

O/0792/24

**TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION NO. 3576134
IN THE NAME OF WHOLESALE GAMES LIMITED
TO REGISTER**

ZEUS LIGHTNING

**AS A TRADE MARK IN CLASS 41
AND
OPPOSITION THERETO (UNDER NO. 424726)
BY
LIGHT & WONDER, INC.**

Background and pleadings

1. On 7 January 2021, Wholesale Games Limited (“***the Applicant***”) applied to register in the UK the trade mark shown on the cover page of this decision, under number UK00003576134 (“***the Contested Mark***”). The Contested Mark claims a priority date of 8 July 2020 from the trade mark number 90042217 filed in the United States of America (US). Details of the application were published for opposition purposes on 26 February 2021. Registration is sought for the following services:

Class 41 Entertainment services, namely, providing temporary use of non-downloadable interactive games; Interactive entertainment services, namely, providing temporary use of non-downloadable interactive games; Gaming services provided on-line from a computer network in the nature of casino gambling.

2. On 27 May 2021, Light & Wonder, Inc. (“***the Opponent***”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“***the Act***”). The Opponent relies upon the prior trade mark registrations set out in the Annex to this decision (“***the Earlier Marks***”). The opposition is directed against all the services in class 41.

3. For the purposes of the opposition, the Opponent relies upon all of the goods and services for which the Earlier Marks are registered as indicated in the Annex.

4. The Earlier Marks are comparable marks (EU)¹ and by virtue of their respective earlier filing dates, the prior registrations set out in the Annex constitute earlier marks within the meaning of section 6 of the Act.

5. Given the respective registration dates of the Earlier Marks (as indicated in the Annex), they had not completed their registration process more than five years before the filing date of the application in issue. Thus, they are not subject to proof of use pursuant to section 6A of the Act. The Opponent can, therefore, rely upon all of the goods and services it has identified without having to demonstrate use.

¹ Following the end of the transition period of the UK’s withdrawal from the EU, all EU trade marks (“EUTM”) registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (EU)’ retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

6. In its notice of opposition,² the Opponent essentially contends that the Contested Mark reproduces Mark 1 in its entirety and that Mark 2 and Mark 3 share with the Contested Mark the dominant and distinctive element “ZEUS”. Therefore, the Opponent argues that the Earlier Marks and the Contested Mark are similar and that the contested services are identical or similar to the Opponent’s goods and services, giving rise to a likelihood of confusion under section 5(2)(b) of the Act.
7. On 21 December 2022 Wholesale Games Limited filed its defence and counterstatement, denying the grounds of opposition. More specifically, the Applicant argued that the Contested Mark contains the distinctive element “LIGHTNING” and that by deleting class 9 and limiting class 41 any similarity or identity between the competing goods and services has been removed.
8. Subsequent to the filing of the counterstatement,³ a preliminary indication was issued to the parties under the provision of Rule 19 of The Trade Marks Rules 2008.⁴ That indication was that there exists a likelihood of indirect confusion in respect of all of the services. The Applicant gave notice that it wished to proceed to evidence rounds.⁵ The preliminary indication, given by a different Hearing Officer, is not binding upon me and will have no bearing upon my decision.
9. The Opponent notified the Tribunal⁶ that it had changed its name from Bally Gaming, Inc. to SG Gaming, Inc. in 2020, and that had assigned its UK trade mark registrations to Light & Wonder, Inc. on 1 February 2023. The Opponent filed the appropriate forms on 4 April 2023 to record this change of name/change of ownership in relation to all its relevant trade marks at the UK IPO including the Earlier Marks on which the opposition is based.
10. The Opponent is represented by Cleveland Scott York. The Applicant is represented by Barker Brettell LLP.
11. During the evidence rounds neither party filed evidence. Neither party requested a hearing, but the Opponent filed submissions in lieu⁷ which will not be summarised

² Dated 2 June 2021.

³ Dated 21 December 2022.

⁴ Official letter dated 10 January 2023.

⁵ As per form TM53, filed on 10 February 2023.

⁶ Communication from the opponent dated 29 June 2023.

⁷ Dated 12 February 2024.

here, but I will refer to them as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

Relevance of EU law

12. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence and submissions

Approach

13. The Opponent relies upon three earlier registrations in the notice of opposition. It seems to me that the Opponent's strongest case clearly lies with the Earlier Mark 1. This is due to the additional words "SON OF KRONOS" in the Earlier Mark 2 and "UNLEASHED" in the Earlier Mark 3 which introduce further points of difference visually, orally, and conceptually between these marks and the Contested Mark. Additionally, the specifications of the Earlier Mark 2 and Earlier Mark 3 do not contain any terms in class 41 that would enhance the Opponent's position. Thus, I will proceed accordingly.

Decision

The law

14. The relevant parts of section 5 of the Act are as follows:

"5(1) [...]

(2) A trade mark shall not be registered if because—

(a) [...]

(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.”

“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.”

