

O/1054/22

TRADE MARKS ACT 1994

INTERNATIONAL TRADE MARK 1476270

IN THE NAME OF PXG PHARMA GMBH

AND

DESIGNATION OF THE UK FOR PROTECTION

AND

OPPOSITION No. 418921

BY PARSONS XTREME GOLF, LLC

Background and pleadings

1. This is an opposition by Parsons Xtreme Golf, LLC (“the opponent”) to the protection of an International trade mark in the UK. The mark is **PXG Pharma** in plain characters (“the contested mark”). The holder is PXG Pharma GmbH (“the holder”). The UK was designated for protection at the date of the International registration on 14th March 2019. The holder claims priority from 21st September 2018 (“the relevant date”) based on an earlier trade mark filing in Germany.

2. The designation of the UK covers a wide range of goods/services in classes 3, 5, 8, 10, 16, 21, 29, 30, 32 and 35, many of which are typical of the sorts of goods/services associated with a chemist shop-type retailer.

3. The opponent’s principal business is the production and sale of golf clubs and related products/services. It is the proprietor of numerous earlier EU and UK trade marks consisting of the letters PXG and the figurative device shown below.



These marks are registered in multiple classes for a wide range of goods/services. However, the only classes common to the contested mark and (some of) the earlier marks are classes 8 (hand tools) and 35 (retail services). The grounds of opposition are:

- (i) Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) because the opponent claims the earlier trade marks are similar to the contested mark, are registered for identical or similar goods/services, and there is a likelihood of confusion on the part of the public;
- (ii) Section 5(3) of the Act because the opponent claims the earlier marks have a reputation in the UK or EU and use of the contested mark would,

without due cause, take unfair advantage and/or be detrimental to the reputation or distinctive character of the earlier marks;

- (iii) Section 5(4)(a) of the Act because the opponent claims to have used PXG and the figurative device shown above in the UK since January 2016 in relation to a very wide range of goods/services, ranging from golf clubs to lip balm, to cars, to bottled water, to cigar boxes, and to have acquired substantial goodwill under these signs. It is claimed that use of the contested mark would therefore amount to passing off.

4. The opponent originally sought to rely on 13 earlier trade marks. Following a Case Management Conference held on 21st October 2021, the proprietor restricted the section 5(2) and 5(3) grounds of opposition to two differing groups of 6 earlier trade marks. At the substantive hearing described below the opponent indicated that it only really needed to rely on 3 of the 6 marks to which it had earlier limited its section 5(2) case. Each of these marks consists of the letters PXG without figurative elements.¹ The section 5(3) case is still based on 6 earlier marks.

5. The holder file a counterstatement denying the grounds of opposition and putting the opponent to proof of the reputation claimed for the earlier trade marks. The holder also denied that any of the respective goods/services are similar and put the opponent to proof of any such similarity.

6. Both sides seek an award of costs.

7. The parties subsequently filed evidence. The opponent's evidence shed little or no light on its reasons for claiming that the goods/services covered by the earlier marks are similar to the goods/services covered by the contested mark. As already noted, with two exceptions, the respective goods/services are in different classes. This is not determinative, but in this case the similarity between the respective goods/services was not, in my view, self-evident. Further, the holder had previously requested

¹ The other three marks are figurative signs which are manifestly less similar to the contested mark than the letters PXG as such, and are registered for the same goods/services as the letter-only marks.

clarification about this matter. Consequently, on 27th July 2022, the registrar directed the opponent, prior to the hearing which it had by then requested, to do the following:

1. Indicate whether it maintained that all the goods/services covered by the IR are similar to all the goods/services covered by the earlier marks.

2. If it did, to provide a schedule for each of the 10 classes covered by the IR, explaining why each of the specific descriptions of goods/services listed in that class of the IR are similar to every specific description of goods/services covered by the earlier marks. Where the same reasoning applies to multiple terms in the IR and the earlier marks, these terms could be grouped accordingly within each of the 10 required schedules.

3. If the opponent no longer maintained that ALL the respective goods/services are similar or identical, it should provide a schedule setting out for each of the classes of the IR it still maintained covers identical or similar goods/services to the earlier marks, which of the goods/services covered by the earlier marks are most similar to the goods/services in that class of the IR, and why.

8. In accordance with Rule 62(3) of the Trade Mark Rules 2008, the consequence of non-compliance with this direction was set out. It was that the opposition under s.5(2) against classes 3, 5, 10, 16, 21, 29, 30 & 32 of the contested mark would be rejected without argument at the hearing on the grounds that the opponent had failed to particularise, as directed, why the respective goods/services were claimed to be similar. The opponent subsequently provided a schedule and maintained that all the goods/services covered by the contested mark were similar to certain specific goods/services covered by one or more of the earlier marks. I return to the content of this schedule below.

Representation

9. The holder is represented by Charles Russell Speechlys. The opponent is represented by Fieldfisher LLP. A hearing took place (remotely) on 20th September 2022 at which Leighton Cassidy of Fieldfisher appeared on behalf of the opponent. Christopher Hall appeared as counsel for the holder.

The evidence

10. The opponent's evidence consists of two witness statements (with 44 exhibits) by Frankie Ho, who is its In-House Legal Counsel. The main purposes of Mr Ho's first statement is to provide background information about the opponent's global business and to show that the earlier marks have acquired a reputation in the UK/EU. His second statement replies to the holder's evidence described below.

11. The holder's evidence consists of a witness statement (with 5 exhibits) by its Managing Director, Duncan van Orsouw. The main purposes of Mr van Orsouw's evidence is to:

- (i) Provide information about the holder's business;
- (ii) Show that Pharma denotes a business in the pharmaceutical sector, but that Pharma is not a word commonly used by retail pharmacies;
- (iii) Explain that the contested mark is derived from the name of the holder's parent company, **Phoenix Group**;
- (iv) Deny that he was aware of the opponent when the holder filed its International trade mark application;
- (v) Point out that although he now understands that the opponent's earlier marks were identified in trade mark clearance searches carried out by the holder's trade mark lawyers, they were discounted on the basis that the parties' fields of trade were sufficiently distinct so as not to be a problem;
- (vi) Draw attention to two other businesses using PXG or PX Group.

12. There is no evidence that the contested mark was in use in the UK at the relevant date.

The section 5(2)(b) grounds

13. Section 5(2)(b) of the Act is as follows:

“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”.

14. Section 5A of the Act is as follows:

“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.”

15. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from retained EU law. That is why this decision continues to refer to EU trade mark case law.

Comparison of goods/services

16. None of the earlier marks the opponent relies on are subject to proof of use under section 6A of the Act. Consequently, the opponent can rely on all the goods/services covered by its earlier trade marks.

17. The goods/services on which the opponent relies and the goods/services said to be similar are set out below.

<i>Holder's goods/services</i>	<i>Earlier TM</i>	<i>Goods/services relied on</i>	<i>Reasons</i>
<p>Class 3: Cosmetics and hair lotions (namely skin-care creams, lotions, deodorants, antiperspirants, hair shampoos, hair conditioners, hair lotions, baby oils, baby lotion, baby creams, make-up removing preparations); cotton for cosmetic purposes; dentifrices; essential oils; lip sticks, lip balms, not for medical purposes; mouthwashes; perfumery; soaps; sunscreen preparations; tissues (namely impregnated with cosmetic lotions or make-up removing preparations); toiletries.</p> <p>Class 5: Pharmaceutical preparations (namely anti-fungals, anti-infectives, anti-itch lotions and creams, asthma medication, analgesics, cough and cold medication, antidiarrheals, laxatives, sleep aids, antiallergics, antihistamines, dermatologics, diaper rash ointments, preparations for allergy prevention and treatment, antacids and acid reducers, hemorrhoid treatments, smoking cessation preparations, pediculicides, wart removal medications, contraceptives, pregnancy testing preparations); dietetic substances adapted for medical use, food for babies; disinfectants (namely antiseptic handwash, antiseptic handcream, antiseptic mouthwash);</p>	EU13652541	<p>Class 18: Toiletry bags sold empty</p>	The goods are complementary

<p>fungicides; meal replacements, dietetic food and beverages, adapted for medical use; medicine cases, filled; nutritional supplements, vitamin preparations, mineral food supplements; plasters, materials for dressings; sanitary preparations for medical purposes (namely incontinence pads and diapers, nursing pads, bathing preparations and bath salts for medical purposes, lubricants for medical purposes); teas for medicinal purposes; wadding for medical purposes.</p> <p>Class 8: Files; nail scissors, cuticle scissors; scissors for children; nail nippers, cuticle nippers; tweezers; nail files; nailclippers; nail polish and nail polish remover; manicure sets; pedicure sets.</p> <p>Class 21: Floss for dental purposes; toothbrushes, electric and non-electric; toothpicks.</p>			
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18. In the judgment of the CJEU in *Canon*² the court stated that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

² Case C-39/97 at paragraph 23 of the judgment

19. There can be no doubt that *Toiletry bags sold empty* are different in nature, purpose, and method of use to toiletries, cosmetics etc. in class 3, pharmaceuticals and other goods in class 5, manicure and pedicure tools in class 8, and dental items in class 21. And they are plainly not competitive goods. The opponent's case is that all these goods are sold to the same consumers through the same channels of trade and are complementary goods.

20. In *Boston Scientific Ltd v OHIM*,³ the EU's General Court stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

21. In *Sanco SA v OHIM*,⁴ the General Court indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*:⁵

"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

Whilst on the other hand:

³ Case T-325/06

⁴ Case T-249/11

⁵ BL-0-255-13

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

22. In *Kurt Hesse v OHIM*⁶ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. Nevertheless, it is plainly necessary to make an overall assessment of the similarity between the goods/services of which complementarity is but one factor.

23. For the holder, Mr Hall submitted that the suggested complementary similarity between the holder’s goods in classes 3, 5, 8 and 21 and the opponent’s toiletry bags in class 18 fell into the same category as wine and wine glasses, i.e. the one product can be put in the other, but consumers do not expect the same undertaking to be responsible for them both. Mr Hall pointed out that there is no evidence to suggest that the respective goods are in fact marketed by the same undertakings.

23. For his part, Mr Cassidy relied on the decision of the Hearing Officers in *Steel LLC v Rituals International Trademarks B.V.*⁷ and *Ningbo Aiyou Holdings Co. v Chapter 4 Corp D.B.A. Supreme*⁸ in which it was held that *cosmetics* and *cosmetic bags* and *toiletry and vanity cases (empty)* and *manicure sets/beard trimmers*, respectively, are similar. These decisions were based on findings that the respective goods are sold in the same trade channels, to the same consumers, and are complementary in the sense that bags/cases in question can be used to store the other goods.

24. I accept that toiletries are used with toiletry bags. They are not used together to perform their functional purpose, as with wine and wine glasses. Rather, toiletries are used alone or with other similar products. Such goods are transported and sometimes stored in toiletry bags when not in use. I accept that toiletries are sold to the same consumers as toiletry bags. However, as this is the general public, very little, if any, weight can be attached to this fact alone. The materials from which the

⁶ Case C-50/15P

⁷ BL O/613/19. The decision was subsequently upheld on appeal to the Appointed Person. However, as Mr Hall pointed out, this does not shed any light on the correctness of the relevant part of the original decision because the appeal did not address that aspect of the decision.

