

**O-870-21**

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NO. 3514959**

**IN THE NAME OF  
POLYBIUS GAMES LTD**

**FOR THE TRADE MARK**

**Spy Quest**

**IN CLASSES  
14, 18, 20, 21, 24, 28 & 30**

**AND**

**THE OPPOSITION THERETO UNDER NUMBER OP000422258**

**BY**

**SPYSCAPE LTD**

## Background and pleadings

1. On 23 July 2020, Polybius Games Ltd (“the Applicant”) applied to register the trade mark “Spy Quest” in the UK. It was accepted and published in the Trade Marks Journal for opposition purposes on 28 August 2020. The application relates to the following goods:

Class 14: Clocks; jewellery; jewellery boxes; jewellery cases; key rings; key chains; decorative key fobs; coins; watches; watch bands.

Class 18: Leather bags, leather handbags and purses, wallets, handbags, purses, key cases, gym bags, school bags, book bags, tote bags, backpacks, knapsacks, shoe bags for travel, luggage and carry-on bags, sports bags, duffel bags, wrist mounted carry all bags, waist pouches, fanny packs, umbrellas.

Class 20: Cushions; decorative mobiles; figurines and statuettes made of plaster; figurines and statuettes made of plastic; figurines and statuettes made of wax; figurines and statuettes made of wood; furniture; gift package decorations made of plastic; hand fans; mattresses; mirrors; non-Christmas ornaments made of plaster, plastic, wax or wood; party ornaments of plastic; picture frames; pillows; plastic cake decorations; plastic name badges; plastic novelty license plates; wind chimes; interior window blinds.

Class 21: Dinnerware and beverageware of paper, plastic or earthenware, including dishes, platters, plates, bowls, cups, saucers, mugs, drinking glasses, servings pitchers; bottles (sold empty), beverage glassware with permanently (*sic*) attached pewter emblems; insulated bottles, containers for food and beverages (for household or kitchen use); lunch boxes, lunch pails; ice pop forms; waste baskets; napkin holders, napkin rings, bottle openers; bed and snack trays, serving trays; statuettes and figurines (of plastic, ceramic or earthenware); non-metal piggy

banks; sun catchers; personal grooming articles, namely, toothbrushes, shaving brushes, hair brushes, hair combs; toothbrush holders, bath sponges.

Class 24: Textiles; fabric; bath linen; bed linen; household linen; kitchen linens; table linen; household textile articles; plastic table covers; plastic flags; plastic banners; plastic pennants; sleeping bags.

Class 28: Toy action figures and accessories therefor, mechanical action toys; playsets for use with toy action figures; battery operated action toys; radio controlled toy vehicles; toy vehicles; playsets for make-believe play battle or adventure activities; plush toys; soft sculpture toys; dolls; doll accessories; bean bag dolls; stuffed toy animals; bendable toys; puppets; balloons; water squirting toys; inflatable toys; target games; chess sets; board games; card games; playing cards; jigsaw puzzles; kites; spools incorporating coiled string which rewind and return to the hand when thrown; flying discs; game tables; toy weapons; toy watches; role playing games; toy model hobbycraft kits; hand held unit for playing video games; coin-operated video games; arcade games; pinball games; pinball-type games; rubber balls; inflatable swimming pools [play articles]; roller skates; in-line skates; skateboards; elbow pads for athletic use; knee pads for athletic use; jump ropes; snow boards; snow sleds for recreational use; surf fins; swim fins; surfboards; swim boards for recreational use; christmas tree ornaments [except confectionery or illumination articles].

Class 30: Confectionery products, candy, candy bars, chocolate, chocolate bars, pastry products, cookies, cakes, biscuits, granola bars, energy bars, chewing gum, bubble gum, frozen ice cream, ice cream bars, ice cream sandwiches, ice cream confections, coffee, tea, cocoa, sugar, rice, flour and preparations made from

cereals, bread, pastry; ices, honey; spices; cereals, bread, candied fruit snacks; frozen custard, frozen yogurt.

2. On 30 November 2020, Spyscape Ltd (“the Opponent”) filed a notice of opposition (which was later amended), against all of the goods of the application; based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The Opponent relies upon six earlier trade marks (either in full or in part, against all, or a portion of, the applied-for goods, respectively) as follows:

<b>UK00003103429</b>
<b>SPYSCAPE</b> Filing date: 10 April 2015 Date of entry in register: 18 September 2015
<p><u>Specifications relied upon:</u></p> <p><b>Class 14:</b> Precious metals and their alloys; jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches.</p> <p><b>Class 18:</b> Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.</p> <p><b>Class 20:</b> Furniture, mirrors, picture frames; garden furniture; pillows and cushions.</p> <p><b>Class 21:</b> Household or kitchen utensils and containers; combs and sponges; brushes (except paintbrushes); brush-making materials; articles for cleaning purposes; steel wool; articles made of ceramics, glass, porcelain or earthenware which are not included in other classes; electric and non-electric toothbrushes.</p>

**Class 24:** Textiles and textile goods; bed and table covers; travellers' rugs, textiles for making articles of clothing; duvets; covers for pillows, cushions or duvets.

**Class 28:** Games and playthings; playing cards; gymnastic and sporting articles; decorations for Christmas.

**Class 30:** Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, edible ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.

