

O/725/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003526229

IN THE NAME OF GRAHAM KEOGH

FOR THE TRADE MARK:

COBBLE

IN CLASSES 9 AND 28

AND

OPPOSITION THERETO UNDER NO. 422733

BY ASMODEE GROUP

Background and pleadings

1. Graham Keogh (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK on 25 August 2020.

2. The application was accepted and published in the Trade Marks Journal on 9 October 2020 in respect of the following goods:

Class 9: *Computer games; downloadable electronic games.*

Class 28: *Board games.*

3. On 11 January 2021, ASMODEE GROUP (“the opponent”) opposed the application on the basis of Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) relying on the trade marks and specifications set out in the table below:

EUTM 011610664 (the “664 mark”)

DOBBLE

Filing date: 27 February 2013

Registration date: 31 July 2013

Relying on:

Class 9: *Video games*

Class 28: *Card games;¹ playing cards.*

Under Section 5(3) the opponent claims reputation for the same goods.

EUTM 017436361 (the “361 mark”)



Filing date: 03 November 2017

Registration date: 08 October 2019

¹ The mark is registered for, inter alia, *Games*.

Under Section 5(2)(b) the opponent relies on all of the goods and services for which the mark is registered in classes 16, 28 and 41. Under Section 5(3) the opponent claims reputation in relation to *games* and *card games*.²

EUTM 017436379 (the “379 mark”)



Filing date: 3 November 2017

Registration date: 8 October 2019

Under Section 5(2)(b) the opponent relies on all of the goods and services for which the mark is registered in classes 16, 28 and 41. Under Section 5(3) the opponent claims reputation in relation to *games* and *card games*.³

International Registration (“IR”)⁴ 01361109 (the “109 mark”)

Registration date: 13 January 2017

Designation date: 13 January 2017

Under Section 5(2)(b) the opponent relies on all of the goods and services for which the mark is registered in classes 9, 16, 28 and 41. Under Section 5(3) the opponent claims reputation in relation to *games* and *card games*.

4. The opponent claims that the applicant’s goods are closely similar to the goods and services covered by the earlier marks and that the marks are very similar, leading to a likelihood of confusion.

5. Under Section 5(3), the opponent makes the following claims:

- a) That the applicant will benefit from the opponent’s investment leading to unfair advantage. The applicant is likely to gain sales, goodwill and enhanced status

² The mark is registered for, inter alia, *Games*

³ The mark is registered for, inter alia, *Games*

⁴ The mark is listed as a EUTM on the opponent’s TM7, but it is actually an IR designating the EU for protection

with its customers as a result of the association with the opponent's marks. It will be easier for the applicant to sell its goods as the reputation established by the opponent in the earlier marks will attach to the applicant's mark and to the goods sold under it;

- b) That any poor-quality goods provided by the applicant under the mark will reflect upon the opponent's business leading to detriment to the opponent's valuable reputation and business. Furthermore, the power of attraction of the opponent's marks will be reduced. The opponent's goods sold under the marks are quality goods and the marks will lose their exclusive cache by virtue of the link established with the applicant's goods;
- c) That there will be detriment to the distinctive character and reputation of the opponent's marks because the average consumer will struggle to distinguish the opponent's goods from those of the applicant. The opponent's marks will be diluted by concurrent use of a similar mark for the same or similar goods, and they will cease to indicate exclusive origin.

6. The opponent's marks have filing dates that are earlier than the filing date of the application ("the relevant date") and are, therefore, earlier marks in accordance with Section 6 of the Act. Only the '664 mark had completed its registration procedure more than five years before the relevant date and is subject to the proof of use provisions contained in Section 6A of the Act. As the other marks had not been registered for five years at the relevant date, the opponent may rely on them for all of the goods and services it has identified without showing that there has been any use of the marks.

7. The applicant filed a counterstatement denying the grounds of opposition. I note, in particular that:

- The opponent is put to proof of use of the '664 mark in relation to *games (other than card games)* and *board games* in class 28;
- The applicant denies that the contested goods in class 9 are similar to the opponent's goods in the same class on the basis that it is common knowledge in the relevant sector that video games (in the earlier marks) differ from computer games (in the application), as video games are mostly made for use

with consoles and hand-held games, whereas computer games are used exclusively on PCs;

- The applicant denies that the contested board games in class 28 are similar to the opponent's card games and playing cards in the same class. It also contends that the applicant's board game does not involve the use of cards and that the applicant does not sell playing cards or any games other than board games;
- The applicant denies that there is a high level of similarity between 'COBBLE' and 'DOBBLE';
- The applicant contends that the opponent is not renowned for board games and thus there is unlikely to be any confusion as to the origin or association with the opponent's marks;
- The average consumer would not choose to purchase the applicant's goods over those of the opponent because they are not similar, one being a board game, the other playing cards. Further, a game, unlikely groceries, would typically be purchased more carefully as consumers are likely to take more care in reading the instructions of a game to see if it is suitable for them.

