

**O/0237/23**

**CONSOLIDATED PROCEEDINGS**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF THE UK DESIGNATIONS OF INTERNATIONAL  
REGISTRATION NO. 1596533 & NO. 1596535  
IN THE NAME OF ADP MERKUR GMBH**

**FOR THE TRADE MARKS**

**Ironclash**

**AND**

**Ironsword**

**IN CLASSES 9 AND 28**

**AND**

**IN THE MATTER OF OPPOSITIONS THERETO  
UNDER NUMBERS 428386 & 428391  
BY PLAY'N GO MARKS LTD.**

## BACKGROUND AND PLEADINGS

1. On 24 February 2021, International Registration (“IR”) No. 1596533 (the “533” mark) was registered for the word mark “Ironclash”, based on EUIPO Trade Mark No. 18324913; and IR No. 1596535 (the “535” mark) was registered for the word mark “Ironsword”, based on EUIPO Trade Mark No. 18325118. Both marks have a priority date of 22 October 2020. With effect from the claimed priority date, adp Merkur GmbH<sup>1</sup> (“the holder”) designated the United Kingdom for protection of each of the marks.

2. Both designations were accepted, and were published for opposition purposes on 27 August 2021 and 3 September 2021 respectively. Both designations were in respect of goods in classes 9 and 28, as listed in the table under paragraph 29 of this decision.

3. The designations are opposed by Play'n GO Marks Ltd. (“the opponent”). The oppositions were each filed on 22 November 2021, and each are based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The oppositions are directed against all of the goods in both designations. These oppositions have been consolidated.

4. The opponent relies upon the following comparable UK word mark:

### IRON GIRL

UK Trade Mark Registration Number 915666894

Filing date: 19 July 2016

Registration date: 1 November 2016

Registered in Classes 9, 28 and 41

Relying on all goods and services, namely:

Class 9: *Computer games and video games; software for gaming machines.*

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<sup>1</sup> I note that on 1 March 2022, the holder company changed its name from “adp Gauselmann GmbH” to “adp Merkur GmbH”, which was confirmed by the holder’s representatives as being the same legal entity. The Tribunal was also notified of the change by WIPO. The new name of the holder has been recorded accordingly in these proceedings.

Class 28: *Slot machines for gambling; videogaming apparatus.*

Class 41: *Games services provided online (via computer networks); prize draws [lotteries]; organising and conducting lotteries.*

5. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Trade Mark designating the EU. As a result, the opponent's mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.<sup>2</sup>

6. The opponent submits that the initial shared element "IRON" in each of the marks will have a strong impact on consumers on the overall impression made by the marks and is the dominant element, and that the second word in the respective marks, being "GIRL" (in the earlier mark), and "CLASH" (the "533" mark) and "SWORD" (the "535" mark) will have a lower impact. It submits that both of the contested marks and the earlier mark all cover identical or similar goods and services which lead to a likelihood of confusion on the part of the public. The opponent submits that it is therefore entitled to prevent the grant of protection of the UK designations pursuant to section 5(2)(b) of the Act.

7. The holder filed a counterstatement denying the claims. It submits that each of the contested marks are different to the earlier mark, but to the extent that any similarity between the respective marks is found to exist, the degree of similarity is not sufficient for a likelihood of confusion to arise. The holder requests that the oppositions are rejected and that an award of costs be made in the holder's favour.

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<sup>2</sup> See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

8. Both parties filed written submissions which will be referred to as and where appropriate during this decision. Both parties elected to file evidence, which will be summarised to the extent considered necessary. Neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

9. In these proceedings, the opponent is represented by Appleyard Lees IP LLP and the holder is represented by Greaves Brewster LLP<sup>3</sup>.

## **EVIDENCE**

### **Opponent's Evidence**

10. The opponent filed evidence by way of two witness statements.

11. The first witness statement is in the name of Cherry Shin, of the opponent's representatives Appleyard Lees IP LLP, which is dated 30 May 2022, and to which there are attached six exhibits, labelled **Exhibit CXS 1** to **Exhibit CXS 6**. Ms Shin states that the main purpose of the evidence is in support of the consolidated oppositions, and specifically to show that it is common industry practice for games developers to use a core trade mark at the start of the name of each successive product and in combination with a different ending.

12. The second witness statement, filed as evidence in reply, is by Hanna Nattfogel, who is a director of Play'n GO Marks Ltd, being the opponent in these proceedings. The witness statement is dated 3 October 2022, to which there are attached thirteen exhibits, labelled **Exhibit 1** to **Exhibit 13**. She submits that the main purpose of the evidence is to show that through the extensive use of "IRON GIRL" in the UK, the mark enjoys an enhanced level of recognition amongst consumers.

### **Holder's Evidence**

13. The holder filed evidence in defence of the consolidated oppositions by way of a witness statement dated 19 July 2022 in the name of Valentine Kohl, who is Head of

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<sup>3</sup> Form TM33 appointing Greaves Brewster LLP as representatives to the holder was received on 8 March 2022.

the holder company's Intellectual Property Department, a position which she states she has held since February 2021. Alongside the witness statement is an index of the forty-nine attached exhibits, labelled **Exhibit VK1** to **Exhibit VK49**, accordingly. Ms Kohl submits that the main purpose of the evidence is to provide information about the average consumer of the holder's relevant goods and services, along with information about the co-existence of trade marks featuring the word "IRON" in the UK market place in the gaming and gambling sectors.

14. I have read and considered all of the evidence and I will refer to the relevant parts at the appropriate points in the course of the decision.

### **Preliminary Issues**

15. In its written submissions, the holder has questioned the substance of the evidence submitted in support of the oppositions.

16. With regard to the evidence-in-chief provided in the witness statement of Ms Cherry Shin, it submits that as a UK qualified trade mark attorney who has not provided any evidence of any particular experience in the gaming industry that would qualify her to comment on practices in that sector, the comments of Ms Shin should be given little weight.

17. I note that a witness statement may only be given in evidence if it includes a statement of truth. Ms Shin has included a statement of truth in her witness statement and as such, she has fulfilled this statutory requirement. I will therefore consider the weight to be given to the essence of the statement in the course of my decision.