Goods opposed under the applied-for mark:

All goods under the application

**UK00003217060**

**SPYMASTER**

**SPY MASTER**

(Series of two marks)

Filing date: 07 March 2017

Date of entry in register: 28 July 2017

Specifications relied upon:

**Class 14:** Precious metals and their alloys; jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches.

Goods opposed under the applied-for mark:

Class 14: Clocks; jewellery; jewellery boxes; jewellery cases; key rings; key chains; decorative key fobs; coins; watches; watch bands.

**EU014655633**

**SPYSCAPE**

Filing date: 08 October 2015

Date of entry in register: 04 February 2016

Priority date: 10 April 2015 (from: UK00003103429)

Specifications relied upon:

The goods relied upon under this right are the same as listed above for Registration UK00003103429.

Goods opposed under the applied-for mark:

All of the goods under the application.

**EU015587488**



Filing date: 27 June 2016

Date of entry in register: 17 November 2016

Specifications relied upon:

**Class 14:** Precious metals and their alloys; jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches.

**Class 18:** Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.

**Class 28:** Games and playthings; playing cards; gymnastic and sporting articles; decorations for Christmas.

Goods opposed under the applied-for mark:

All goods in classes 14, 18 and 28

**WE00001367851**

**SPYMASTER**

Filing date: 30 August 2017

Date of entry in register: 07 March 2018

Priority date: 07 March 2017 (from: UK00003217060)

Specifications relied upon:

**Class 14:** Precious metals and their alloys; jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches.

Goods opposed under the applied-for mark:

Class 14: Clocks; jewellery; jewellery boxes; jewellery cases; key rings; key chains; decorative key fobs; coins; watches; watch bands.

<b>EU017901321</b>
<b>SPYCON</b>
Filing date: 16 May 2018 Date of entry in register: 25 September 2018
<p>Specifications:</p> <p><b>Class 14:</b> Precious metals and their alloys; jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches.</p> <p><b>Class 18:</b> Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksack, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.</p> <p><b>Class 28:</b> Games and playthings; playing cards; gymnastic and sporting articles; decorations for Christmas.</p>
<p><u>Goods opposed under the applied-for mark:</u></p> <p>All goods in classes 14, 18 and 28</p>

3. The Opponent contends that the mark applied-for and the earlier marks share the same dominant and distinctive element, SPY. It further submits that “[t]his word being the first element in each mark means that consumers are likely to focus attention primarily on this element. Consumers would see [the respective] marks as SPY marks”.<sup>1</sup> Further, that the contested goods are identical or highly similar to the goods covered under its earlier rights; and that “registration of the mark applied for should therefore be refused by virtue of section 5(2) of the ... Act”.

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<sup>1</sup>In its initial pleadings (later amended), the Opponent submitted that its earlier rights constituted a family of marks; however, the family of marks claim was subsequently withdrawn by the Opponent in its letter dated 10 August 2021.



4. In an amended notice of defence and counterstatement, the Applicant denies the grounds of the opposition. Although the Applicant admits that some of its goods are identical to goods under the earlier rights, it submits “that the trade marks at issue are so different visually, aurally, and conceptually that there is no likelihood of confusion, or association, even where the goods are identical”. For this reason, the Applicant claims that “there is no likelihood of confusion or association between the Applicant's trade mark and any of the Opponent's trade marks”.
5. Professional representatives are on record for both parties: MW Trade Marks Limited for the Opponent; and Ancient Hume Limited for the Applicant. Submissions in lieu of a hearing were filed by both parties; neither filed any evidence of fact; and the Applicant also opted to file submissions during the evidence rounds. I shall refer to the written submissions where appropriate during this decision, which is taken after careful review of all the papers before me, as neither party requested a hearing and one was not considered necessary.

### **Preliminary issue**

6. The Applicant makes diverse submissions (in its defence and counterstatement and subsequent pleadings) in relation to an earlier trade mark, which is independent of the application in suit; to defend its claim to use of the applied-for mark as an earlier right. It is therefore necessary for me to make clear that, as a matter of law, such submissions will have no bearing on my decision. I need not say more on this matter, as the Tribunal previously informed the Applicant (by letter date 22 March 2021), that such an argument or defence is wrong in law, in these proceedings.<sup>2</sup> Furthermore, the Applicant states in

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<sup>2</sup> *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Tribunal Practice Note (“TPN”) 4/2009 further provides that: Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the Applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the Applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark.

submissions dated 6 September 2021, that it is “aware that its earlier trade mark registration could be used in actions to challenge the Opponent's UK registrations but to do so would not be consistent with its view that none of the Opponent's marks is similar to Spy Quest”.

## **DECISION**

### **Section 5(2)(b)**

7. The opposition is founded upon section 5(2)(b) of the Act, which stipulates that:

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

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

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

### **Section 5A**

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

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

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 Opponent’s trade mark registrations qualify as earlier trade marks under section 6 of the Act. Further, given that they had not been registered for more than five years at the date the contested application was filed, they are not subject to the proof of use provisions contained in section 6A of the Act.<sup>3</sup> The Opponent is, as a consequence, entitled to rely upon its earlier marks in relation to all of the goods indicated without having to prove that genuine use has been made of them. Therefore, I must make the assessment based upon the full width of the services relied upon by the Opponent, regardless of whether or not the marks have actually been used in relation to those services. This is because the Opponent is entitled to protection across the breadth of what it has registered on a ‘notional’ use basis.

