:

Computer games and video games (software), hereunder software for slot machine games, betting and wagering games, video slot games and casino games provided online and via computer networks and playable on any type of computing device including arcade games, personal computers, handheld devices and mobile phones, on cruise ships and other physical casino locations; software for slot machine games, betting and wagering games, video slot games and casino games provided online and via computer networks and playable on any type of computing device including arcade games, personal computers and handheld devices, on cruise ships and other physical casino locations.

⁶ See, for example, Lord Justice Arnold at paragraph 47 of *Sky v Skykick* [2020] EWHC 990 (Ch).

⁷ *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, case T-133/05 at paragraph 29. See Case T-388/00 *Institut für Lernsysteme v OHIM — Educational Services (ELS)* at paragraph 53 for this principle applied to services.

34. The Applicant's Class 9 goods are essentially gaming software that is designed to be accessed online. In its first set of submissions filed during the evidence rounds, the Applicant contends that the Opponent's goods differ in their nature, intended purpose and end user as they are worded to be offline, whereas the Applicant's goods are offered online. I disagree with the Applicant here and highlight that the Opponent's goods include "*online games (software), in particular for online betting games, online prize games, online gambling games, online games of skill and online casino games*". This term in the Opponent's Mark A covers online games software at large, with "*in particular*" providing examples of the nature of the software, but in my view, not limiting it. As such, I find the Applicant's goods in Class 9 to be identical to the Opponent's goods within the *Meric* principle. Even if "*in particular*" from the Opponent's goods limits the nature of its online games software in Class 9, these goods are nevertheless similar to the Applicant's Class 9 goods to a high degree, sharing the same nature, intended purpose, users and channels of trade.

35. The opposition is directed at the following goods in Class 28:

Videogaming apparatus, hereunder slot machines for gambling, gaming machines, poker machines and other video based casino gaming machines; arcade games; gaming machines, namely, devices that accept a wager; reconfigurable casino and lottery gaming equipment, hereunder gaming machines including computer games and software therefore sold as a unit.

36. In its submissions, the Applicant admits that there is some overlap between the parties' goods in Class 28, however, it submits that the respective goods are different overall because the Opponent's goods are physical gaming cabinet hardware, requiring a physical wager, such as coins or tickets, whereas the Applicant's goods are for online gaming, without a physical wager. The Applicant submits that the respective goods therefore differ in their distribution channels and end users.

37. I am required to decide this opposition on a notional assessment based on the mark applied for and the mark as registered. The Applicant's list of goods in Class 28 are not limited to functioning only online and neither are they restricted to only work

without a physical wager. As such, I disagree with the Applicant's submissions concerning the differences between the respective goods in this class.

38. The Opponent's list of goods in Class 28 include "*gaming apparatus (including coin-operated apparatus)*" and "*automatic gaming machines and gaming machines, in particular for commercial use in casinos and gaming arcades, with or without a prize payout*". I find these goods from the Opponent's Mark A to be identical to the Applicant's goods in Class 28 under the *Meric* principle, as the Applicant's goods in Class 28 are all forms of gaming equipment. If I am wrong and the goods are not identical, I nevertheless find them to be similar to a very high degree, as they share the same nature, intended purpose, users and channels of trade.

39. The opposition is directed at the following online gaming services in Class 41:

Games services provided online (via computer networks), hereunder providing slot machine games, betting and wagering games, video slot games and casino games, playable via local or global computer networks; online gaming services; entertainment services, namely, conducting a game of chance simultaneously at multiple, independent gaming establishments; entertainment services, hereunder providing online computer games; [...]; all the foregoing excluding arranging sports events and televised entertainment.

40. Comparing these services to the Opponent's "*online games (software), in particular for online betting games, online prize games, online gambling games, online games of skill and online casino games*", the goods and services share the same intended purpose, to enable a punter to access games. In addition to this, the games software in the Opponent's mark is indispensable to the provision of the Applicant's online games services and due to this relationship, a significant part of the relevant public may believe the contested goods and services are produced by the same or linked undertakings and are therefore complementary. I find the Applicant's gaming services listed at paragraph 39 to be similar to the Opponent's goods to a degree that is between medium and high.

