

**O/1070/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBER 3945436**

**BY Mattel, Inc**

**TO REGISTER THE FOLLOWING MARK IN CLASS 28**

**ESCAPE ROOM IN A BOX**

### **Background**

1. On 14 August 2023 Mattel, Inc. (the applicant) applied to register the above mark for the following goods:

Class 28 - Board games; tabletop games; tabletop cooperative puzzle games; tabletop cooperative games consisting of riddles, clues, puzzles, and brainteasers that players must solve within a set time limit.

2. On 26 September 2023 the Intellectual Property Office ("IPO") issued an examination report in response to the application informing Keltie ("the first attorney") that a search of the Register had revealed five earlier marks which were considered to be similar to the mark of this application and that the examiner was obliged to inform the owners of those marks that this mark was going to be published in the online Trade Mark Journal. No objection was raised under Section 3 of the Act. The applicant was given two months to consider if they wished to proceed in the face of the earlier marks. As nothing was received from the first attorney the examiner wrote to them on 6 December 2023 to inform them that the application would now be published in the online Trade Marks Journal. The publication took place on 8 December 2023.

3. Following publication the following observations were received under Section 38(3) which states "*Where an application has been published, any person may, at any time before the registration of the trade mark, make observations in writing to the registrar as to whether the trade mark should be registered; and the registrar shall inform the applicant of any such observations*" These were received from the following

a. Jo Smedley of Red-Herring Games who informed the IPO that there are a number of indie game designers who use the term 'Escape room in a box' as a descriptive term of a puzzle game that has a series of puzzles that require solving, each providing the answer to some codes/locks in similarity with an escape room. He went on to say that the term has been in generic parlance among puzzle players and designers for several years and is a descriptive term employed by everyone.

b. 'postcurious' who stated that the term "ESCAPE ROOM IN A BOX" is inherently descriptive and generic within the context of the gaming and entertainment industry. It is a term widely used by various entities, including

independent and small-scale creators, to describe a type of gaming experience. Granting exclusive rights to this term to a single entity would unfairly restrict competition and the ability of others to describe their products or services accurately. Just like the term “ESCAPE ROOM” describes an entire genre of live gaming, the term “ESCAPE ROOM IN A BOX” describes a similar type of cooperative puzzle-solving gameplay but in the format of a tabletop game rather than a live ticketed event.

4. On 6 February 2024 the examiner wrote to the observers, neither of whom wished to be anonymised, informing them that she had written to the applicant advising that the mark may have been accepted in error and that she may, at a later date, refuse to register the mark under the provisions of Section 40 of the Trade Marks Act 1994. On the same date she wrote to the first attorney enclosing copies of the observations and in view of the new information contained in the observations she considered the application had been accepted in error and was not acceptable for the following reason:

***Absolute grounds for refusal***

*The application is not acceptable in Class 28. There is an objection under Section 3(1)(b) and (c) of the Act. This is because the mark consists exclusively of a sign which may serve in trade to designate the kind of the goods e.g. escape room themed games contained within a box.*

*The Oxford English Dictionary defines the term ‘Escape Room’ as: ‘A leisure activity in which a group of people must solve a series of puzzles against the clock in order to escape from a locked room or rooms’. It is felt that the addition of the term ‘in a box’ merely serves to inform the consumer that the escape room activity is in the form of a game contained within a box.*

*Research conducted using the search engine Google UK on 06/02/2024, with the search term “escape room in a box”, has shown that the term ‘escape room in a box’ is in use to describe boxed games that feature an escape room activity. Please see Annex A for examples of this research. (Annex A is attached to the end of this Statement).*

*In order to function as a Trade Mark your mark must be distinctive and not descriptive of the goods being offered. I do not feel that your mark conveys any brand origin and the relevant consumer would not easily recognise your goods from one undertaking to another. Therefore, it cannot function as a Trade Mark.*

The first attorney was given two months in which to reply.

5. On 5 April 2024 Allen & Overy LLP (we will now refer to as the attorney) informed the IPO that they had taken over representation of the application and requested a hearing.

6. The hearing took place on 8 May 2024 and was attended by Mr Stone of the attorneys. Mr Stone informed me that an identical mark had been accepted in the US

in 2016. He went on to say that he did not agree with the objections and felt that the examples of use of the term 'escape room in a box' sent by the examiner with the examination report were not sufficient to show that the term was descriptive; furthermore he contended that the use by 'Trapped' and 'Virgin' appearing to be trade mark use. I was then directed to to the applicant's website where he considered their use to be trade mark use. Mr Stone stated that only a low, minimum degree of distinctive character is necessary for acceptance and this mark is just catchy enough to have that level of distinctive trade mark character, adding that it is not possible (literally) to put a room in a box.