⁸ BL O/136/21

goods are made, and the manufacturing process for making toiletries, are entirely different to toiletry bags. There is nothing about the nature of the goods themselves which suggests they are likely to be made by the same undertakings. So far as I am aware, it is not usual for the respective goods to exhibit aesthetic complementarity either. In any event, as the General Court stated in *Compagnie des montres Longines, Francillon SA v OHIM*⁹:

“60. it is important to point out that the mere existence of aesthetic complementarity between the goods is not sufficient to conclude that there is a similarity between them. For that, the consumers must consider it usual that the goods are sold under the same trade mark, which normally implies that a large number of the producers or distributors of the goods are the same (see judgment in Emidio Tucci, cited in paragraph 48 above, EU:T:2012:499, paragraph 52 and the case-law cited).”

25. There is no evidence as to whether the goods are sold through the same shops or, if they are, whether they are marketed on the same shelves or in the same part of the shop. I have no doubt that toiletries and toiletry bags can be found in a department store, but there is no evidence that both types of goods would normally be found on the same counters.

26. It is well established that within the limits to which facts can be taken into account as a matter of judicial notice, hearing officers can take account of their own knowledge as consumers of everyday goods in assessing the likelihood of confusion. However, this does not assist the opponent in this case because I do not, in fact, have experience of it being common for toiletries and toiletry bags to be marketed by the same or related undertakings. So far as I can see, there was no actual evidence of this in *Steel LLC v Rituals International Trademarks B.V.* either. It is not possible or appropriate for me to import whatever experience the hearing officer in that case may have had which may have led her to conclude cosmetics/cosmetics bags are “complementary” in the sense described in the case law. Based on my own assessment of the probabilities, I find that even if toiletry bags are important for the

⁹ Case T-505/12

use of toiletries (in the sense of storing or transporting the products), there is no reason to believe that they are connected “..in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

27. Importantly, the holder put the opponent to proof that the respective goods are similar. Therefore, the opponent was on specific notice of this issue from the outset and had ample opportunity to file evidence supporting its case that the respective goods/services are similar in relevant respects. It filed no such evidence. In the absence of evidence, I find that toiletries and toiletry bags are not “*complementary*” goods in the sense indicated in the case law. I see no basis for finding that there is material similarity between them on any other basis.

28. Turning to the claimed similarity between *toiletry bags (empty)* and the holder’s manicure and pedicure goods in class 8, I find that much the same considerations apply. I note that the likelihood of a case being marketed by the same undertaking that markets the intended content of the case may vary, depending partly on the degree to which the case is adapted to hold its specific content. For example, a case for holding a chess set is much more likely to be marketed by the undertaking selling the chess pieces that fit in that case than someone selling suitcases is likely to sell clothes. It is possible that the *toiletry and vanity cases* (my emphasis) and manicure sets/beard trimmers considered in *Ningbo Aiyou Holdings Co. v Chapter 4 Corp D.B.A. Supreme* were thought to fall closer to the chess cases example. Be that as it may, I see no proper basis for finding that *toiletry bags (empty)* and the holder’s manicure and pedicure goods in class 8 are complementary goods in the sense required by the case law. I find they are not similar goods.

29. As to the opponent’s case that the holder’s goods in classes 5 and 21 should also be considered complementary and therefore similar to *toiletry bags (empty)*, this appears to amount to an argument that anything that could feasibly be put into a toiletry bag is complementary and therefore similar goods. I reject this submission because there is no basis for it, either in the case law or in common sense.

30. The opponent runs a similar argument for establishing similarity between the holder's goods in class 10 and certain other bags in class 18. These are set out below.

<i>Holder's goods/services</i>	<i>Earlier TM</i>	<i>Goods/services relied on</i>	<i>Reasons</i>
Class 10: Surgical, medical and dental apparatus and instruments (namely surgical scissors, blood pressure measuring apparatus, apparatus for blood analysis [for medical use], clinical thermometers, diagnostic apparatus for pregnancy testing, inhalers for medical use, contraceptive devices, oral irrigators for use in dentistry); compression socks; orthopedic articles; suture materials.	EU13652541	Class 18: Carry-all bags; carry-on bags; back packs; travel bags.	The goods are complementary

31. According to the opponent, the bags in class 18 could be sold alongside the class 10 medical goods for storage purposes. By way of example, the opponent suggests that diabetic or hypertension sufferers could carry blood analysing or blood pressure testing apparatus in such bags.

32. Again, there is no evidence that these goods are often (or ever) sold alongside one another. I would be extremely surprised if they are. After all, the bags in question are general purpose bags, not bags adapted for carrying specific medical devices¹⁰. The submission that (say) a back pack is complementary to *apparatus for blood analysis [for medical use]* merely because consumers could carry the latter in the former is manifestly absurd. I therefore reject the opponent's case on complementarity and similarity between the goods in classes 10 and 18.

¹⁰ Apart from the descriptions used, the explanatory headnotes to class 18 indicate that it does not cover bags adapted to carry specific goods

33. The opponent claims that a further raft of the holder's goods are similar to *towels* covered by EU13652541 on the basis they are complementary goods. The respective goods are set out below.

<i>Holder's goods/services</i>	<i>Earlier TM</i>	<i>Goods/services relied on</i>	<i>Reasons</i>
<p>Class 3: Cosmetics and hair lotions (namely skin-care creams, lotions, deodorants, antiperspirants, hair shampoos, hair conditioners, hair lotions, baby oils, baby lotion, baby creams, make-up removing preparations); cotton for cosmetic purposes; dentifrices; essential oils; lip sticks, lip balms, not for medical purposes; mouthwashes; perfumery; soaps; sunscreen preparations; tissues (namely impregnated with cosmetic lotions or make-up removing preparations); toiletries.</p> <p>Class 5: Pharmaceutical preparations (namely anti-fungals, anti-infectives, anti-itch lotions and creams, asthma medication, analgesics, cough and cold medication, antidiarrheals, laxatives, sleep aids, antiallergics, antihistamines, dermatologics, diaper rash ointments, preparations for allergy prevention and treatment, antacids and acid reducers, hemorrhoid treatments, smoking cessation preparations, pediculicides, wart removal medications, contraceptives, pregnancy testing preparations); dietetic substances adapted for medical use, food for babies;</p>	EU13652541	Class 24: Towels	The goods are complementary

<p>disinfectants (namely antiseptic handwash, antiseptic handcream, antiseptic mouthwash); fungicides; meal replacements, dietetic food and beverages, adapted for medical use; medicine cases, filled; nutritional supplements, vitamin preparations, mineral food supplements; plasters, materials for dressings; sanitary preparations for medical purposes (namely incontinence pads and diapers, nursing pads, bathing preparations and bath salts for medical purposes, lubricants for medical purposes); teas for medicinal purposes; wadding for medical purposes.</p> <p>Class 21: Floss for dental purposes; toothbrushes, electric and non-electric; toothpicks.</p>			
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34. The opponent’s similarity-of-goods case directed at the holder’s class 3 goods is that towels, and in particular face towels, are marketed by the same undertakings that market cosmetics and personal care products, and are therefore complementary goods. Even after the hearing, I am not clear whether or why it is said that face towels are important or indispensable for the use of cosmetics. If it is because they can be used to remove make-up, this appears to be a rather tenuous connection between their (possible) functional uses.

35. Once again, the evidence the opponent filed does not address the factual matter of whether consumers are likely to believe that undertakings selling cosmetics also sell face towels. The opponent sought to make up for the deficiency by including in its schedule of similarity of goods/services two pictorial examples of internet pages showing undertakings who sell cosmetics also marketing what the opponent submits are face towels.

36. For the holder, Mr Hall pointed out that this material is not ‘evidence’ because it has not been filed by a witness, or in any other way that would make it acceptable as evidence in court¹¹. I agree. It is clearly factual material of a kind that should have been filed as evidence, not simply cut and paste into a schedule comprising written submissions. No application was made to submit this material as additional evidence. It follows that the holder has had no opportunity to file evidence in reply to it. In the absence of an appropriate application from the opponent, it would be inappropriate for me to give this material evidential weight. In any event, the material could be of little, if any, evidential weight for the following reasons:

- (i) Two examples of undertakings (at least one of which is household name) marketing ‘face towels’ for removing cosmetics does not show that it is common practice for, and/or that consumers expect, cosmetics sellers to also sell face towels;
- (ii) The two examples relied on appear to have been extracted from websites in 2022 and cannot, therefore, be said to inform the tribunal about consumers’ expectations some 4 years earlier at the relevant date;
- (iii) The goods in question are not even described as face towels, they are described as ‘towelling cloths’ and ‘muslin cloths’.

37. On the face of things, I see no reason to believe that average consumers of cosmetics would expect face towels marketed under the same or similar brand to identify the goods of the same undertaking. The goods are very different in nature, purpose and method of use, and they are not in competition. Therefore, in the absence of relevant evidence that consumers are accustomed to the goods being marketed by the same undertakings, I find that cosmetics/personal care products and towels are not “*complementary*” goods in the sense indicated in the case law.

38. The opponent further submits that towels are used in conjunction with pharmaceutical products, health supplements, and dental care goods. According to the opponent this means they are “*at least*” complementary goods. I do not

¹¹ Per Rule 64(1)(b) of the Trade Mark Rules 2008

understand why one would use a towel in conjunction with pharmaceutical products, health supplement, or dental care products. I therefore see no basis to conclude that the one product is indispensable or important for the use of the other product.

39. It follows that there is no reason to believe that average consumers of pharmaceuticals, nutritional supplements, vitamin preparations, and mineral food supplements (the goods actually specified in the designation), or dental care products, would expect towels marketed under the same or similar brand to identify the goods of the same undertaking. After all, the goods are very different in nature, purpose and method of use, and they are not in competition. In the absence of relevant evidence, I find that these goods are also not “*complementary*” to towels in the sense indicated in the case law. The opponent has not explained why any of the other goods in class 5 of the contested mark are similar to towels. I see no obvious similarity. Therefore, I find these are not similar goods.

40. I next turn to the opponent’s case for submitting that *toiletty bags* and *towels* are similar to the holder’s goods in class 16. The respective goods are set out below.

<i>Holder’s goods/services</i>	<i>Earlier TM</i>	<i>Goods/services relied on</i>	<i>Reasons</i>
Class 16: Tissues of paper and cellulose for babies; tissues of paper or cellulose for removing make-up; babies' bibs of paper or cellulose; paper tissues for cosmetic purposes; toilet paper; paper towels; paper handkerchiefs; bags, envelopes and pouches of paper or plastics, for packaging.	EU13652541	Class 18: Toiletty bags sold empty Class 24: Towels	<i>Bags, envelopes, pouches, of paper or plastics, for packaging</i> have the same purpose as <i>toiletty bags</i> because they are both used to hold and transport other goods. Tissues and paper related goods in class 16 have the same purpose and method of use as towels in class 24, and the consumers are the same.