Case law

15. 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

16. The competing services are as follows:

| Opponent's goods | Applicant's goods |
|--|--|
| <u>Class 41</u> | <u>Class 41</u> |
| Providing an online computer game; electronic games services provided by means of the internet; providing computer games and wagering games through a computer or mobile | Entertainment services, namely, providing temporary use of non-downloadable interactive games; Interactive entertainment services, namely, providing temporary use of non-downloadable |

| | |
|---|---|
| platform; providing online computer games through a social media platform; none of the aforesaid services being for training or educational purposes. | interactive games; Gaming services provided on-line from a computer network in the nature of casino gambling. |
|---|---|

- *“Entertainment services, namely, providing temporary use of non-downloadable interactive games; Interactive entertainment services, namely, providing temporary use of non-downloadable interactive games; none of the aforesaid services being for training or educational purposes”*

17. The terms above essentially are “non-downloadable interactive games” and, even if worded differently, they are identical to the Opponent’s “*electronic game services provided by means of the internet*”.

- *“Gaming services provided on-line from a computer network in the nature of casino gambling; none of the aforesaid services being for training or educational purposes”*

18. The above term essentially identifies the provision of online computer games consisting of casino gambling. Thus, this term, although worded differently, is self-evidently identical to the Opponent’s term “*providing computer games and wagering games through a computer or mobile platform*”.

The average consumer and the nature of the purchasing act

19. It is necessary to determine who the average consumer is for the respective parties’ services. I must then decide the manner in which these services 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”.

20. The average consumer of the category of services concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96, *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31).
21. For the purposes 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 services in question.⁸
22. The average consumer for the services in Class 41 (online game services, including betting games) will be a member of the general public (end users who play the games and who are likely to be over the age of 18) as well as businesses offering the services in their own premises. I consider the costs of the services will vary from low (for end users accessing single games) to possibly fairly high (for businesses providing the games on a larger scale) and that the services will be purchased fairly regularly by frequent game players (including gamblers) and more infrequently by a more casual purchaser. The average consumer will likely consider cost, suitability, game play (as well as chances of winning and potential returns for betting games). I therefore find the degree of attention will vary from medium (average) for the general public to above average for the businesses. However, the likelihood of confusion must be assessed from the perspective of the former (the general public) since they are the group who will pay the lower degree of attention.⁹ I consider the purchase of the services to be mainly visual with the mark being placed on websites, mobile apps, or machines in arcades, but I do not discount aural word of mouth recommendations.

Comparison of trade marks

⁸ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, (Case C-342/97, para 26).

⁹ Case T-356/14, [25] – [26].

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

24. 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”.

25. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

26. The trade marks to be compared are as follows:

| Earlier trade mark | Contested trade mark |
|--------------------|----------------------|
| ZEUS | ZEUS LIGHTNING |

Overall impression

27. The overall impression of the Earlier Mark resides in the word "ZEUS" of which it is composed.

28. In the Contested Mark I find that the words "ZEUS" and "LIGHTNING" are not correlated to create a unitary meaning, but each retain an independent distinctive role being equally dominant in the mark and equally contributing to the overall impression.

Visual similarity

29. The Earlier Mark consists of the single word “ZEUS”. The Contested Mark is comprised of the words “ZEUS” and “LIGHTNING”. Both marks are represented in standard typeface, capitalised letters, and coincide in the word “ZEUS”, this being placed at the beginning of the Contested Mark. The Earlier Mark is a relatively short mark whilst the Contested Mark is a longer mark comprising two words. Overall, I find the marks have a medium degree of visual similarity.

Aural similarity

30. The Earlier Mark is comprised of a one-syllable word. The Contested Mark features two words with the former (ZEUS) being identical to the Earlier Mark and the latter (LIGHTNING) forming a two-syllable word. All the words constituting the competing marks are English dictionary words and the relevant consumers will voice them accordingly. The relevant consumers will find the Contested Mark longer in its enunciation than the Earlier Mark.

31. Therefore, I find the marks to be aurally similar to a medium degree.

Conceptual similarity

32. The Opponent submitted that ‘Zeus’ *“is well known as the name of the King of the gods in Greek mythology. Because he is the King of the gods, Zeus is one of the most important members of the Greek Pantheon, and is the subject of many famous Greek myths and legends. Zeus is also associated with thunder and lightning, and for retaining law and order”*.¹⁰ Accordingly, the Opponent argued that in the Contested Mark *“the word LIGHTNING describes an attribute of the Greek god Zeus”*.¹¹ I agree with the Opponent that a significant proportion of the relevant consumers is likely to understand the respective marks as clearly referring to the ancient Greek god of thunder Zeus and perceive the word ‘LIGHTNING’ in the Contested Mark as indicating an attribute that is typically associated with Zeus. I also find that a separate, significant proportion of consumers is likely to understand “ZEUS” as the Greek god, but not to be aware of the relationship between Zeus and lightning. This section of consumers is likely to understand the two words in

¹⁰ Opponent’s submissions in lieu dated 12 February 2024.

¹¹ Opponent’s submissions in lieu dated 12 February 2024.

the Contested Mark individually, each in its own meaning. Thus, regarding the former proportion of consumers I find the marks to have a high degree of conceptual similarity, whilst regarding the latter I find the marks to have a medium degree of conceptual similarity.