18. With regard to the opponent's evidence in reply, the holder submits that it was not part of the pleaded case that it owns a reputation, or enjoys an enhanced level of recognition, in the combination "IRON GIRL", rather that the opponent's pleaded case was that "the word IRON has an enhanced distinctive character". It submits that the evidence of Ms Nattfogel should not be taken into account as it does not form evidence in reply.

19. In the Tribunal Section of the Manual of trade marks practice, “4.8.7 Evidence in reply” states that:

“The aim of ‘evidence in reply’ is to achieve finality in the proceedings; evidence in reply must not involve a departure from a case put in chief, but may include comment on the other side’s evidence. It should not ‘seek to adduce additional evidence...’ (Ernest Scragg & Sons Ltd’s Application (1972) RPC 679). However, it should be noted that this is no longer a requirement of the Rules. The Tribunal has the power to direct what evidence should be filed and may specify that the evidence should be limited to evidence in reply. If the evidence is not in reply it may still be admissible as additional evidence.”

20. I further note that the case for enhanced distinctiveness does not need to be expressly pleaded. I will therefore make my consideration on this issue at the appropriate juncture of my decision.

## **DECISION**

21. Although the UK has left the European Union, 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 on in these proceedings are derived from an EU Directive. Therefore, this decision contains references to the trade mark case-law of the European courts.

### **Section 5(2)(b) –**

22. Section 5(2)(b) of the Act is relied upon, which reads as follows:

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

...

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

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

23. Section 5A states:

“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.”

24. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.- (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) 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,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

...”

25. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As the trade mark had not been registered for more than

five years before the priority date claimed for the designations of the contested marks, it is not subject to the use provisions contained in section 6A of the Act. The opponent is, therefore, entitled to rely upon it in relation to all of the goods and services indicated without having to prove that genuine use has been made of them.

26. I am guided by the following principles which 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("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:

(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 to mind the earlier mark, is not sufficient;

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

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

## **Comparison of goods and services**

27. Section 60A of the Act provides:

“(1) For the purposes of this Act goods and services —

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

28. I am therefore mindful of the fact that the appearance of respective goods and services in the same class is not sufficient in itself to find similarity between those goods and services, and that likewise, neither are goods and services to be automatically found to be dissimilar simply because they fall in a different class.

29. The goods and services to be compared are:

Opponent’s goods and services	Holder’s goods
<p><u>Class 9</u> <i>Computer games and video games; software for gaming machines.</i></p> <p><u>Class 28</u> <i>Slot machines for gambling; videogaming apparatus.</i></p> <p><u>Class 41</u> <i>Games services provided online (via computer networks); prize draws [lotteries]; organising and conducting lotteries.</i></p>	<p><b>The “533” and the “535” marks<sup>4</sup></b></p> <p><u>Class 9</u> <i>Software; coin-operated mechanisms; computer and video games software; games software, in particular for use with computer-aided platforms of all kinds, including entertainment electronics and games consoles; computer game programs; video games (software);</i> <b><i>computer games provided through a global computer network or supplied by means of multi-media electronic broadcast or through telecommunications or electronic transmission or via the internet;</i></b> <i>computer games, leisure and recreational</i></p>

<sup>4</sup> Please see explanation of goods highlighted in red under paragraph 39, below.

*software, video games and computer software, all being provided in the form of storage media; programs for operating electric and electronic apparatus for games, amusement and/or entertainment purposes; computer software for computer games on the internet; online games (software), in particular for online betting games, online prize games, online gambling games, online games of skill and online casino games; computer software in the form of a mobile device or computer application; calculating apparatus in coin-operated machines [calculating apparatus] and parts thereof, included in this class; electric, electronic, optical or automatic apparatus, for identifying data carriers, identity cards and credit cards, bank notes and coins; software, in particular for casino and/or amusement arcade games, for gaming machines and/or slot machines, all of the aforesaid with or without a prize payout; games software that generates or displays betting results of slot machines; software for operating computer games; computer software for games administration (games compilation); compilation of video games [computer software].*

**Class 28**

*Games; **toys**; gaming apparatus (including coin-operated apparatus); coin-operated arcade games (machines); games for amusement arcades (included in class 28); coin-operated video gaming apparatus;*

	<p><i>video game machines adapted for use with an external display screen or monitor; 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, gaming machines, games machines and 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; electronic games; <b>apparatus for electronic games adapted for use with an external display screen or monitor</b>; arcade video games; drawing apparatus for prize games and lotteries, draws or raffles; housings of metal, plastic and/or wood for coin-operated automatic machines; games in</i></p>
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	<p><i>the form of hardware (including video games), other than additional apparatus for an external screen or monitor; pinball machines being electropneumatic and electric pulling machines; gaming tables, in particular for table football, billiards, sliding games; flying discs (toys) and darts; electric, electronic or electromechanical gaming machines for gambling including slot machines or video lottery terminals; lcd games consoles; 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; gaming machines, namely devices which accept a cartridge.</i></p>
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30. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.<sup>5</sup>

31. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“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

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<sup>5</sup> Paragraph 29

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”.<sup>6</sup>

32. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 include an assessment of the channels of trade of the respective goods or services.

33. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.<sup>7</sup>

34. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where appropriate. In *Separode Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”<sup>8</sup>

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<sup>6</sup> Paragraph 23

<sup>7</sup> Paragraph 82

<sup>8</sup> Paragraph 5

35. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. ... Nevertheless the principle should not be taken too far. ... 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."<sup>9</sup>

36. In *Sky v Skykick* [2020] EWHC 990 (Ch), Arnold LJ considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

"...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded."