41. As regards the claimed similarity between *bags, envelopes, pouches, of paper or plastics, for packaging and toiletry bags*, I do not accept that the goods have the same intended purpose merely because they are designed to hold other goods. In my view, this approaches the issue at too high a level of generality. Rather, it is necessary to consider the intended purpose of the goods from the perspective of an average consumer. Such a consumer would focus on the purpose of the bags, rather than the mere fact that they can both be used to hold 'something'. The holder's class 16 goods are intended for packaging purposes, e.g. for packing cards or gifts. Toiletry bags are obviously for toiletry products, usually for transport and/or storage purposes. Considered from the perspective of an average consumer, the respective purposes are quite different. The goods are not in competition. The nature and method of use of the respective goods also appears different. The holder's goods are items of packaging, often for single use, whereas the opponent's bags are for holding personal care products on a repeated or long-term basis. Admittedly, toiletry bags are usually made of plastic, like some of the holder's packaging products. However, I consider that the mere fact that two products are made from something as ubiquitous as plastic would not create any real similarity between them from the perspective of an average consumer. I therefore find these are not similar goods.

42. As regards the suggested similarities of purpose and method of use between the holder's *tissues of paper and cellulose for babies; tissues of paper or cellulose for removing make-up; paper tissues for cosmetic purposes* in class 16 and towels in class 24, I find that the types of tissues specified are normally used to remove something from the face or body. Typically, the 'something' would be a leakage of fluid from the body, e.g. a runny nose, or something that has inadvertently found its way onto the body, e.g. a piece of food, or something applied on purpose, e.g. make-up. By contrast, towels in class 24 are textile goods normally used to dry the body when it is wet, often after it has already been cleaned. I acknowledge that face towels can be used for washing the face or hands. However, one would not normally wipe a baby's runny nose in a towel, or use it to remove stray food or make-up. I therefore reject the opponent's submission that these goods have the same purpose. I accept that tissues and towels have the same method of use in that both are rubbed against the body. The goods are different in nature – one being a paper or cellulose product, the other being a textile product – and they are not in competition

or complementary. Further, I would not expect to find paper tissues for babies/make-up removal on the same aisles of a shop, or on the same part of a website, as textiles such as towels. Considered in the round, I find these are not similar goods.

43. The similarity between *babies' bibs of paper or cellulose; toilet paper; paper handkerchiefs* and towels has not been explained. I see no similarity. These are plainly dissimilar goods.

44. I accept that there is a degree of similarity of purpose between towels in class 24 and paper towels in class 16. Both can be used to dry an area of the body, such as the hands or face, usually after washing, and face towels can be used for washing the face or hands. The method of use is the same. The goods are different in nature – one being a paper disposable product, the other being a re-useable textile product. They are not usually competitive or complementary products. Further, there is no evidence that they would normally be marketed on the same aisles of a shop, or on the same part of a website. Considered in the round, I find these are similar goods, albeit to a low degree.

45. I next turn to the opponent's case for submitting that goods in classes 29, 30 and 32 are similar to the holder's services in class 41. The respective goods/services are set out below.

<i>Holder's goods</i>	<i>Earlier TM</i>	<i>Services relied on</i>	<i>Reasons</i>
<p>Class 29: Fruit-based snack food; fruit-based snack bars; whey-based snack foods; whey bars; nut-based snack foods; nut bars; protein bars.</p> <p>Class 30: Tea; tea-based beverages; flowers or leaves for use as tea substitutes; infusions for non-medicinal purposes; confectionery; sweetmeats; sweetmeats on the basis of herbs or plant extracts; fruit drops; lozenges; chewing gums; fruit gums; cereal bars;</p>	EU13652649	Entertainment in the nature of golf tournaments; golf club services	It is very common for consumers when attending a golf tournament or visiting a golf club, to purchase the club's own-brand snacks. Therefore, the respective goods/services are at least complementary.

energy bars; cereal-based snack foods; rice-based snack foods. Class 32: Non-alcoholic beverages; isotonic beverages; energy drinks; whey beverages.			
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46. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

47. In my view, the core meanings of *entertainment in the nature of golf tournaments* and *golf club services* do not cover the sale of snacks. The core meaning of the former is providing a golf tournament to entertain spectators. The core meaning of the latter is to provide the services required for members to play golf. In any event, there is no evidence to support the opponent’s submission that it is common for consumers when attending a golf tournament or visiting a golf club, to purchase the club’s own-brand snacks. The goods/services at issue are plainly different in all material respects. They are dissimilar goods/services.

48. I next turn to the opponent's case for submitting that the goods in class 10 of the contested mark are similar to some of the opponent's goods in class 25. The respective goods are set out below.

<i>Holder's goods/services</i>	<i>Earlier TM</i>	<i>Goods relied on</i>	<i>Reasons</i>
Class 10: Surgical, medical and dental apparatus and instruments (namely surgical scissors, blood pressure measuring apparatus, apparatus for blood analysis [for medical use], clinical thermometers, diagnostic apparatus for pregnancy testing, inhalers for medical use, contraceptive devices, oral irrigators for use in dentistry); compression socks; orthopedic articles, suture materials.	EU13652541	Footwear	Footwear covers socks and shoes, which coincide in nature and method of use and target users with compression socks and orthopaedic shoes.

49. The opponent claims that this part of its case is supported by the decision of 29th November 2019 by the EUIPO in opposition No. 3050384 *Belvest S.p.A., v Adledo Piotr Józwiak*: The Opposition Division held that *"The contested medical compression stockings; ladies' stockings [surgical] are lowly similar to the opponent's clothing. The goods have the same nature, can coincide in their method of use and target the same end user."*

50. I accept that 'footwear' covers socks. I also accept that there is some similarity in the nature of 'ordinary' socks in class 25 and *compression socks* in class 10: they are both socks and are made from similar materials. The method of use is also similar; they are worn on the feet. They may also target the same end user, i.e. the general public. The main purpose of compression socks (or stockings, as they are more usually called) is to reduce swelling in the feet and ankles. The main purposes of 'ordinary' socks is to keep the feet warm and reduce frictional damage to the feet from rubbing against shoes or boots. These are secondary purposes of compression socks too. The goods are not alternative choices. Compression socks are only worn when there is medical need, so they are not in competition with 'ordinary' socks. The opponent says they are *"at least"* complementary goods, but they are clearly not

complementary in any sense of that word. Once again, there is no evidence to guide me but based on my experience and the primary purposes of the respective goods, I would expect compression socks to be marketed by specialist medical goods suppliers rather than retailers of ‘ordinary’ socks. Considering all these factors, I find the goods are similar to a low degree.

51. I have carefully considered whether *orthopedic* (sic, orthopaedic) *articles* covers orthopaedic shoes. ‘Articles’ is not a word an average consumer would likely use to describe shoes. On the other hand it is a collective term covering a range of things. So the fact that none of them may be individually described as an ‘article’ is not decisive. On balance, I have decided that orthopaedic articles covers items of orthopaedic footwear. The factors affecting the similarity of such footwear to ordinary footwear in class 25 mirrors the previous analysis of the similarity between compression socks and ordinary socks. For the same reasons, I find that *orthopedic* (sic) *articles* is similar to footwear in class 25 to a low degree, but only to the extent that the former description covers orthopaedic footwear. Other orthopaedic articles in class 10 are dissimilar to footwear in class 25.

52. The parties goods in class 8 are set out below.

<i>Holder's goods/services</i>	<i>Earlier TM</i>	<i>Goods/services relied on</i>	<i>Reasons</i>
Class 8 Files; nail scissors, cuticle scissors; scissors for children; nail nippers, cuticle nippers; tweezers; nail files; nailclippers; nail polish and nail polish remover; manicure sets; pedicure sets.	EU14894877	Hand tools, namely wrenches.	If the <i>files</i> covered by the holder's mark are for use in construction, maintenance and repair, they would be similar to wrenches. The goods would be at least complementary.

53. The holder concedes that if *files* covers workbench tools, there is some similarity between *files* and wrenches. Otherwise, it denies the goods are similar. If necessary, the holder says it would be willing to limit its claim to “*files*” to files for personal hygiene. I accept the holder's submission that the similarity between these goods

disappears if the enquiry is limited to files for personal care use. Such goods are manifestly dissimilar to wrenches.

54. The holder's services in class 35 and the goods/services the opponent claims are similar are set out below.

<i>Holder's goods/services</i>	<i>Earlier TM</i>	<i>Goods/services relied on</i>	<i>Reasons</i>
Class 35: Retail services and wholesale services in relation to toiletries, beauty care preparations, body cleaning and body care preparations, cotton for cosmetic purposes, oral hygiene preparations, essential oils, cosmetics, perfumery, soaps, suncream preparations, tissues impregnated with cosmetic lotions or make-up removing preparations, medicinal and pharmaceutical preparations and articles, dietetic preparations and nutritional supplements, meal replacements, vitamin preparations, food for babies, sanitary preparations and articles, plaster, materials for dressings, portable filled medicine cases, teas for medicinal purposes, wadding for medical purposes, hygienic and beauty implements, surgical, medical and dental apparatus and instruments, compression socks, orthopedic articles, tissues of paper and cellulose for babies, babies' bibs of paper or cellulose, paper tissues for cosmetic purposes, toilet paper, paper towels, bags, envelopes and pouches of paper or plastics, for packaging, floss for dental	EU14894877	Class 8: Hand tools, namely wrenches.	Retail services are complementary to the goods/services in classes 8, 18, 24 & 41
	EU13652541	Class 18: All purpose sport bags; back packs; carry-all bags; carry-on bags; duffel bags; golf umbrellas; leather and imitation leather bags; luggage; messenger bags; Shoe bags for travel; sport bags; toiletry bags sold empty; tote bags; travel bags; umbrellas.	
	EU13652649	Class 24: Golf towels; towels. Class 41: Entertainment in the nature of golf tournaments; Fitting of golf clubs to	

<p>purposes, toothbrushes, electric and non-electric, toothpicks, fruit-based snack food, fruit bars, whey-based snack foods, whey bars, nut-based snack foods, nut bars, tea, tea-based beverages, flowers or leaves for use as tea substitutes, non-medicinal infusions, confectionery, cereal bars, protein bars, energy bars, cereal-based snack foods, rice-based snack foods, non-alcoholic beverages.</p>		<p>individual users; Golf club services; Providing a website featuring information relating to the sport of golf; Providing news and information on the sport of golf.</p> <p>Class 35: Retail store services and on-line retail store services in the field of golf equipment, clothing, eyewear, footwear, headwear, bags of all kinds, umbrellas, accessories made of leather and imitations of leather, and accessories for all of the foregoing goods; providing on-line consumer product information in the field of golf-related products and services; providing on-line product registration services for golf-related products for the purpose of providing customer service in the field of golf-related products and services; advertising and marketing.</p>	<p>The holder's class 35 services are similar to the opponent's retail services. Consumers understand that retailers provide a wide range of goods.</p>
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55. The opponent has not explained why any of the goods/services in classes 8, 18, 24 or 41 of the earlier trade marks are complementary (or otherwise similar) to *wholesale* services. Consequently, I find these are not similar goods/services.

56. In *Oakley, Inc v OHIM*¹², the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

57. In *Tony Van Gulck v Wasabi Frog Ltd*,¹³ Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

*“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”*

58. However, on the basis of the European courts judgments in *Sanco SA v OHIM*¹⁴, and *Assembled Investments (Proprietary) Ltd v. OHIM*¹⁵, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*¹⁶, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently

¹² Case T-116/06, at paragraphs 46-57

¹³ Case BL O/391/14

¹⁴ Case C-411/13P

¹⁵ Case T-105/05, at paragraphs [30] to [35] of the judgment

¹⁶ Case C-398/07P

pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

59. I have already found that none of the goods relied on by the opponent in classes 8, 18, or 24 are similar to the kinds of goods covered by the retail services for which the contested mark has been designated for protection in class 35, except for the holder's *paper towels*. Retail services in relation to paper towels apart, I find that none of the holder's retail services are normally associated with the opponent's goods. Therefore, I find they are not complementary goods/services.

