

BL O/0500/26

TRADE MARKS ACT 1994

IN THE MATTER OF
UK TRADE MARK REGISTRATION No. 3839659
IN THE NAME OF
PAX INNOVATIONS (SHENZHEN) LIMITED
FOR THE TRADE MARK:

THE CRYSTAL PRO MAX

IN CLASS 34

-AND-

AN APPLICATION FOR A DECLARATION OF THE INVALIDITY THEREOF
UNDER No. 506848
BY
BARGAIN BUSTING LIMITED

Background and pleadings

1. PAX Innovations (Shenzhen) Limited (“PAX”) is the registered proprietor of UK trade mark registration number 3839659, for the word mark THE CRYSTAL PRO MAX. The trade mark was filed on 17 October 2022 and completed its registration procedure on 6 January 2023. It is registered in respect of the following goods:

Class 34

Tobacco; Cigarettes containing tobacco substitutes, not for medical purposes; Electronic cigarettes; Liquid nicotine solutions for use in electronic cigarettes; Filter-tipped cigarettes; Oral vaporizers for smokers; Lighters for smokers; Cigarette filters; Cigarettes; Flavorings, other than essential oils, for use in electronic cigarettes; Pipe racks for tobacco pipes; Tobacco pouches; Tobacco pipes; Cigarette cases; Cigars; Herbs for smoking; Cigar cases; Tobacco jars; Ashtrays for smokers; Matches.

2. On 28 December 2023, Tashmeen Kaur, applied to have the Proprietor’s mark declared invalid under section 47(2) of the Trade Marks Act 1994 (“the Act”).¹ The application is based on section 5(2)(b) of the Act and is directed against all of the goods for which the contested mark is registered.

3. Tashmeen Kaur relied on UK trade mark application number 3786148 for the word mark CRYSTAL BAR, which was filed on 10 May 2022 in respect of the following goods, all of which are relied on for the purpose of the claim:

Class 34

Electronic cigarettes; Electronic cigarette filters; Filter tipped cigarettes; Hookah; Tobacco pouches; Cigarette cases; E Liquid; Electronic cigarette liquid; Shisha pen liquid; Disposable cigarettes; Disposable vape bars; Vape bars; Refillable cigarette lighters; Disposable cigarette lighters; Cigarette rolling

¹ The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

tins; Electronic cigarette with nicotine; Electronic cigarette without nicotine; Devices for heating tobacco for the purpose of inhalation; Cigarette tips; Cigarette filters; Disposable vape with nicotine; Disposable vape without nicotine.

4. After the application for invalidation was filed, trade mark application number 3786148 was assigned by Tashmeen Kaur to Bargain Busting Limited, who is the present proprietor. Bargain Busting Limited also undertook to stand by the claims and statements made in the statement of grounds, confirming that where the name of the original cancellation applicant appears, it should be read as Bargain Busting Limited; it also undertook to be liable for costs in these proceedings in the event that PAX is successful. Accordingly, I will hereinafter refer to the applicant as Bargain Busting Limited (“Bargain”) and the assignment of the earlier mark has no further relevance in these proceedings.

5. Due to its filing date, the trade mark upon which Bargain relies qualifies as an earlier trade mark pursuant to section 6 of the Act.

6. Bargain claims that the competing marks are similar and that the competing goods are similar or identical, giving rise to a likelihood of confusion.

7. PAX filed a counterstatement admitting that the competing goods are similar, however it denied all other claims.

8. Neither party filed evidence nor submissions during the evidence rounds. Bargain requested a hearing and, at the time of the hearing before me on 11 July 2025, the trade mark on which it relies had not yet proceeded to registration. It eventually became registered on 19 September 2025. Only Bargain was represented at the hearing, by Mr Stephen Lowry of Brandsmiths SL Limited. In these proceedings PAX is represented by Pawel Wowra however it elected not to attend the hearing and did not file submissions in lieu of attendance either.

