

United Kingdom – game of thrones vs game of vapes

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The UK [Intellectual Property](#) Office (“UKIPO”) has dismissed Home Box Office (“HBO”) trade mark opposition filed against the registration of GAME OF VAPES in class 34 for ‘Tobacco, smoker articles’, matches’ in the UK.

HBO relied on its prior EU registration for GAME OF THRONES in class 34 asserting that there is likelihood of confusion between the two marks and as a consequence of the repute associated with GAME OF THRONES, the use and registration of GAME OF VAPES by the applicant, Maanohan Singh, would dilute its distinctive character also causing damage to its reputation.

Although the UKIPO acknowledged the respective goods and trade channels for class 34 goods are the same, it held that there is an overall conceptual difference between the marks due to the addition of the words THRONES (referring to Kings and Queens) and VAPES (smoking devices) respectively with the result that there is no direct confusion.

Further, while one might assume that there is a connection or association between the marks GAME OF THRONES and GAME OF VAPES, there was no finding that GAME OF VAPES would be presumed a natural brand extension of GAME OF THRONES but instead “a comedic play” on GAME OF THRONES. HBO demonstrated a limited reputation in relation to the TV show with no repute extending to other activities and therefore ‘no commonality between the respective fields of activity’.

COMMENT

The trade mark GAMES OF THRONES may well not be associated with tobacco and smokers articles which is classified in class 34. It is likely that it filed its trade mark in a range of classes, not only confined to goods and services in direct relation to its hit television production, GAME OF THRONES, as defensive trade mark registrations.

Registering and maintaining defensive registrations is in accordance with best practice by brand owners, increasing protection for brands for a range of goods and services in various classes and territories.

In *Werksmans Legal Brief* January 2019 edition concerning the cancellation of the PRIMARK and BIG MAC registrations respectively, a possible disadvantage to registering and maintaining defensive registrations is that a trade mark is vulnerable to cancellation if it has not been used for a certain period of time post registration (access article [here](#)).

Non-use cancellations do, however, need to be brought by an interested party before the relevant authorities therefore the value attributed by securing registrations, albeit defensively, certainly outweighs the risk of cancellation for non-use.

It has been suggested that if HBO had registered the trade mark ‘GAME OF’ the UKIPO may have favoured HBO, the opposed mark GAME OF VAPES incorporating these two identical words. This decision infers that brand owners should also consider defensive registrations that comprise separate elements contained in its marks.



Donvay Wegierski

Director

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