60. As regards retail services relating to paper towels, I earlier found that *paper towels* are similar to a low degree to towels in class 24, notwithstanding that they would not usually be found on the same aisles of a shop or the same page of a website. That does not mean that consumers of paper and textile towels would not expect the same retailer to offer both types of towels. I do not consider the matter to be clear cut but, on balance, I find that retail services for paper towels are complementary, and similar to a low degree, to towels in class 24.

61. I have already explained why I do not consider *entertainment in the nature of golf tournaments; fitting of golf clubs to individual users; golf club services* in class 41 to

be complementary to food and drinks as goods in classes 29, 30 and 32. They are no more similar to retail services associated with those goods in class 35. The opponent's services in class 41 are manifestly dissimilar to retail services relating to the other goods listed in class 35 of the contested mark.

62. The opponent does not rely on the registration of EU13652541 for footwear in class 25 as a basis for claiming similarity between these goods and retail services relating to compression socks and orthopaedic articles (including orthopaedic footwear). Consequently, I do not have to decide this point. I simply draw attention to my earlier finding that orthopaedic footwear is normally marketed through different retailers to ordinary footwear.

63. The opponent has not explained why *advertising and marketing* services covered by the earlier mark are similar to the holder's services in class 35. Having regard to the guidance from *Sky v Skykick*, that terms in specifications of services should be given only the core of the possible meanings of the words used, I consider that advertising and marketing services cover commercial services provided to others, usually for remuneration, to advertise/market their goods/services. These services appear to be fundamentally different in nature, purpose, etc. to those provided by a retailer or wholesaler, which are directed at encouraging consumers to buy goods/services from them rather than from another retailer/wholesaler of those goods/services. Therefore, in the absence of any positive or specific arguments to the contrary from the opponent, I find these are not similar services.

64. As regards the opponent's claim that the parties' respective retail services in class 35 are similar, I note that in *Praktiker Bau*¹⁷ the CJEU stated:

“34. ...it should be noted that the objective of retail trade is the sale of goods to consumers. That trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. That activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services

¹⁷ Case C-418/02

aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question rather than with a competitor.”

65. In *Apple Inc. v Deutsches Patent- und Markenamt*¹⁸, the CJEU ruled that a trade mark used in retail services may be protected for services intended to induce the consumer to purchase the goods provided that those services do not form an integral part of the offer for sale of the goods. Thus bringing together an assortment of goods for the consumer to choose from may constitute a retail service, but the mere act of offering to sell goods is not a service.

66. In *Netto Marken*¹⁹ the CJEU held that it was possible to register a trade mark for services involved in the bringing together of other services, even where some of the latter services were provided by the trade mark proprietor itself. By analogy, the same applies to retail services for goods. Therefore, provided there is sufficient selection in the range of goods brought together for the public's convenience so as to constitute a service to consumers, and/or other identifiable retail services are provided, such services may be protected by a trade mark in class 35. In principle, this should be possible even where the retail services in question are intended to induce the consumer to purchase only the proprietor's own goods.

67. These judgments show that the potential scope of a 'retail services' type registration is potentially very wide. The CJEU wrestled with this issue in *Praktiker Bau*. The court was asked whether it was necessary for the services provided by a retailer to be specified in order to guarantee the certainty of the subject-matter of trade-mark protection and define the scope of protection of such a trade mark in the event of a conflict. The court addressed this matter as follows:

“40. The question arises as to whether, in the particular case of the retail trade, the concept of ‘services’ within the meaning of the directive needs further specification.

¹⁸ Case C-421/13

¹⁹ Case C-420/13

41. *In that regard, in the observations submitted to the Court, it was maintained that the services eligible for protection as retail services should be identified in a way which distinguishes them from services which, being closely connected with the sale of goods, could not give rise to registration of a trade mark. It was pointed out, moreover, that the application for registration of the trade mark should specify in detail the service(s) for which the applicant seeks protection.*

42. *It is argued that such details are necessary, in particular, to safeguard the essential function of the trade mark, namely, as the guarantee of the identity of the origin of the goods or services covered by the trade mark, and to prevent trade marks for retail services from being afforded over-wide and indeterminate protection.*

43. *The difficulty of the questions thus raised is illustrated by the different answers proposed by the parties which submitted observations and by the information available to the Court regarding the current practices of the Member States.*

44. *For the reasons set out below, there is no need to rely on a definition of 'retail services' for the purposes of the directive which is more restrictive than that which follows from the description contained in paragraph 34 of this judgment.*

45. *It must first be stated that any distinction between the various categories of services provided with the sale of goods which involved a more restrictive definition of 'retail services' would prove artificial in the light of the reality of the important economic sector represented by retail trade. It would inevitably raise difficulties both as regards the general definition of the criteria to be adopted and as regards the application of those criteria in practice.*

46. *Admittedly, a more restrictive definition of 'retail services' would reduce the protection afforded to the proprietor of the trade mark, so that questions*

concerning the application of Articles 4(1) and 5(1) of the directive would arise less often.

47. However, that is not sufficient to justify a restrictive interpretation.

48. There is nothing to indicate that any problems resulting from the registration of trade marks for retail services could not be resolved on the basis of the two relevant provisions of the directive, as they have been interpreted by the Court. In that regard, it should be recalled that, according to the Court's case-law, the likelihood of confusion must be assessed globally, taking into account all the factors relevant to the circumstances of the case (see Case C-251/95 SABEL [1997] ECR I-6191, paragraph 22, and Case C-39/97 Canon [1998] ECR I-5507, paragraph 16). In the context of that global assessment, it is possible to take into consideration, if need be, the particular features of the concept of 'retail services' that are connected with its wide scope, having due regard to the legitimate interests of all interested parties.

49. In those circumstances, for the purposes of registration of a trade mark covering services provided in connection with retail trade, it is not necessary to specify in detail the service(s) for which that registration is sought. To identify those services, it is sufficient to use general wording such as 'bringing together of a variety of goods, enabling customers to conveniently view and purchase those goods'.

50. However, the applicant must be required to specify the goods or types of goods to which those services relate by means, for example, of particulars such as those contained in the application for registration filed in the main proceedings (see paragraph 11 of this judgment).

51. Such details will make it easier to apply Articles 4(1) and 5(1) of the directive without appreciably limiting the protection afforded to the trade mark. They will also make it easier to apply Article 12(1) of the directive, which states that '[a] trade mark shall be liable to revocation if, within a continuous period of five years, it has not been put to genuine use in the Member State in

connection with the ... services in respect of which it is registered, and there are no proper reasons for non-use'."

68. It can be seen from the above extract that the court rejected submissions to the effect that it was necessary to specify the retail services in detail. Rather, the CJEU favoured an approach through which the services are characterised by reference to the goods to which they relate. Thus it is not necessary to specify exactly which services are provided or how they are provided, e.g. through a bricks and mortar store or online. By contrast, it is necessary to provide a list of all the goods to which the retail services relate. The approach adopted by the court was intended, in part, to deal with the potential number of conflicts that would arise if traders were permitted to register trade marks for retail services *per se*. As paragraph 48 of the above extract shows, the court also pointed out that the wide concept of 'retail services' can also be taken into account, if necessary, "*..having due regard to the legitimate interests of all interested parties.*"

69. The CJEU thus made it clear than in examining the scope of protection of a retail services-type trade mark registration, the court or tribunal should (a) pay particular attention to the specified goods in relation to which the retail services are registered, and (b) have regard to the legitimate interests of the proprietor, and of third parties using, or wishing to use, similar marks to attract consumers to their goods.

70. The retail services covered by the opponent's mark are:

Retail store services and on-line retail store services in the field of golf equipment, clothing, eyewear, footwear, headwear, bags of all kinds, umbrellas, accessories made of leather and imitations of leather, and accessories for all of the foregoing goods.

71. Aside from *bags of all kinds*, none of the goods listed as the subjects of the opponent's retail services appear to be the same as the goods covered by the holder's specified retail services, or goods that are likely to be marketed by the same kind of retailer.

72. The legitimacy of using the class in which the goods have been applied for as a tool to interpret the meaning of the words used to describe them does not apply to descriptions of goods in the specification of a retail services mark in class 35. Accordingly, it is necessary to construe the meanings of the descriptions of goods forming part of the opponent's retail services specification by reference to their ordinary natural meaning. However, in doing so it is again necessary to keep in mind the guidance from *Sky v Skykick* that specifications of services should be interpreted as covering the core of the possible meanings of the words used. On that basis, I do not consider it appropriate to interpret *retail... services in the field of footwear* as covering retail services relating to orthopaedic footwear. This is because absent the word 'orthopaedic', that is not one of the core meanings of the description of services.

73. By contrast, *retail services relating to bags of paper or plastics, for packaging* in the holder's class 35 specification is one of the core meanings of *retail... services in the field of bags of all kinds* in the opponent's specification. Consequently, the opponent's services must be regarded as encapsulating the holder's services. This means that they must be regarded as identical retail services. By extension of the same logic, *retail services relating to envelopes and pouches of paper or plastics, for packaging* in the holder's specification must be regarded as highly similar to *retail... services in the field of bags of all kinds* in the opponent's specification. Further, as retail services and wholesale services in the same field of trade must be considered highly similar services, I find that the holder's *wholesale services relating to bags, envelopes and pouches of paper or plastics, for packaging* are similar to at least a medium degree to the opponent's *retail services in the field of bags of all kinds*.

74. I see no similarity between the holder's other *wholesale* services and any of the retail services covered by the earlier mark. Consequently, in the absence of any positive or specific arguments to the contrary from the opponent, I find these are not similar services.

Conclusions on identity/similarity of goods/services

75. The overall result of this lengthy analysis of the opponent's case on similarity of goods/services is as follows:

Class 8: *Files* are similar to *hand tools, namely wrenches*, in the same class, but only to the extent that *files* covers workbench tools.

Class 10: *Compression socks and orthopaedic articles* (to the extent this term covers footwear) are similar to *footwear* in class 25 to a low degree.

Class 16: *Paper towels* in class 16 are similar to *towels* in class 24 to a low degree.

Class 35: *Retail services relating to paper towels* are similar to a low degree to *towels* in class 24.

Class 35: *Retail and wholesale services relating to bags, envelopes and pouches of paper or plastics, for packaging* are the same or similar to at least a medium degree to *retail... services in the field of bags of all kinds* in the same class.

None of the holder's other goods/services are the same or similar to any of the goods/services the opponent relies on in the registrations of the earlier marks.

Global assessment of the likelihood of confusion

76. My finding that apart from the goods/services listed in the previous paragraph, none of the goods/services the opponent relies on are the same or similar to the goods/services covered by the contested mark, means that the opposition under section 5(2) of the Act must fail in relation to the bulk of the holder's goods/services. This is because there must be some similarity between the goods/services to succeed under this provision²⁰. I will therefore primarily focus on the likelihood of confusion arising from use of the contested mark in relation to the goods/services I have found to be the same or similar. However, in case I am wrong about the other

²⁰ See *Waterford Wedgwood plc v OHIM* – Case C-398/07P, CJEU

goods/services, I will also briefly consider the likelihood of confusion on the footing that, contrary to my primary findings, some of them may be similar to a very low degree.