8. Only the opponent filed evidence during the evidence rounds. The applicant filed submissions dated 17 January 2022. I shall refer to the evidence and submissions to the extent that I consider necessary.

9. The applicant is represented by Agile IP LLP and the opponent by HGF Limited. Neither party requested a hearing, but both parties filed submissions in lieu. This decision is taken following a careful consideration of the papers.

10. 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.

THE EVIDENCE

11. The opponent filed evidence in the form of two witness statements of David Kenneth Page and a witness statement of Celine Bucki.

12. Mr Page is a director of Asmodee UK, a company which is part of the corporate group owned by the opponent. Mr Page's witness statements are dated 19 July 2021 and 14 September 2021 respectively and are accompanied by 15 exhibits (DKP1-14 and DKP1).

13. Ms Bucki is the Head of Legal Department of the Asmodee group. Her witness statement is dated 14 September 2021, and is accompanied by 19 exhibits (CB1-19)

DECISION

Proof of use

Relevant statutory provision: Section 6A:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

14. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

15. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale

and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

16. Proven use of a mark which fails to establish that “*the commercial exploitation of the mark is real*” because the use would not be “*viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark*” is not, therefore, genuine use.

17. The relevant period in which proof of use must be shown is the five-year period ending with the date of the application for registration, namely 26 August 2015 – 25 August 2020. This applies to both grounds of opposition under Section 5(2)(b) and Section 5(3).

18. Since the earlier mark that is subject to proof of use is a EUTM, I must consider the EU as the market in which the opponent is required to show genuine use - see *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, paragraph 36.

Evidence

19. The key points emerging from Mr Page’s witness statements can be summarised as follows.

- The opponent designs and publishes the series of ‘DOBBLE’ games. The series is described by Mr Page as “highly successful”;
- Asmodee UK has been selling the opponent’s DOBBLE-branded games in the UK since March 2011;
- As well as the original ‘DOBBLE’ game, the range sold by the opponent’s corporate group includes related sub-brands such as ‘DOBBLE XXL’, ‘DOBBLE 360’, ‘DOBBLE BEACH’, ‘DOBBLE’ 1, 2, 3, ‘DOBBLE ANIMALS’ and a wide range of licensed varieties featuring well-known characters such as Disney Princess, Disney Frozen, Harry Potter, the Gruffalo, Minions and Paw Petrol. Examples are shown below:



- Turnover generated by the sale of ‘DOBBLE’ games in the UK for the years 2015-2020 is as follows:

2015: £710,256

2016: £1,800,873

2017: £2,074,239

2018: £2,595,193

2019: £5,298,164

2020: £2,373,810

- The opponent's 'DOBBLE' games are sold through well-known national retailers including Amazon, Argos, John Lewis, Sainsburys, Tesco and Waterstones, as well as smaller and independent hobby stores;
- According to Mr Page, the original 'DOBBLE' game was the biggest selling game of its category in the UK in 2018 and 2019 and the second biggest selling game of its category in the UK in 2017. The evidence supporting this statement corroborates the claim that the 'DOBBLE' game was ranked as the top game sold in the UK in 2018-2019;⁵
- Expenditure on marketing dedicated to the original 'DOBBLE' brand in the UK for the years 2015-2020 is as follows:

2015: £16,316

2016: £55,761

2017: £69,718

2018: £93,065

2019: £59,064

2020: £37,743

Examples of marketing material include extracts from UK product catalogues and copies of printed adverts,⁶ screenshots of adverts published on social media and YouTube⁷ and copies of articles from The Guardian, The Telegraph and The Daily Mail mentioning the opponent's DOBBLE game as one of the best board games;⁸

⁵ Mr Page's second witness statement and accompanying DPK1 which is covered by confidentiality