### **Relevant law**

11. The following principles are gleaned from the decisions of the courts of the European Union 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*,

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<sup>3</sup> As these proceedings commenced after 14 January 2019, when the Trade Mark Regulations 2018 came into force, the relevant period for proof of use purposes is the five years prior to and ending on the filing date of the application.

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.<sup>4</sup>

**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;

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<sup>4</sup> Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

- f. however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- g. a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- h. there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- i. mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- j. the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- k. if the association between the marks creates a risk that the public 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 the goods**

12. When conducting the comparison, all relevant factors should be considered as set out in the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where 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”.

13. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- 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 inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

14. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut 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”.

Class 14 – opposed under all of the earlier rights

15. The Applicant admits that its applied-for goods: *clocks*; *jewellery* and *watches* are identical terms upon which the Opponent relies. On the question of the remaining contested goods under this class, the Opponent submits that *Jewellery boxes*, *jewellery cases* and *watch bands* are accessories sold with jewellery and watches respectively. *Coins* are sold by jewellers as separate items or as part of jewellery, such as on a signet ring or pendant. The nature of the goods and their trade channels overlap. The goods are complementary”. However, I note that there are no specific submissions regarding the contested “*key rings*”; “*key chains*”; and “*decorative key fobs*”.

16. I agree that *jewellery boxes* and *jewellery cases* share a degree of similarity, notwithstanding the fact they are different in nature and method of use, to the Opponent’s goods. They coincide in relevant public and may be produced by the same or linked entities; as the companies that produce watches and clocks may also produce accessories, including cases for storing jewellery/timepieces. They target the same consumers and have the same distribution channels: consumers buying the items would ordinarily expect them to be suitably packaged. Therefore, these goods are also complementary. For these reasons I find that there is an average degree of similarity between the Applicant’s “*jewellery boxes*” and “*jewellery cases*” and the Opponent’s “*jewellery*”; “*horological and chronometric instruments*”; “*clocks and watches*”.

17. The contested “*watch bands*” are generally relevant in the manufacture of watches; and are also provided as replacements to repair or restyle, for example. I consider that they are offered through the same channels of trade and to the same consumers as watches. They are also complementary, particularly in relation to wristwatches, for example. I therefore find that they are similar to an average degree.

18. The Applicant's "*decorative key fobs*", "*key rings*", and "*key chains*" are terms which describe what the average consumer may hang keys on, which could be akin to jewellery; and may constitute items of adornment, or may be worn as jewellery. They are considered similar to the Opponent's "*Precious metals and their alloys*"; "*jewellery, costume jewellery, precious stones*"; and they may also be made of the same materials and overlap in purpose (to be worn for decorative purposes, for example). Moreover, the respective goods can coincide in producers, end users and distribution channels. I therefore find that they are similar to an average degree.

19. I agree with the Opponent's submissions regarding "*coins*", to the extent that they could be made from the same material as *jewellery* or *Precious metals and their alloys*; and they may coincide in channels of trade. However, they may differ in purpose from jewellery; and as such, are neither in competition, nor are they complementary with jewellery. Therefore, I find these items to be of low similarity to the related earlier goods.

**SCYSCAPE**

20. The Applicant concedes that "*handbags and purses, knapsacks*", and "*umbrellas*" are identical to goods under the relevant earlier rights. "*Leather bags, wallets, key cases, gym bags, school bags, book bags, tote bags, backpacks, shoe bags for travel, luggage and carry-on bags, sports bags, duffel bags, wrist mounted carry all bags, waist pouches, and fanny*" packs are either self-evidently or Meric identical to "*trunks and travelling bags*"; "*handbags, rucksacks, and purses*" in the Opponent's specification.

21. In the alternative, if I am wrong in this finding, I consider that the goods will overlap in method of use, purpose, trade channels, user and nature; and there will be competition between them. These goods can, therefore, be considered as highly similar.



22. “Cushions”; “furniture”; “mirrors”; “picture frames” and “pillows” identically occur in the earlier and later specifications, as agreed by both parties. The Opponent further submits that the remaining contested goods in this class (excluding “plastic cake decorations”) as listed below, “are items sold to complement the identical goods. For example, a mattress would frequently be sold along with a bed which is an item of furniture. An ornament is sold through the same channels and to the same consumers as mirrors, furniture and picture frames. Wind chimes are complementary to garden furniture”.

*Decorative mobiles; figurines and statuettes made of plaster; figurines and statuettes made of plastic; figurines and statuettes made of wax; figurines and statuettes made of wood; gift package decorations made of plastic; hand fans; mattresses; non-Christmas ornaments made of plaster, plastic, wax or wood; party ornaments of plastic; plastic name badges; plastic novelty license plates; wind chimes; interior window blinds.*

23. I agree with the Opponent’s submission regarding *mattresses*, which are ordinarily complementary to beds (a type of furniture) and to a lesser extent, pillows/cushions. These goods target the same users and coincide in channels of trade. Therefore, I find that they are similar to an above average degree.

24. Although I agree that it is common for furniture stores to offer for sale various types of ornaments or figurines and other decorative accessories; to capitalise on consumers purchasing home furnishings at the same time or from the same place to achieve an aesthetically agreeable ensemble (for example); which sees overlaps in target public and distribution channels. However, that does not mean that these are sufficient to find similarity between the goods. They do not share nature, purpose, method of use, are not complementary or in competition.