77. The following principles are gleaned from the decisions of the EU courts 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*, 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.

Average consumer and the selection process

78. Although the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.

79. Most of the holder's goods/services will be selected by members of the general public. However, some of the goods in class 5, such as prescription medicines, as

well as most of the goods in class 10, and related retail services in class 35, are likely to be selected by medical professionals. Further, consumers of the holder's wholesale services in class 35 are likely to be mainly other businesses.

80. The opponent submits that the average consumer will pay an average, or just above average, degree of attention when selecting the goods/services covered by the contested mark.

81. The holder argues that the average consumer will pay a high degree of attention when selecting (at least) pharmaceuticals, toiletries and medical apparatus.

82. According to the General Court in *Olimp Laboratories sp. z o.o. v EUIPO*²¹, medicinal products, whether or not issued on prescription, can be regarded as receiving a heightened level of attentiveness on the part of consumers. The holder's goods in class 5 are mostly medicinal products, although some are not, e.g. plasters and baby foods. The level of attention paid by consumers when selecting class 5 products is likely to vary from average (plasters) to above average (baby foods, over the counter pain killers) to high (medicines for more serious conditions).

83. I accept the holder's submission that consumers are likely to pay a high degree of attention when selecting medical apparatus etc., including compression socks and orthopaedic articles. The reason for this is obvious: if the wrong product is selected there could be serious consequences for the intended user.

84. These findings follow through to the holder's related retail and wholesale services in class 35.

85. I reject the holder's submission that the same applies to toiletries and other goods in class 3. The holder's argument is that the average consumer is particularly careful about which products go on (or in) the body. I think that depends on the perceived risk. I see no reason to believe that the average consumer of (say) soap or

²¹ Case T-817/19 at paragraph 40

mouthwash pays an unusually high degree of attention when selecting such products. The same applies to the holder's other class 3 goods.

86. I accept the opponent's submission that the remaining goods/services covered by the contested mark are likely to be selected by consumers paying an average degree of attention.

87. The general public is likely to select the goods/services primarily through a process of visual selection, e.g. from shelves or pages on a website. Medical professionals are also likely to select the goods in classes 5 and 10 (and associated retail services in class 35) through mainly visual means, e.g. from brochures. However, oral recommendations may also come into the process. Business users of the holder's wholesale services are also likely to select the goods/services primarily through a process of visual selection, e.g. from shelves or pages on a website.

88. However, in each case, oral enquiries and recommendations are likely to come into the process. Therefore, the look of the marks is most important, but the way they sound must also be considered.

Distinctive character of the earlier marks

89. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, 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).”

90. The opponent says that the consumer is likely to see the letters PXG as invented and therefore highly distinctive. The letters would not be perceived as an invented word because there is no vowel and it is almost impossible to pronounce them as a word. It appears to me that consumers will see (and hear) PXG as simply three random letters. The opponent cannot claim to have invented the letters PXG. I accept that the earlier marks are not descriptive of the goods/services relied on by the opponent. However, that is true of the majority of trade marks on the register. They cannot all be of above average distinctiveness. Considered as just a string of three letters, PXG is not particularly memorable or striking. In my view, the earlier marks have a ‘normal’ or average degree of inherent distinctiveness as trade marks for all the opponent’s goods/services.

91. The opponent’s pleaded case is vague as to whether it is claiming that the earlier marks have an enhanced degree of distinctive character in relation to the goods/services it relies on for its section 5(2) case (which it will be remembered was initially all the goods/services for they are registered). The opponent’s skeleton argument took the matter no further. At the hearing, Mr Cassidy for the opponent asked me to take account of the enhanced distinctiveness of the earlier marks in assessing the opponent’s section 5(2) case. When I asked him to identify the goods/services for which the opponent claimed the earlier marks had acquired an enhanced degree of distinctive character through use, he pointed to:

- (i) online retail store services

- (ii) golf towels and clothing
- (iii) golf club wear, bags, accessories, coats, jacket and ancillary products sold in connection with lifestyle items.

92. There is no point in considering the claim in relation to clothing at large because the only goods in class 25 the opponent identified as being similar to the holder's goods/services is footwear. As to the claimed use of PXG in relation to bags, towels and footwear (assuming the latter term falls within clothing), Mr Ho's evidence is that the opponent started using the PXG marks in the UK in 2016 "*..primarily in relation to a range of golf equipment, including golf clubs.*" UK sales of "*PXG-branded products and services*" in the years 2016 – 2018 were as follows:

2016 – in excess of \$500k

2017 – in excess of \$1m

2018 – in excess of \$2.5m

According to Mr Ho, the UK is the opponent's largest market in Europe. In 2018, the UK accounted for 54% of its European sales. Mr Ho does not provide any details of sales or market share relating specifically to bags, towels and footwear (or any other individual goods/services, including torque wrenches). I note that the invoices in evidence almost exclusively relate to golf clubs²².

93. Mr Ho says that the opponent spent over \$300k promoting the PXG brand to UK consumers in 2017 and \$400k in 2018. However, once again there is no indication of which specific goods/services this was spent promoting. Mr Ho says that the marketing spend includes TV advertising on Sky Sports. The extract from the one such advertisement in evidence relates to golf clubs²³. Similarly, the examples of the opponent's print and Facebook advertising in evidence (at least prior to the relevant date) also relate to golf clubs and a related fitting service²⁴.

²² See exhibit FH7

²³ See exhibit FH26

²⁴ See exhibits FH27, 28 & 29

94. As to the opponent’s online retail store services, the supposed UK website at www.pxg.com/en-gb shows only a US telephone number for contact²⁵. Further, it appears to relate to golf clubs, not the goods/services the opponent relies on for its section 5(2) grounds.

95. I conclude that there is no evidence that the earlier marks had acquired enhanced distinctiveness in the UK through use prior to the relevant date in relation to the goods/services the opponent relies on for the purposes of its section 5(2)(b) grounds.

Similarity of marks

96. The respective trade marks are shown below:

Earlier trade marks	Contested trade mark
PXG	PXG Pharma

97. The CJEU stated in *Bimbo SA v OHIM*²⁶ 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.”

98. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the

²⁵ See exhibit FH6

²⁶ Case C-591/12P, at paragraph 34 of the judgment

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.

99. At the hearing, the parties disagreed about the weight (if any) that should be attached to the 'Pharma' element of the contested mark. The opponent submits that 'Pharma' is descriptive and should therefore be given little or no weight. In support of this submission, the opponent relies on a decision of the EUIPO²⁷ to the effect that 'Pharma' designates companies in the pharmaceutical sector. The holder accepts this but says that 'Pharma' therefore helps to distinguish its goods/services from sellers of bags, towels, etc., which are not usually associated with pharmaceutical companies.

100. It is well established that the distinctive character of a trade mark must be assessed in relation to the goods/services for which it is protected (or for which protection is sought). I accept that 'Pharma' designates a company in the pharmaceutical sector. The holder argues that Pharma is not a word commonly used by retail pharmacies. That may be so, but this is irrelevant to the distinctiveness of the word for the goods covered by the contested mark. This is because they are not (and could not) be limited to goods sold via retail pharmacies. Further, even in relation to *retail services relating to ...medicinal and pharmaceutical preparations and articles*, the word Pharma will be understood by consumers to designate a member (i.e. any member) of the pharmaceutical sector. This means that 'Pharma' is not distinctive of any particular undertaking in relation to pharmaceutical products, or retail or wholesale services relating to such products. Therefore, PXG should be regarded as the distinctive element of the contested mark in relation to pharmaceutical products and retail or wholesale services relating to such products. And as it comes before 'Pharma', PXG is also the most dominant element of that mark. It follows that although the marks are not identical (because it seems unlikely that 'Pharma' would be overlooked altogether), the marks are highly similar from a visual and aural perspective when considered in relation to these goods/services.

²⁷ *Swiss Pharma International AG v Colpharma S.R.L.* Opp 2679580 citing *PharmaResearch* Case T-464/07

101. The word 'Pharma' is not descriptive of the other goods/services for which the holder seeks to protect the contested mark. Nevertheless, I consider that because 'Pharma' is associated with a branch of the health sector it will be regarded as less distinctive than PXG (although not devoid of distinctive character) in relation to goods/services associated, loosely or otherwise, with the health sector. This finding does not apply to (workbench) files in class 8 or food and drinks in classes 29, 30 and 32. The word 'Pharma' appears to have no relevant meaning or association in relation to these goods. It is therefore as distinctive as PXG.

102. In all cases, PXG will tend to make more impact on consumers because it comes first (to those reading from left to right). However, 'Pharma' is not negligible. Therefore, it is necessary to give appropriate weight to this element when determining the overall degree of similarity between the marks.

103. From a visual perspective, PXG Pharma consists of two elements. The 'Pharma' element is longer but has relatively less impact. In my view, the parties' marks are visually similar to a medium to high degree.

104. From an aural perspective, PXG Pharma will be verbalised as the letters P-X-G followed by Far-Ma. The earlier marks will obviously sound like the three letters P-X-G. The beginning of the contested mark therefore sounds the same as the earlier marks, but the additional element 'Pharma' will aurally distinguish the marks to some extent. Nevertheless, in my view, the marks are aurally similar to a medium to high degree.

105. The holder gives evidence that the contested mark is derived from the name of the holder's parent company, **Phoenix Group**. I accept this but it is irrelevant because the average UK consumer of the goods/services covered by the contested mark would be unaware of this. The opponent submits that when put together the letters P-X-G have no meaning to the average consumer. It nevertheless submits that the conceptually dominant element of the contested mark is PXG. This seems to be muddled reasoning. If, which I accept, average consumers will not attach any clear meaning to the letters PXG, it follows that those letters do not have a conceptual meaning. The 'Pharma' element of the contested mark has a meaning –

a pharmaceutical business – which is absent from the earlier marks. There is, therefore, a conceptual difference between the marks which distinguishes them to a low degree.

Likelihood of confusion

106. The highpoint of the opponent's case is where the respective goods/services are the same, or similar to at least a low degree (see paragraph 75 above). Taking account of:

- (i) The medium to high degree of visual and aural similarity between the marks in relation to the same/similar goods/services specified in paragraph 75 above;
 - (ii) The small conceptual difference between the marks;
 - (iii) The normal degree of attention likely to be paid by average consumers when selecting the holder's same/similar goods/services, except for *compression socks* and *orthopaedic articles* in class 10;
 - (iv) The average degree of distinctiveness of PXG in relation to the opponent's goods/services specified in paragraph 75 above;
 - (v) The relatively lower degree of distinctiveness of 'Pharma', except in relation to (workbench) *files* and food and drinks;
 - (vi) The principle that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks;
 - (vii) The need to take account of the average consumer's imperfect recollection of the marks;
- I find there is a likelihood of confusion through direct and indirect confusion with the earlier marks, if the contested mark is used in relation to:
- (i) *Files* in class 8 (but only to the extent that *files* covers workbench tools);
 - (ii) *Paper towels* in class 16;
 - (iii) *Retail services relating to paper towels* in class 35;

- (iv) *Retail and wholesale services relating to bags, envelopes and pouches of paper or plastics, for packaging* in class 35.