37. In its Statement of Grounds, the opponent submits that the goods covered by the designations consist of a range of gaming goods. It submits that all of those goods in Class 9 are encompassed within the terms "*Computer games and video games*;

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<sup>9</sup> Paragraph 12

*software for gaming machines*” in Class 9 of its own registration, while all of the terms in Class 28 of the designations are encompassed by “*Slot machines for gambling; videogaming apparatus*” in Class 28 of the earlier mark, and thus the competing goods are identical. In its submissions in lieu, the opponent has also provided examples of where it considers the opposed goods to be identical to its own goods, and submits that the remaining goods are, at the very least, highly similar.<sup>10</sup> I do not intend to fully reproduce those submissions here, however, I have taken them into consideration in making my own comparisons.

38. In its counterstatement, the holder disputes the opponent’s above submissions, and has highlighted certain goods in both classes which it considers are neither identical to nor encompassed within the opponent’s goods. In its written submissions, the holder submits that a large proportion of its goods are highly specialised and aimed at professional consumers in the gaming industry, although it admits that other of its goods largely constitute video and computer games which may be used by ordinary consumers.

39. I note that the majority of goods within Class 9 and Class 28 of the contested designations are identical to both marks. However, there are also some additional goods included in Class 9 and Class 28 of the “533” mark which are not present in the specifications of the “535” mark. For the sake of clarity, in the above table under paragraph 29, I have recorded the goods covered by both designations together under one heading for each class, however, I have highlighted in red and in bold the additional terms present under the “533” mark only.

40. I will first make my comparison of the goods common to both the designations against the goods and services of the earlier mark before addressing the additional terms of the “533” mark separately. I note that the terms “in particular” and “including” have been used within the holder’s specifications in both classes. In *Häfele GmbH & Co. KG v OHIM*, Case T-336/09, the GC stated that the words “in particular” used in a description of goods are merely indicative of an example, rather than limiting those

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<sup>10</sup> See paragraphs 7 – 9 of the opponent’s final submissions filed on 14 December 2022.



goods to those listed following the term.<sup>11</sup> The same can be said for those goods which follow the term “including” within the specifications. However, where the term “namely”, has been used in the list of the holder’s goods, the scope of protection is restricted to those named goods only, rather than encompassing all goods under the preceding wider term.

### Class 9

*Software, in particular for casino and/or amusement arcade games, for gaming machines and/or slot machines, all of the aforesaid with or without a prize payout.*

41. As mentioned previously, the term “in particular” does not limit the specification beyond software at large. However, the aforementioned goods are self-evidently identical to the opponent’s “*software for gaming machines*”, or they encompass them, making them identical as per the principle outlined in *Meric*.

*Software; computer software in the form of a mobile device or computer application.*

42. The broad term “*Software*” clearly encompasses the opponent’s “*software for gaming machines*” whilst “*computer software in the form of a mobile device or computer application*” also covers “*software for gaming machines*”, as gaming machines may also be in the form of a mobile device or hand-held console. As such, I consider “*Software; computer software in the form of a mobile device or computer application*” to be identical to the earlier “*software for gaming machines*” as per *Meric*.

*Computer and video games software; games software, in particular for use with computer-aided platforms of all kinds, including entertainment electronics and games consoles; video games (software); computer games, leisure and recreational software, video games and computer software, all being provided in the form of storage media; computer software for computer games on the internet; online games (software), in particular for online betting games, online prize games, online gambling games, online games of skill and online casino games; games software that*

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<sup>11</sup> Paragraph 33.

*generates or displays betting results of slot machines; software for operating computer games; computer software for games administration (games compilation); compilation of video games [computer software].*

43. All of the aforesaid goods are specific to gaming, including gambling games, which I consider to be encompassed by the opponent's broad category "*Computer games and video games*" and/or "*software for gaming machines*", rendering the competing goods *Meric* identical.

*Computer game programs.*

44. The terms "computer software" and "computer programs" are used interchangeably, and I note that the Collins English dictionary states that "Computer programs are referred to as software"<sup>12</sup>. As such, I consider that "*Computer game programs*" are identical as per *Meric* to the opponent's "*software for gaming machines*".

*Programs for operating electric and electronic apparatus for games, amusement and/or entertainment purposes.*

45. While the holder's goods are essentially different in nature and purpose to the opponent's "*Computer games and video games*", in my view, there is an interdependent relationship between them, with the programs running in the background in order to execute the game. Accordingly, I consider the competing goods to be highly similar.

*Coin-operated mechanisms*

46. There is an overlap between "*coin-operated mechanisms*" and the opponent's "*Slot machines for gambling*" in Class 28, as the slot machine may need such a mechanism in order to operate, with the mechanism being a component of the

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<sup>12</sup> Collins Dictionary online, sourced on 17 February 2023.

finished machine. In *Les Éditions Albert René v OHIM*, Case T-336/03, the GC found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

The purpose of the mechanism is to allow the operation of a machine, for whatever purpose, through the insertion of coins, while the opponent’s machine is specified as being for the purpose of gambling which is likely to utilise either coins or tokens. Bearing in mind the findings of the GC, while it is possible that the same undertaking would provide the component parts and the finished article, I do not consider that the average consumer would automatically expect this to be the case for “*coin-operated mechanisms*” and “*Slot machines for gambling*”. Overall, I consider “*coin-operated mechanisms*” to be dissimilar to “*Slot machines for gambling*”.

*Calculating apparatus in coin-operated machines [calculating apparatus] and parts thereof, included in this class; electric, electronic, optical or automatic apparatus, for identifying data carriers, identity cards and credit cards, bank notes and coins.*

47. In *RALEIGH INTERNATIONAL Trade Mark* [2001] RPC 11, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, observed that when goods or services are not identical or self-evidently similar, the opposition should be supported by evidence as to their similarity.<sup>13</sup> In the absence of evidence to the contrary, I find nothing to suggest that the average consumer would make the link between the holder’s above listed goods and any of the opponent’s earlier goods and services. I therefore find them to be dissimilar.

