

O-466-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3207627 BY
ADP GAUSELMANN GMBH**

TO REGISTER:

SPARTA

AS A TRADE MARK IN CLASS 9

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000655 BY
IGT UK INTERACTIVE LIMITED**

Background & pleadings

1. On 19 January 2017, adp Gauselmann GmbH (“the applicant”) applied to register the trade mark **SPARTA** for the goods shown in paragraph 12 below. The application was published for opposition purposes on 10 March 2017.

2. On 19 May 2017, the application was opposed in full under the fast track opposition procedure by IGT UK Interactive Limited (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) .The opponent relies upon European Union Trade Mark (“EUTM”) registration no. 11012011 for the trade mark shown below (in relation to which it claims the colours black and white) which has an application date of 18 June 2012 and registration date of 5 November 2012. The opponent relies upon all the goods and services for which its trade mark is registered (shown in paragraph 12 below):



3. The applicant filed a counterstatement in which the basis of the opposition is denied.

4. In these proceedings, the opponent represents itself; the applicant is represented by Greaves Brewster LLP.

5. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary; only the applicant filed written submissions which I will refer to, as necessary, below.

DECISION

8. The opposition is based upon section 5(2)(b) of the Act, 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.”

9. 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, international trade mark (UK) or Community 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. The registration upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this earlier trade mark is not subject to proof of use, the opponent is entitled to rely upon it for each of the goods and services it has identified.

Section 5(2)(b) – case law

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

The principles:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public 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

12. The competing goods and services are as follows:

The opponent's goods and services	The applicant's goods
<p>Class 9 - Computer software for playing games and video games; Computer software for computer games on the internet or for terminal games or games machines; Software for playing computer-, terminal-, and online games; Computer programs for computer-, video-, and online games for usage on several platforms; Computer programmes for interactive television and for interactive games and/or quizzes; Electronic publications (downloadable) provided on-line from databases or the Internet; Parts and fittings for all the aforesaid; Audiovisual games (programs) on computer hardware platforms; Audio and video receivers.</p> <p>Class 28 - Games and plaything; Gaming machines, automatic and coin controlled; Television games apparatus; Computer games apparatus for use with television apparatus.</p> <p>Class 41 - Entertainment provided via the Internet; Services for internet games; Providing online computer games; Games services provided on-line from a</p>	<p>Class 9 - Computer software; Computer and video games software; Games software for use on any computer platform, including electronic entertainment and games consoles; Computer game programs; Video games (software); 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; Computer games, leisure and recreational 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; automatic lottery machines; 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 an app for mobile devices and computers; Computer hardware and software for casino and</p>

<p>computer network; Providing interactive games, interactive entertainment and competitions and electronic quizzes, all provided via a global computer network or the Internet; Provisioning of on-line computer games; Online entertainment in the form of tournaments and other similar gaming programs; Online information concerning computer gaming entertainment; Providing games via cellular telephone communication; Supply of games for mobile phone usage.</p>	<p>amusement arcade games, for gaming machines, slot machines or video lottery gaming machines or games of chance via the Internet.</p>
--	---

13. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment that:

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

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;

- e) The extent to which the respective goods or services are competitive. This enquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court ("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”.

14. In its submissions, the applicant states:

“8...The goods in classes 28 and services in class 41 are very different to those shown in the application.”

15. It submits that the following goods in the application are “not identical or similar” to those of the opponent:

“Leisure and recreational software all being provided in the form of storage media; Programs for operating electric and electronic apparatus for games, amusement and/or entertainment purposes; automatic lottery machines; computer software in the form of an app for mobile devices and computers; Computer hardware and software for casino and amusement arcade games, for gaming machines, slot machines or video lottery gaming machines or games of chance via the Internet.”

16. The applicant further states:

“In regards remainder of the goods the applicant submits that if a mark is considered different visually, phonetically and conceptually then there can be no risk or likelihood of confusion in the marketplace regardless of any similarity of goods”.

17. The applicant’s approach is, in my view, to be interpreted as an acceptance by it that the goods that it has not specifically identified (i.e. all those other than those set out in paragraph 15 above) are either identical or similar to those of the opponent in class 9. However, for the avoidance of doubt, I shall conduct an analysis. Before doing so, I remind myself that in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the GC stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

18. “Computer software” in the application includes, for example, “Computer software for playing games and video games” in the opponent’s specification; the competing goods are identical on the *Meric* principle.

19. “Computer software for playing games and video games” in the opponent’s specification is either an alternative way of describing or includes the following goods in the application which are either literally identical or, once again, to be regarded as identical on the principles outlined in *Meric* i.e. “Computer and video games software”, “Games software for use on any computer platform, including electronic entertainment and games consoles”, “Computer games programs”, “Video games (software)”, “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”, “Computer games, 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”.