Distinctive character of the Earlier Mark

33. 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).”

34. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the services, to those with high inherent distinctive character, such as invented words.

35. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the Opponent has filed no evidence of use of its mark. Accordingly, I have only the inherent position to consider.
36. The Earlier Mark is the English dictionary word “ZEUS” indicating the name of the chief god of the ancient Greeks. Therefore, the Earlier Mark is an arbitrary dictionary word that is neither descriptive of the services at hand nor does it have any other semantic correlation with the services. For this reason, I find the Earlier Mark has an above average degree of inherent distinctive character.

Likelihood of confusion

37. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep 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]).
38. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other (*L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10).
39. I have found the respective services to be identical. The level of attention is medium for the general public. The distinctiveness of the Earlier Mark is above average. The visual and aural similarity is medium; the competing marks are either conceptually highly similar or similar to a medium degree according to how the relevant consumers will understand the word “ZEUS” in both marks. The purchase of the contested services is considered to be mainly visual but the potential for aural use is borne in mind. The Contested Mark fully contains the Earlier Mark, however it also contains an additional (relatively long) dictionary word that the relevant consumers are likely to perceive independently from “ZEUS”. Therefore, I find that the marks are unlikely to be mistakenly recalled or misremembered as each other and I do not consider there to be a likelihood of direct confusion.

40. It now falls to me to consider the likelihood of indirect confusion. The concept of indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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)”.

41. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of

Appeal.¹² I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.¹³ The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.¹⁴

42. I found above that a significant proportion of consumers is likely to understand “ZEUS” as being the ancient Greek god associated with lightning. Therefore, for this significant section of the relevant consumers, the word “LIGHTNING” in the Contested Mark is likely to be perceived as an attribute merely reinforcing the concept of “ZEUS”. It follows that, also taking into consideration the distinctive character of the Earlier Mark, a significant proportion of the relevant consumers will likely see the Contested Mark as a sub-brand or brand extension deriving from the Earlier Mark and will likely believe that both marks originate from the same or economically linked undertakings. As a result, I find that there is a likelihood of indirect confusion.

Conclusion

43. The opposition succeeds and the application will be refused for all services.

Costs

44. The Opponent has been successful and is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice (“TPN”) 2/2016. Bearing that scale in mind, I award costs to the Opponent as follows:

| | |
|---|-------------|
| Official fee | £100 |
| Preparing the notice of opposition and considering the counterstatement | £200 |
| Submissions in lieu | £300 |
| Total: | £600 |

¹² *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

¹³ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.

¹⁴ *Liverpool Gin Distillery*.

45. I order Wholesale Games Limited to pay Light & Wonder, Inc. the sum of **£600**.

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 19th day of August 2024

Andrea Rossi

For the Registrar

ANNEX

The Opponent's Earlier Marks

1) UK00915352271

Mark 1: ZEUS

Goods and services relied upon for the opposition:

Class 28 Gaming machines that generate or display wager outcomes; currency-, coin- and/or credit-operated slot machines, fruit machines and gaming machines; slot machines, fruit machines and gaming machines, all of the aforesaid being related to gaming, gambling, betting and sports.

Class 41 Providing an online computer game; electronic games services provided by means of the internet; providing computer games and wagering games through a computer or mobile platform; providing online computer games through a social media platform; none of the aforesaid services being for training or educational purposes.

Filed: 18/04/2016

Date of entry in the register: 21/03/2017

2) UK00915773476

Mark 2: ZEUS SON OF KRONOS

Goods and services relied upon for the opposition:

Class 9 Software for currency, coin and/or credit operated slot machines, fruit machines, gaming machines and gaming devices; electrical components for gaming machines that generate or display wager outcomes, including controllers, displays, button panels, electrical wiring, and computer hardware and software associated therewith; computer hardware and software for non-electrical components for gaming machines that generate or display wager outcomes; gaming software.

Class 41 Providing an online computer game; electronic games services provided by means of the internet; providing computer games and wagering

games through a computer or mobile platform; rental of gaming machines; rental of fruit machines; rental of slot machines; none of the aforesaid services being for training or educational purposes.

Filed: 24/08/2016

Date of entry in the register: 11/01/2017

3) UK00917416256

Mark 3: ZEUS UNLEASHED

Goods and services relied upon for the opposition:

Class 9 Software for currency, coin and/or credit operated slot machines, fruit machines, gaming machines and gaming devices; electrical components for gaming machines that generate or display wager outcomes, including controllers, displays, button panels, electrical wiring, and computer hardware and software associated therewith; computer hardware and software for non-electrical components for gaming machines that generate or display wager outcomes; gaming software.

Class 41 Providing an online computer game; electronic game services provided by means of the internet; providing computer games and wagering games through a computer or mobile platform; rental of gaming machines; rental of fruit machines; rental of slot machines; none of the aforesaid services being for training or educational purposes.

Filed: 30/10/2017

Date of entry in the register: 28/03/2018