7. I considered all of Mr Stones' submissions but was not persuaded to waive the objection. An 'escape room' is a game in which participants are confined to a room or other enclosed settings and are given a set amount of time to find a way to escape, maybe by discovering clues or solving riddles or puzzles. This much is clear from the dictionary definition supported by judicial notice based on personal knowledge. Many towns and cities have escape rooms and I think it is unlikely that members of the general public would be unaware of what they are. Anyone seeing 'escape rooms in a box' on boxed games would merely see this as a means of playing 'escape rooms' in their own home. It is unlikely that the consumer would give the sign any trade mark significance in my opinion.

8. At the hearing Mr Stone suggested that if the specification of this application was limited to exclude puzzle games the mark should be acceptable. I informed him that this limitation would lead to uncertainty and I referred to the decision in *Postkantoor* (363/99) where it was stated that '*the Directive prevents a trade mark registration authority from registering a mark for certain goods or services on condition that they do not possess a particular characteristic*' as this would lead to legal uncertainty as to the extent of the protection afforded by the mark, (see paragraph 20). Mr Stone then suggested, as an alternative, that a positive limitation may help and I agreed to look at any specification they wished to propose. I allowed until 9 July 2024 for the submission of a limited specification. For the purposes of this decision I am treating this alternative amendment, which I do accept as being *Postkantoor* compliant, as having been offered unconditionally (see e.g. *CARDINAL PLACE* BL O/339/04 at para 10 and *CITIBOND* [2007] RPC 13 and BL O/197/06 at paras 9-13, 19-21 and 51,)

9. On 9 July 2024 the attorney requested an extension of time in which to reply and I allowed extra time until 16 September 2024. On 16 September 2024 the attorney sent in further submissions from the applicant for acceptance of the mark, maintaining that the mark was acceptable for all the goods applied for but intended to limit the specification to the following in order to overcome the objection:

*Class 28 Board games, namely, abstract strategy games, area control games, campaign games, city building games, card games, dice games, economic games, bluffing games, children's games, educational board games, memory games, trivia games, storytelling games, negotiation board games, math based board games, word games, collectible games, tile-based board games, quiz games; tabletop games, namely, abstract strategy games, area control games, campaign games, city building games, card games, dice games, economic games, bluffing games, children's games, educational board games, memory*

*games, trivia games, storytelling games, negotiation board games, math based board games, word games, collectible games, tile-based board games, quiz games; tabletop cooperative puzzle games namely, abstract strategy games, area control games, campaign games, city building games, card games, dice games, economic games, bluffing games, children's games, educational board games, memory games, trivia games, storytelling games, negotiation board games, math based board games, word games, collectible games, tile-based board games, quiz games.*

This contrasts with the original specification as filed and as set out in paragraph 1 above.

10. The further submissions included details of case law to back their argument that a trade mark will be distinctive where the sign in question identifies the product and/or services in respect of which registration is sought as originating from a particular undertaking and distinguishes that product and/or service from those of other undertakings, referring to Joined Cases C-53/01 and C-55/01) Linde, paragraphs. 40 and 47; Joined Cases C-468/0J P and C-472/01 Proctor and Gamble at paragraph. 32; C-104/01 *Libertel* at paragraph. 62; Yakult Honsha KK's Trade Mark Application [2001] RPC 39, 756 and 758-759; Dualit Ltd's (Toaster Shapes) Trade Mark Applications [1999] R.P.C. 890, 897; OKOTOKS Limited (Formerly Spicerhaart Limited) v Fine & Country Limited [2013] EWCA Civ 672, 81; O2 Holdings Ltd (formerly O2 Ltd) v Hutchison 3G Ltd [2006] EWHC 534 (Ch), 2006 WL 789495, 701).

11. The applicant went on to say that following the limitation, the mark would serve to identify the goods listed at paragraph 9 above as originating from them on the basis that the mark is not descriptive of the goods (following the removal of the Contentious Goods) and thus the mark is "distinguishable" for the purpose of satisfying distinctive character. Only a minimum degree of distinctive character is sufficient to overcome these grounds (see *Eurocool Logistik v OHIM (EUROCOOL) (T-34/00) EU:T:2002:4; [2002] E.C>R. II-683*). The positive limitation away from games relating to puzzles eliminates any possibility of the sign being descriptive of the goods it seeks to protect and therefore the mark serves as a badge of origin that the relevant public can rely on to distinguish the Applicant's goods from those of others in the marketplace.