9. I make my decision following a careful consideration of the papers before me and the oral submissions made on behalf of Bargain at the hearing.

DECISION

Legislation and Case Law

10. Section 5(2)(b) of the Act has application in invalidation proceedings pursuant to section 47(2) of the Act. The relevant provisions of the Act are as follows:

Section 47

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground—

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

[...]

- (6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.

Section 5(2)(b)

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

(a) [...]

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

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

11. I am guided by the principles applicable to the assessment of the likelihood of confusion, as cited with approval by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25. These 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 Office for Harmonisation in the Internal Market (“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:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods

12. The Class 34 goods being compared are as follows:

Bargain’s goods	PAX’s goods
Electronic cigarettes; Electronic cigarette filters; Filter tipped cigarettes; Hookah; Tobacco pouches; Cigarette cases; E Liquid; Electronic cigarette liquid; Shisha pen liquid; Disposable cigarettes; Disposable vape bars; Vape bars; Refillable cigarette lighters; Disposable cigarette lighters; Cigarette rolling tins; Electronic cigarette with nicotine; Electronic cigarette without nicotine; Devices for heating tobacco for the purpose of inhalation; Cigarette tips; Cigarette filters; Disposable vape with nicotine; Disposable vape without nicotine.	Tobacco; Cigarettes containing tobacco substitutes, not for medical purposes; Electronic cigarettes; Liquid nicotine solutions for use in electronic cigarettes; Filter-tipped cigarettes; Oral vaporizers for smokers; Lighters for smokers; Cigarette filters; Cigarettes; Flavorings, other than essential oils, for use in electronic cigarettes; Pipe racks for tobacco pipes; Tobacco pouches; Tobacco pipes; Cigarette cases; Cigars; Herbs for smoking; Cigar cases; Tobacco jars; Ashtrays for smokers; Matches.

13. Whilst some goods are self-evidently identical or are identical based on the principle outlined in *Gérard Meric v OHIM*² (for example, “*electronic cigarettes; filter-tipped cigarettes*” appear identically in both specifications; and Bargain’s “*Vape bars*” are identical, according to the *Meric* principle, to PAX’s “*oral vaporizers for smokers*”), as I have noted from the outset, PAX has conceded that all the goods are similar, I shall therefore proceed on the basis of this concession. Although PAX has not specified the degree of similarity, for reasons that will become apparent, it is sufficient for me to treat all of the competing goods as similar to at least a low degree.

² Case T- 133/05, wherein the General Court held to the effect that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

The average consumer and the nature of the purchasing process

14. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods and services in question. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, at [15]-[20], where he pointed out the following in relation to the average consumer:

- (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
- (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
- (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
- (d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;
- (e) The average consumer's level of attention varies according to the category of goods or services in question; and
- (f) The average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and

must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

15. The competing goods are smoking products and smokers' articles, such as cigarettes, cigarette filters, tobacco pipes and lighters, as well as electronic cigarettes (including vape bars) and related liquids.

16. The average consumer of those goods will be a member of the general public of legal age to purchase smoking or vaping related products. The goods are likely to be purchased frequently, with consumers taking into account considerations such as price as well as flavour and strength to suit their personal preferences, but overall the goods would not be overly scrutinised and the average consumer is likely to pay a medium degree of attention when selecting the goods.

17. The purchasing process is also likely to vary depending on the goods in question. In relation to vaping products and related accessories, visual considerations are likely to play an important role, as the goods will be selected from retail displays, specialist shops or online listings. However, in the case of tobacco products, sold in physical retail premises in the UK, consumers may be required to request the goods orally without seeing them displayed due to UK legislation prohibiting their display. In those circumstances, the consumer is only likely to see the mark on the packaging after asking a retail assistant for the product, but will nonetheless see the mark before completing the sales transaction. I therefore bear in mind that the purchasing process may involve both visual and aural considerations, depending on the particular goods and circumstances of purchase.