⁶ DKP4

⁷ DKP5

⁸ DKP6

- Asmodee UK is renowned for having a leading demonstration programme, with a team of 150 demonstrators, who during the relevant period (except in 2020 when the coronavirus pandemic impacted events) attended 40 shows and trade events per year, including in various UK toy shops as well in the Great Ormond Street Hospital;⁹
- Asmodee UK maintains the website www.dobblegame.com, a YouTube channel and social media accounts on Instagram and Facebook for the DOBBLE brand;¹⁰
- The DOBBLE game and its sub-brands has won/been nominated for various awards in the UK including ‘Dobble Beach’ (2017), ‘Blog On Toy Awards’ (2017 and 2020), ‘Independent Toy Awards’ (2020), ‘Imagination Gaming Awards’ (2020), ‘Made for Mums Toy Awards’ (2020), ‘Dansnet Awards’ (2020), ‘The Baby Awards’ (2020) and ‘Bizziebaby Awards’ (2020);¹¹
- A digital version of the ‘DOBBLE’ game was released by the opponent’s corporate group in 2017 in the form of a mobile phone app. Between 2017 and 2019 the game was downloaded by 18,500 users in the UK;

20. In addition to this evidence, Ms Bucki filed a witness statement with a view of demonstrating that the earlier marks have acquired a reputation and an enhanced distinctive character in the EU. I shall return to the relevance of this evidence later in this decision.

21. Before I proceed further, it is important to clarify what are the goods in respect of which the opponent is put to proof of use. In its written submissions, the opponent points out that (a) the applicant’s request for proof of use does not specify which registration is challenged and (b) the applicant requested proof of use in respect of “*games (other than card games)*” and “*board games*” in class 28, however, the class 28 goods relied upon in relation to the ‘664 mark (i.e. the only mark that is subject to proof of use) are “*card games; playing cards*”.

22. The ‘664 mark is registered for, inter alia:

⁹ DKP7

¹⁰ DKP9-12

¹¹ DKP13

Class 9: *Video games; memory cards for consumer video games; Programs for hand-held games with liquid crystal displays; Power adapters for portable games with liquid crystal display screens; Video games for consumers, designed to be used solely with a separate display screen or a monitor.*

Class 28: *Games toys and playthings; Playing cards; Balls and balloons, board games, dolls, puzzles, figurines (playthings), teddy bears and other soft toys, building blocks (playthings); Electronic games other than those adapted for use with television receivers and computers only; Game controllers and joysticks for consumer video game consoles.*

23. In its Form TM7, the opponent stated that it wished to rely on the '664 mark in relation to the following goods:

Class 9: *Video games*

Class 28: *Card games; Playing cards.*

24. In its Form TM8, the applicant requested that the opponent provides proof of use for the following goods without specifying the mark in relation to which proof of use is required:

Class 28: *games (other than card games); Board games*

25. Although the applicant did not specify the mark in relation to which it put the opponent to proof of use, it must have referred to the '664 mark because the other marks are not subject to proof of use.

26. In terms of goods, the applicant did not require the opponent to provide proof of use in relation to *video games* in class 9. The opponent can therefore rely on these goods without showing that it has genuinely used the mark for them.

27. Turning to the goods in class 28, although the applicant put the opponent to proof of use in relation to *Board games* (which is a registered term covered by the

specification of the '664 mark), the opponent did not rely on *board games* and cannot be required to show genuine use in relation to these goods.

28. The opponent also relied on *Playing cards* in class 28. However, the applicant did not require proof of use in relation to *Playing cards*. Consequently, the opponent can rely on these goods without showing that it has genuinely used the mark for them.

29. Finally, the opponent relies on *Card games*. Although this is not a registered term, the '664 mark is registered for *Games toys and playthings* which cover *Card games*. However, the applicant expressly excluded *card games* from the proof of use request, which means that the opponent is not required to show genuine use in relation to these goods.

30. I think these points should have been picked up when the Form TM8 was filed in order to give the applicant an opportunity to file an amended Form TM8. This was not done, and the opponent did not challenge the applicant's request until after it filed evidence of use. Further, when filing evidence of use in relation to the goods relied upon in class 28, the opponent appears to have accepted that the applicant put it to proof of use in relation to these goods – and make specific reference to the proof of use evidence in its cover email. Finally, the evidence filed is sufficient to establish that the '664 mark has been genuinely used for the goods in class 28, which means that the opponent will be not prejudiced if the applicant's request for proof of use is allowed for the goods relied upon in class 28.

31. The last point I need to address is on which basis I am satisfied that the evidence is sufficient to show genuine use of the '664 during the relevant period.

32. I have already outlined the main points emerging from the opponent's evidence. The turnover and marketing figures for the relevant five-year period, amounting to around £15million and £330,000 respectively, are significant taking into account the market for the goods concerned which are relatively inexpensive – in this connection, the evidence shows an average retail price of around £10-£15 or above. Although there is no indication of market share, the evidence establishes that the 'DOBBLE' game was ranked as the top game sold in the UK in 2018-2019. The goods were sold

by major UK retailers and were also mentioned in UK well-known publications. Further, the evidence filed by Ms Bucki shows that significant sale figures were also achieved in the EU, with a total turnover of 68million euros generated in the EU between 2015 and 2020.