12. The applicant referred to the decision in *Audi AG v OHIM, Case C-398/08 P* in which it annulled the General Court's earlier decision that the mark "Vorsprung durch Technik" (translated to 'Advantage through Technology') was devoid of any distinctive character for various goods and services relating to technology. The CJEU ruled that the mark did in fact possess the necessary level of distinctive character, overturning the earlier court's initial ruling. The applicant considered that that case is factually comparable to this Application. Further, in *Procter & Gamble v OHIM, Case C-383/99*, the Court ruled that descriptiveness must be assessed not only in relation to each word taken separately, but also in their totality. The CJEU overturned the initial ruling by the OHIM and the mark was deemed to be distinctive. In applying that principle, the Applicant maintains the Application satisfies the requirements of Section 3(1)(b) and (c) of the Act.

12. I did not agree that the proposed specification limitation overcame the objection as all of the goods listed in the restricted specification consist of games which could be played as part of an escape room in a box. On 18 September 2024 I wrote to the attorney maintaining the objection and refusing the application.

13. On 27 September 2024 the attorney submitted a form TM5 requesting a statement of reasons for the Registrar's decision. I am now asked under Section 76 of the Trade Marks Act 1994 and Rule 69 of the Trade Mark Rules 2008, to state the grounds of my decision and the material used in arriving at it. No formal evidence has been put before me for the purposes of demonstrating acquired distinctiveness, therefore I only have the prima facie case to consider.

### **The Law**

14. Section 3(1) of the Act reads as follows:

3(1) The following shall not be registered –

(b) trade marks which are devoid of distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it .

### **Relevance of EU Law**

15. 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 those applying assimilated law to follow assimilated EU case law. That is why this decision may refer to decisions of the EU courts which predate the UK's withdrawal from the EU.

### **The relevant legal principles – Section 3(1)(c)**

16. The case law under section 3(1)(c) of the Act was summarised by Arnold J (as he then was) in Starbucks (HK) Ltd v British Sky Broadcasting Group Plc. [2012] EWHC 3074 (Ch). These are the most relevant points:

*(a) The general interest underlying section 3(1)(c) is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services.*

*(b) With a view to ensuring that that objective of free use is fully met, it is not necessary that the sign in question actually be in use at the time of the*

*application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes*

*(c) The application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question. It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration.*

*(d) The situations specifically covered by section 3(1)(c) of the Act are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.*

*(e) The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in section 3(1)(c) of the Act are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. A sign can be refused registration on the basis of section 3(1)(c) only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics. (f) In addition, a sign is caught by the exclusion from registration in section 3(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned.*

17. In addition, there are a number of judgments from the CJEU which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 (recoded and replaced by Directive 2008/95/EC on 22 October 2008) and Article 7(1)(c) of the Community Trade Mark Regulation (the 'CTMR'), whose provisions correspond to section 3(1)(c) of the UK Act. For the avoidance of doubt, it is noted that the Trade Marks Act 1994 is largely derived from EU law (Directive 2015/2436). I derive the following main guiding principles from the cases noted below:

- Subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (*Wm Wrigley Jr & Company v OHIM*, C-191/01P 'Doublemint', paragraph 30);

- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest, namely that signs or indications relating to the categories of goods or services in respect of which registration is sought may be freely used by all. The provision therefore prevents such signs or indications from being reserved to one undertaking alone because they have been registered as trade marks (see judgment of 4 May 1999 in Joined cases C108/97 and C-109/97 Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots-und Segelzubehör Walter Huber and Franz Attenberger (Chiemsee) [1999] ECR I2779, at paragraph 25);
- It is also a well-established principle that the Registrar's role is to engage in a full and stringent examination of the facts, underlying the Registrar's frontline role in preventing the granting of undue monopolies, see to that effect CJEU Case C-51/10 P, Agencja Wydawnicza Technopol sp. z.o.o. v OHIM [2011] ECR I-1541 (Technopol);
- When determining whether a sign is devoid of distinctive character or is descriptive of the goods or services in respect of which registration is sought, it is necessary to take into account the perception of the relevant consumer who is reasonably well-informed and reasonably observant and circumspect (Matratzen Concord AG v Hukla Germany SA, C-421/04);
- There must be a sufficiently direct and specific relationship between the sign and the goods in question to enable the relevant consumer immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics (Ford Motor Co v OHIM, T67/07).
- In 'Postkantoor' (see C-363/99 Koninklijke KPN Nederland NV v Benelux-Merkenbureau) the Court of Justice stated: 98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Art. 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