41. The remaining services in Class 41 of the Application are:

prize draws [lotteries]; organising and conducting lotteries; all the foregoing excluding arranging sports events and televised entertainment.

42. The Opponent's list of goods under Mark A include "automatic lottery machines" in Class 9 and "drawing apparatus for prize games and lotteries, draws or raffles" in Class 28. I do not have either submissions or evidence before me specifically related to the nature of the market for lottery equipment and services, however, I consider that in order to organise and conduct a lottery, either a machine or drawing apparatus will be required, meaning that these goods will be indispensable to the provision of the services. Due to this relationship, I find that a proportion of the relevant public may consider that the goods and services are provided by the same undertaking and are therefore complementary. Additionally, I consider the respective goods and services to share the same intended purpose, in respect of enabling lotteries to take place. Overall, I find the Applicant's services listed at paragraph 41 to be similar to the Opponent's goods to a medium degree.

Average consumer and the purchasing act

43. It is necessary to determine who is the average consumer for the respective goods and services and how the consumer is likely to select them.

44. In *Hearst Holdings Inc*⁸, Birss J. explained that:

"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 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 word "average" denotes that the person is typical ..."

⁸ *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), at paragraph 60.

45. 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*⁹.

46. The Applicant's position is that the relevant public is both the average consumer and the specialised consumer. Due to the expensive nature of the goods and legal requirements around gambling, the Applicant submits that the average consumer will pay a higher degree of attention, making informed decisions based upon factors including price, chances of success and characteristics of the games. I also note the registration requirements for online gambling as referred to in Mr Törnqvist's witness statement. In its submissions in lieu of a hearing, the Opponent refers to aspects of the second witness statement of Mr Schröder, including that slot machines are often played with very low stakes and with favourable odds, which will mean that the average consumer will not be very attentive or overly cautious. Also noted are Mr Schröder's comments that where a consumer has already made significant wins, or has just started a session, they may be less risk averse and so less attentive.

47. The general public that is the end user of gaming machines and software of the type in these proceedings will primarily access them in a setting such as a casino, or online via a gaming website of the sort seen within the parties' evidence. As a result, I do not consider that the general public will normally be the purchaser of the goods in Classes 9 and 28. Instead, I find that the relevant public for these goods to be a professional public, this being a casino, betting shop, or a provider of online gambling services. This professional public will pay attention to the characteristics of the specific games including odds, wager level and game theme, to ensure that they are suitable for their customers. I consider that the purchase will predominantly be a visual one, although I do not discount that aural considerations could play a part, through possible telephone orders, or word of mouth recommendations. For the goods in Classes 9 and 28, I find that a high level of attention will be paid.

⁹ Case C-342/97.

48. In respect of the Applicant's services in Class 41, I consider that the average consumer will be predominantly members of the general public, over the age of 18, who gamble online. It can be seen from the evidence that consumers, when accessing these online games, are required to log in to an account. From Exhibit JT3, it appears that the consumer will see a significant number of games from which they can choose to play but it is only once they have logged in to the overall website, that they are able to access the individual games. The Applicant's evidence shows that the amount that is bet varies greatly, with Exhibit JT1 indicating a starting bet of €0.20 per spin and a maximum stake of €100 per spin.

49. Taking account of the evidence before me, I find that the relevant member of the general public, engaging in online gambling will include regular gamblers of the type described by Mr Törnqvist, who gamble more frequently, with the aim of making money, may bet at higher stakes and will pay attention to the "Return To Player (RTP)" rates of specific games. Whereas at the other end of the spectrum will be the consumer described by Mr Schröder, who gambles infrequently, for fun and at lower stakes. Therefore, I find the level of attention paid by the consumer for the services in Class 41 will vary from between medium and high. I consider the purchase of the services to be visual in nature, although I do not rule out aural considerations through word of mouth recommendations.

Comparison of the marks

50. It is clear from *Sabel BV v. Puma AG*¹⁰ (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 *Bimbo SA v OHIM*,¹¹ 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


¹⁰ Case C-251/95.