## Class 28

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<sup>13</sup> Paragraph 20

*Gaming apparatus (including coin-operated apparatus); coin-operated arcade games (machines); games for amusement arcades (included in class 28); coin-operated video gaming apparatus; video game machines adapted for use with an external display screen or monitor; coin-operated automatic gaming machines and gaming machines, in particular for gaming arcades, with or without a prize payout; electronic or electrotechnical gaming apparatus, gaming machines, games machines and 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; electronic games; arcade video games; games in the form of hardware (including video games), other than additional apparatus for an external screen or monitor; electric, electronic or electromechanical gaming machines for gambling including slot machines or video lottery terminals; lcd games consoles; automatic gaming machines; including all the aforesaid automatic machines, machines and apparatus operating in networks; gaming machines, namely devices which accept a cartridge.*

48. I consider that all of the holder's aforementioned goods would either fall within, or are encompassed by, either the opponent's "Slot machines for gambling" or its "videogaming apparatus", and as such the competing goods are identical as per the guidelines outlined by *Meric*.

*Games.*

49. While a game may be loosely interpreted as a pastime or activity for amusement, the term is suitably vague, and while I am mindful of the guidance given by *YouView*, I consider that the holder's "Games" could feasibly encompass hand-held video games. As such, there will be an overlap in users with the opponent's "Computer games and video games" in Class 9, and although the method of use would be different, the goods may be in competition with each other, with the consumer making an informed choice between the type of game it wishes to purchase. Neither would it be unreasonable for the average consumer to expect the competing goods to be

provided from the same or economically linked undertakings. Overall, I consider the holder's "Games" to be similar to the opponent's "Computer games and video games" to a medium degree.

*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; housings of metal, plastic and/or wood for coin-operated automatic machines.*

50. I consider the above housings to form a component of the opponent's "Slot machines for gambling" and/or its "videogaming apparatus", and as such there is a link between the competing goods. Again, I note the findings of the GC in *Les Éditions Albert René*, and I consider that the nature, intended purpose and end users of the respective goods are different. Therefore any link between the holder's "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; housings of metal, plastic and/or wood for coin-operated automatic machines" and the opponent's "Slot machines for gambling; videogaming apparatus" is insufficient for a finding of similarity between the goods.

*Drawing apparatus for prize games and lotteries, draws or raffles.*

51. The above goods are likely to be utilised in the provision of the opponent's "prize draws [lotteries]; organising and conducting lotteries" in Class 41. In *Commercy AG v OHIM* Case T-316/07, the Board of Appeal ("BOA") found that just because goods are used by an undertaking in order to provide its services, the respective goods and services are targeted at different consumers, and as such, there can be no complementary connection between them.<sup>14</sup> As per *Commercy*, although the holder's "Drawing apparatus for prize games and lotteries, draws or raffles" may support the provision of the opponent's "prize draws [lotteries]; organising and conducting

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<sup>14</sup> At [49-62].

*lotteries*”, they are different in nature, method of use, intended purpose and target user. Consequently, I consider the respective goods and services to be dissimilar.

*Casino fittings, namely roulette tables, roulette wheels.*

52. The above goods are very specific in nature, and I note that the opponent does not enjoy protection for Casino services *per se*, although its “Games services provided online (via computer networks)” in Class 41 could encompass online casino services. To my mind, the holder’s goods would be utilised within bricks and mortar premises (casinos), which I consider to be one step removed from the goods at issue, with said goods and the respective services being distributed through different trade channels, and with different users. The holder’s “Casino fittings, namely roulette tables, roulette wheels” are even further removed from the opponent’s “Games services provided online (via computer networks)”. Overall, I find the goods and services at issue to be dissimilar.

*Pinball machines being electropneumatic and electric pulling machines; gaming tables, in particular for table football, billiards, sliding games; flying discs (toys) and darts.*

53. Once again, I note that the term “in particular” does not limit the specification beyond gaming tables at large. While the above goods are clearly types of games, without evidence to the contrary, I do not perceive them to be in the same category as the opponent’s goods and services, nor do I see anything within the earlier specifications which immediately strikes me as being self-evidently similar to the holder’s “Pinball machines being electropneumatic and electric pulling machines; gaming tables, in particular for table football, billiards, sliding games; flying discs (toys) and darts”. Therefore, I find the holder’s aforementioned goods to be dissimilar to the opponent’s earlier goods and services.

*...; Apparatus and devices for accepting and storing money, being fittings for the aforesaid automatic machines, included in class 28.*

54. Given the punctuation of the holder's Class 28 specification as a whole, the above term relates to all relevant goods that precede the term. As a fitting or component for such machines, I consider the holder's goods could also be a component of the opponent's "*Slot machines for gambling*". However, for the same reasons given in paragraphs 46 and 50 of this decision regarding the findings of *Les Éditions Albert René*, I consider "...; *Apparatus and devices for accepting and storing money, being fittings for the aforesaid automatic machines, included in class 28*" to be dissimilar to "*Slot machines for gambling*". If I am wrong in this, then due to the different nature and purpose of the competing goods, I consider them to be similar to only a low degree.

#### Additional terms included in the "533" mark

##### Class 9

*Computer games provided through a global computer network or supplied by means of multi-media electronic broadcast or through telecommunications or electronic transmission or via the internet.*

55. The above goods are encompassed within the opponent's wider term "*Computer games and video games*" and as such are identical as per *Meric*.

##### Class 28

*Apparatus for electronic games adapted for use with an external display screen or monitor.*

56. The holder's above listed goods are likely to be used by the same users as, and in conjunction with the opponent's "*Computer games and video games*" in Class 9 and the goods are likely to share the same channels of trade. However, the physical nature and method of use of the respective goods are different and I do not consider them to be complementary in a trade mark sense, as per *Boston Scientific*. Overall, I consider "*Apparatus for electronic games adapted for use with an external display*

screen or monitor” to be similar to “*Computer games and video games*” to a medium degree.

### *Toys.*

57. I consider that a toy would be readily understood as being an object that children play with, such as, inter alia, a doll or a model train set, although I recognise that certain goods which are specifically aimed at adults may also be considered to be a toy. Although it could be argued that the opponent’s “*Computer games and video games*” in Class 9 constitute toys, I am mindful of the guidance given in *Skykick* not to interpret terms too widely. I do not consider a toy in the traditional sense of the word to be of the same nature or have the same method of employ as a computer game or video game, neither do I consider that the average consumer would automatically expect the competing goods to be provided from the same or economically linked undertakings. Overall, I considered the holders “*Toys*” to be dissimilar to the opponent’s “*Computer games and video games*”. If I am wrong in this, then I find them to be similar to only a low degree.

