

**O-548-20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3446040**

**IN THE NAME OF PLAY'N GO MARKS LTD FOR THE TRADE  
MARK**

**RING OF  
ODIN**

**IN CLASS 9, 28 & 41**

**AND**

**THE OPPOSITION THERETO UNDER NUMBER OP600001379**

**BY ADP GAUSELMANN GMBH**

## Background and pleadings

1. On 21 November 2019, Play'n GO Marks Ltd (“the applicant”) applied to register the trade mark RING OF ODIN in the UK; and claimed priority for same from its European Union Intellectual Property Office (EUIPO) application, dated 14 October 2019. It was accepted and subsequently published in the Trade Marks Journal for opposition purposes on 3 January 2020. The application relates to the following goods and services:

Class 9: Computer games and video games (software), hereunder software for slot machine games, betting and wagering games, video slot games and casino games provided online and via computer networks and playable on any type of computing device including arcade games, personal computers, handheld devices and mobile phones; software for slot machine games, betting and wagering games, video slot games and casino games provided online and via computer networks and playable on any type of computing device including arcade games, personal computers and handheld devices.

Class 28: Videogaming apparatus, hereunder slot machines for gambling, gaming machines, poker machines and other video based casino gaming machines; arcade games; gaming machines, namely, devices that accept a wager; reconfigurable casino and lottery gaming equipment, hereunder gaming machines including computer games and software therefor sold as a unit.

Class 41: Games services provided online (via computer networks), hereunder providing slot machine games, betting and wagering games, video slot games and casino games, playable via local or global computer networks; online gaming services; entertainment services, namely, conducting a game of chance simultaneously at multiple, independent gaming establishments; entertainment

services, hereunder providing online computer games; prize draws [lotteries]; organising and conducting lotteries.

2. On 30 March 2020, the application was opposed under the fast track opposition procedure by adp Gauselmann GmbH (“the opponent”). The opposition is based upon Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis, inter alia, of its two earlier trade mark registrations: European Union Trade Mark EU012482221 (“the first earlier mark”) and International Registration (IR) WO0000001339715 (“the second earlier mark”). The opposition is directed against all of the goods in the application. The goods and services relied upon in this opposition are as follows:

- (i) **EU012482221** – Filing date: 8 January 2014; date registration procedure completed: 22 May 2016

## **Odin**

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Compact discs, DVDs and other digital recording media; Cash registers, calculating machines; Computer software; Fire-extinguishing apparatus; Musical jukeboxes and parts for the aforesaid automatic machines; Automatic cash dispensers, automatic money counting and money changing machines; Coin-operated mechanisms; Computer and video games software; Games software for use on any computer platform, including electronic entertainment and games consoles; Computer game programs; Computer games; Video games (software); Computer games provided through a global computer network or supplied by means of multi-media electronic broadcast or through telecommunications or electronic transmission or via the Internet; Computer games, leisure and

recreational software, video games and computer software, all being provided in the form of storage media; Programs for operating electric and electronic apparatus for games, amusement and/or entertainment purposes; automatic lottery machines; computer software for computer games on the Internet; Online games (software), in particular for online betting games, online prize games, online gambling games, online games of skill and online casino games; computer software in the form of an app for mobile devices and computers; Calculating apparatus in coin-operated machines and parts for the aforesaid goods; Apparatus for recording, transmission, processing or reproduction of data, including sound or images, including parts for all the aforesaid goods, except radio sets, television receivers, hi-fi systems, video recorders, telephone apparatus, fax machines and telephone answering machines; Computer software for casino and arcade games, for gaming machines or slot machines, video lottery gaming machines or games of chance via the Internet; Electric, electronic, optical or automatic apparatus, for identifying data carriers, identity cards and credit cards, bank notes and coins; Electric, electronic or optical alarm and monitoring installations, including video cameras and apparatus for image transmission and image processing; Electric wiring harnesses; Circuit boards, printed circuit boards (electronic components) and combinations thereof, being assemblies and parts for apparatus, included in class 9.