Comparison of marks

18. I have already set out the principles gleaned from established case law with regard to comparing competing marks. I also note that the Court of Justice of the European Union ("CJEU") stated in *Bimbo SA v OHIM*,³ 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

³ Case C-591/12P, at paragraph 34.

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.”

19. 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 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.

20. The marks being compared are shown below:

Bargain’s earlier mark	PAX’s mark
CRYSTAL BAR	THE CRYSTAL PRO MAX

Overall impression

21. The competing marks are both word-only marks. The overall impression of both marks therefore lies solely in the words of which they consist.

22. Mr Lowry’s submission was that *“because vapes and e-cigarettes are in the shape of a bar, we accept that BAR would be descriptive and nondistinctive for those goods”*. However, in relation to the remainder of Bargain’s goods, Mr Lowry submitted that CRYSTAL BAR as a whole is distinctive and that it is not descriptive.

23. I agree with Mr Lowry that the word BAR has limited relative weight in relation to electronic cigarettes and other vaping or vaping-related products, since consumers of those goods are likely to perceive it as referring to the kind of product, i.e. a vape bar (this finding is supported by the fact that *“vape bars”* and *“disposable vape bars”* are terms for which the earlier mark is registered). The average consumer would therefore accord it less attention than the word CRYSTAL. However, even for tobacco products and smokers’ articles, for which BAR is not wholly descriptive, I do not consider that it will attract the greatest consumer attention. This is because it is shorter, appears as

the second word in the mark and, whilst this is only a rule of thumb, consumers generally pay greater attention to the beginnings of marks.⁴ Taking these matters together, I consider that CRYSTAL plays the greater role in the overall impression of the earlier mark.

24. As for PAX's mark, Mr Lowry made the following submissions:

"The word "THE" is a defined article or determiner and, therefore, from our perspective, it should be rendered nondistinctive. The word "PRO" is descriptive and nondistinctive and is short form for the word "professional". The word "MAX" again, is descriptive and nondistinctive and short form for the word "maximum" [...]. [The] terms PRO, MAX and the word THE, add little to nothing whenever it comes to the perception of the average consumer."

25. I agree with Mr Lowry, the word THE, being a definite article, will have little, if any, effect on the perception of the average consumer and on the overall impression. I also agree with Mr Lowry that the words PRO and MAX will be understood by the average consumer as abbreviations of 'professional' and 'maximum' respectively. In the context of the goods, they are likely to be perceived as elements which emphasise characteristics or qualities of the goods, rather than as distinctive or dominant components of the mark. For example, MAX may be perceived merely as an indication of maximum strength. Whilst I do not overlook that the word PRO may seem somewhat odd in relation to the goods – in the sense that it would be unusual to describe smoking or vaping goods as being of a 'professional' grade – I do not consider that the average consumer would overly scrutinise that oddity and is, nonetheless, likely to accord the word less attention, perceiving it instead as a simple marketing ploy rather than an indicator of trade origin. Accordingly, the words THE, PRO and MAX have limited relative weight in the mark, such that the overall impression of the mark is dominated by the word CRYSTAL.

Visual comparison

26. Visually, the marks coincide in the word CRYSTAL. Although there are other elements in both marks, the shared element CRYSTAL is the dominant and distinctive

⁴ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

element of both marks. The marks differ due to the presence of BAR in Bargain's mark and THE, PRO and MAX in PAX's mark, but as those words have limited relative weight in the overall impression, those differences carry limited weight. Overall, I consider the marks to be visually similar to a medium to high degree.

Aural comparison

27. The word CRYSTAL will be pronounced identically in both marks. Although PAX's mark begins with THE, I bear in mind that, as a definite article, the average consumer may not perceive it as part of the brand name and may not articulate it when asking for the goods. The point of aural identity in such circumstances therefore essentially lies at the beginning of the marks.