¹¹ Case C-591/12P.

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.”

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

52. The Applicant’s mark and the Opponent’s Mark A are shown below:

Opponent’s Mark A	Applicant’s mark
	GAME OF GLADIATORS

53. The overall impression of the Opponent’s Mark A is of the English-language word “GLADIATORS”, written along a ribbon device. I find the dominant part of the Opponent’s mark to be the word “GLADIATORS”, with the flowing ribbon serving to set off the prominent and distinctive verbal element. The word “GLADIATORS” will be understood as referring to people in ancient Rome who fought in public shows.

54. The Applicant’s mark consists of the three English language words “GAME OF GLADIATORS”, with the overall impression being taken from the three words that collectively designate a game involving people in ancient Rome who fought in public shows. The words “GAME OF” are non-distinctive in respect of gaming software, equipment and services and I find “GLADIATORS” to therefore be the distinctive and dominant element of the Applicant’s mark.

Visual similarity

55. Visually, the marks are similar in that they both contain the same sequence of ten letters forming the word “GLADIATORS”. The marks differ visually in that the word

“GLADIATORS” in the Opponent’s mark is written along a ribbon device, with the letters rising and falling with the ribbon. There are also two words in the Applicant’s mark – “GAME OF” – which do not appear in the Opponent’s mark.

56. The Opponent submits that the respective marks are visually highly similar, whereas the Applicant highlights the different number of words and letters that are present in the marks and the fact that the figurative element that appears only in the Opponent’s mark. The Applicant also makes reference to the established principle that UK consumers attach more importance to the beginning of a mark.

57. Taking account of the additional words in the Applicant’s mark, the figurative features in the Opponent’s mark and bearing in mind the principle that consumers tend to focus more on the beginning of the mark, I find the marks to be visually similar to a degree that is somewhere between low and medium.

Aural similarity

58. Aurally, the marks align in that the four syllables in the Opponent’s mark are entirely contained within the Applicant’s mark. The Applicant’s mark has two additional syllables – “GAME OF”. The Opponent submits that the marks are phonetically highly similar, whereas the Applicant contends that it’s mark is significantly longer than the Opponent’s. I find that the coincidence of the word “GLADIATORS” means that there is a medium degree of aural similarity between the marks, but no higher that this due to the different sound – “GAME OF” – in the Applicant’s mark.

Conceptual similarity

59. The Applicant contends that there are significant conceptual differences between the marks as “GAME OF GLADIATORS” refers to an event, whereas the Opponent’s mark refers to the participants. In support of this, the Applicant refers to the witness statement of Mr Thomas and the Wikipedia entry for “Gladiator” at Exhibit COT2, which mentions that gladiator combat occurred in events referred to as “games”.

60. Plainly, the Applicant's mark "GAME OF GLADIATORS" refers to a competition, match or event involving fighters from the era of ancient Rome. Conversely, the Opponent's mark "GLADIATORS" refers to fighters from the era of ancient Rome, i.e. the participants of the event referred to in the Applicant's mark. So, there is a slight degree of conceptual difference. However, when seen in respect of the goods and services at issue in these proceedings, which are essentially games or the provision of access to games, for both marks, consumers will understand that the games offered have a gladiator theme, i.e. they are related to fighters from ancient Rome. As such, I find the marks to be conceptually similar to a high degree.

Distinctive character of the earlier mark

61. Distinctive character is the capacity of the mark to identify the goods or services for which it is registered as coming from a particular undertaking, and to distinguish those goods or services from those of other undertakings: see *Lloyd Schuhfabrik Meyer*, paragraph 22.

62. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The inherent distinctive character may be enhanced through the use that has been made of the mark.

63. In *Lloyd Schuhfabrik Meyer*, the CJEU set out how an assessment of a mark's distinctive character should be made:

"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)."*

64. I shall begin my assessment by considering the inherent distinctiveness of the Opponent's earlier Mark A, before assessing whether this distinctiveness has been enhanced through use that has been made of the mark.