Consequently, they are dissimilar; there can be no likelihood of confusion and the opposition to these goods fails accordingly.<sup>5</sup>

25. The remaining goods contested under class 20: *plastic cake decorations* (for which no submissions are offered); *plastic name badges*; and *plastic novelty license plates* (both deemed to be similar by the Opponent), have a different nature and method of use from those of the goods relied upon under the earlier marks. They do not usually have the same commercial origin; they target different end users; and are neither complementary, nor in competition. Therefore, they are considered dissimilar. Consequently, these goods would also not form part of my analysis on likelihood of confusion and the opposition in relation to these fails accordingly.

Class 21 – opposed under: SPYSCAPE (429 and 633)

26. The following goods are identical to goods protected under the relevant earlier rights, as admitted by the Applicant:

*Dinnerware and beverage ware of ... earthenware, including ... drinking glasses, serving pitchers; bottles (sold empty), beverage glassware ...; ... containers for food and beverages (for household or kitchen use); ... statuettes and figurines (of plastic, ceramic or earthenware); ... personal grooming articles, namely, toothbrushes, shaving brushes, hair brushes, ... (hair, omitted in the Applicant's admission) combs; ..., bath sponges.*

27. In this admission, the Applicant omits from its “dinnerware and beverage ware” specification, the terms: “*of paper, plastic*”; and “*including dishes, platters, plates, bowls, cups, saucers, mugs, ... serving pitchers*”. Taking the latter omission first, I consider that the listed items can constitute “*articles made of ceramics, glass, porcelain or earthenware which are not included in other classes*” (as covered under the earlier specifications). Therefore, they are at least *Merit* identical. In considering the terms “*Dinnerware and beverage ware*

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<sup>5</sup> *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

of *paper, plastic*”, I find that these will overlap in trade channels, user, method of use and purpose with the Opponent’s *“Household or kitchen utensils and containers”* and *“articles made of ceramics, glass, porcelain or earthenware...”*. The main distinction between the goods is the material with which they are made. In my view, these goods can compete with each other. I therefore consider them to be highly similar.

28. The contested *“bottles (sold empty), beverage glassware with permanently attached pewter emblems”* are self-evidently goods of the kind encompassed by the Opponent’s *“articles made of ceramics, glass, porcelain or earthenware ...”*. Therefore, if these goods are not *Merici* identical, they would at least be highly similar.

29. The Applicant submits that the term *“insulated bottles”* is dissimilar to the earlier protected terms; however, I note that said term is a constituent of the complete specification (as it appears between semi-colons in the Applicant’s specification): *“insulated bottles, containers for food and beverages (for household or kitchen use)”*. Therefore, I find that this contested term is encompassed by the Opponent’s *“Household or kitchen utensils and containers”*. Further, bottles may be insulated with material (ceramics, for example) covered in the Opponent’s specification. The respective goods belong to the broad category of household and kitchen utensils; they target the same market and are distributed through the same channels. Therefore, if they are not *Merici* identical, they are similar to at least a high degree.

30. The contested *“lunch boxes, lunch pails;” “ice pop forms;” “waste baskets;” “napkin holders, napkin rings, bottle openers;”* and *“bed and snack trays, serving trays”* are all implements for kitchen or household use that facilitate the preparation and serving of food or drinks, or the performance of domestic activities. Therefore, they have some points in common with the Opponent’s *“Household or kitchen utensils and containers”*. These goods are also directed at the same public, through the same commercial channels, for example kitchenware sections in supermarkets and department stores; and are

expected to be manufactured by the same undertakings. Therefore, they are similar to an above average degree.

31. The contested “*non-metal piggy banks*” are traditional coin receptacles normally used by children for saving money, which has a different purpose and method of use from the Opponent’s earlier goods. I consider too, that they are normally manufactured by different undertakings; are not complementary or in competition; and are generally sold through different distribution channels or, at least, in different sections of department stores. Although the contested *piggy banks* can be “articles made of ceramics, glass, porcelain or earthenware”, (as covered by the Opponent’s specification), this of itself, is not sufficient to find similarity between the respective goods. Therefore, the contested “*non-metal piggy banks*” is dissimilar to the Opponent’s goods; and the opposition in relation to these goods must also fail.

32. I consider that the same reasoning applies to the contest term “*sun catchers*”<sup>6</sup>, even considering that they may be sold through the same distribution channels (as the Opponent’s Class 20 goods, for example). There is no complementarity between sun catchers and the Opponent’s goods; and consumers would not assume that they come from the same or economically linked undertakings. Therefore “*sun catchers*” is dissimilar to the Opponent’s goods. If I am wrong on these findings, I consider that any similarity between “*non-metal piggy banks*” and “*sun catchers*” would be low.

33. In considering “*toothbrush holders*”, which the Applicant contends is dissimilar to the Opponent’s goods, I find that it may coincide in producer, relevant public and distribution channels with the earlier “*electric and non-electric toothbrushes*”. Therefore, they are similar to an average degree.