Class 28: Toys; Toys; Gymnastic and sporting articles not included in other classes; Decorations for Christmas trees; Gaming apparatus (including coin-operated apparatus); Automatic and coin-operated amusement machines; Games for amusement arcades (included in class 28); Coin-operated video gaming apparatus; Video games adapted for use with external screens or monitors only; Casino fittings, namely roulette tables, roulette wheels; Coin-operated automatic gaming machines and gaming

machines, in particular for gaming arcades, with or without a prize payout; Electronic or electrotechnical gaming apparatus, automatic gaming machines, gaming machines, slot machines operated by coins, tokens, banknotes, tickets or by means of electronic, magnetic or biometric storage media, in particular for commercial use in casinos and amusement arcades, with or without a prize payout; Automatic gaming machines and gaming machines, in particular for commercial use in casinos and gaming arcades, with or without a prize payout; Coin-operated gaming machines and/or electronic money-based gaming apparatus (machines), with or without prizes; Housings adapted for gaming machines, gaming apparatus and automatic gaming machines, operated by means of coins, tokens, tickets or by means of electronic, magnetic or biometric storage media, in particular for commercial use in casinos and gaming arcades, with or without a prize payout; Electronic games; Electronic game entertainment apparatus and accessories; Video output game machines; Drawing apparatus for prize games and lotteries, draws or raffles; Housings of metal, plastic and/or wood for coin-operated automatic machines; Apparatus for games (including video games), other than adapted for use with external screens or monitors only; Electropneumatic and electric pulling machines (gaming machines); Gaming tables, in particular for table football, billiards, sliding games; Arrows and flying discs (toys); Electric, electronic or electromechanical apparatus for bingo games, lotteries or video lottery games and for betting offices, networked or unnetworked; LCD games consoles; Automatic gaming machines; Including all the aforesaid automatic machines, machines and apparatus operating in networks; Apparatus and devices for accepting and storing money, being fittings for the aforesaid automatic machines, included in class 28.

Class 41: Education; Providing of training; Entertainment; Sporting and cultural activities; Rental of automatic slot machines and

entertainment machines for casinos; Arranging and conducting games; Gambling; Operating of lotteries; Operating games on the Internet, including online and being applications for smartphones; On-line games (over the Internet); provision of entertainment and/or educational content for apps for mobile devices and computers; Conducting quizzes by means of smartphone applications; Providing casino facilities (gambling), betting offices; Operating gaming establishments, arcades and/or online Internet casinos and betting platforms; Gambling services via the Internet.

(ii) WO0000001339715 – Filing date: 17 January 2017; Date of protection of the International Registration in UK: 29 September 2017

# Odin

Relying on the goods registered in class 9 only, which are almost identically worded to the earlier EU registration.

3. The opponent argues that the goods and services of the application are “identical with and/or similar to” the goods and services covered by its earlier registrations; that the marks are “closely similar”, in that its mark constitutes, and is the primary identifying element of, the applicant’s mark. The opponent further contends that the applicant’s business activities are in direct competition with its business activities. The opponent therefore claims that there is a likelihood of confusion between the marks.
4. The applicant filed a counterstatement denying the claims made and requested that the opponent is “put to strict proof that the [parties’ respective marks] are confusingly similar”.
5. The applicant further asserts in its counterstatement that the marks are different; citing that the respective marks are “different in length”: “as they

contain a different number of letters and words”; that the “first word in a mark is the most dominant”; that the marks are “aurally different in length pronunciation”; and that the marks are conceptually different.

6. An alternative argument put forward by the applicant is that “Odin is a well-known god within Norse mythology and that, by reason of its notoriety, it could not be “monopolised by one party, especially when used in a descriptive way in relation to the goods and services at question, namely media upon which a theme or story can be conveyed”.

### **Preliminary Issues**

7. The opponent in its written submissions highlights a perceived issue in relation to the depiction of its UK-protected International Registration (WO0000001339715) in the UK Registry. The opponent submits that the mark of this registration appears on the UK Register “with a small degree of unwanted pixilation”. Thereby giving the impression that it is stylised, which according to the opponent, does not represent its intended word (only) mark; as per its EU registration, from which the international/UK right emanates. I note that the opponent is at liberty to explore its options to rectify the alleged anomaly independently of these proceedings.
8. It is important to clarify that said apparent discrepancy has had no effect on my decision. It is trite to point out that EUTM registrations provide protection in the UK. Furthermore, the IR relies on goods in class 9 only, which are almost identically worded to the earlier EU registration. Therefore the issue of the depiction of the IR on the UK Register would only come into play if I reach a determination against the opponent on the identity of the marks in relation to the EU registration. I will say more on this later.
9. A further issue for clarification is the applicant’s assertion that: “consumers upon perceiving the Opponent’s marks, will interpret them as a direct indication of the theme of the games offered, rather than indications of commercial origin. Furthermore, descriptive marks should remain free for all to use” and; “the

Opponent's Registrations are invalidly registered because Odin, in the context of games themed around the god Odin is descriptive and devoid of distinctive character".