58. A degree of similarity between the goods and services is essential for there to be a finding of likelihood of confusion: see paragraph 49 of *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.

59. In relation to the goods which I have found to be dissimilar, as there can be no likelihood of confusion under section 5(2)(b), I will take no further account of such goods, with the opposition failing to that extent.

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

60. 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. (as he was then) described the average consumer in these terms:

“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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.<sup>15</sup>

61. 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.

62. In its Statement of Grounds, the opponent submits that the average consumer of the goods and services at issue is comprised of the general public with an interest in purchasing or using games software or, in relation to gambling games, professionals and public, both of which will possess an average degree of attention. Meanwhile, in its written submissions, it submits that the goods are everyday items, being gaming products, which are consumed by the public at large who have no specialist knowledge of the low purchase value goods, with the level of attention paid during purchasing being “relatively low”.<sup>16</sup>

63. In its counterstatement, the holder submits that the level of care and attention paid by the opponent's consumers operating on a business-to-business basis will be high, while in its written submissions, the holder submits that a large proportion of its own goods are highly specialised, and aimed at professional consumers in the UK gaming industry who are “typically sophisticated and high attentive, investing a high degree of care and attention while purchasing the goods” [sic]. With regard to the remaining goods which the holder states largely constitute video and computer games which may be used by “ordinary consumers”, it submits that these consumers “may still be expected to be reasonably attentive and circumspect”.

64. In my view, the average consumer for the competing goods will most likely be a member of the public with an interest in gaming and/or gambling as a regular pastime,

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<sup>15</sup> Paragraph 60

<sup>16</sup> See paragraph 7 of the opponent's written submissions dated 30 May 2022, and paragraph 20 of its final submissions filed on 14 December 2022.

a professional gamer, or a gaming or gambling establishment. Given the strict gambling laws in the UK, certain goods will be targeted towards adults over the age of 18.

65. Software such as betting software and that which is particular to the operation of slot machines and the like, and commercial apparatus such as coin-operated/slot machines, are likely to be acquired by the service providers of, for example, casinos or amusement arcades, and turf accountants/online gambling sites, rather than the public at large who would then access the goods as the end user. These goods will therefore be sourced from specialist providers where a high degree of attention will be paid to ensure that the software and machines procured are appropriate to specific business needs.

66. Purchases of general software in relation to gaming are likely to be bought relatively frequently, where the general public/hobbyist will pay at least a medium degree of attention to the genre of games they wish to play and the features and player options available, with the professional gamer paying a higher degree of attention. The goods may be sold through a range of channels including via online sales or through a high street retail outlet, with the purchasing process being a combination of visual and aural; some consumers would seek information from written reviews and recommendations, particularly on the internet, whereas other consumers would receive verbal advice and recommendations from sales representatives, as well as from fellow gamers. The initial outlay of gaming equipment is likely to be relatively high, however subsequent purchases of compatible software will be much less expensive.

### **Comparison of marks**

67. 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 in *Bimbo SA v OHIM* Case C-591/12P, 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.”<sup>17</sup>

68. 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.

69. The respective trade marks are shown below:

Opponent’s trade mark	Holder’s trade marks
<b>IRON GIRL</b>	<u>The “533” mark</u>  <div style="text-align: center;"><b>Ironclash</b></div>
	<u>The “535” mark</u>  <div style="text-align: center;"><b>Ironsword</b></div>

70. The opponent submits that consumers generally tend to focus on the beginning of a sign and as such, the shared element “IRON” in all three marks will have a strong impact on consumers in the overall impression and is therefore the dominant and distinctive element, with the second word in each of the marks having a lower impact on consumers.

71. The holder submits that the earlier mark is visually, aurally and conceptually dissimilar to either of its designations when each is considered as a whole, and it

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<sup>17</sup> Paragraph 34

disagrees with the opponent that in these instances, the consumers will focus on the beginning of the signs, although it accepts that this may be the case in other circumstances. In the context of its own marks, the holder submits that the word “CLASH” in the “533” mark, and the word “SWORD” in the “535” mark are the most dominant and distinctive elements of the respective marks.

### **Overall impression**

72. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginning of words tend to have more visual and aural impact than the ends, although I acknowledge that this is not always the case.

73. The opponent’s mark consists of two dictionary defined words “IRON” and “GIRL”, presented in a standard typeface in capital letters. To my mind, neither word dominates, and as the mark contains no other elements, the overall impression therefore rests in the combination of the words themselves.

74. The holder’s “533” mark consists of the single word “Ironclash”, presented in title case in a standard typeface. In my view, a significant proportion of consumers would immediately construe the holder’s mark as two distinct, dictionary-defined words, “Iron” and “clash”, rather than perceiving it as an invented word. Neither word dominates, and as the mark contains no other elements, the overall impression therefore rests in the combined (conjoined) words.

75. The holder’s “535” mark consists of the single word “Ironsword”, presented in title case in a standard typeface without any other elements to contribute to the overall impression. In *Usinor SA v OHIM*, Case T-189/05, the GC found that:

“62. ... it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Lloyd Schuhfabrik Meyer, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT) [2004] ECR II-3445,

paragraph 51, and Case T-256/04 Mundipharma v OHIM – Altana Pharma (RESPICUR) [2007] ECR II-0000, paragraph 57)”

To my mind, there is a natural break between the letter N and the letter S, which would lead the consumers to identify the mark as comprising two distinct, dictionary-defined words, “Iron” and “sword”, rather than seeing it as an invented word. Although I concede that the mark could also be separated as the words “Irons” and “word”, this seems unlikely to me, given the aforementioned alternative. Neither word dominates, with the overall impression resting in the combined (conjoined) words.