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<sup>6</sup> “Any device for utilizing or harnessing the light or energy of the sun”; or “A decorative item made from (stained) glass (or other reflective or translucent material) suspended so as to sparkle or glow in sunlight”. Oxford Dictionary: <https://www.lexico.com/definition/sun-catcher>

Class 24 – opposed under: SPYSCAPE (429 and 633)

34. The applied-for goods: “*Textiles*”; “*fabric*”; “*bath linen*”; “*bed linen*”; “*household linen*”; “*kitchen linens*”; “*table linen*”; “*household textile articles*”; “*plastic table covers*”; and “*sleeping bags*” are either identically contained in, and/or are encompassed by, the protected specifications; and are therefore, either self-evidently or *Merici* identical, to the earlier goods: “*Textiles and textile goods*,” “*bed and table covers*,” and “*textiles for making articles of clothing*”. The term “*plastic table covers*”, for example, is covered by the earlier “... *table covers*”.
35. If my finding on the identity of “*sleeping bags*” is wrong, I consider in the alternative, that in addition to “*Textiles and textile goods*”, it may also be compared with “*travellers' rugs*” and “*bed ... covers*” and “*duvets*”. They share commonalities in the sense that they have the same nature, overlap in purpose, target the same relevant public; and are distributed through the same channels of trade. Accordingly, they are considered similar to a high degree.
36. The remaining goods applied for under class 24: “*plastic flags*”; “*plastic banners*”; “*plastic pennants*” are similar to an above average degree to the Opponent’s “*Textiles and textile goods*”. The latter goods may also include flags or banners/pennants made of textile fabrics or textiles containing plastics. In this context, these goods will have the same nature and purpose as well as the same method of use. These goods are distributed through the same channels and target the same relevant public.

Class 28 - opposed under: SPYSCAPE (429 and 633)

37. The goods under this specification can be classified into three categories: (i) games/toys; (ii) protective gear for athletic use; and (iii) Christmas tree decorations. Having given the terms in the competing specifications their natural meanings; and after having considered the intended purpose, method of use and whether there exists a complementary or competitive relationship between them, I have concluded that they are identical or *Merici* identical (some self-evidently so). The majority of these contested goods are encompassed

by the Opponent's "*Games and playthings*", including: "*hand held unit for playing video games*"; "*coin-operated video games*"; and "*arcade games*" (in the later specification). "*Elbow pads for athletic use*" and "*knee pads for athletic use*" are covered by "gymnastic and sporting articles"; and it is self-evident that the Applicant's "*christmas tree ornaments...*" is encompassed by the earlier "*decorations for Christmas*". I also find that the latter term is highly similar to the contested "*gift package decorations made of plastic*", in the Applicant's class 20 specification.

Class 30 - opposed under: SPYSCAPE (429 and 633)

38. "*Coffee*", "*tea*", "*cocoa*", "*sugar*", "*rice*", "*flour and preparations made from cereals*", "*bread*", "*pastry*"; "*ice[/s]*"; "*honey*"; and "*spices*" appear in both the earlier and later specifications: these are self-evidently identical. The contested "*confectionery products*" and "*pastry products*" are identical under the principle outlined in *Meric*, to "*pastry and confectionery*". "*Frozen ice cream*", "*ice cream bars*", "*ice cream sandwiches*" and "*ice cream confections*" are also identical, under *Meric*, to the earlier "*edible ices*".
39. The contested "*candy*", "*candy bars*", "*chocolate*", "*chocolate bars*", "*cookies*", "*cakes*", "*biscuits*", and "*candied fruit snacks*" are covered in the broad category of the Opponent's "*pastry and confectionery*". Therefore, these goods are *Meric* identical. If I am wrong in relation to "*cookies*", "*cakes*" and "*biscuits*", they would be at least highly similar. They usually coincide in producer, relevant public, channels or trade; and can compete with the Opponent's goods.
40. The opposed "*granola bars*", "*energy bars*" and "*cereals*" are highly similar to the Opponent's "... *preparations made from cereals*". They have the same purpose and are in competition. Furthermore, they usually coincide in producer, relevant public and distribution channels.

41. Similarly, “*chewing gum*” and “*bubble gum*” are encompassed by the earlier “*confectionery*”. They share purpose, users, channels of trade and method of use and are in competition. Therefore, they are at least similar to a high degree.

42. “*Frozen custard*” and “*frozen yogurt*” are at least highly similar, if not *Merit* identical, to the Opponent's “*edible ices*”. They have the same nature, distribution channels, end users and producers.

### **Average consumer and the purchasing act**

43. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide 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”.

44. For the purpose of assessing the likelihood of confusion, it must also 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.

45. In the absence of submissions from either party regarding the average consumer, I conclude that the goods (which I found to be identical or similar to varying degrees), are directed at the general public and at the professional public, with specific knowledge or expertise (in “*precious metals and their alloys*”, for example). This professional consumer is expected to exhibit a reasonably high level of care and attention in the purchasing process; though I accept that this may vary from average to high, depending upon the degree of sophistication, or associated terms and conditions, of the goods at issue.

46. I find that the general public’s degree of attentiveness is likely to vary from low to high, according to the reason for the purchase, cost of the items, the nature of the goods and frequency of purchase. For example, it is likely that greater care will be employed when purchasing high-grade jewellery, in contrast to the level attention the average consumer is expected to exhibit in relation to commonplace confectionery.