10. The issue of validity in relation to a registered trade mark is covered by section 72 of the Act, which provides:

"In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmissions of it."

11. On this point, the comments of the CJEU in *Formula One Licensing BV v OHIM*, Case C-196/11P are also relevant, where it held that:

"41. ....it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.



44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

12. At the time of writing this decision there was no indication that the applicant had instituted invalidation proceedings against the opponent’s earlier trade marks. Therefore, in light of all of the foregoing, it is not open to me to find that the earlier marks have no distinctive character; because this would be tantamount to a finding that the earlier marks are invalidly registered. I will return to this point when I consider the distinctive character of the earlier marks.

### **Procedural Background**

13. In these proceedings the applicant is represented by Appleyard Lees IP LLP; Dr Walther Wolff & Co represents the opponent.

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

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

15. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings. Evidence constitutes facts. Since leave must be sought to file evidence, the contents of the counterstatement which relate to facts concerning the applicant’s business could be deemed admissible in these proceedings. I will say more about the content of the counterstatement later in this decision.

16. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at a proportionate cost; otherwise, written arguments will be taken.

17. A hearing was neither requested nor considered necessary. The opponent filed written submissions in lieu of a hearing. The applicant did not file written submissions, but I will treat the contents of its counterstatement as its written submissions.

## **DECISION**

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

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

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

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

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

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

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

a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which

has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

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

20. Given its dates of filing (8 January 2014 in relation to the EUTM and 17 January 2017 for the IR), the opponent’s marks qualify as earlier marks in accordance with the above provisions.

21. As these earlier trade marks have not been registered for more than five years at the date the application was filed, they are not subject to the proof of use provisions contained in section 6A of the Act.<sup>1</sup> The opponent is, as a consequence, entitled to rely upon them in relation to all of the goods and services indicated without having to prove that genuine use has been made of them. Therefore, I must make the assessment based upon the full width of the goods and services relied upon by the opponent, regardless of whether or not the marks have actually been used in relation to those goods and services. This is because the opponent is entitled to protection across the breadth of what it has registered on a ‘notional’ use basis.

### **Section 5(2)(b) – case law**

22. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*,

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<sup>1</sup> As these proceedings commenced after 14 January 2019, when the Trade Mark Regulations 2018 came into force, the relevant period for proof of use purposes is the five years prior to and ending on the date of application of the contested application.

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 greater degree of similarity between the marks, and vice versa;

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

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

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

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

### **Comparison of goods and services**

23. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

“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”.

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

- a. The respective users of the respective goods or services;
- b. The physical nature of the goods or acts of services;
- c. The respective trade channels through which the goods or services reach the market;
- d. In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e. The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

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

26. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en*

*Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

### **Similarity of goods and services – Nice Classification**

27. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

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

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

### **Class 9 Goods Comparison**

28. The applicant’s goods specification under class 9, for ease of analysis, are subdivided as: (i) “computer games and video games (software) hereunder software for slot machine games, betting and wagering games, video slot games and casino games”; (ii) “software for slot machine games, betting and wagering games, video slot games and casino games”. Both subdivisions further specify, in identical terms, that these goods are “provided online and via computer networks and playable on any type of computing device including arcade games, personal computers and handheld devices”; with the exception that the former subdivision also includes “mobile phones”.

29. “Computer games and video games (software)”; and “software for slot machine games”, as included within the applicant’s specification, are collectively software for gaming. This term falls within the scope of the opponent’s wider term “computer software”, in the same class. Therefore these goods are identical on the principle established in *Meric*.