### **Visual comparison**

76. Each of the contested marks and the opponent’s mark consist of the same initial four letters, I R O N, however, this is where the similarity ends. I do not consider the difference in capitalisation/title case is relevant to the visual impact, as the registration of a word mark gives protection irrespective of capitalisation: see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17. Conversely, each mark contains an additional word which is not present in the other mark. The opponent’s mark also comprises the separate four letter word “GIRL” following the word “IRON”. Meanwhile, the holder’s “533” mark contains the 5 letters CLASH which are abutted to the IRON element, and in the “535” mark, the 5 letters SWORD are adjoined to the IRON element, creating a visual disparity between the marks. Considering the marks as a whole, I find there to be no more than a medium degree of visual similarity between them.

### **Aural comparison**

77. The common element of the competing marks is the word “IRON”, which will be pronounced identically in all three marks, as two syllables, EYE-UN ( aɪən). I consider that each of the marks will be pronounced in its entirety. The word “GIRL” in the opponent’s mark will be pronounced as one syllable, the whole mark being articulated as three syllables, EYE-UN-GUHRL ( aɪəngz:rl). The word “clash” in the holder’s “533” mark will also be pronounced as one syllable, the whole mark being articulated as three syllables, EYE-UN-KLASH ( aɪərnklæʃ), and the “535” mark will be voiced as

three syllables, EYE-UN-SAWED (aɪə'nsɔːɪd). Considering each of the marks as a whole, I find there to be no more than a medium degree of aural similarity between them.

### Conceptual comparison

78. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006]<sup>18</sup>.

79. In its statement of grounds, the opponent has provided a list of definitions of the word “IRON”, as a noun, as a verb and as an adjective. In its written submissions, it further submits that “IRON” has no obvious meaning for the goods at issue, and in all three marks, the most natural meaning of “IRON” would be to describe or allude to something strong, and that the additional words “CLASH” and “SWORD” in the holder’s marks do not change the conceptual meaning of “IRON”. The opponent directs me to *Medion v Thomson Life* Case C-120/04 [2005], and submits that the “IRON” element plays an independent distinctive role within the overall marks.<sup>19</sup>

80. I disagree that the word “IRON” plays an independent role in any of the competing marks, or that it conveys the same concept in all three signs. Although the word “IRON” is present in all three marks, in each case it acts as a qualifier to the respective word which follows it, with the two words that make up each individual mark forming a unit. Therefore, in this case, the “iron” component should not be interpreted in isolation. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015], Arnold J. (as he was then) considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*:

“ ...

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<sup>18</sup> Paragraph 56.-120/04,

<sup>19</sup> See paragraphs 10-11 of the opponent’s written submissions dated 30 May 2022.

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.”<sup>20</sup>

**(My emphasis).**

81. Rather than being taken literally, the opponent’s mark alludes to either a physically or emotionally strong female character, being an “iron girl”. This is also acknowledged by the opponent in its comparison of the marks, where it states that “... The opponent’s mark therefore alludes to a girl who is tough... In the context of the goods, each mark uses the same metaphor which alludes to the nature and content of the games”.<sup>21</sup> Meanwhile, the holder’s “533” mark alludes to a battle, implying a confrontation involving weapons made of the metallic element iron, i.e. “IRONCLASH” (a clash of iron against iron). Regardless that the words are conjoined, the holder’s “535” mark indicates a sword which is made from the metal iron, “IRON SWORD”. The concept of the common element “IRON” therefore differs between the opponent’s mark where it would be seen as indicating strength as a characteristic of the subject noun (the girl), whereas in the holder’s marks it describes the metal material itself. When considered as a whole, I therefore find the competing marks to be conceptually dissimilar.

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<sup>20</sup> *Whyte and Mackay Limited v Origin Wine UK Limited and Dolce Co Investing* [2015] EWHC 1271 (Ch).

<sup>21</sup> See paragraph 10 of the opponent’s written submissions dated 30 May 2022.

## **Distinctive character of the earlier marks**

82. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

83. 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).”

84. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented



words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

85. I will first consider the inherent distinctiveness of the opponent's mark. The mark is made up of two ordinary, dictionary defined words, which when considered in combination, and in direct reference to the competing goods, alludes to the subject matter of those goods, being an iron girl<sup>22</sup> who features as the protagonist of the games. Consequently, I consider the mark to be at the lower end of the spectrum of inherent distinctive character, but not of the very lowest degree.

86. The opponent submits that it has made extensive use of the mark, resulting in a higher degree of distinctiveness, as it submits has been demonstrated through the witness statement of Hanna Nattfogel and attached exhibits.<sup>23</sup> The territory relevant to the assessment of enhanced distinctiveness is the United Kingdom. I must now assess if the evidence demonstrates whether, at the claimed priority date of the contested designations for protection in the UK, being 22 October 2020, the earlier mark enjoyed an enhanced degree of distinctive character by virtue of the use made of it in relation to the UK market.

87. I note that in the witness statement of Ms Nattfogel, she states that the "IRON GIRL" game was released in various countries, including the UK, on 3 October 2018, and that it is available to play on various UK licensed online casino platforms. She states that the "IRON GIRL" game has generated a gross gaming revenue of around 313,000 euros in the period between 2018 to 2021. However, no breakdown to show how much/what percentage of that revenue relates to the UK market.

88. Exhibits 1 and 2 relate to the success of Play'n GO as the opponent company, rather than to its "IRON GIRL" mark. As such, I take no account of this evidence in my considerations of enhanced distinctive character of the mark at issue. Exhibit 3 is described as a capture of the game's page on the opponent's website. The page shows the mark "IRON GIRL" in relation to video slot games, presented both

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<sup>22</sup> See paragraph 81 of this decision regarding the concept of the marks at issue.

<sup>23</sup> I acknowledge the reservations of the holder in regard to the opponent's evidence, as outlined earlier in this decision under paragraphs 18-20.

figuratively and as plain words. I note that the website, which has .com rather than a .co.uk domain, is not specifically directed towards the UK market:



## IRON GIRL

Get Ready for an Intergalactic Adventure!