47. I consider that the purchasing act will be predominantly visual in nature; as consumers generally put a certain amount of consideration into aesthetic values when selecting most of the goods at issue, for example. However, I do not disregard aural considerations, which may play a part in business to business transactions, as well as in cases where a member of the public is assisted by a specialist in the purchasing process, for example.

### **Comparison of the marks**


48. 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 Court of Justice of the European Union 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.”

49. 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

50. The respective trade marks are shown below:

<p style="text-align: center;"><b>SPYSCAPE</b> [UK00003103429] [EU014655633]</p> <p style="text-align: center;"><b>SPYMASTER SPY MASTER</b> [UK00003217060 – series of two] [WE00001367851 – first mark only]</p> <p style="text-align: center;"> [EU015587488]</p> <p style="text-align: center;"><b>SPYCON</b> [EU017901321]</p>	<p><b>Spy Quest</b></p>
<p>Earlier Trade Marks</p>	<p>Contested Trade Mark</p>

51. There is demonstrable duplication/overlap between the marks relied upon in these proceedings: SPYSCAPE and SPYMASTER are UK trade marks, from which priority was claimed for the respective EU registrations (or the latter marks are replicas of two UK registrations); and  is deemed to constitute a figurative representation of SPYSCAPE. SPYCON is the only mark (of the earlier marks) without parallel in this context.
52. On preliminary consideration, I find that the figurative mark offers no advantage over the earlier mark SPYSCAPE. To my mind, the figurative SPYSCAPE mark would require prior knowledge or additional information to aid its interpretation by a signification proportion of the relevant public. Therefore, I will focus my assessment of the earlier marks on (the word marks): SPYSCAPE, SPYMASTER and SPYCON. I will consider the difference introduced by the space in the SPY MASTER mark later on in this assessment.

Overall impression of the respective marks

53. In comparing the marks there is no difference between the variation in casing; because a word trade mark registration protects the word itself, irrespective of the font capitalisation or otherwise. Therefore, a trade mark in capital letters covers notional use in lower case and vice versa.<sup>7</sup>
54. The Applicant's mark consists of the word elements, SPY and QUEST (separated by a space). There are no other elements in the mark; and with neither word dominating, its overall impression lies in the unit formed by the combination of the two word elements.
55. The earlier marks, SPYSCAPE, SPYMASTER and SPYCON, are stand-alone word marks. There are no other elements to contribute to the overall impression of these marks, which is contained in (the combined form of) each independent word. Even if the SPYMASTER mark is seen as the conjunction of two words,

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<sup>7</sup> *Bentley Motors Limited v Bentley 1962 Limited* BL O/159/17

SPY and MASTER, I find that the overall impression also resides in the mark as a whole, as the two words hang together to form a unit.

56. The Opponent's second mark in the series of two, SPY MASTER, is different from its first in the series, SPYMASTER;<sup>8</sup> in that the words SPY and MASTER are separated by a space. In its written submissions, the Opponent affirms, with reference to its pleadings regarding the SPY MASTER mark, that "[t]he same comments apply to SPYMASTER as this mark would be seen as the combination of two words SPY and MASTER". I agree with the substance of this submission, in view of the fact that the average consumer does not normally indulge in an analytical examination of a trade mark, but perceives it in its entirety. Moreover, I find that the difference created by the space between the words SPY and MASTER is not sufficiently significant to impact the overall impression of this mark, which is contained in the two words in combination.

#### Visual and aural comparisons

57. The Opponent submits that SPYSCAPE and SPY QUEST "commence with the identical element 'Spy' and each is followed by an element which contains 5 letters, making both marks contain the same number of letters. The first part of the mark is the one which attracts the attention of the consumer". Similar submissions are made in relation to the other earlier marks.

58. The Applicant contends that "[t]he mathematical information concerning the number of syllables and letters in these elements [SCAPE and QUEST] is irrelevant. The comparison must be between the trade marks in their entireties". Further, "[t]he trade marks share the element Spy, but that is not sufficient for a finding that there is a likelihood of confusion between them. The strong visual and aural differences are immediately apparent". The Opponent counterargues that "when comparing marks from a visual point of view, it is relevant to consider the number of letters. Likewise, when comparing marks from a phonetic point of view, it is relevant to consider the number of syllables".

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<sup>8</sup> As well as the WE00001367851 mark.

59. “Visually and aurally, the marks coincide in the element “SPY” (and its sound); positioned at the beginning of each respective mark. They differ in the appearance and pronunciation of the suffixes (or second word): SCAPE, MASTER and CON of the earlier marks and the second element, QUEST, of the contested mark. It is well settled that the first element, the common element of the marks, will first catch the consumer’s attention when encountering them; by reason of the fact that the public reads from left to right, which makes the part placed at the left of the sign (the initial part) the one that first catches the attention of the reader. However, this does not mean that the average consumer would only focus on the initial element of the marks. Consequently, having weighed up the similarities and differences, I find that SPYSCAPE, SPYMASTER (in both its forms) and SPYCON are visually and aurally similar to an average degree to SPY QUEST.

### Conceptual comparisons

#### SPYSCAPE

60. The Opponent submits that: “The element ‘scape’ is reminiscent of adventure as in the word ‘seascape’. The Applicant states that the word Quest also means adventure (*see the Applicant’s counterstatement, continuation sheet in relation to earlier UKTM No UK00003103429*). Conceptually the marks share a similar meaning”.<sup>9</sup>

61. The Applicant contends that its “trade mark conveys the very strong Quest conceptual impression which is missing from the Opponent's trade mark”; that “[n]one of the meanings or the element SCAPE is related to the word Quest”; and that the “marks are not similar”.