### **Class 28 Goods Comparison**

30. Under class 28 the applicant specifies “videogaming apparatus, hereunder slot machines for gambling, gaming machines, poker machines and other video based casino gaming machines”. These terms are included in the opponent’s specifications respectively as: “Coin-operated video gaming apparatus”; “Gaming apparatus and (including coin-operated apparatus)”. Although the term “poker machine” does not appear in the opponent’s specifications, a direct counterpart is evident in “Coin-operated video gaming apparatus” and/or in “Electronic or electrotechnical gaming apparatus, automatic gaming machines, gaming machines, slot machines operated by coins, tokens, banknotes, tickets or by means of electronic, magnetic or biometric storage media, in particular for commercial use in casinos and amusement arcades, with or without a prize payout”. Therefore “poker machine” is at least *Meric* identical.

31. The broad term, “other video based casino gaming machines” also falls within either of the opponent’s broader specifications: “Automatic gaming machines and gaming machines, in particular for commercial use in casinos and gaming arcades, with or without a prize payout”; “Apparatus for games (including video games), other than adapted for use with external screens or monitors only”; “Coin-operated video gaming apparatus”; or “Video games adapted for use with external screens or monitors only”. On this non-exhaustive list, said goods are identical on the principle outlined in *Meric*.

32. “Arcade games; gaming machines, namely, devices that accept a wager” are all goods which fall within the opponent’s specifications; albeit the latter is expressed in slightly different terms (“Coin-operated automatic gaming



machines and gaming machines, in particular for gaming arcades, with or without a prize payout”). Therefore these are identical.

### **Class 41 Services Comparison**

33. The terms “games services provided online (via computer networks) ... ; online gaming services; entertainment services ...; and prize draws [lotteries]; organising and conducting lotteries” are all encompassed by the same or direct counterparts in the opponent’s specification. The latter of which includes: “Operating games on the Internet, including online and being applications for smartphones”; “On-line games (over the Internet)”; “Operating gaming establishments, arcades and/or online Internet casinos and betting platforms”; “Gambling services via the Internet”; “Operating of lotteries”; and “Entertainment”. These services are therefore identical.

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

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

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.

35. For the purpose of assessing the likelihood of confusion, it must also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.
36. As a preliminary point, it is settled law that, when assessing the likelihood of confusion, the public with the lowest level of attention must be taken into account. I have also considered that the respective goods and services are likely to be bought by different categories of consumers, which I refer to as commercial consumers and the general public (though I am aware that age restrictions apply in relation to gambling goods and services).
37. Commercial consumers, those businesses purchasing goods and services for profit-making ventures, would exercise a higher degree of attention; especially as they may procure the items in bulk and expend more for high-end items.
38. The general public is likely to have an average degree of attention when making purchases. According to the General Court of the EU, computer games and computer software are “no longer sold merely on ‘focused markets’ but have gone ‘mainstream’ (*Kalypso Media Group v EUIPO — Wizards of the Coast (DUNGEONS)* (Case T-700/18) at paragraph 36). In this case the Court went on to say (at paragraph 37) that:

‘[I]n view of the availability and distribution of those goods and services on the market and of the fact that special skills or knowledge are not indispensable or required in order to purchase them, it cannot be excluded that consumers who do not have such knowledge or skills may purchase such goods. This may, for example, be the case for those who buy the games or computer games in question in order to make a gift to someone else, or for those who proceed with a purchase to find out more about the product. Such consumers are also part of the relevant public, as are the most discerning consumers.’

39. The purchase of the goods and services is, predominantly, a visual one; as they will be bought by self-selection whether from a shelf in a store or from an online outlet and may have come to the average consumer's attention via visual promotional material; though this is not to the exclusion of the other considerations. They are also easily accessible: in a few clicks or taps, anyone can download a game onto their smart devices (a mobile phone, tablet, TV or even a car). In the light of these considerations, an (at best) average degree of attention or care would be taken over the purchase of the goods and services at issue.


### **Comparison of the marks**

40. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

41. 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

42. The respective trade marks are shown below:

<p>Odin</p> 	<p>RING OF ODIN</p>
<p>Earlier trade mark</p>	<p>Contested trade mark</p>

43. The opponent’s earlier mark consists of the word “Odin”, with a case distinction; that is, with its first letter in uppercase and the remaining letters in lowercase. As regards the second of the opponent’s marks, as earlier indicated, this would not form the focus of my analysis. However, for the avoidance of doubt, I consider that the overall impression of that mark is dominated by the word itself, while the stylisation plays a secondary role. The overall impression of the earlier marks resides solely in the word ODIN. The applicant’s mark, RING OF ODIN, is presented in uppercase only. As fair and notional use of word marks mean they may be used in any case (lower, upper or title), I do not consider this a factor that adds to the overall impression of the marks. The overall impression of the applicant’s mark is that it is a phrase – the ring which belongs to Odin. ODIN is marginally more dominant than RING because it is ODIN which qualifies to whom the ring belongs.

