

O-429-17

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3186578
BY ELECTRONIC ARTS INC
TO REGISTER

SIMCITY BUILDIT


AS A TRADE MARK
IN CLASSES 9 & 41
AND OPPOSITION THERETO (UNDER NO. 60000612)
BY
DUF LTD

BACKGROUND AND PLEADINGS

1. Electronic Arts Inc ('the applicant') applied under No 3186578 to register **SIMCITY BUILDTIT** on 29 September 2016. The application has a priority date of 21 March 2016 based on EUTM 15243744. The mark was accepted and published on 9 December 2016 for the following goods and services:

Class 9	Class 41
Computer game software; downloadable computer game software via a global computer network and wireless devices; video game software	Entertainment services, namely, providing an on-line computer game; Provision of information relating to electronic computer games provided via the Internet.

2. Duf Ltd ('the opponent') opposes the trade mark under Section 5(2)(b) of the Trade Marks Act 1994 (the Act) using the fast track opposition procedure. This is on the basis of its earlier UK Trade Mark set out below. This mark is registered in classes 25, 37, 41 and 42 but it is only class 41 which forms the basis of the opposition.

Opponent's mark	Services relied on
Trade Mark No. 3125527  Filing date: 4 September 2015 Date of entry in the register: 18 December 2015	Class 41: Entertainment services.

3. The applicant filed a counterstatement in which it admits that its services in class 41 are 'similar or identical' to the services of the opponent. In its counterstatement it

denies that the goods in class 9 are similar to the opponent's services in the counterstatement but subsequently conceded there is similarity in their written submission.

4. The opponent's trade mark is an earlier mark, in accordance with section 6 of the Act and, as it had not been registered for five years or more at the publication date of the applicant's mark, it is not subject to the proof of use requirements, as per section 6A of the Act.

5. Rules 20(1)-(3) of the Trade marks Rules ("TMR") (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

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

6. The effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. The applicant sought leave to file evidence in this case but leave was refused in the Tribunal's preliminary view dated 26 May 2017 and subsequently reconfirmed at a Case Management Conference (CMC) which took place before another Hearing Officer on 21 June 2017.

7. Rules 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was not requested nor considered necessary in this case. I make this decision from the papers before me including written submissions.

8. The opponent represented itself in these proceedings whilst the applicant was represented by J A Kemp.

DECISION

9. I shall deal first with the opposition based on Section 5(2)(b) of the Act which states:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

10. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

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

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

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

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

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

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

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

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

COMPARISON OF GOODS AND SERVICES

11. The goods and services to be compared are:

Opponent's services	Applicant's goods and services
Class 41: Entertainment services	Class 9: Computer game software; downloadable computer game software via a global computer network and wireless devices; video game software Class 41: Entertainment services, namely, providing an on-line computer game; Provision of information relating to electronic computer games provided via the Internet.

12. With regard to the comparison of services, 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”.

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services

- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This 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 applicant has admitted that their services in class 41 are identical to the opponent's services. With regard to the class 9 goods, the applicant has admitted that:

"non-downloadable internet games in class 41 are similar to the goods appearing in class 9 of the application"

15. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court ('GC') stated that:

"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".

16. On the basis that 'entertainment services' *per se* is a broad term and will cover gaming services such as 'non-downloadable internet games', I find that the goods and services referred to above are highly similar.

AVERAGE CONSUMER AND THE PURCHASING ACT

17. I must now consider the role of the average consumer and how the goods and services are purchased. 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*.


18. 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.”

19. The average consumer for the respective goods and services are members of the general public. Non downloadable games (which are proper to class 41) can vary in price as would be the case for games software and downloadable games in class 9. Ordinarily I would expect a normal level of attention to be paid by the consumer when selecting such services and goods. The purchasing act will be mainly visual and will likely be based on factors such as technical specifications, the type of game or multiplayer functionality. Online games, both downloadable and non-downloadable, will evidently be selected from websites. Software can also be bought online or from traditional bricks and mortar retail premises. Although I have stated above that purchasing will be a primarily visual process, I do not discount that aural considerations may also play a part.

COMPARISON OF THE MARKS

20. The marks to be compared are:

Opponent's mark	Applicant's mark
	SIMCITY BUILDIT

21. 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.”