33. The main criticism raised by the applicant is that the evidence shows use of the word 'DOBBLE' with a reverse 'B', which is not an acceptable variant of the registered mark. Although the reverse 'B' appears most prominently on packaging, the evidence includes many examples of use of the plain word 'DOBBLE'/'double' (which is used of the mark as registered) on invoices, websites and marketing material.

34. The goods in relation to which the mark is used consist of a card game. Accordingly, I find that the opponent has shown genuine use of the '664 mark in relation to *Card games* in class 28.

35. The opponent also relies on *playing cards*. Playing cards are defined by the Collins Online dictionary as "*thin pieces of cardboard with numbers or pictures printed on them, which are used to play various games*"; such definition would cover the use made. However, the same dictionary also contains another definition (in British English) that is more specific and is as follows "*one of a pack of 52 rectangular stiff cards, used for playing a variety of games, each card having one or more symbols of the same kind (diamonds, hearts, clubs, or spades) on the face, but an identical design on the reverse*"; based on this definition, it is arguable whether use in relation the opponent's card games is sufficient to retain the term playing cards (because playing cards and card games are not the same thing and the opponent does not seem to sell playing cards). However, I do not need to deal with this issue because if a difference exists between card games and playing cards, I consider card games to be more similar to board games than playing cards. Hence, I will carry out the comparison based on the term *card games* alone.

Section 5(2)(b)

36. Section 5(2)(b) of the Act is as follows:

“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”.

37. 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.”

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

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods

39. In the judgment of the 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”.

40. 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 uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. 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.

41. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity

between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, 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”.

42. The law requires that goods and services also be considered identical where one party’s description of its goods and services encompasses the specific goods and services covered by the other party’s description (and vice versa).¹²

43. Although the opponent relies on four earlier marks, two of them (the ‘361 mark and the ‘379 mark) are visually more complex than the others as they consist of images of packaged goods, one being the image of a cylindrical card box in which the cards are sold, the other being the image of the packaging of the card box product itself. The opponent’s submission in relation to these marks is that *“there is a strong case that the word DOBBLE is a dominant element of these marks”* and that *“the analysis of the marks at issue should focus on the comparison between DOBBLE versus COBBLE”*.

44. The opponent did not therefore put forward any reason why the figurative elements of the ‘361 and ‘379 marks increase the likelihood of confusion compared to the other two marks (which consist of the plain word ‘DOBBLE’ (the ‘664 mark) and of the word ‘DOBBLE’ with one of the ‘B’ reversed (the ‘901 mark), respectively). On the contrary, the opponent seems to reduce the ‘361 and ‘379 marks to the word ‘DOBBLE’, which is the only element that gives rise to a degree of similarity between the marks.

45. Given the above, I am satisfied that the ‘361 and ‘379 marks cannot produce a better result for the opponent. I will therefore carry out the comparison of the marks based on the other two marks (the ‘664 mark and the ‘109 mark), although I will at the end briefly explain how (if at all) the different additional elements in the ‘361 and ‘379 marks affect the analysis.

¹² See *Gérard Meric v OHIM*, Case T-33/05

46. The comparison between the goods covered by the application and the goods covered by the '664 and the '109 marks is as follows:

The applicant's goods	The opponent's goods
<p>Class 9: <i>Computer games; downloadable electronic games.</i></p> <p>Class 28: <i>Board games.</i></p>	<p>The '664 mark</p> <p>Class 9: <i>Video games</i></p> <p>Class 28: <i>Card games</i></p> <p>The '109 mark¹³</p> <p>Class 9 Electronic or mobile apparatus for draws; computers, micro-computers; code readers for credit and similar cards for games, lotteries, games of chance, gambling games, betting or pools; game capture terminals; interactive points for games, betting, lottery or pools; software; software downloadable from or distributed via the Internet; computer programs for recorded games, portable game programs with liquid crystal displays; software for games, gambling games, lotteries, games of chance, betting or pools; video game cartridges; memory cards for video games; power adapters for hand-held games with liquid crystal displays; electronic and digital apparatus for games, gambling games, lotteries or games of chance; electronic publications and information provided on-line from databases or the Internet (downloadable); electronic publications provided by electronic mail.</p> <p>Class 16 Paper, cardboard, cardboard articles; bags, sachets and sheets for packaging made of paper; printing products; newsletters (printed matter), tickets, scratch cards (printed), receipts (printed) for gambling games, games of chance, lotteries; journals, newspapers, magazines; subscription cards (non-magnetic); bookbinding articles, photographs, printing blocks; stationery, adhesives (glues) for stationery, artists' material, paint brushes, typewriters and office requisites (other than furniture), instructional or teaching material (except apparatus); bags, sachets and sheets for packaging made of plastic; printing type; school supplies; boxes, cases and pencil cases and cases for stationary articles, slate, paper cutters, pencils, pens, pencil lead holders, rubber erasers, pads (stationery), envelopes, files, agendas, exercise books, envelope folders, scrapbooks, books, illustrated books, almanacs, brochures, notebooks, catalogs, calendars, posters, maps, newspapers, journals (periodicals), magazines; sealing machines, adhesive bands for stationery or household use; wrapping paper, signboards of paper or cardboard.</p> <p>Class 28 Games, board games, games of chance, lotteries, gambling games, pooling, games of skill, knowledge games; puzzles, playing cards; electronic games other than those adapted for use only with television receivers and/or computers; controllers and joysticks for video game machines; balls and balloons; toys, dolls, figurines (toys), teddy bears and other plush toys, building blocks (toys); gymnastic and sporting articles (excluding clothing, footwear and mats); game apparatus adapted for use with an external display screen or monitor.</p> <p>Class 41 Entertainment; organizing of competitions regarding education or entertainment, of games (entertainment), arranging and providing of games, leisure activities and entertainment; lotteries, organizing of lotteries, gambling games, games of chance, raffles, draws, betting and pools; game services provided online (via a computer network); gambling services; entertainment in the nature of an amusement park; amusement park and theme park services; production of information programs, radio and television entertainment, audiovisual and multimedia programs; film production; dubbing services; sound effect services; organization of shows (impresario)</p>

¹³ The specification of the mark is in French, but the opponent has provided a translated list of goods and services

	services); show production; videotape editing; scriptwriting services; editing and publishing of texts (other than advertising texts), illustrations, books, journals, newspapers, periodicals, magazines, publications of all types and in all forms (other than for advertising purposes) including electronic and digital publications (other than advertising) of audio and/or video media, multimedia carriers (interactive discs, audio-digital compact discs with read-only memory), multimedia programs, games and in particular television games, audiovisual games and games on CDs and audio-digital compact discs, on magnetic media; organizing of exhibitions for cultural and educational purposes; photography and photographic reporting; production of music; teaching and training and educational services.
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The '664 mark

47. The applicant's *Computer games; downloadable electronic games* in class 9 encompass the opponent's *video games*. These goods are identical (*Meric*).

48. Although I note the applicant's submission that video games differ from computer games because video games are mostly made for use with consoles and hand-held games, whereas computer games are used exclusively on PCs, I disagree with it.

49. The Collins online dictionary defines "video game" as "*a computer game that you play by using controls or buttons to move images on a screen*". This confirms that a video game is a computer game. The same goes for *downloadable electronic games* which include downloadable video games. These goods are identical.

50. Turning to the competing goods in class 28, the dictionary definition of "board game" (in the application) is "*any game played on a board, often using dice and small pieces that are moved around*". Although the goods are not identical to the opponent's *card games* because a card game does not include a board, game manufacturers commonly make both board games and card games and many games are hybrid card/board games. In this connection, I note that are some references in the evidence to the opponent's card games being described as a board game. Further, the goods coincide in their users, have the same purpose, are in competition and coincide in their producers and distribution channels. These goods are similar to a high degree.

The '109 mark

51. The closest clash I can identify in class 9 is between the applicant's *Computer games; downloadable electronic games* and the opponent's *software for games*, which

include software for computer games and downloadable electronic games. The goods are similar because they coincide in their ultimate purpose and are complementary, since the opponent's software is essential for the proper functioning of the contested *computer games* and *downloadable electronic games*. In addition, the goods target the same consumers and have the same origin. In my view the goods are similar to a medium degree.

52. Both parties' specifications in class 28 include *Board games*. These goods are self-evidently identical.

Average consumer

53. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

54. 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.”

55. The opponent states that the contested goods are ordinary, common goods intended for the general public at large and are not directed towards a specific public.

56. In its submissions, the applicant states that the average consumer is an individual looking for a game to play with another person or a select group of people and that when considering the purchase, consumers would take into account various factors such as the number of people expected to play, the ages of the players, the space and time likely to be available for the game, the complexity of the rules, etc. The applicant also states that “*consumers would also be likely to differentiate between the desire to purchase a card game or a board game*” and that “*consumers would take a longer than average time to read and understand the rules behind the game before they [...] purchase it*”.