**Visual and Aural Comparisons**

44. There is an obvious similarity, both visually and aurally, between the marks because of the shared element “ODIN”. However, the applicant contends that the marks are visually and aurally different; as “they contain a different number of letters and words”. The applicant’s “consists of three words of ten letters in total”: “RING OF ODIN”. Whereas the earlier mark is a single word of four letters, “ODIN”.

45. The visual difference between the marks is also obvious given that the shared element, “Odin”, is prefixed by “Ring of” in the applicant’s mark; whereas the

opponent's mark is solely "Odin". The average consumer will read the text in the way in which it is normally read in English, that is, from left to right. Therefore, given my earlier assessment of the overall impressions, I consider that the respective marks are visually similar to a medium degree.

46. Aurally, "Ring of" does contribute to the overall impression of the applicant's mark. This obvious point of difference does not overcome the fact that the shared element (Odin) is pronounced identically between the respective marks. I also believe that, in the case of the applicant's mark, the average consumer may place emphasis on Odin, as the marginally more dominant element. The fact of the identical pronunciation of the common element alone, inevitably leads to a degree of aural similarity between the marks. Therefore, I consider that the marks are aurally similar to a medium degree.

### **Conceptual Comparison**

47. The applicant, in its Counterstatement, submits that the respective marks are conceptually different. It argues inter alia:

"Conceptually, the Opponent's Registrations refer to Odin, a prominent god who has featured in the history and folklore of northern Europe for millennia. In the context of games or goods and services themed around mythology, consumers are likely to regard the term Odin as a reference to the legend rather than as an indication of origin. The subject of the Applicant's mark is Odin's ring, known as Draupnir, and the concept of its influence and power, not Odin himself. Odin's ring has its own detailed folklore, for instance, it was one of three items forged as part of a wager (the others being Thor's hammer and a boar whose mane glowed in the dark) and having been placed by Odin on the funeral pyre of his son, revealed an ability to multiply itself. As a consequence, Odin's ring has a semantic connotation with wagers and rewards and a unique identity separate and distinct from Odin himself."

48. The opponent essentially agrees that “Odin is the name of a widely revered god in Germanic (and Norse) mythology and in this mythology the 'Ring of Odin' is a gold ring possessed by the god Odin (the ring having the ability to multiply itself).” It is therefore clear that the marks share a common concept.
49. In my view this makes ODIN the most distinctive element in the respective marks. This is particularly relevant for the part of the public familiar with Norse mythology. However, a substantial proportion of the relevant public will not have detailed knowledge of Norse mythology.
50. The applicant further submits that “Odin’s ring [is] known as Draupnir” [my emphasis]. Firstly, detail of this type should be formally adduced into evidence. Secondly, even if I were to take judicial notice of this submission, it would not assist the applicant’s case. Although the marks are not conceptually identical because the applicant’s mark contains the additional concept of a ring, from the perspective of the consumer with knowledge of Norse mythology, they are conceptually similar to a medium to high degree. For those who do not know what ODIN means, there will still be a reasonable degree of conceptual similarity because the construction of the applicant’s mark means it will be perceived as a name: a ring belonging to Odin.

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

51. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.
52. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing*

*Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

53. From its counterstatement, I note the applicant's argument that: (i) "‘Odin’ is a well-known god within Norse mythology, the concept of 'Odin' cannot be monopolised by one party, especially when used in a descriptive way in relation to the goods and services in question, namely media upon which a theme or story can be conveyed" and; (ii) "the Opponent cannot enforce its Registrations against the Application, as consumers upon perceiving the Opponent's marks, will interpret them as a direct indication of the theme of the games offered, rather than indications of commercial origin".

54. The applicant has filed no evidence to substantiate the latter claim on the use of the mark on Odin-themed games; nor on the alleged consumer perception. It is settled law that, even if an earlier registered trade mark can be perceived as an allusion to a term referring to goods or services covered by it, it should be recognised in opposition proceedings that the earlier trade mark has a minimal intrinsic distinctive character because it has been registered.<sup>2</sup>

55. The distinctiveness of a mark can be enhanced by virtue of the use made of it. In this case, the opponent has not pleaded that its marks have acquired enhanced distinctiveness through use and has not filed any evidence to support such a claim. Consequently, I have only the inherent position to consider.