### ABOUT GAME

Join Iron Girl in her infamous Iron Armour to rid the universe of evil, in this latest space age slot from Play'n GO. Battling against the universe's most nefarious criminals; Quake, Shia, Sith and Thunder, Iron Girl needs your help to triumph against evil.

### SPECIFICATIONS

Release Date	03 Oct 2018
Game Type	Video Slot

89. Exhibit 4 is described as screenshots of the IRON GIRL games which are available to play on various platforms, including Lucky VIP, Play Ojo, Bet365 and Spin and Win. However, these screenshots are either undated, save for the date the sites were accessed, or they post-date the claimed priority date of the UK designations, and again are not specifically targeted towards the UK market:

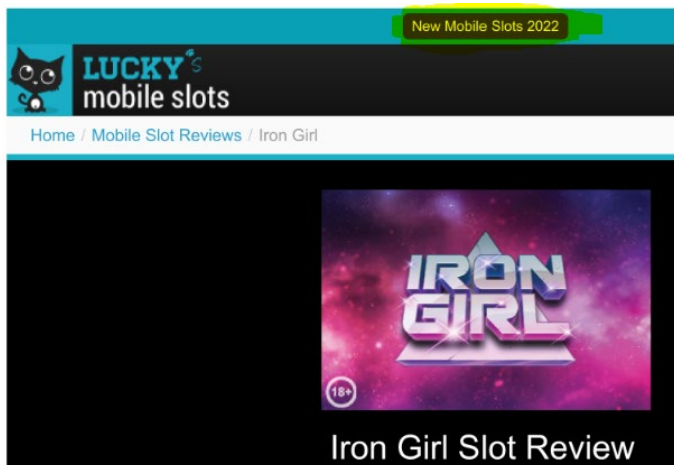
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which can be viewed here

Availability depends on your country

PlayOJO sister sites: [Casino PlayUZU España](#), [Casino PlayUZU México](#), [Casino PlayUZU Chile](#), [PlayOJO Casino Canada](#)



90. Exhibit 5 comprises rankings and reviews from independent sources. Of the eight reviews provided, only two are dated, and only one of which is prior to the filing date of the UK designations, being 20 days after the release date of the game in question:

*Review by Lucky Mobile Slots, last updated: December 28, 2020 - Rating 3*

The screenshot shows a review on the AskGamblers website. At the top, there is a red banner with the text "ASKGAMBLERS". Below this, there is a "MESSAGE" icon and a snippet of text: "from, I can't resist testing out each new release as they come along and Iron Girl did not disappoint." The main review text begins with "The main feature to land the multi-line hits...". A red circular icon with a white 'P' is next to the main review text: "Like many other games that offer the chance for big rewards, unfortunately this is accomplished by also inevitably delivering the hopeful player nothing except a mind boggling amount of spins that pay nothing and respin feature opportunities that are sparse to begin with and end up only being more disappointing because when they 'FINALLY' appear, they don't even line up enough new symbols to trigger a reward...". Below the text are "SHOW MORE" and "LIKE" buttons. The second review is by user "FIEKIE247" from South Africa, dated "REVIEWED ON OCTOBER 23, 2018", with a 4.5-star rating. The text of this review says: "Iron Girl takes you to outer space where you join Iron Girl and universe criminals which are the villains. Symbols on the reels include space age royal symbols as well as the 4 criminals. Iron Girl is the wild symbol and replaces all symbols on the reels to help you achieve a winning combination. This is the latest release from Play 'N Go and the game does not come with a free spins feature." It also includes "SHOW MORE" and "LIKE" buttons.

91. Exhibit 6, being videos about the IRON GIRL game on YouTube, is also undated. Ms Nattfogel explains in her witness statement that Exhibits 7 and 8 relate to the online tool Google Trends and the SLOTCATALOG platform which provides slot game analytics and rankings for the gambling industry. Exhibit 9 shows screenshots of a search conducted into the popularity of IRON GIRL in the UK, the results being calculated from 23 September 2018 until 21 September 2022 as tabulated in Exhibit 10. The results of the search interest for “IRON GIRL” are shown against two competing games of the same genre:

**Table 1**

Year	Iron Girl	Robots. Energy Conflict	Monster Clone
<b>2018 (calculated from 23/09/18)</b>	358	0	0
<b>2019</b>	1441	0	0
<b>2020</b>	1599	0	0
<b>2021</b>	1914	0	0
<b>2022 (calculated until 21/09/2022)</b>	1515	0	0

**Table 2**

Region	Iron Girl	Robots. Energy Conflict	Monster Clone
<b>Wales</b>	100%	0%	0%
<b>Scotland</b>	100%	0%	0%
<b>England</b>	100%	0%	0%

The numbers are explained below:

**Interest over time** ✕

Numbers represent search interest relative to the highest point on the chart for the given region and time. A value of 100 is the peak popularity for the term. A value of 50 means that the term is half as popular. A score of 0 means that there was not enough data for this term.

Ms Nattfogel explains that the above figures demonstrate the dominance of “IRON GIRL” in comparison to other games. As explained in the box above, the score for the two games being compared was 0 which means that there was not enough data for the terms. While the figures show the number of times the IRON GIRL game was searched for via Google Trends, this does not reflect the popularity of “IRON GIRL” as a whole against all other available games, or show how, based on the above figures, the mark enjoys enhanced distinctiveness in the UK market.

92. Exhibit 11 contain press articles and examples of social media posts at, or after, the time of the game’s release. I note that in the Twitter and Facebook feeds, the mark is presented in a variety of figurative formats, with the titular character “Iron Girl” also being referred to in the synopsis of the game in the press articles:



93. Exhibit 12 is described by Ms Nattfogel as a landing page for Play'nGO clients to access information, however, there are no references to the mark at issue within this exhibit. Exhibit 13 comprises further promotional material explaining the game rules and settings, which Ms Nattfogel states may be used to promote the game to players by Play'nGO clients at their online casinos. Again, none of this actually demonstrates enhanced distinctiveness of the mark through use.