28. The words BAR in Bargain's mark and PRO MAX in PAX's mark are points of aural difference. Given my earlier findings that those words have limited relative weight, it is necessary to bear in mind that secondary or descriptive elements in a mark may not always be spoken by the average consumer. In that regard, Professor Philip Johnson, sitting as the Appointed Person in *ENRICH LEARNING*, BL O/1141/25, made the following observations (my emphasis for clarity):

"15. The General Court continues to take the view that secondary or descriptive elements of marks are not necessarily spoken: see T-68/2021 *Hauz 1929 v EUIPO*, EU:T:2021:127, [40]; T-560/20 *Yadex International v EUIPO*, EU:T:2021:714, [75]; T-357/21 *Jose Alfonso Arpon v EUIPO*, EU:T:2022:405, [52]; T-1144/23 *Enedo Oyj v EUIPO*, EU:T:2025:207, [88]. These cases follow the general pattern of the jurisprudence before the UK left the EU and so they remain strongly persuasive, and I therefore consider them as reflecting English law: see *Lipton v BA Cityflyer Ltd* [2024] UKSC 24, [158].

16. In my view, the principle that descriptive or secondary elements in a mark may not be pronounced when the mark is spoken is distinct from the rule that negligible elements of marks can be disregarded in the comparison of marks (see C-3/03/P *Matratzen Concord* [2004] ECR I-3657). The former is a reflection of the fact that in everyday life people often say things in a simplified or shortened form (even though they may be aware of the entire

mark). The latter principle, on the other hand, reflects the fact that negligible or insignificant elements of the mark will be forgotten (or not memorised in the first place).

17. Accordingly, if Philip Harris, sitting as the Appointed Person, in *Purity Wellness Group v The Stockroom (Kent)* (O/115/22), [31]-[32] was suggesting (and I am not sure he was) that all descriptive elements of a mark must be considered as spoken in the aural comparison (unless those elements are negligible) I disagree with him; rather, I consider that I should follow the approach of the General Court outlined above.

18. Accordingly, it was open to the Hearing Officer to treat the word “LEARNING” as descriptive in relation to education-related services. And in light of this finding, it was likewise perfectly acceptable for the Hearing Officer to conclude that this element of the mark would not usually be verbalised. I therefore reject this ground of appeal.”

29. Given the descriptive nature of the word BAR in relation to some of the goods, I do not overlook that a proportion of the average consumer may, when selecting those relevant goods, shorten the mark to CRYSTAL. The same may also be true of PRO and MAX. As I have already noted, the word THE is also likely to be dropped in pronunciation. The result may therefore be that a proportion of the average consumer simply shortens PAX’s mark to CRYSTAL when requesting the goods. In those circumstances, the marks would be aurally identical in the form in which they are verbalised.

30. That said, even though BAR, PRO and MAX carry limited weight in the overall impression of the marks, I also consider that there remains a proportion of average consumers who, when requesting the goods, will verbalise those words and ask for CRYSTAL BAR and CRYSTAL PRO MAX, whilst still being likely to omit THE. Taking these matters together, I consider the marks to be aurally similar overall to a medium degree in such circumstances.

Conceptual comparison

31. The word THE does not materially affect the conceptual impression. Conceptually, the marks principally coincide in the word CRYSTAL, which is an ordinary English word, the meaning of which would be known to the average consumer. The concept conveyed by that word is therefore the same in both marks. To that extent, there is conceptual identity between them.

32. The words BAR and PRO MAX introduce different concepts. This is because, in relation to at least a significant proportion of the goods, BAR is likely to be understood as a reference to a vape bar. By contrast, PRO MAX is likely to be perceived as indicating a maximum or enhanced version of the goods. Taking these matters together, I consider that the marks are conceptually similar overall to a medium degree. However, given my earlier assessment of those words, the conceptual differences they introduce are of limited significance and do not materially alter the overall concept introduced by the word CRYSTAL. Even in relation to goods for which BAR is not wholly descriptive, the shared concept conveyed by the word CRYSTAL remains the same in both marks.