107. I have considered whether the higher degree of attention paid by average consumers of *compression socks* and *orthopaedic articles* in class 10 during the selection process avoids a likelihood of confusion with the opponent's PXG mark for (ordinary) footwear. On balance, I have decided that there is a likelihood of confusion. This is because the common PXG element is distinctive enough to indicate a common source of the parties respective socks and footwear.

108. However, the opponent's opposition under section 5(2) to *files* and *orthopaedic articles* is only partially successful because it relates to only a subset of these goods. Therefore, the objection fails in relation to *files for personal care use* in class 8 and *orthopaedic articles (other than footwear)* in class 10.

109. If I am wrong about the absence of similarity between the holder's goods/services and the goods/services relied on by the opponent, any such similarity will be of a very low degree. For example, if some consumers might believe that undertakings marketing toiletries are also likely to be responsible for toiletry bags marketed under the same mark, I note that the marks here are different. The 'Pharma' element of the contested mark cannot be simply discounted, particularly as it is not descriptive of toiletries or toiletry bags. Further, the common PXG element, although relatively more distinctive, is not highly distinctive in relation to toiletry bags.

110. Consequently, even if I am wrong about the complete absence of similarity between many of the holder's goods/services and some of the other goods/services relied on by the opponent, in the absence of evidence showing a relevant connection between the respective goods/services, the opposition under section 5(2) of the Act would not have succeeded to any greater extent. This is because I would have found that a very low degree of similarity between the respective goods/services was insufficiently pronounced in all the circumstances of this case to create a likelihood of confusion.

The section 5(3) ground of opposition

111. At the relevant date, section 5(3) of the Act was as follows:

*“(3) A trade mark which-
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.*

112. The opponent claims the following earlier trade marks have a reputation for the goods/services listed in the following table:

Trade mark No.	Mark	Goods/services
EU13652649	PXG	Class 35 Retail store services and on-line retail store services in the field of golf equipment, clothing, eyewear, footwear, headwear, bags of all kinds, umbrellas, accessories made of leather and imitations of leather, and accessories for all of the foregoing goods; providing on-line consumer product information in the field of golf-related products and services; providing on-line product registration services for golf-related products for the purpose of providing customer service in the field of golf-related products and services; advertising and marketing. Class 40 Custom manufacture and fitting of sports equipment, namely, golf equipment. Class 41 Entertainment in the nature of golf tournaments; Fitting of golf clubs to individual users; Golf club

		<p>services; Providing a website featuring information relating to the sport of golf; Providing news and information on the sport of golf.</p> <p>Class 42</p> <p>Custom design and engineering of golf equipment; design and development of golf equipment; computer services, namely, providing search platforms to allow users to request content from and receive content to a computing device or a wireless telecommunication device; providing user-defined generated content automatically selected and customized based on the known or estimated geographical location of a user; providing temporary use of on-line non-downloadable software to enable users to view and listen to audio, video, text, and other multimedia content; hosting an online website featuring content relating to sports; hosting of digital content on the Internet.</p> <p>Class 45</p> <p>Online social networking services in the field of golf; Online social networking services in the field of golf provided via a website.</p>
EU14894877	PXG	Class 8: Hand tools, namely, wrenches.
EU13652541	PXG	<p>Class 9</p> <p>Eyewear, namely, sunglasses; cases for eyewear; cases for computers and wireless communication devices; protective covers for computers and wireless communication devices; computer software for computers and wireless communication devices, namely, software for shopping, social networking, or transmission and receipt of data; computer software for processing images, graphics, audio, video, or text; computer software for wireless content delivery;</p>

		<p>computers and wireless communication devices for voice, data, or image transmission.</p> <p>Class 18</p> <p>All purpose sport bags; back packs; carry-all bags; carry-on bags; duffel bags; golf umbrellas; leather and imitation leather bags; luggage; messenger bags; Shoe bags for travel; sport bags; toiletry bags sold empty; tote bags; travel bags; umbrellas.</p> <p>Class 24</p> <p>Golf towels; towels.</p> <p>Class 25</p> <p>Clothing, namely, belts, coats, gloves, jackets, mittens, pants, pullovers, rainwear, shirts, shorts, skirts, skorts, slacks, sweaters, sweatshirts, vests, and wind shirts; footwear; headwear, namely, caps, hats, and visors.</p> <p>Class 28</p> <p>Golf equipment, namely, golf clubs, golf bags, head covers for golf clubs, golf club grips, golf club shafts, golf balls, golf gloves, golf tees, golf ball markers, divot repair tools, and golf bag covers.</p>
UK3222880	Pxg	Class 35 for a subset of the services covered by EU13652649
UK3187919	PXG	Class 25 for a subset of the goods covered by EU13652541
UK3222877	PXG	Class 25 for a subset of the goods covered by EU13652541

113. The relevant case law can be found in the following judgments of the CJEU: *Case C-375/97, General Motors*, *Case 252/07, Intel*, *Case C-408/01, Adidas-Salomon*, *Case C-487/07, L’Oreal v Bellure* and *Case C-323/09, Marks and Spencer v Interflora* and *Case C383/12P, Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

- (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

Reputation

114. I considered Mr Ho's evidence of use of PXG in relation to golf clubs at paragraphs 92 to 94 above. In an earlier opposition between the opponent and a third party²⁸, and on essentially the same evidence, I found that PXG had acquired a modest UK reputation for golf clubs by the relevant date in that case. The relevant date in this case is very close to that in the earlier opposition proceedings. The opponent naturally relies on this finding as support for its claim that the mark has a qualifying reputation in relation to (at least) golf clubs.

²⁸ Opposition 416792 BL O/353/21

115. However, Mr Hall pointed out that:

- (i) Mr Ho says that a set of his company's clubs cost \$5k;
- (ii) At this price, the UK sales under PXG prior to the relevant date would cover around 800 sets of golf clubs;
- (iii) An article exhibited to Mr Ho's second witness statement states that the number of UK golf players increased from 3.1m to 5.2m in 2020, therefore it is likely there were around 3m players of golf in the UK at the relevant date;
- (iv) If the opponent made only 800 sales in the UK prior to the relevant date, that amounts to around only 0.03% of the relevant market;
- (v) This does not appear to be a significant part of the relevant UK public;
- (vi) As the UK appears to have been the opponent's largest EU market at the relevant date, expanding the enquiry to the whole of the EU does not improve the opponent's case.

116. For the opponent, Mr Cassidy did not appear to take serious issue with the holder's analysis of the opponent's market share. However, I note that there is nothing in the evidence which indicates that the opponent's golf clubs are only sold as sets. The number of UK customers prior to the relevant date may therefore have been higher than 800. Mr Cassidy pointed out that the opponent's goods are aimed at the top end of the market and had been widely promoted under PXG prior to the relevant date. His point was that the mark probably had more recognition than actual customers. In fact, the amount spent promoting the mark in the UK prior to the relevant date is not huge - \$700k. This is said to include TV advertising on Sky Sports, through which 4 different advertisements were run over 4000 times between 2017 – 2019. It is not entirely clear how many of these were run prior to the relevant date in September 2018, and there is no evidence as to the number of UK viewers who were watching when these adverts were run. Nevertheless, it seems likely that a substantial number of golf enthusiasts in the UK saw one or more of these advertisements. The opponent has also promoted its marks through advertisements in lifestyle and sports magazines. There is one example of such advertising in

evidence in Esquire UK magazine (May 2018 edition) which pre-dates the relevant date²⁹.

117. Mr Ho also claims that the opponent placed sponsored posts on UK social media to promote its golf clubs and fitting service. He provides six examples which he says were placed on Facebook in 2017, 2018 and 2019³⁰. Three are for clubs and three for the PXG Master Fitter service. None are dated. It is not clear which are from 2017/18 and which are from 2019 (i.e. after the relevant date).

118. Mr Ho says that the opponent has social media accounts and by November 2019 (i.e. over a year after the relevant date) it had around 72k followers on Facebook, 30k on Twitter and 177k on Instagram. These appear to be global figures. There is no evidence as to the number of followers based in the UK/EU.

119. I conclude that although there is evidence that PXG was promoted in the UK prior to the relevant date (mainly in relation to golf clubs), the scale of such promotion was significant rather than massive.

120. In the earlier opposition proceedings the holder conceded that PXG had acquired a qualifying reputation for the purposes of section 5(3). The only dispute was about the size of the reputation. Consequently, I did not have to decide whether the opponent had a qualifying reputation. This is now disputed. The holder's representative makes strong points about the very limited scale of the opponent's UK and EU customer base at the relevant date. I accept that, even if it was more than 800, the likely number of actual customers does not amount to a significant proportion of the relevant public for golf clubs. However, the test is whether the mark was known to a significant part of the UK and EU public. On balance, I consider that the evidence is (just) sufficient for me to conclude that EU13652541 was known to a significant part of the relevant UK public for golf clubs. And as a reputation in one Member State (as the UK was at the time) is sufficient to constitute a reputation in the EU, the earlier EU mark qualifies for protection under section 5(3)³¹.

²⁹ See FH27

³⁰ See exhibit FH29

³¹ *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07

121. Mr Ho also claims that:

“Alongside its core golf club collection, the Opponent also manufactures and sells an ever-expanding wide range of products including apparel, bags, and accessories for use in golf such as torque wrenches and ball markers.”

122. There is barely any evidence of use of the earlier marks in the UK or EU in relation to anything other than golf clubs, at least prior to the relevant date. It follows that the opponent has not established that the earlier marks were known to a significant part of the relevant section of the public in the EU as regards any other goods or services. I find accordingly.

Link

123. As noted above, my assessment of whether the public will make the required mental ‘link’ between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

124. The parties’ marks are shown below.

Contested mark	Earlier marks
PXG Pharma	PXG

125. I earlier found that the marks are highly visually and aurally similar when the holder’s mark is considered in relation to pharmaceutical goods and related services, and similar to a medium to high degree when considered in relation to other goods/services. There is a low degree of conceptual distinction between them because of the meaning of ‘Pharma’, which is absent from the earlier mark.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

126. Golf clubs are bought by members of the general public. The opponent points out that the holder's goods in classes 3, 5, 8, 16, 29, 30 & 32, and related retail and wholesale services in class 35, are likewise aimed (at least in part) at the general public. Apart from wholesale services, which are normally provided to businesses, I accept this. There is, therefore, a degree of overlap between consumers of golf clubs and consumers of most of the holder's goods/services.

127. However, the respective goods/services themselves are entirely dissimilar and they are marketed through wholly different sectors of trade.

The strength of the earlier mark's reputation

128. As the holder has sought protection for the contested mark in the UK, the question of whether the public will make a link between the contested mark and the earlier mark must be considered in the context of the public in the UK.

129. For the reasons I have already given, I find that the opponent's evidence (including evidence I have not specifically mentioned above), shows that the earlier mark had a moderate reputation in the UK at the relevant date as a relatively new and growing brand for golf clubs.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

130. For the reasons given earlier (which also apply to golf clubs), I find that PXG has an average or normal degree of inherent distinctive character in relation to golf clubs.

131. I accept that the distinctive character of the earlier marks had been enhanced through use prior to the relevant date. Although PXG had not reached the highest level of distinctiveness, it had become more distinctive through use in relation to golf clubs.