22. It would be wrong, therefore, artificially to 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.

23. The opponent's mark consists of two words, **BUILD IT**, in block capitals with a thick black rectangular border surrounding the words. The overall impression is based on this presentation.

24. The applicant's mark consists of two words, **SIMCITY BUILDT**, in plain block capitals. The overall impression of the applicant's mark is based solely on these words. There is nothing about the presentation which suggests that one word would have more weight than the other. The two elements make an equal contribution to the overall impression of the applicant's mark.

25. In a visual comparison of the marks, the point of similarity are the words **BUILD IT**. In the opponent's mark the words are presented separately whereas in the applicant's mark these words are conjoined. However, as the applicant fairly conceded in its written submission, the conjoined word "is likely to be read as 'build it'". There are points of visual difference, namely the rectangular border in the opponent's mark and applicant's mark containing the additional word **SIMCITY**. However overall I find there to be a medium degree of visual similarity.

26. In an aural comparison, the applicant's mark will vocalised in full as **SIMCITY BUILDT** whereas the opponent's mark has only the words **BUILD IT** to be vocalised. However the applicant has conceded in their written submissions that the **BUILDT** element of their mark will be pronounced in the same way as the opponent's mark. Therefore overall I find there to be a medium degree of aural similarity.

27. In a conceptual comparison, the opponent's mark will bring to mind the concept of building something. The applicant has conceded that their **BUILDT** element will also bring to mind the same concept. With regard to the other word element, the applicant states that although **SIMCITY** is an invented word, it will have a concept in the minds of knowledgeable gaming consumers as denoting the brand of a game for building virtual cities. However I cannot take the reputation of the applicant's **SIMCITY** mark into account for the purposes of a conceptual comparison. Therefore the concept of the applicant's mark is that of an invented word plus a reference to building something. On that basis I find there to be a medium degree of conceptual similarity.

DISTINCTIVE CHARACTER OF THE EARLIER MARK

28. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).”

29. No evidence was filed showing use of the earlier mark for the services relied on so I have only the inherent distinctiveness of the earlier mark to consider.

30. The earlier mark consists of an ordinary English language expression enclosed in a border. The word element is not descriptive of the services and there is nothing unusual in the use of a border as a form of presentation. Therefore I consider that the earlier mark has an average degree of inherent distinctiveness.

LIKELIHOOD OF CONFUSION

31. I must now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*).

32. So far it has been established that the services at issue in class 41 are identical and that the goods in class 9 are highly similar. In addition I found that the average consumer is a member of the general public who will select the services and goods by primarily visual means whilst paying a normal degree of attention during the purchasing process. I also found that the earlier mark has an average level of inherent distinctiveness.

33. With regard to the comparison of the marks, I have found that they are visually, aurally and conceptually similar to a medium degree.

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

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark

contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

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

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

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

35. The competing trade marks both contain the identical words **BUILD IT**, either separately or conjoined, and I have found that they are visually, aurally and conceptually similar to a medium degree. The applicant has stated that the mark **SIMCITY** is a “well known franchise of computer games” and this was conceded by the opponent in the Case Management Conference held on 21 June 2017. However

I find the words **BUILDIT** do play an independently distinctive role with the applicant's mark and will therefore lead to a likelihood of confusion.

CONCLUSION

36. The opposition has succeeded.

COSTS

37. As the opponent has been successful, it is entitled to a contribution towards its costs. I also have to consider the issue of costs in relation to the Case Management Conferences (CMCs) which took place on 21 June 2017 and 5 July 2017. The first of these CMCs was called to hear the applicant's request to file evidence which was denied. The second CMC was called to discuss the nature of the 'without prejudice' correspondence.

38. Awards of costs in Fast Track opposition proceedings are governed by Tribunal Practice Notice (TPN) 2/2015. I award costs to the opponent on the following basis:

Official fee for filing a notice of opposition:	£100
Filing a notice of opposition:	£100
Preparation and attendance at Case Management Conferences:	£100
Consideration of written submissions:	£100
Total:	£400

39. I order Electronic Arts Inc to pay Duf Ltd the sum of £400 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 12th day of September 2017

June Ralph
For the Registrar
The Comptroller-General