### **Application of legal principles**

**18.** It is clear from the aforementioned case law that I must determine whether or not the mark applied for could be perceived by the relevant consumer as a means of designating characteristics of the goods being provided. To do this I must assess who I consider the relevant consumer to be for the goods covered by the application, as the level of attention of the average consumer will vary depending on the category of goods or services in question (see C-342/97, 'Lloyd Schuhfabrik Meyer'). In respect of the goods covered by this application the relevant consumer will be the

general public, and given the nature of these goods, I am of the opinion that only an average level of attention will be given to their purchase.

19. Having established who the average consumer is I have to ascertain what I think their reaction would be when faced with the words 'escape room in a box' when appearing on games. The Oxford English Dictionary defines the term 'Escape Room' as:

*'A leisure activity in which a group of people must solve a series of puzzles against the clock in order to escape from a locked room or rooms'*

These escape rooms have become popular and appear in many towns and cities, as I have already said, throughout the UK I think it is unlikely that the average consumer would be unaware of what an escape room is.

20. As I informed Mr Stone, anyone seeing the words 'escape room in a box' on games would see them as providing a way to play 'escape rooms' in their own home i.e it would provide what is necessary to transform a room at home to one in which an 'escape room' could be played via, for example, a board game which is generally contained in a box. Clues, puzzles and riddles are provided and will need to be solved in order to make an escape. I will deal below with the question whether the positively limited specification indicated at para 9 above overcomes the objection.

21. At the hearing the attorney proposed limiting the specification to exclude puzzle games. As I informed him at the hearing, the limitation offered would not in my opinion be acceptable in accordance with the the decision in *Postkantoor* (-363/99) where it was stated that "*the Directive prevents a trade mark registration authority from registering a mark for certain goods or services on condition that they do not possess a particular characteristic*" as this would lead to legal uncertainty as to the extent of the protection afforded by the mark. I am mindful of *Omega SA (Omega AG) (Omega Ltd) v Omega Engineering Incorporated* [2012] EWHC 3440 (Ch), in which Arnold J. provided the following guidance on the application of the POSTKANTOOR principle to limitations to specifications:

*"43. The POSTKANTOOR principle. In POSTKANTOOR the applicant applied to register the word POSTKANTOOR (Dutch for POST OFFICE) in respect of goods and services in Classes 16, 35–39, 41 and 42. The Benelux Trade Mark Office refused registration on the grounds that the sign was descriptive. On appeal, the Gerechtshof te s'-Gravenhage (District Court of The Hague) referred nine questions of interpretation of the Directive to the Court of Justice, of which the eighth was as follows: "Is it consistent with the scheme of the Directive and the Paris Convention for a sign to be registered for specific goods or services subject to the limitation that the registration applies only to those goods and services in so far as they do not possess a specific quality or specific qualities (for example, registration of the sign 'Postkantoor' for the services of direct-mail campaigns and the issue of postage stamps, provided they are not connected with a post office)?"*

22. *The Court of Justice answered this question as follows:*

*“113. ... when registration of a mark is sought in respect of an entire class within the Nice Agreement, the competent authority may, pursuant to Article 13 of the Directive, register the mark only in respect of some of the goods or services belonging to that class, if, for example, the mark is devoid of any distinctive character in relation to other goods or services mentioned in the application.*

*114. By contrast, where registration is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic*

*115. Such a practice would lead to legal uncertainty as to the extent of the protection afforded by the mark. Third parties — particularly competitors — would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they might thus be led to refrain from using the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods.”*

23. At the hearing Mr Stone instead suggested positively limiting the specification and I advised Mr Stone that if he wished to submit a suitably limited specification I would consider it. He proposed the specification shown in paragraph 9 above. I did not agree that this specification overcomes the objection. For the avoidance of any doubt, even if I am wrong about the first limitation as regards the exclusion of puzzle games not being Postkantoor compliant, I would nonetheless find that neither limitation overcomes the primary objection. The restricted specification of para 9, which I am treating as having been unconditionally offered, consists of games and puzzles, all of which could be played as part of the escape room process and could be provided in a box. Mr Stone’s proposed positive limitation in para 9 aims to circumvent the dictionary definition of an escape room provided above. This specifies that an escape room is a puzzle game. However, the specification still includes for example, ‘board games, namely, abstract strategy games’ which is, in my opinion, still a puzzle game and reflects the overall strategy of escaping from the room within a specific time limit. Further, in my opinion, the relevant consumer would make no distinction between a puzzle game and a strategy game.