Whether there is a likelihood of confusion

132. The vast difference between, on the one hand, the holder's goods in classes 3, 5, 8, 10, 16, 21, 29, 30, 32 and 35 and, on the other hand, golf clubs, is sufficient to exclude any likelihood of direct or indirect confusion. In reaching this conclusion I have borne in mind the possibility that the 'Pharma' element of the contested mark could, in some circumstances, be understood to designate a branch of a larger business trading in a wide range of goods/services. In my view, there is no risk of that here. This is because, firstly, there is no evidence that the opponent was known to have used PXG in relation to a wide range of goods/services at the relevant date. On the contrary, it was essentially a maker of golf clubs. Secondly, there is simply no reason for average consumers to suppose that the user of a mark for golf clubs would have any economic connection with the user of a similar mark for the sorts of goods/services covered by the contested mark.

Finding on link

133. In my view, the relevant public will not make a mental link of any kind between the contested mark and the earlier marks. Without such a link there can be no unfair advantage or detriment caused to the earlier marks. The opposition under s.5(3) must therefore fail.

Unfair advantage/detriment

134. I would add that even if I am wrong and consumers of the holder's goods/services, and/or consumers of the opponent's golf clubs, would call the other side's mark to mind, the opposition under section 5(3) would still have failed. This is because:

- (i) The distance between the trades in the respective goods/services, coupled with their difference in nature, is such that it is difficult to see how the image of the earlier mark, or of the characteristics which it projects, would attach to the goods/services covered by the contested mark;
- (ii) Without such a transfer of image, it does not seem very likely that the reputation of the earlier mark would have given the contested mark a commercially significant 'free-ride' on the back of the opponent's emerging-but-still-moderate reputation for golf clubs;
- (iii) In the absence of a likelihood of consumers expecting the users of the marks to be economically connected, the opponent's contention that the reputation of its mark may suffer if the contested mark is used in relation to lower quality goods/services (of entirely different kinds) is purely speculative;
- (iv) Therefore, without more, this does not pose a 'serious risk' of future damage to the reputation of the earlier mark³²;
- (v) There is no evidence that use of the contested mark in relation to the goods/services covered by the designation would be likely to change the economic behaviour of the opponent's existing or potential customers for golf clubs, and there is no other reason to believe that this is a serious possibility.

135. In his skeleton argument, Mr Cassidy on behalf of the opponent, submitted that the holder "*..is actively seeking to build an association or alignment between its brand and the Opponent's brand.*" In support of this submission Mr Cassidy relied on Mr van Orsouw's evidence that the holder knew about the earlier marks when it adopted the contested mark.

136. I acknowledge that evidence of an intention to take advantage of an earlier mark is relevant to the issue of whether any such advantage is unfair. There is no such evidence in this case. Mr van Orsouw's evidence is that even though he had no

³² See *Unite The Union v The Unite Group Plc*, Case BL O/219/13, Ms Anna Carboni as the Appointed Person

knowledge of the earlier marks, the holder's lawyers did. However, they considered them to be registered for goods/services that were sufficiently distinct from the goods/services of interest to the holder so as not to be a problem. This is a million miles away from evidence of an intention to take unfair advantage of the earlier marks. The normal rule is that the same or similar trade marks can legitimately be registered and used for dissimilar goods/services. Consequently, there is nothing remotely sinister or suspicious about carrying on with plans to register a trade mark after finding out that someone else has registered a similar mark for dissimilar goods/services. I also note that the 'intention' point was not included in the opponent's pleaded section 5(3) case. Consequently, even if there had been anything in the point, it would have been inappropriate and unfair to place any weight on it when the allegation was only raised for the first time at the hearing of the opposition.

137. The opposition under section 5(3) is rejected.

The section 5(4)(a) ground of opposition

138. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark”.

139. The opponent claims to have established goodwill under PXG and the figurative device shown in paragraph 3 above in relation a long list of goods/services. After de-duplication and a certain amount of streamlining, the list looks like this:

Lip balm: sun-block lotions, creams and sprays; licence plate frames; key rings of common metal.

Golf ball washing machines; shaft couplings, not for land vehicles.

Wrenches

Sunglasses: cases for eyewear; cases and protective covers for computers and wireless communication devices; computer software for shopping, social networking or transmission or receipt of data, wireless content delivery, or processing images, graphics, audio, video or text; computers and wireless communication devices for voice, data or image transmission.

Compression garments; compression sleeves for athletic use.

Automobiles, cars, electric golf caddies; motorcycles; motorised golf carts and trolleys; sun blinds, shields and visors for automobiles and cars; vans.

Bracelets, jewellery hat pins; key chains; key rings; non-monetary coins: rubber or silicone wristbands; watch bands, straps, and pouches; watches.

Books in the field of golf instruction; decorative stickers for cars and bumpers; golf scorecards and holders therefor; golf yardage books: money clips; pens and pencils; posters; sports bags, carry-all bags; carry-on bags, back packs, duffel bags, travel bags, bags of leather or imitation leather, messenger bags, shoe bags, tote bags, toiletry bags sold empty; bags for securing valuables, general utility bags for commercial use; luggage; umbrellas.

Display cases, racks and stands; golf course benches; picture and photograph frames; point of purchase displays; display units for use in retail stores.

Drinking glasses, mugs, water bottles sold empty; sports bottles sold empty; baskets for household purposes; cleaning brushes for sports equipment; pilsner(?), waste baskets.

Towels.

Clothing, namely, belts, coats, gloves, jackets, mittens, pants, pullovers, rainwear, shirts, shorts, skirts, skorts, slacks, sweaters, sweatshirts, vests, and wind shirts; footwear; headwear, namely, caps, hats, and visors; lanyards for holding badges or keys; belt buckles.

Floor mats; door mats.

Golf clubs, golf bags, head covers for golf clubs, golf club grips, shafts, balls, gloves, tees, golf ball markers, divot repair tools, golf bag covers.

Bottled water; energy drinks; sports drinks.

Cigar boxes and cases; cigar clippers, cutters and holders; cigar lighters and cigar pouches.

Retail store services and on-line retail store services in the field of golf equipment, clothing, eyewear, footwear, headwear, bags of all kinds, umbrellas, accessories made of leather and imitations of leather, and accessories for all of the foregoing goods; providing on-line consumer product information in the field of golf-related products and services; providing on-line product registration services for golf-related products for the purpose of providing customer service in the field of golf-related products and services; advertising and marketing.

Financial sponsorship of golf tournaments and gold professionals participating in golf tournaments; maintenance and repair of golf clubs; providing information related to the installation, maintenance and repair of golf clubs.

Providing shuttle services for golfers.

Custom manufacture and fitting of golf equipment.

Entertainment in the nature of golf tournaments; Fitting of golf clubs to individual users; golf club services; providing a website featuring information relating to the sport of golf; providing news and information on the sport of golf.

Custom design and engineering of golf equipment; design and development of golf equipment; computer services, namely, providing search platforms to allow users to request content from and receive content to a computing device or a wireless telecommunication device; providing user-defined generated content automatically selected and customized based on the known or estimated geographical location of a user; providing temporary use of on-line non-downloadable software to enable users to view and listen to audio, video, text, and other multimedia content; hosting an online website featuring content relating to sports; hosting of digital content on the Internet.

Online social networking services in the field of golf; online social networking services in the field of golf provided via a website.

140. In *Discount Outlet v Feel Good UK*³³, Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501, [2013] FSR 21).”

³³ [2017] EWHC 1400 IPEC

Relevant date

141. There is no evidence that the contested mark was used in the UK prior to the date of priority claimed. That being the case, the matter must be assessed at 21st September 2018.

Goodwill

142. It follows from my findings under s.5(3) that I accept that actionable goodwill had been acquired under the PXG letter and figurative marks prior to the relevant date in relation to golf clubs.

143. I do not accept that the evidence shows that the opponent had any UK customers for any other goods prior to the relevant date. The sole invoice showing the provision of three “*torquetools*” on 10th January 2016 to an unidentified person at an address somewhere in the UK does not show there was goodwill in relation to torque tools in the nature of wrenches. Apart from the trivial scale of use, there was only one transaction that occurred over 2 years before the relevant date, and the fact that the goods appear to have been provided at zero cost suggests that even this was not a normal commercial transaction.

144. Mr Ho claims that the opponent also offers a Master Fitting Service in the UK. This appears to be a custom fitting service for PXG golf clubs. He does not say when it was introduced. There are no specific sales or advertising figures for this service. So far as I can see, there is only one advertisement showing use of PXG in relation to this service that Mr Ho (or the material itself) identifies as having been placed prior to the relevant date³⁴. It is possible that the opponent’s UK goodwill extended to fitting services for golf clubs. However, even if it did, this does not take the opponent’s case much further because this service is intrinsically tied to its trade in golf clubs.

³⁴ See the first page of exhibit FH27, which Mr Ho says is an advertisement placed in Esquire UK magazine in May 2018

Misrepresentation and damage

145. The opponent's golf clubs, and any related services, are part of the sports goods market. By contrast, the goods/services covered by the contested mark are in the beauty, healthcare, personal hygiene, packaging and food/drink markets. They are different fields of commercial activity. In *Harrods Limited v Harroddian School Limited*³⁵, Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not. He said:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression “common field of activity” was coined by Wynn-Parry J. in McCulloch v. May (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd. (1898) 15 R.P.C. 105 (cameras and bicycles); Walter v. Ashton [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the Advocaat case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the Lego case Falconer J. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

³⁵ [1996] RPC 697 (CA)

'...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant':

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the Lego case Falconer J. likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In Stringfellow v. McCain Foods (G.B.) Ltd. [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson L.J. said at page 547:

'...in a case such as the present the burden of satisfying Lord Diplock's requirements in the Advocaat case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the Advocaat case, be substantial.' "

146. In my view, the opponent's evidence comes nowhere near showing that a substantial number of the opponent's customers or potential customers would expect any of the goods/services marketed under the contested mark to be the opponent's goods, or goods sold with the opponent's consent. Further, even if a few such customers momentarily thought about the opponent's mark for golf clubs, the tiny scale and tenuous nature of any such link would cause no real damage to the opponent's goodwill. Consequently, use of the contested mark would not constitute a damaging misrepresentation to the public. The s.5(4)(a) case therefore also fails.

Overall outcome

147. The opposition under sections 5(3) and 5(4)(a) has failed.

148. The opposition under section 5(2)(b) has also mostly failed. However, this ground of opposition succeeds in relation to:

Files in class 8 (but only to the extent that *files* covers workbench tools);
Compression socks and *orthopaedic articles* (to the extent this term covers orthopaedic footwear) in class 10;

Paper towels in class 16;

Retail services relating to paper towels in class 35;

Retail and wholesale services relating to bags, envelopes and pouches of paper or plastics, for packaging in class 35.

149. Therefore, with refused goods/services struck through and new limitations underlined, the contested mark will therefore be protected in relation to:

Class 3

Cosmetics and hair lotions (namely skin-care creams, lotions, deodorants, antiperspirants, hair shampoos, hair conditioners, hair lotions, baby oils, baby lotion, baby creams, make-up removing preparations); cotton for cosmetic purposes; dentifrices; essential oils; lip sticks, lip balms, not for medical purposes; mouthwashes; perfumery; soaps; sunscreen preparations; tissues (namely impregnated with cosmetic lotions or make-up removing preparations); toiletries.