57. The relevant average consumer is likely to be a member of the UK public seeking to purchase a game. Although the average consumer might take into account some of the factors listed by the applicant when purchasing a board game, a card game and/or a computer/video game, the goods are not the most expensive of items. They will certainly not be purchased with an above average level of care and attention. Having said that, they are not completely casual purchases either. The purchasing act will be one of a medium degree of consideration.


58. The goods are likely to be obtained by self-selection from the shelves of a retail outlet or an online equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as advice may be sought from a sales assistant or representative and word-of-mouth recommendations may play a part.

Comparison of marks

59. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated 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.”

60. 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. The respective marks are shown below:

The applicant's mark	The opponent's earlier marks
<p>COBBLE</p>	<p>DOBBLE (The '664 mark)</p>  <p>(The '109 mark)</p>

The applicant's mark and the opponent '664 mark

61. Neither mark lends itself to deconstruction into separate elements; their respective overall impressions are based solely on the single word of which they consist.

62. Visually, the only difference between the marks resides in their first letter, which is a 'C' in the applicant's mark and a 'D' in the opponent's mark. Even taking into account the principle that beginning of marks are more focused upon, the marks are of equal length, both consisting of six letters, and as is obvious, the second, third, fourth, fifth and six letter of each of the marks are the same. Further, the letters 'C' and 'D' are not

strikingly different as they both contain curved lines. In my view, the marks are similar to a medium to high degree.

63. Aurally, the applicant states that the letter 'C' creates a hard sound in which the mouth must open up, whereas a 'D' creates a soft sound in which the tongue raises to the roof of the mouth. The opponent states that the marks differ only by one letter and that *"when spoken, the sound-OBBLE has the most distinctive sound"* and is identical in both marks. Given that both marks have the same length and coincide in their pronunciation of the sequence -OBBLE, they are also aurally similar to a medium to high degree.

64. Conceptually, the word 'DOBBLE' has no meaning. In its submissions, the applicant contends that the opponent's marketing of the game 'DOBBLE' is a play on the word 'DOUBLE', because the idea of a pair is in line with the game instructions. Although, the applicant referred to a video published on the opponent's website, it did not file any evidence of it. The opponent disagrees with this argument. Whilst it is possible that, for some consumers, the word 'DOBBLE' might evoke the word 'DOUBLE' (see below), it will still be perceived as an invented word with no meaning. 'COBBLE' is a dictionary word meaning *"a rounded stone used on the surface of an old-fashioned road"*. The applicant further argues that the word 'COBBLE' *"has the connotation of putting a number of randomly selected things together, often in a haphazard way"*, however, such use of the word 'COBBLE' is always in conjunction with the word 'together' as confirmed by the following dictionary definition:

"cobble together

PHRASAL VERB

If you say that someone has cobbled something together, you mean that they have made or produced it roughly or quickly"

65. On that basis, I conclude that that the only meaning conveyed by the applicant's mark is that of a round stone. The marks are conceptually different.

The applicant's mark and the opponent '109 mark

66. The '109 mark consists of the stylized word "DOBBLE" with the first B reversed. Whilst the stylisation contributes to the overall impression, the most dominant element of the mark is the word itself. In terms of aural similarity, the stylisation will have no impact; similarly to what I found in relation to the '664 mark, the marks are aurally similar to a medium to high degree. Visually, the stylisation will have a visual impact, reducing the similarity of the marks to medium degree. Conceptually, the same considerations outlined above apply and the marks are conceptually different.

Distinctive character of earlier mark

67. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

68. Registered 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. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

69. As I have already discussed, the earlier marks consist of the word 'DOBBLE'. As invented words, the marks have a high level of inherent distinctive character.

70. The opponent's own evidence shows that the card game in relation to which the opponent uses the mark is based on the concept of spotting and matching symbols on the playing cards as pairs. Further, the word 'DOBBLE' sounds very similar to 'DOUBLE' so it is possible that some consumer might ultimately understand the word 'DOBBLE' as a play on the word 'DOUBLE' when the mark is used in relation to a card game based on the concept of matching pairs. In those circumstances, whilst the word 'DOBBLE' will still be perceived as invented, it will evoke a concept (that conveyed by the word 'DOUBLE') which has a meaning in respect of the goods. This perception of the marks will result in a level of inherent distinctive that falls between medium and high.

71. The opponent claims that its marks benefit from an enhanced distinctive character based on use of the marks in respect of the sales of card games and playing cards in the UK and in the EU in the period 2015-2020.