20. As to those goods which the applicant argues are not identical or similar to the opponent’s goods, I make the following observations. The phrases “leisure and recreational 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 in the form of an app for mobile devices and computers” and “Computer software for casino and amusement arcade games, for gaming machines, slot machines or video lottery gaming machines or games of chance via the Internet” in the application would all include the opponent’s “computer software for playing games and video games” and are, as a consequence, to be regarded as identical on the *Meric* principle.

21. As to the remaining goods i.e. “automatic lottery machines” and “Computer hardware for casino and amusement arcade games, for gaming machines, slot machines or video lottery gaming machines or games of chance via the Internet”, it is, I think, self-evident such goods will depend upon computer software to function. As all of the applicant’s hardware is for use in, broadly speaking, the fields of amusement/gaming and as the opponent’s specification in class 9 includes, for example, “computer software for computer games on the internet or for terminal games or games machines”, the competing goods are, in my view, complementary, because 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”, which in turn leads to at least a medium degree of similarity.

The average consumer and the nature of the purchasing act

22. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

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

23. The average consumer of the goods which I have identified as being either identical or similar to at least a medium degree is either a member of the general public buying for personal use or a business user buying on behalf of a commercial undertaking. Although I have no evidence as to how such goods will be selected, my own experience as a member of the general public tells me that the goods aimed at the general public are most likely to be selected from the shelves of a bricks and mortar retail outlet or from the pages of a website or catalogue, all of which strongly suggests that visual considerations will have an important part to play in the selection process. However, as such goods may also, in my experience, be the subject of request to sales assistants (both in person and by telephone) and in the context of word-of-mouth recommendations, aural considerations will also feature in the selection process, although, in my experience, to a much lesser extent than visual considerations. In the absence of evidence or submissions to the contrary, I see no reason why a business user selecting, for example, computer software or hardware for casino and amusement arcade games, would not select the goods in much the same way.


24. As to the degree of care these average consumers will deploy during the selection process, once again my experience as a member of the general public wishing to buy games hardware and/or software, informs me that one is likely to have in mind, inter alia, the cost of the hardware and the range of software available for it, the type of games software being selected (for example, a third party shooter or combat game), the age of the person for whom the software is intended, the format of the software and the platform or platforms on which it will operate. All of the above suggests to me that a member of the general public will pay an above average (but not a high degree of attention) during the selection process of such goods. I would expect a business user selecting such goods (who may well be purchasing in volume with larger sums of money likely to be in play), to pay a somewhat higher degree of attention than a member of the public buying for personal use.

Comparison of trade marks

25. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

26. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

The opponent's trade mark	The applicant's trade mark
	SPARTA

27. The applicant's trade mark consists of the word SPARTA presented in block capital letters. That is the overall impression it will convey and where its distinctiveness lies.

28. The opponent's trade mark consists of a number of components. The first is the device of what the applicant describes as a "gladiator/soldier"; a description I am happy to adopt. Behind the device of a gladiator holding a sword above his head there appears devices of nine spears and in the top right hand corner the words "SPEARS of SPARTA" presented in a stylised but unremarkable font; to the right of the word "SPEARS" appears the TM symbol. All of these components are presented within a square border.

29. The square border and the letters TM have no distinctive character and will make no contribution to either the overall impression the trade mark conveys or its distinctiveness. That is not true of the device of the gladiator which given its size and positioning will make an important contribution to the overall impression the trade mark conveys and its distinctiveness. Although the device of spears are unlikely to go unnoticed, as they are partially obscured by the gladiator device, other than to reinforce the concept conveyed by the presence of the well-known English language word "SPEARS", their relative weight in the overall impression conveyed is likely to be fairly modest. That leaves the phrase "SPEARS of SPARTA" to consider. In my view, these words form a unit the meaning of which is different to the individual words of which the unit is composed (I shall return to this point later in this decision). Although relatively small in the context of the trade mark as a whole, this unit will also make an important contribution to the overall impression the trade mark conveys and its distinctiveness. Despite their differing sizes and positioning, I consider the device of a gladiator and the phrase "SPEARS of SPARTA" will make a roughly equal contribution to the overall impression the trade mark conveys and to its distinctive character.

30. The only visual and aural similarity between the competing trade marks is in relation to the word "SPARTA" which appears in the opponent's trade mark as part of a unit. The degree of visual similarity between the competing trade marks is low. As to the aural similarity, it is well established that when trade marks consists of a

combination of words and figurative elements it is by the word elements that the trade mark is most likely to be referred. The applicant's trade mark will be referred to by the two syllable word SPAR-TA and the opponent's trade mark by the four syllable combination SPEARS of SPAR-TA. Although the words "SPEARS of" will be articulated first, as the word SPAR-TA will be articulated in an identical fashion, it results in a medium degree of aural similarity between the competing trade marks.