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<sup>9</sup> I note that the Applicant filed definitions of the words at issue, annexed to supplementary submissions. The Opponent in turn requested that these be struck out as they were not filed as evidence during the evidence rounds. I also note that the definitions had been included in the Applicant’s earlier submissions, during the evidence rounds and that they consist of common dictionary words.

62. SPYSCAPE, though not itself a standard dictionary word, is composed of two ordinary dictionary words, SPY and SCAPE. Dictionary definitions of SPY include: the *noun* - “a person who secretly collects and reports information about the activities of another country or organisation” and the *verb* - “to see or notice someone or something usually when it involves looking hard”.<sup>10</sup> SCAPE is defined as: a *suffix* - used to form nouns referring to a wide view of a place, often one represented in a picture: [for example] landscape, seascape, cityscape”.<sup>11</sup>

63. The element QUEST in the Applicant’s mark is defined as: (noun) – “the act or an instance of looking for or seeking; search”; or (verb) – “to go in search (of)”.<sup>12</sup>

64. Although SPYSCAPE may be seen as an invented portmanteau, keeping in mind that the average consumer will not spend time considering the meaning/s of a word/s in a mark, but will simply look at the mark as a whole and attach significance to dictionary words or words with recognisable meaning, I consider that the average consumer will be familiar with the words SPY and SCAPE and attribute meaning to them. Though I find that there is no universal definition of SPYSCAPE (and no submissions have been made as to what it means). Whether the average consumer attaches meaning to the words in the mark collectively or individually, there are clear conceptual differences in the additional word elements in the respective marks, which pull the conceptual similarity away from the simple meaning of SPY. Therefore, I consider that SPYSCAPE and SPY QUEST share a low degree of conceptual similarity.

### SPYMASTER and SPY MASTER

65. The earlier assertions regarding the difference created by the space in this mark also apply here. SPY and MASTER are ordinary dictionary words, which will be

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<sup>10</sup> Cambridge Dictionary: [https://dictionary.cambridge.org/dictionary/english/spy?q=spy\\_1](https://dictionary.cambridge.org/dictionary/english/spy?q=spy_1)

<sup>11</sup> Cambridge Dictionary: <https://dictionary.cambridge.org/dictionary/english/scape>. SCAPE is also a term used in Botany, to define: “A long, leafless flower stalk coming directly from a root” (Oxford Dictionary: <https://www.lexico.com/en/definition/scape>. However, I do not consider that this is likely to be known, or perceived (in this mark), by a significant portion of the relevant public.

<sup>12</sup> Collins Dictionary: <https://www.collinsdictionary.com/dictionary/english/quest>

readily understood by the average consumer. The MASTER element conjures the perception of either *a person who has general authority over other spies* or *an expert in this field*. Additionally, the combined form SPYMASTER is a standard dictionary word, meaning: “*a person who is in charge of a number of spies and coordinates their activities*”.<sup>13</sup> The only similarity between the marks is the shared word SPY. QUEST and MASTER carry entirely different meanings, which frame the concepts of the respective marks. Accordingly, regardless of whether or not the relevant public is familiar with the dictionary definition of SPYMASTER, I consider that the marks (either in the conjunctive or split form) are similar to a low degree to SPY QUEST.

### SPYCON

66. The CON element of SPYCON may evoke different meanings: an abbreviation for convention (the more likely perception) or to deceive, for example. In the absence of submissions from the Opponent as to the meaning of SPYCON, I consider that the overall meaning created as a unit has a different concept to SPY QUEST. The common element SPY is altered by the addition of the respective word elements. Taking the meanings of these into consideration, I find that the marks are conceptually similar to a low degree, based on the fact of the shared common element SPY.

### **Distinctive character of the earlier trade mark**

67. The degree of distinctiveness of the earlier marks is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive an earlier mark, the greater the likelihood of confusion<sup>14</sup>. 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.

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<sup>13</sup> Collins Dictionary: <https://www.collinsdictionary.com/dictionary/english/spymaster>

<sup>14</sup> *Sabel BV v Puma AG*, Case C-251/95 [para. 24]

68. “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.

69. Trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Further, the distinctiveness of a mark can be enhanced by virtue of the use made of it. In this case, however, the Opponent has not pleaded that any of its marks has acquired enhanced distinctiveness through use and has not filed any evidence to support such a claim. Consequently, I have only the inherent position to consider.

70. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. sitting 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 said:

“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.”

71. 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.

72. The conjoined word elements "SPY" and "SCAPE", as earlier explained, may be perceived as an invented term; nevertheless, it is comprised of ordinary dictionary words with recognisable meaning. Accordingly, as this term does not describe or allude to the goods for which it is registered, SPYSCAPE has an average degree of inherent distinctive character. For similar reasons, I find that SPYMASTER (in both its forms) and SPYCON are also inherently distinctive to an average degree.

### **Conclusions on Likelihood of Confusion**

73. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear 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]).

74. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other; and indirect, where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related. The distinction between these was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By 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:

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).

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.).

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).”