56. In assessing the inherent distinctiveness of the earlier mark, I considered the perspectives of the average consumer with knowledge of Norse mythology and the average consumer without such knowledge. Those with the relevant knowledge will recognise that Odin is not an invented word and that it has some meaning in relation to the goods and services concerned. From this perspective, the earlier mark has an average degree of inherent distinctiveness.

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<sup>2</sup> See section 72 of the Act and *Formula One Licensing BV v OHIM*, Case C-196/11 P, CJEU, paragraphs 41 to 44.

57. Conversely, against the backdrop of the average consumer who sees Odin as an invented word, or a word with no particular meaning in relation to the goods or services at issue, the mark is of a high degree of inherent distinctive character.

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

58. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

59. There are two types of possible confusion: direct (where the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). The distinction between these was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10. He said:

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



the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

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

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

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

60. The applicant submits that “[t]he first word in a mark is the most dominant. It is the first word that the relevant public will read and so is more likely to be remembered. The first word of the mark in the Application is ‘RING’. The first [and only] word in the Opponent’s Registrations is ‘ODIN’”.

61. It is true that there is a general rule of thumb that the beginning of a mark is likely to have more visual and aural impact than the remainder (the comments of the GC in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 refer); however, bearing in mind my assessment that “Odin” is marginally more

dominant than “Ring of”, I do not consider that the latter is more likely to be remembered by the average consumer; though I conclude (later) that it will assist in another respect.

62. Earlier in this decision I concluded that the marks are visually and aurally similar to an average degree. Their conceptual similarity ranges from reasonable to high; respectively, for consumers who do not know what Odin means and for those who do. The converse applies in relation to the level of inherent distinctiveness for the earlier mark: knowledge of Norse mythology would lead to an average degree of inherent distinctiveness; and to a high degree of inherent distinctive character in the case of the average consumer not knowing its meaning. The goods are identical and will be purchased with varying degrees of attention: to a high degree for the commercial consumer and to a medium degree for the average general public. The purchase of the goods and services is predominantly a visual one though not to the exclusion of aural considerations.

63. Notwithstanding the principle of imperfect recollection, and taking all of the above factors into account, I consider that the additional words “Ring of” at the beginning of the contested mark will be sufficient to enable the consumer to differentiate between them. This applies particularly in circumstances where the commercial consumer pays a high degree of attention when selecting the goods and services at issue and; (to a lesser degree) in the case of the average consumer exhibiting a medium level of care. Therefore I do not consider that there is a likelihood of direct confusion.

64. Although I consider that the average consumer will notice that there is a difference between the marks and is unlikely to directly confuse one for another, confusion works both ways; and I must also consider the possibility of indirect confusion. In my view, the average consumer would believe that there is an economic connection between the marks or that they are variant marks from the same undertaking as a result of the shared common element. I also maintain this view in relation to the commercial consumer who will pay a high degree of attention when selecting the goods and services at issue. The high

level of attention will not overcome the likelihood of indirect confusion because the dominance of the word “ODIN” in the earlier mark, coupled with the identical nature of the respective goods and services and the element of competition between them, means that the average consumer is likely to assume that “RING OF ODIN” is an extension or sub-brand of “ODIN”. As a consequence, the average consumer is likely to assume that the goods are produced by the same or economically linked undertakings, thereby resulting in indirect confusion.

65. Given all of the above factors and findings, I find that there is a likelihood of confusion under section 5(2)(b) of the Act.

### **Conclusion**

66. The opposition has succeeded in full. Subject to appeal, the application is refused.

### **COSTS**

67. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in fast track opposition proceedings are governed by Tribunal Practice Notice 2/2015. Using that TPN as a guide, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant’s statement:	£200
Opposition fee:	£100
Written submissions	£200
<b>Total:</b>	<b>£500</b>

68. I order Play'n GO Marks Ltd to pay to adp Gauselmann GmbH the sum of £500.

This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 4<sup>th</sup> day of November 2020**

**Denzil Johnson,  
For the Registrar**