Class 5

Pharmaceutical preparations (namely anti-fungals, anti-infectives, anti-itch lotions and creams, asthma medication, analgesics, cough and cold medication, antidiarrheals, laxatives, sleep aids, antiallergics, antihistamines, dermatologics, diaper rash ointments, preparations for allergy prevention and treatment, antacids and acid reducers, hemorrhoid treatments, smoking cessation preparations, pediculicides, wart removal medications, contraceptives, pregnancy testing preparations); dietetic substances adapted for medical use, food for babies; disinfectants (namely antiseptic handwash, antiseptic handcream, antiseptic mouthwash); fungicides; meal replacements, dietetic food and beverages, adapted for medical use; medicine cases, filled; nutritional supplements, vitamin preparations, mineral food supplements; plasters, materials for dressings; sanitary preparations for medical purposes (namely incontinence pads and diapers, nursing pads, bathing preparations and bath salts for medical purposes, lubricants for medical purposes); teas for medicinal purposes; wadding for medical purposes.

Class 8

Files for personal care use; nail scissors, cuticle scissors; scissors for children; nail nippers, cuticle nippers; tweezers; nail files; nailclippers; nail polish and nail polish remover; manicure sets; pedicure sets.

Class 10

Surgical, medical and dental apparatus and instruments (namely surgical scissors, blood pressure measuring apparatus, apparatus for blood analysis [for medical use], clinical thermometers, diagnostic apparatus for pregnancy testing, inhalers for medical use, contraceptive devices, oral irrigators for use in dentistry); ~~compression socks~~; orthopaedic articles, other than orthopaedic footwear; suture materials.

Class 16

Tissues of paper and cellulose for babies; tissues of paper or cellulose for removing make-up; babies' bibs of paper or cellulose; paper tissues for cosmetic purposes; toilet paper; ~~paper towels~~; paper handkerchiefs; bags, envelopes and pouches of paper or plastics, for packaging.

Class 21

Floss for dental purposes; toothbrushes, electric and non-electric; toothpicks.

Class 29

Fruit-based snack food; fruit-based snack bars; whey-based snack foods; whey bars; nut-based snack foods; nut bars; protein bars.

Class 30

Tea; tea-based beverages; flowers or leaves for use as tea substitutes; infusions for non-medicinal purposes; confectionery; sweetmeats; sweetmeats on the basis of herbs or plant extracts; fruit drops; lozenges; chewing gums; fruit gums; cereal bars; energy bars; cereal-based snack foods; rice-based snack foods.

Class 32

Non-alcoholic beverages; isotonic beverages; energy drinks; whey beverages.

Class 35

Retail services and wholesale services in relation to toiletries, beauty care preparations, body cleaning and body care preparations, cotton for cosmetic purposes, oral hygiene preparations, essential oils, cosmetics, perfumery,

soaps, suncream preparations, tissues impregnated with cosmetic lotions or make-up removing preparations, medicinal and pharmaceutical preparations and articles, dietetic preparations and nutritional supplements, meal replacements, vitamin preparations, food for babies, sanitary preparations and articles, plaster, materials for dressings, portable filled medicine cases, teas for medicinal purposes, wadding for medical purposes, hygienic and beauty implements, surgical, medical and dental apparatus and instruments, compression socks, orthopedic articles, tissues of paper and cellulose for babies, babies' bibs of paper or cellulose, paper tissues for cosmetic purposes, toilet paper, ~~paper towels, bags, envelopes and pouches of paper or plastics, for packaging~~, floss for dental purposes, toothbrushes, electric and non-electric, toothpicks, fruit-based snack food, fruit bars, whey-based snack foods, whey bars, nut-based snack foods, nut bars, tea, tea-based beverages, flowers or leaves for use as tea substitutes, non-medicinal infusions, confectionery, cereal bars, protein bars, energy bars, cereal-based snack foods, rice-based snack foods, non-alcoholic beverages; wholesale services in relation to paper towels.

Costs

150. The opposition having mostly failed the holder is entitled to a contribution towards its costs. Mr Hall requested costs at the top end of the published scale on account of the scattergun and vague nature of the opponent's pleadings, its reluctance to clarify its case until specifically directed to do so, and failure to fully do so even then. The latter point is a reference to the opponent's schedule and related submissions at the hearing, which claimed similarity between specific goods covered by the earlier marks and all the goods/services in all the classes of the contested mark using reasoning that (at best) only applied to some of the latter goods/services. For example, the reasoning used to explain the supposed similarity between cosmetics and towels was also used to justify the claim that pharmaceuticals, and even laxatives, are similar to towels. As the above analysis of the similarity between the respective goods/services shows, this is not the only example of the opponent resorting to absurd propositions in a desperate attempt to show some similarity between the respective goods/services.

151. The holder also complains about the irrelevancy of parts of the opponent's evidence. This includes use of the earlier marks outside the UK/EU and after the relevant date

152. In my view, the opponent is guilty of massively over pleading its case in terms of the number of earlier marks it needed to rely on, the blanket approach it took to the similarity of all the holder's goods/services, and the extent of the goodwill and reputation claimed. The opponent subsequently only focussed parts of its case when specifically directed to do so. The unfocussed nature of the opponent's pleadings and evidence obscured the opponent's few arguable points in a blanket of fog. And judging from the fact that the opponent belatedly resorted to trying to slip evidence of common trade channels into its post-evidence schedule in order to support one of its section 5(2) arguments, it seems likely that the opponent was until that point lost in its own fog. The opponent's unfocussed 'kitchen sink' approach may have kept its own costs down, but by doing so it unnecessarily increased the holder's costs. This is because the holder would have had to spend time working out what the opponent's real case might be. It should not have had to do so. I will therefore accede to the holder's request for top end scale costs.

153. I do not accept the holder's request for off scale costs for the hearing itself. I accept that the opponent's skeleton argument was probably a little longer than it would have been if the opponent had fully clarified its case prior to the hearing. However, the holder did not think this failure was serious enough to ask for off scale costs in its skeleton argument. The hearing was kept to the usual allocated half day. I will therefore stick to scale costs for the hearing, but make an award towards the top end of the scale to take account of the added work required for the preparation of the holder's skeleton.

154. I will also take account of the success of the section 5(2(b)) ground of opposition in relation to a handful of the goods/services covered by the designation.

155. Taking all of this into account I assess costs as follows:

- (i) £600 for considering the opponent's notice of opposition and filing a counterstatement;
- (ii) £600 for taking part in a case management conference on 21st October 2021 occasioned by the opponent's objection to reducing the number of earlier trade marks relied on for the purposes of this opposition;
- (iii) £2000 for considering the opponent's evidence and filing evidence in answer;
- (iv) £1300 for taking part in the substantive hearing and filing a skeleton argument.

156. I therefore order Parsons Xtreme Golf, LLC to pay PXG Pharma GmbH the sum of £4500. This to be paid within 21 days of the end of the period allowed for appeal.

Dated this 1st day of December 2022

Allan James

For the Registrar

Annex A

Class 3

Cosmetics and hair lotions (namely skin-care creams, lotions, deodorants, antiperspirants, hair shampoos, hair conditioners, hair lotions, baby oils, baby lotion, baby creams, make-up removing preparations); cotton for cosmetic purposes; dentifrices; essential oils; lip sticks, lip balms, not for medical purposes; mouthwashes; perfumery; soaps; sunscreen preparations; tissues (namely impregnated with cosmetic lotions or make-up removing preparations); toiletries.

Class 5

Pharmaceutical preparations (namely anti-fungals, anti-infectives, anti-itch lotions and creams, asthma medication, analgesics, cough and cold medication, antidiarrheals, laxatives, sleep aids, antiallergics, antihistamines, dermatologics, diaper rash ointments, preparations for allergy prevention and treatment, antacids and acid reducers, hemorrhoid treatments, smoking cessation preparations, pediculicides, wart removal medications, contraceptives, pregnancy testing preparations); dietetic substances adapted for medical use, food for babies; disinfectants (namely antiseptic handwash, antiseptic handcream, antiseptic mouthwash); fungicides; meal replacements, dietetic food and beverages, adapted for medical use; medicine cases, filled; nutritional supplements, vitamin preparations, mineral food supplements; plasters, materials for dressings; sanitary preparations for medical purposes (namely incontinence pads and diapers, nursing pads, bathing preparations and bath salts for medical purposes, lubricants for medical purposes); teas for medicinal purposes; wadding for medical purposes.

Class 8

Files; nail scissors, cuticle scissors; scissors for children; nail nippers, cuticle nippers; tweezers; nail files; nailclippers; nail polish and nail polish remover; manicure sets; pedicure sets.

Class 10

Surgical, medical and dental apparatus and instruments (namely surgical scissors, blood pressure measuring apparatus, apparatus for blood analysis [for medical use], clinical thermometers, diagnostic apparatus for pregnancy testing, inhalers for medical use, contraceptive devices, oral irrigators for use in dentistry); compression socks; orthopedic articles; suture materials.

Class 16

Tissues of paper and cellulose for babies; tissues of paper or cellulose for removing make-up; babies' bibs of paper or cellulose; paper tissues for cosmetic purposes; toilet paper; paper towels; paper handkerchiefs; bags, envelopes and pouches of paper or plastics, for packaging.

Class 21

Floss for dental purposes; toothbrushes, electric and non-electric; toothpicks.

Class 29

Fruit-based snack food; fruit-based snack bars; whey-based snack foods; whey bars; nut-based snack foods; nut bars; protein bars.

Class 30

Tea; tea-based beverages; flowers or leaves for use as tea substitutes; infusions for non-medicinal purposes; confectionery; sweetmeats; sweetmeats on the basis of herbs or plant extracts; fruit drops; lozenges; chewing gums; fruit gums; cereal bars; energy bars; cereal-based snack foods; rice-based snack foods.

Class 32

Non-alcoholic beverages; isotonic beverages; energy drinks; whey beverages.

Class 35

Retail services and wholesale services in relation to toiletries, beauty care preparations, body cleaning and body care preparations, cotton for cosmetic purposes, oral hygiene preparations, essential oils, cosmetics, perfumery, soaps, suncream preparations, tissues impregnated with cosmetic lotions or make-up removing preparations, medicinal and pharmaceutical preparations and articles, dietetic preparations and nutritional supplements, meal replacements, vitamin preparations, food for babies, sanitary preparations and articles, plaster, materials for dressings, portable filled medicine cases, teas for medicinal purposes, wadding for medical purposes, hygienic and beauty implements, surgical, medical and dental apparatus and instruments, compression socks, orthopedic articles, tissues of paper and cellulose for babies, babies' bibs of paper or cellulose, paper tissues for cosmetic purposes, toilet paper, paper towels, bags, envelopes and pouches of paper or plastics, for packaging, floss for dental purposes, toothbrushes, electric and non-electric, toothpicks, fruit-based snack food, fruit bars, whey-based snack foods, whey bars, nut-based snack foods, nut bars, tea, tea-based beverages, flowers or leaves for use as tea substitutes, non-medicinal infusions, confectionery, cereal bars, protein bars, energy bars, cereal-based snack foods, rice-based snack foods, non-alcoholic beverages.