65. The Applicant's position is that "gladiator(s)" has only a modest degree of distinctive character in respect of the goods and services at issue. In its submissions filed during the evidence rounds, the Applicant refers to Exhibit COT1 which consists of the first page of results of a Google search for the words "gladiator game". The Applicant submits that the 70 million plus Goggle search engine results are an indication that the term has become diluted for games. I am not persuaded by this argument and consider that a simple Google search, not limited to the UK, or the relevant market, is not convincing evidence that "gladiator(s)" possesses only a modest degree distinctive character.

66. The witness statement of Ms Sissel Weitzhandler, filed as part of the Applicant's second round of evidence in chief, features information about the use of themes in the market for gaming and examples of gladiatorial-themed games. Ms Weitzhandler explains that online slot games seek to emulate themes that are popular with their customer base, with gladiators being a theme that has "*constantly*" been adapted into forms of media and entertainment. Ms Weitzhandler then provides two articles, at Exhibit SW3, the first of which indicates that historical themes are popular for slot machine games and the second which shows the importance of themes (in general)

for slot machine games. Ms Weitzhandler concludes that the gladiator theme has become trendy among slot game developers in recent years and in support of this, at Exhibit SW4 are provided examples of online slot machine games, with themes of gladiators and ancient Rome.

67. On the basis of the evidence at Exhibit SW2, I do not agree that the theme of gladiators is *constantly* in use in media and entertainment as a whole. Indeed, the Wikipedia pages provided show the TV programme “Gladiators” and the film “Gladiator”, in respect of which around 20 years have passed since respectively, the broadcast of the last episode of the programme and the release of the film. Also included in Exhibit SW2 is a webpage from what appears to be an online computer game platform (non-gambling) called “crazy games” which includes games with a gladiator theme. It is not clear from the evidence whether these games are accessible in the UK and this evidence, taken together with the TV programme and film references does not convince me of the Applicant’s contention that gladiator themes are *constantly* in use in media and entertainment.

68. What is apparent from Ms Weitzhandler’s evidence is that themes are important in the market for slot games, where consumers are confronted with a huge selection of games to choose from, which appear to be primarily characterised through their theme. In this respect I note Exhibit JT1 which shows around 160 different games on the Applicant’s website and the comment of Mr Schröder in his witness statement¹² that his company’s games are sold in packages of 30 or 60 games. Exhibit SW3 consists of the aforementioned articles about themes for slot games and what I note here is that historical themes are a category within the list, although gladiators are not specifically mentioned. Neither gladiators, nor historical themes are mentioned in the second article in Exhibit SW3, which includes a list of top themes for online casino games in 2018. In respect of SW4, scant information is provided to show that the games are accessible to, or are used by UK consumers. I can see three examples of gladiatorial themed games that appear to be from the UK and that show the actual game – *Spartacus Gladiator of Rome; Gladiators Victory; and Gladiator Jackpot*. However, I have no information before me concerning the extent to which these games

¹² See para. 18 of the first witness statement of Mr Wolfgang Schröder.

have been promoted to the average consumer, or through what channels, or how the average consumer will perceive the term “GLADIATORS” in respect of the goods and services concerned.

69. I find it appropriate at this point in my decision to address the Applicant’s primary argument in respect of section 5(2)(b) that it advances in its submissions in lieu of a hearing. The Applicant seeks to draw parallels between the registry’s famous names practice, developed in light of cases including *Arsenal Football Club Plc v Reed*¹³ and *Presley Enterprises Inc v Sid Shaw Elvisly Yours*¹⁴ and applied in *ALEX FERGUSON*¹⁵ and *LINKIN PARK*¹⁶. If I have followed the Applicant’s argument correctly, it is that “GLADIATORS” is so well known for gaming goods and services, that average consumers will not consider goods and services marketed under the Applicant’s mark to originate from the Opponent. On the basis of the evidence that I have before me, I do not accept that the term “GLADIATORS” in respect of gaming goods and services has the same renown as names such as Arsenal Football Club, Elvis Presley, Alex Ferguson or Linkin Park. As such, I do not find the parallels that the Applicant has drawn between the signs at issue and the approach with regards to famous names to represent a sustainable argument.