72. In my view, the evidence filed is sufficient to support the opponent's claim that the distinctiveness of the mark has been enhanced through use, at least, in the UK, resulting in a high (for those consumers who perceive the mark as an invented word evoking the word 'DOUBLE') or very high degree of distinctive character (for those consumers who perceive the mark simply as an invented without making the connection with the word 'DOUBLE'). The turnover figures achieved by the opponent in the 5-year period is significant, being in the region of £15million, and there is evidence indicating that DOBBLE game was the top selling game in the UK for the two consecutive years 2018-2019.

73. The fact that the opponent's marks might also have acquired an enhanced level in distinctiveness in the EU does not improve the opponent's position because the matter must be judged from the perspective of the average consumer in the UK.

Likelihood of confusion

74. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 marks may be offset by a greater degree of similarity between the respective goods and services vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

75. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained that:

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

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

76. Earlier in this decision, I found that the goods of the ‘664 mark are either identical or highly similar to those of the contested mark. The goods of the ‘109 mark are either identical or similar to a medium degree to those of the contested mark. The ‘664 mark and the contested mark are visually and aurally similar to a medium to high degree and conceptually different. The ‘109 mark and the contested mark are visually similar to a medium degree, aurally similar to a medium to high degree and conceptually different. The average consumer is a member of the general public who will select the goods visually - although I do not discount aural considerations – with a medium degree of attention. Both earlier marks are inherently distinctive to a medium to high degree (for those consumers who perceive the mark as an invented word evoking the word ‘DOUBLE’) or to a high degree (for those consumers who perceive the mark simply as an invented without making the connection with the word ‘DOUBLE’). The distinctiveness of the earlier marks has been enhanced through use to a high and very high degree respectively.

77. The opponent's arguments seem to be based on the likelihood of direct confusion. It states that *"direct confusion of the marks owing to their visual and aural similarities (leading to the public thinking one mark is the other) would naturally give rise to the public falling to differentiate them from a conceptual angle"*. It also states that *"conceptual differences are insufficient to outweigh the clear visual and aural similarities and the likelihood of confusion arising from that"* referring to the relevant public's moderate degree of attention (which I take to mean lower-than-average degree of attention). However, I have already rejected the opponent's submission that the average consumer will pay a lower-than-normal level of attention.

78. I will assess the likelihood of confusion in relation to the '664 mark first.

79. Whilst the respective marks share five out of six letters and the similarities between the marks are quite pronounced, the identical -OBBLE letters are preceded in each mark by a different letter, namely the letter 'C' in the contested mark and the letter 'D' in the opponent's mark. Whilst the principle that the consumers normally attach more importance to the first part of words¹⁴ is only a rule of thumb, it does, in my view, find application in this case, in particular because the difference in the first letters of the marks also creates a conceptual difference.

80. Having considered all of the above, my conclusion is that it is unlikely that a significant number of average consumers will directly confuse one mark for the other. I am not saying that it is not possible that some consumers might misremember or misread the marks due to their visual and aural similarities, however, the correct test is not whether some people will be confused but whether a significant proportion of the relevant public is likely to be confused. In my view, it is unlikely that a sufficient number of average consumers paying a medium degree of attention will directly confuse the marks at issue.

81. As regards indirect confusion, the opponent's case is even weaker. None of the categories of indirect confusion listed by Mr Purvis is applicable in this case. Further, it is unlikely that the average consumer having noted the differences in the first letters

¹⁴ El Corte Inglés, SA v OHIM, Cases T-183/02 and T-184/02

of the marks will perceive the sequence -OBBLE in the later mark as indicating that the applicant's goods come from the opponent or from an economically related undertaking. There is no likelihood of confusion.

82. The opposition based on the '664 mark fails.

83. The other earlier marks are visually less similar to the applicant's mark due to the presence of figurative elements. Further, the word 'DOBBLE' with a 'b' reversed remains the only element in common. Consequently, for similar reason to those outlined in relation to the '664 mark, I find that there is no likelihood of confusion in respect of the other earlier marks.

Section 5(3)

84. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

85. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

86. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*

and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

Reputation

87. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

88. In its submissions in lieu the applicant seems to admit the opponent's claim to reputation. It states:

"The opponent has not provided information of the mark used in relation to a board game...the opponent's reputation lies solely in the mark DOBBLE; it is likely the higher than average consumer would not expect the opponent's mark to be incorrectly spelt for the purpose of a board game"

89. Even if there was not such an admission, for the reasons I have outlined above when I talked about genuine use and enhanced distinctive character, I would have found that all of the opponent's marks have a reputation in the UK for card games. Given that the earlier marks consist of either EUTMs or an IR designating the EU for protection, when assessing reputation in the EU, I consider the UK to be a substantial part of the Union.