31. As to the conceptual comparison, collinsdictionary.com defines SPARTA as "an ancient Greek city in the S Peloponnese, famous for the discipline and military prowess of its citizens and for their austere way of life." In its submissions, the applicant suggests that in the context in which they appear in the opponent's trade mark the words "would suggest perhaps a weapon from ancient Greece or perhaps in some way bring to the mind of the consumer a battle or war."

32. As I mentioned above, the word SPEARS will be well-known to the average consumer. I have, however, no evidence as to how the average consumer will construe the word SPARTA. Speaking as an ordinary member of the general public, prior to writing this decision I was aware of the word SPARTA and would have understood it to be a place name. Although I would not have been aware of its precise location, I would have associated it with the ancient Greek empire. Whilst I have paused to consider whether my own view of the matter may be regarded as idiosyncratic, having done so, I am satisfied that it is not and the legal construct that is the average consumer is most likely to understand the word in much the same way. Approached on that basis, the applicant's trade mark is most likely to be conceptualised as geographical and the opponent's trade mark as spears used by a gladiator emanating from SPARTA. The competing trade marks are, in my view, conceptually similar to the extent that they either consist of or contain a word which is likely to trigger images in the average consumer's mind of a geographical location.

Distinctive character of the earlier trade mark

33. 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. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

34. These are fast track opposition proceedings in which it was not necessary for the opponent to provide evidence of the use it may have made of its earlier trade mark. As a consequence, I have only the inherent characteristics of its trade mark to consider. While the device of a gladiator is not highly original it is, in my view, distinctive to an average degree and, as far as I am aware, when considered in the context of the goods I have found to be either identical or similar to at least a medium degree, the phrase "SPEARS of SPARTA" is neither descriptive nor non-distinctive. Considered as a whole, it is, in my view, a trade mark possessed of a normal degree of inherent distinctive character. Of course, it is the distinctiveness of the shared element i.e. SPARTA which is important and I shall return to this point below.

Likelihood of confusion

35. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact 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. Earlier in this decision I concluded that:

- the competing goods are either identical or similar to at least a medium degree;
- the average consumer is either a member of the general public or a business user who is likely to select the goods at issue by predominantly visual means paying at least an above average degree of attention during the selection process;
- the overall impression conveyed by the applicant's trade mark and its distinctiveness lies in the single word of which it comprises;
- the device of a gladiator and the words "SPEARS of SPARTA" make a roughly equal contribution to the overall impression the opponent's trade mark conveys and its distinctiveness;
- the competing trade marks are visually similar to a low degree, aurally similar to a medium degree and conceptually similar to the extent that both trade marks contain a word which will evoke a geographical location;
- the opponent's earlier trade mark is possessed of a normal degree of inherent distinctive character.

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

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

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided

by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

37. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie? Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

38. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

39. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. He stated:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

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

and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

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

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

40. In reaching a conclusion, I bear in mind the need for me to consider the likelihood of confusion on the basis of the global approach advocated taking into account all relevant factors. I remind myself that I characterised the degree of aural similarity as medium and concluded that the competing trade mark are conceptually similar to the limited extent that they both are likely to evoke a geographical location.

41. Notwithstanding that the word “SPARTA” is distinctive in its own right, when combined with the words “SPEARS of”, it creates a unit in which the word SPARTA does not play an independent distinctive role but merely contributes to the unit which is created. Bearing in mind the inclusion of the averagely distinctive device in the opponent’s trade mark (resulting in a low degree of visual similarity), combined with the addition of the words “SPEARS of” in the opponent’s trade mark (and the aural and conceptual differences these words introduce), I see no reason why an average consumer paying an above average degree of attention during the selection process (thus making them less prone to the effects of imperfect recollection) would confuse

the competing trade marks either directly or indirectly and the opposition fails accordingly.

Overall conclusion

42. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

Costs

43. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice (“TPN”) 2 of 2015. Using that TPN as a guide, but bearing in mind that the applicant’s submissions filed in lieu of a hearing were, for the most part, duplicative of the submission contained in its counterstatement, I award costs to the applicant on the following basis:

Preparing a statement and considering the opponent’s statement:	£200
Written submissions:	£100
Total:	£300

44. I order IGT UK Interactive Limited to pay to adp Gauselmann GmbH the sum of £300. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of September 2017

C J BOWEN
For the Registrar