94. Given that I have no evidence to show turnover or advertising figures in relation to the mark being used in UK market, nor any information as to how or where potential customers were able to access the goods and services under the mark in the UK during the relevant period, I do not consider the evidence sufficient to establish that the distinctive character of the mark has been enhanced through use.

### **Likelihood of confusion**

95. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average

consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

96. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

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

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

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

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

97. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

98. Earlier in this decision, I found that:

- The level of attention of the general public/hobbyist as the average consumer will be at least medium when selecting the goods, being higher for the professional gamer, while the business consumer is likely to pay a high degree of attention to the selection process;
- For all consumers, the selection of the goods at issue will be a combination of visual and aural;
- The competing trade marks are visually and aurally similar to no more than a medium degree, and are conceptually dissimilar;
- The earlier mark is at the lower end of the spectrum of inherent distinctive character, but not of the very lowest degree, with insufficient evidence for a finding of enhanced distinctive character through use;
- Although some of the contested goods in both classes are identical or similar to the opponent’s goods, I found there to be no similarity between certain of the holder’s goods and the goods and services of the earlier mark.

99. In its written submissions in lieu, the holder references the EUIPO decisions of the oppositions filed by the opponent against the EU trade marks on which the international registrations designating the UK in these proceedings are based, and which concerned the same marks and goods at issue in the matter before me.<sup>24</sup> It has provided a copy of those opposition decisions, being No. B 3 142 232 and No. B 3 142 233, both of which found no likelihood of confusion between the marks, which resulted in the rejection of the oppositions. Whilst I have considered the impact of these decisions, I am not bound by the findings of the EUIPO, and I draw my own conclusions based on the evidence before me.

100. The holder has filed evidence through the witness statement of Valentine Kohl and attached exhibits to support its submissions regarding the co-existence of a variety of “IRON” trade marks in the UK. Ms Kohl states that she is aware of a number of trade marks featuring the word “IRON” used in the UK for computer/video games. Exhibits VK1 – VK49 largely comprise such examples, although I note that details of actual UK trade mark registrations have not been cited. However, this has no bearing on my assessment. In *Zero Industry Srl v OHIM*, Case T-400/06, the GC stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

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<sup>24</sup> See paragraphs 119 – 122 of the holder’s written submissions dated 15 December 2022.



101. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that they would mistake one mark for the other. In my view, the average consumer will notice and recall the visual, aural and conceptual differences between the marks. I do not consider there is any likelihood of direct confusion as the differences between the marks are too great for confusion to arise, even where the respective goods are held to be identical, which offsets a lesser degree of similarity between the marks.

102. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was) in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion.

103. 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.

104. In its written submissions, the opponent refers to its evidence in chief which it submits demonstrates that it is common practice for a video game producer to build on an existing game and develop it into a series which will form part of a video games franchise. It submits that the names of the sequel games are likely to begin with and consist of identical terms that appear in the original game which are succeeded by a differing word or words. It submits that in these proceedings, given the shared initial word "IRON", there is a likelihood of confusion with the contested marks for identical and similar goods.

105. Exhibit CXS 1, attached to the witness statement of Cherry Shin for the opponent, shows a definition and examples of a videogame franchise, while Exhibit CXS 2 comprises a copy of a WIKIPEDIA entry which lists, in alphabetical order, the names of video games franchises. Several entries relating to various franchises, including, inter alia, the Mario franchise, Sonic the Hedgehog, Tomb Raider and Call of Duty franchises have been highlighted to demonstrate how these game franchises are

developed, with screen shots showing some of the related slot games comprising Exhibit CSX 3. Exhibit CSX 4 contains a copy of a WIKIPEDIA entry listing video game sequels, with Exhibit CXS 5 comprising an article identifying the importance of sequels to game producers. Exhibit CSX 6 comprises press releases by the opponent company demonstrating the launch of sequels to some of its other slot games.

106. I acknowledge that in certain circumstances, a conclusion of likelihood of confusion in relation to the goods in question would be found on the basis of sequel games which share a distinctive and dominant component. In the examples provided by the opponent, there is a clear link between the first game of the franchise and the sequels, for example, “Tomb Raider” and “Tomb Raider Secret of the Sword”, or “Street Fighter” and “Street Fighter II The World Warrior”. However, I do not consider there to be any such association between the opponent’s mark and the contested marks. Earlier in my decision, I considered that the common element “IRON” did not play an independent distinctive role within the overall marks, rather, in all three marks, the two word combination formed a unit. Further, given the meaning of those combined words, I have found both the “IRON” element and the overall meaning to be conceptually different between the competing marks. I also found that the earlier mark had a low degree of inherent distinctiveness, although I bear in mind the decision of the CJEU in *L’Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion.<sup>25</sup>

107. Keeping in mind the global assessment of the competing factors in my decision, it is my view that it is unlikely that the average consumer would assume that there is a connection between the parties, particularly when the point of similarity resides in an element which does not play an independent role. I acknowledge that the categories listed by Mr Iain Purvis Q.C. are not exhaustive, and I note the evidence submitted by the opponent to support the practice of video games franchises, however, as outlined above under paragraph 106 of my decision, I do not see anything which would lead the average consumer into believing that one mark is a sequel to, or brand extension

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<sup>25</sup> Paragraph 45.

of the other, or assume that there is an economic connection between the undertakings. I therefore find no likelihood of indirect confusion.

108. The opposition under section 5(2)(b) fails.

## **CONCLUSION**

109. The holder has been successful. Subject to any successful appeal, each of the IRs by adp Merkur GmbH may be granted protection in the UK in respect of all goods for both designations.

## **COSTS**

110. The holder has been successful, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 2/2016. Applying the guidance in that TPN, I award the holder the sum of £1300, which is calculated as follows:

Considering the notice of opposition and preparing a counterstatement:	£300
Preparing evidence:	£600
Preparing written submissions in lieu of a hearing:	£400
<b>Total:</b>	<b>£1300</b>

111. I therefore order Play'n GO Marks Ltd. to pay adp Merkur GmbH the sum of £1300. 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 6<sup>th</sup> day of March 2023**

**Suzanne Hitchings  
For the Registrar,  
the Comptroller-General**