90. The opponent's evidence also shows that 'DOBBLE' was the number 1 selling card game in Spain in 2017 and the number 2 selling card game in France in 2017. Whilst the opponent may also have a reputation in the EU, where an EUTM has a reputation outside the UK, it will be harder to show the necessary 'link'¹⁵ because the relevant public is the UK (not the EU) public. It follows that the opponent's case based on reputation in the EU does not improve the opponent's case.

¹⁵ *Whirlpool Corporations and others v Kenwood Limited* [2009] ETMR 5 (HC)

Link

91. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in Intel are:

The degree of similarity between the conflicting marks. Although the opponent relies on four earlier marks, I will limit my consideration to the '664 mark because it is more similar to the applicant's mark than the other earlier marks. The marks are visually and aurally similar to a medium to high degree and conceptually different.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public. The opponent claims reputation for *video games* in class 9 and *card games* in class 28. I found that the opponent has a reputation in the UK for card games. The respective goods in class 28 are highly similar. Whilst the opponent has released a digital version of the 'DOBBLE' game, I am not sure that the evidence is sufficient to establish reputation in relation to video games. Comparing the opponent's *card games* in class 28 with the contested *Computer games; downloadable electronic games* in class 9 I find that the goods are similar to a low to medium degree, because they share the same purpose of use, namely that of amusing and entertaining the user, can be in competition with each other and whilst their nature and method of use are different, the usual commercial origin and the sales outlets for these goods can be the same in the case of large producers or large stores manufacturing or selling a range of amusement products.

The strength of the earlier mark's reputation. The opponent has a moderate reputation in the UK.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use. The earlier mark is inherently distinctive to a medium to

high degree (for those consumers who perceive the mark as an invented word evoking the word 'DOUBLE') or to a high degree (for those consumers who perceive the mark simply as an invented without making the connection with the word 'DOUBLE'). The distinctiveness of the earlier mark has been enhanced through use to a high and very high degree respectively.

Whether there is a likelihood of confusion.

I found that there is no likelihood of confusion.

92. Taking all of the above into account, I find that a significant part of that relevant public will make a link between the earlier mark with its reputation for card games and the contested mark when used in relation to *board games* (in class 28) and *computer games* and *downloadable electronic games* (in class 9).

93. Whilst I have concluded that the difference created by the letters 'C' and 'D' at the begging of the marks is sufficient to avoid the risk of confusion, the visual and aural similarities deriving from the common sequence -OBBLE are sufficiently pronounced to call the earlier mark to mind. Therefore, a link is made out for the contested goods in class 28 which are highly similar to the goods for which the opponent has a reputation.

94. Although, as I have said, the opponent does not have a reputation for goods in class 9, the evidence shows that the opponent released a digital version of the 'DOBBLE' game in 2017 and the terms *computer games* and *downloadable electronic games* in the contested specification would cover apps for card games and card games played on computers. A link is also made out for these goods.

95. Such a bringing to mind is enough for damage to arise.

Unfair advantage

96. Three heads of damage have been pleaded. I shall consider unfair advantage first.

97. Unfair advantage means that consumers are more likely to buy the goods of the contested mark than they would otherwise have been if they had not been reminded of the earlier marks. In *L'Oréal SA & Ors v Bellure & Ors*, Case C-487/07, the CJEU said:

“The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image.”

98. Earlier in the same case, the CJEU also said:

“As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.”

99. The strength of the reputation and the distinctiveness of the earlier mark is such that, in my view, use of the mark for the contested goods would constitute an unfair advantage. As the opponent pointed out, there is nothing preventing the applicant from using the mark ‘COBBLE’ in relation to a game (in class 9 or 28) involving matching pairs of images or a similar concept or even, I would add, similar round playing cards (especially if one considers that the word COBBLE refers to a round stone). In such circumstances, the relevant public would be likely to think of the ‘DOBBLE’ game and there would be, in turn, a transfer of the image of the opponent's mark or of the characteristics which it projects, i.e. fun game, to the applicant's goods so the applicant

would not have to spend as much on marketing and promotion to attract the attention of the consumer. I find that damage is made out.

100. As the applicant has not shown that it has due cause to use the contested mark, the Section 5(3) ground succeeds in its entirety.

OUTCOME

101. The opposition is successful, and the mark will be refused.

COSTS

102. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances, I award the sum of £1,600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement:	£300
Preparing evidence:	£800
Submissions in lieu:	£300
Official fees:	£200
Total:	£1,600

103. I therefore order Graham Keogh to pay ASMODEE GROUP the sum of £1,600. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 25th day of August 2022

Teresa Perks
For the Registrar