24. I should stress at this point that my objection to this application is based exclusively on the plain meaning of the words ‘ESCAPE ROOM IN A BOX’. That is, literally, what the product covered by the specification, is, in fact. I am only fortified in my objection by the fact that two observers have seen fit to make formal observations to the registrar.

25. Regarding Mr Stone’s submission that the mark had been accepted in the US in 2016. I am bound to determine the mark’s acceptability in accordance with the relevant legal principles in the UK rather than assessing the mark based on the state of the register in another jurisdiction altogether. This well-established principle in trade mark law was cited in the Treat case and has been summarised recently in *BREXIT O-262-18*, where the AP (James Mellor KC) stated:

11. *In addition, just because a mark is on the Register does not mean it will be held valid when challenged. Furthermore, if the touchstone for registration was to be a comparison with marks already on the register, then registration would come to depend on the lowest common denominator. In any event, it is quite clear that the application of the section 3(1)(b) ground requires an assessment not against other marks on the register, but against the standard laid down in that provision, as interpreted in the case law.'*

Although this refers to marks on the UK register the same principle must apply to marks registered in other jurisdictions.

26. As I have found that the mark in question is open to objection under section 3(1)(c) of the Act, it follows that it is also open to objection under section 3(1)(b). Anna Carboni, sitting as the Appointed Person in COMBI STEAM (O363-09), summarised the leading case law in respect of this part of the Act:

*"It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs "a residual or sweeping-up function", backing up the other two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: Procter & Gamble Ltd's Trade Mark Application [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): Koninklijke KPN Nederland BV v Benelux- Merkenbureau Case C-363/99 (POSTKANTOOR) [2004] ETMR 57 (ECJ) at [86]."*

27. I consider the sign to be descriptive of the kind of goods pursuant to Section 3(1)(c) of the Act and, by inference, also devoid of any distinctive character under section 3(1)(b). In this case there is in, in my opinion, no separate or independent objection under section 3(1)(b) only. The application in regard to the proposed limited specification set out at para 9 is therefore refused because it fails to qualify under sections 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994.

**Dated this 13<sup>th</sup> day of November 2024**

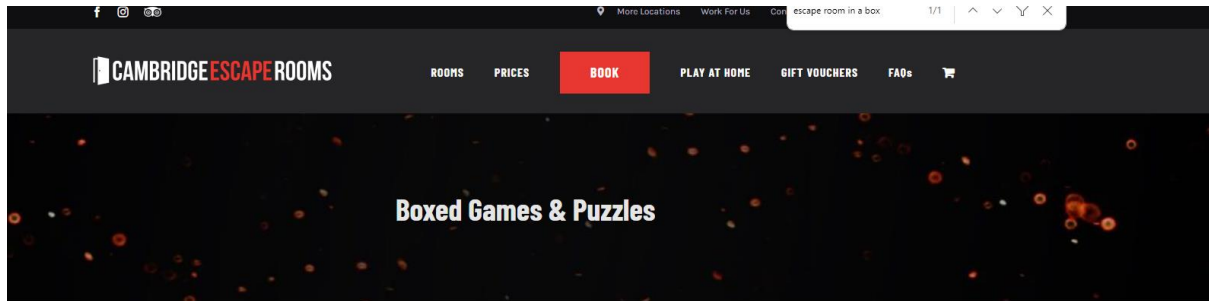
**Linda Smith**

**For the Registrar**

**The Comptroller General**

# ANNEX A

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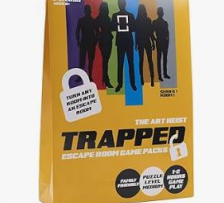


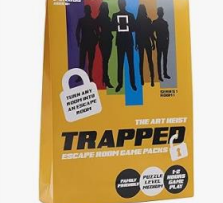







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### Overview

Unleash your inner detective as you decipher puzzles, unravel clues and complete mind-bending challenges in the comfort of your living room with this at-home **Escape Room in a Box**.

From the moment your escape room box is delivered to your door, you'll receive a carefully crafted immersive storyline that draws you in with a variety of original puzzles and challenges to solve. Your puzzle solving skills will be put to the test as you complete one of the two games available: The Home Detective & The Wizard's Apprentice.

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