70. Taking all of the above into account, I find the Opponent’s Mark A to possess a medium degree of inherent distinctive character.

71. Turning to whether the distinctiveness of the Opponent’s Mark A has been enhanced through use, the Opponent’s evidence appears to relate solely to the German market. In his first witness statement, Mr Schröder indicated the place of use of the mark as being the Federal Republic of Germany. Indeed, the regulatory documents, sales figures, delivery notes and promotional material all relate specifically to the German market and there are no further exhibits in the Opponent’s evidence in reply to show use outside of Germany. With no evidence relating to the UK market, I find that the Opponent’s Mark A cannot benefit from enhanced distinctiveness through use.

¹³ [2002] EWHC 2695(Ch).

¹⁴ (ELVIS PRESLEY Trade Marks) [1999] R.P.C. 567 CA.

¹⁵ O-266-05.

¹⁶ O-035-05.

Likelihood of confusion

72. I have so far considered the factors that need to be taken into account when assessing the likelihood of confusion and I now come to make a global assessment of these factors. In making this global assessment, I take stock of my findings in the foregoing sections of this decision and the authorities and principles that I have set out, in particular, at paragraph 27 above.

73. There are two types of confusion that I may find. The first type is direct confusion which occurs where the consumer mistakes one mark for another. The second type is indirect confusion, where the consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that the goods or services derive from the same, or a related economic undertaking.¹⁷

74. In this decision I have found the goods and services to be similar to at least a medium degree, with most being identical. The word element “GLADIATORS” appears in both marks and I have found this to constitute the distinctive and dominant element of each mark, noting in particular the purely descriptive nature of “GAME OF” in the Applicant’s mark. Conceptually, I have found the marks to be similar to a high degree and aurally similar to a medium degree, and I have found the Opponent’s mark to possess a medium degree of distinctive character. On the other hand, I have found the marks to be visually similar to a degree that is somewhere between low and medium and in respect of the goods concerned, I have found the average consumer will pay a high degree of attention when making this predominantly visual purchase, whereas for the services, the average consumer will pay either a medium or high level of attention in purchasing the services.

75. Taking all of these findings into account, I conclude that the average consumer, even paying a high level of attention, would directly confuse the Applicant’s mark and the Opponent’s Mark A. I find this to even be the case in respect of the goods and services where I have identified only a medium degree of similarity. The coincidence

¹⁷ L.A. Sugar Limited v Back Beat Inc, BL O/375/10

of the distinctive and dominant element in the marks “GLADIATORS” would in my view lead the average consumer to mistake one mark for the other.

76. I also find indirect confusion between the Applicant’s mark and the Opponent’s Mark A, with the addition of “GAME OF” in the later mark simply adding a non-distinctive element to the Opponent’s mark. Under this head of confusion, I consider that consumers would recognise the difference between the marks, but because of the dominance of the common element “GLADIATORS”, would conclude the Applicant’s mark to be another brand of the owner of the earlier mark.

Conclusion

77. The opposition under section 5(2)(b), based upon the Opponent’s Mark A succeeds against all of the goods and services in the Applicant’s mark. This being the case, it is not necessary for me to proceed to assess this ground of opposition in respect of the Opponent’s Mark B.

Application made in bad faith

78. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

79. The Opponent’s case under this ground is that the Applicant has acted in bad faith in respect of its application for goods in Class 28. The Opponent contends that the Applicant is only interested in the market for online gaming software and that the Applicant has provided no evidence or indication to show that it currently provides, or intends to develop gaming equipment. The Opponent highlights a filing practice of the Applicant who habitually files its trade marks in Classes 9, 28 and 41 and points to various aspects of the Applicant’s evidence and witness statements of Mr Törnqvist and Ms Weitzhandler, which in the Opponent’s view, indicate that the Applicant’s business is focused entirely on gaming software and the online gaming market, and not on gaming equipment of the type that falls within Class 28.