75. I remind myself that I have found most of the goods to be identical or similar to a high degree (save and except for those found to be dissimilar; against which, the opposition cannot succeed). The average consumer has been identified as members of the general and professional publics, who will select the goods primarily by visual means; though I do not discount an aural component. I have concluded that the degree of attention paid will vary from low to high, depending on the nature or objective of the purchase and the respective consumer groups.
76. I have found the parties' marks to be visually and aurally similar to an average degree. Conceptually, the marks were found to be similar to a low degree. The earlier marks each possess an average degree of inherent distinctive character.
77. I earlier indicated that, as a general rule, the first parts of words catch the attention of consumers. However, it is also clear that each case must be decided on its merits, considering each mark in its entirety. In this case, the fact that the first word or syllable of each mark is the same does not necessarily mean that they are likely to be confused.
78. In my view, the fact that all of the marks coincide in the presence of the word SPY, positioned first in each is not, of itself, sufficient for a finding of a likelihood of confusion. I must also take account of the additional elements in the respective marks when considering them in their totalities.
79. Bearing in mind that visual considerations are likely to dominate the purchasing process, I find that the average consumer is likely to notice the visual differences between the marks; even in instances where the goods are identical, low priced, frequent purchases. I also bear in mind that the earlier marks are likely to be viewed and remembered as whole, single units (SPYSCAPE, SPYMASTER and SPYCON, even in the case of the split form, SPY MASTER), with particular, and sufficiently different, meanings from SPY QUEST.

80. I have also considered the possibility of confusion through consumers mishearing one mark for the other. However, I consider this to be unlikely, as the marks are aurally similar to an average degree and by reason of the fact that they hang together as units and would be articulated as such. Furthermore, I also find that the goods at issue would be purchased after the consumer has had the opportunity to visually examine them and their associated brands. Therefore, I do not consider that the average consumer would purchase one party's goods based on a false perception that they are goods produced by the other.

81. At the very highest, to my view, it might be said that there was a possibility that one mark might bring the other to the mind of some members of the relevant public; but I consider that that would not be sufficient to lead consumers to associate the origin of the products at issue to the respective parties. It is of importance to note that what has to be identified is the likelihood of confusion; and not simply that one mark brings another to mind. Therefore, after having carefully considered all of the above factors and weighed them against each other, I come to the view that there is no likelihood of direct confusion (where the applied-for mark is mistaken for either of the earlier marks).

82. Although I consider that the average consumer will notice the differences between the marks, I must also consider the possibility of indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the competing 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.

83. In approaching the question of indirect confusion in this case, I must assess whether the average consumer will make a connection between the marks and assume that the goods in question are from the same or economically linked undertakings.

84. I have found that the average consumer will recognise that the applied for mark is different from the earlier marks; and more significantly, that the common element SPY is not perceived independently of, and/or is equally dominant and distinctive with, the other elements in the respective marks. I also bear in mind that there was no evidence that the earlier marks have been used, or are referred to independently, as SPY; or that they formed, or were recognised as, a family of marks. I find that the SPY element (common to all of the marks) does not have an independent distinctive role in the earlier marks; and that the other elements of the marks form units having different meanings to those of the words taken separately.<sup>15</sup>

85. The Opponent, however, claims that: “In Spy Quest the word Spy is separate from Quest, which makes it even more likely that it would be seen as a ‘Spy mark’”. To my mind, this is tantamount to claiming exclusive rights over the common element (in its series of registrations, not a family of marks), which has not been registered simpliciter. By the same token, the registration of the marks containing a common element does not ipso facto give rise to a presumption that they will be perceived as belonging to a family of marks; and more crucially, there was no evidence (nor argument) to advance such a claim.

86. Even though the SPY element is distinctive, this is in tandem with other elements in the marks. Furthermore, I find that as an ordinary dictionary word at the beginning of the marks (in most cases conjoined with other word elements), SPY could not be said to be so unusual that the average consumer, when selecting the goods at issue, would assume that no other trader would use this element as a part of their trade marks, so as to render the parties economically linked. Further, I do not consider that SPY QUEST constitutes a consistent or natural extension of any of the earlier marks. It does not simply add an element to the earlier marks, which would suggest to the average consumer that it was merely a sub-brand or extension of the earlier known brands. The earlier marks are, or hang together as cohesive units, conveying different meanings to their constituent elements; and that complete unit or

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<sup>15</sup> See the CJEU’s judgment in *Bimbo* and paragraph 20 of Arnold J.’s judgment in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch).

combination is an important element of the overall impression held by the average consumer when selecting the goods under consideration. That difference in overall impression held by the average consumer, in my view, is sufficient to preclude an instinctive reaction that the respective marks are variants or sub-brands or that the goods in question are from the same or economically linked undertakings. I therefore find there is no likelihood of indirect confusion.

## **Conclusion**

87. The opposition under section 5(2)(b) fails in its entirety. Accordingly, subject to any successful appeal, the application may proceed to registration.

## **COSTS**

88. As the Applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. Applying this guidance, I award costs to the Applicant on the following basis:

Reviewing the Notice of Opposition and filing the Counterstatement:	£450
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Filing written submissions:	£400
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<b>Total:</b>	<b>£850</b>
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89. Accordingly, I hereby order Spyscape Ltd to pay to Polybius Games Ltd the sum of **£850**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 29<sup>th</sup> day of November 2021**

**Denzil Johnson  
For the Registrar**