80. The Applicant disputes the Opponent's claims under section 3(6) and submits that the Opponent has failed to meet the evidential standards to establish that the application was made in bad faith.

81. In its submissions in lieu of a hearing, the Applicant also contends that its evidence shows that its mark has been used in respect of goods in Class 28, these being "*online slot gaming that accept digital wagers, which are to be accessed through compatible devices that are connected [to] the internet*". On this point, it is not clear to me which part of the evidence is referred to by the Applicant, however, on the basis of the description it has provided, I would interpret the goods/services referred to as either software or gaming services, rather than gaming equipment in Class 28. I do not therefore find this submission from the Applicant to be conclusive against a finding of bad faith.

82. An allegation of bad faith is a serious allegation which must be distinctly proved.¹⁸ The allegation by the Opponent falls very much within the area of bad faith concerning intention to use and the scope of specifications that are the subject of the *Sky Kick* cases to which both parties refer in their submissions. I am aware that leave has been sought to appeal the Court of Appeal's judgment in *Sky Limited & Ors v Skykick, UK Ltd & Ors*¹⁹ to the Supreme Court, leaving this aspect of bad faith law in a state of flux. What can be seen from the preliminary ruling of the CJEU in *Sky Kick*²⁰ (the implementation of which is the subject of the ongoing cases in the UK courts), is that this form of bad faith may only be established only if:

"77...there is objective, relevant and consistent indicia tending to show that, when the application for a trade mark was filed, the trade mark applicant had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark."

¹⁸ *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch)

¹⁹ [2021] EWCA Civ 1121

²⁰ *Sky v Skykick*, CJEU, Case C-371/18

And

“78. The bad faith of the trade mark applicant cannot, therefore, be presumed on the basis of the mere finding that, at the time of filing his or her application, that applicant had no economic activity corresponding to the goods and services referred to in that application.”²¹

83. It is not apparent to me from the Opponent’s submissions and evidence that the Applicant’s practice of filing its applications in Class 28 constitutes a practice that undermines the rights of third parties, or concerns obtaining rights for purposes other than those falling within the functions of a trade mark. What is evident is the close relationship between gaming software, gaming services and gaming equipment, in respect of which I recall the evidence of Mr Schröder in his first witness statement for the Opponent, which indicates that it common practice in the gambling industry that manufacturers of game software also produce gaming equipment that would fall within the scope of Class 28. These factors steer me away from finding that the Applicant’s mark, in as far as it covers goods in Class 28 has been filed in bad faith.

84. In these proceedings, it is clear to me that the more secure ground of opposition is that under section 5(2)(b), with the questions over whether the Applicant has met the evidential requirements for section 3(6) being compounded by the ongoing uncertainty surrounding the outcome of *Sky Kick*. However, in the interests of dealing conclusively with what is a serious allegation, and applying the CJEU’s finding set out at paragraph 82, I find that bad faith has not been established by the Opponent.

Outcome

85. The opposition under section 3(6) fails. The opposition under section 5(2)(b) succeeds fully on the basis of the Opponent’s earlier Mark A. Subject to appeal, the application will be refused.

²¹ Case C-371/18

COSTS

86. The Opponent has been successful and is entitled to a contribution towards its costs, in line with the scale set out in Tribunal Practice Notice 2/2016. It appears that the Opponent's first filed evidence in chief largely mirrors the evidence filed in the proceedings between the parties before the EUIPO²² and the award for the preparation of evidence therefore reflects this. I make no award in respect of the claim under section 3(6) which has been unsuccessful.

<i>Form TM7 fee</i>	£200
<i>Preparing a statement and considering the other side's statement:</i>	£350
<i>Preparing evidence and considering and commenting on the other side's evidence:</i>	£550
<i>Preparation of submissions in lieu of a hearing</i>	£400
	Total: £1500

87. I order Play'n GO Marks Ltd. to pay adp Gauselmann GmbH the sum of **£1500**. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19 day of October 2021

Charlotte Champion
For the Registrar

²² Exhibits WS1 to WS14 appear to be the same, with Exhibits WS15 to WS18 being additional in these proceedings.