Distinctive character of the earlier trade mark

33. The degree of distinctiveness of the earlier mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the earlier mark, the greater the likelihood of confusion may be.⁵

34. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,⁶ 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

⁵ *Sabel v Puma*.

⁶ Case C-342/97.

(see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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).”.

35. Whilst distinctiveness is assessed by reference to the mark as a whole, simply stating the overall level of distinctiveness of the earlier mark is not sufficient, it is the distinctive character of the component or components that are similar between the marks that is of particular relevance.⁷

36. Registered trade marks possess varying degrees of inherent distinctive character, ranging from low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

37. I have no evidence of use to consider, I therefore have only the mark’s inherent distinctiveness to assess.

38. For the reasons already stated, it is the distinctiveness of the word CRYSTAL which is particularly relevant, since it is that word which the competing marks have in common.

39. CRYSTAL does not convey a clear meaning in relation to the goods. It is an ordinary English word which has a medium degree of inherent distinctive character.

⁷ *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, [39] to [40].

40. Considered as a whole, the earlier mark is not materially more distinctive by reason of the presence of the word BAR, even for goods in relation to which that word is not wholly descriptive. Accordingly, the earlier mark has a medium degree of inherent distinctive character overall.

Conclusions on Likelihood of Confusion

41. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.⁸ I must also consider the average consumer of the goods, the nature of the purchasing process and bear in mind that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.⁹

42. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.¹⁰ The relative weight of the factors is not laid down by law but is a matter of judgement for the tribunal on the particular facts of each case.¹¹

43. It is well established that direct confusion arises where the consumer mistakes one mark for the other; whereas indirect confusion arises where the consumer recognises that the marks are different, but because of their similarities, believes that the goods or services bearing the later mark come from the same undertaking, or from an economically linked undertaking.¹² For example, the consumer concludes that the later mark is another brand of the owner of the earlier mark because the marks share a

⁸ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

⁹ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*, Case C-39/97, paragraph 17

¹⁰ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

¹¹ See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

¹² *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 10

common element.¹³ Such instances may arise where, for example, the later mark simply adds a non-distinctive element to the earlier mark of the kind one would expect to find in a sub-brand or brand extension.¹⁴ In *L.A. Sugar Limited v By Back Beat Inc*,¹⁵ Mr Iain Purvis Q.C., as the Appointed Person, explained that instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:¹⁶

- “(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example).”

44. I summarise my findings as follows:

- (1) I am proceeding on the basis of PAX’s concession, that the goods are similar (at least to a low degree). However, I do not overlook that the competing specifications also contain identical terms.

¹³ *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16-17 wherein Mr Iain Purvis QC, sitting as the Appointed Person, dealt with the distinction between direct and indirect confusion. In *Liverpool Gin Distillery* Arnold LJ approved Mr Purvis’s formulation but added at [12] that it is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.

¹⁴ *Ibid.*

¹⁵ *Ibid.*

¹⁶ In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis’s formulation but added at [12] that it is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.

(2) The purchasing process may involve both visual and aural considerations, depending on the particular goods and circumstances of purchase. The degree of attention paid is likely to be medium.

(3) The marks are visually similar overall to a medium to high degree. Depending on the circumstances, a proportion of the average consumer may simplify or shorten the marks when requesting the goods, articulating only the word CRYSTAL and thereby rendering the marks aurally identical. In circumstances where the average consumer does not shorten the marks, they are aurally similar overall to a medium degree. The marks share the identical concept with regard to the word CRYSTAL. BAR and PRO MAX introduce different concepts, rendering the marks conceptually similar overall to a medium degree. However, those differences are of limited significance and do not materially alter the overall concept introduced by CRYSTAL.

(4) As to the distinctive character of the earlier mark, I have found that the component common to the competing marks (which is the element of particular relevance), namely the word CRYSTAL, possesses a medium degree of inherent distinctiveness and that overall the earlier mark is distinctive to a medium degree.

45. Taking all the above factors into consideration, and allowing for imperfect recollection, whilst bearing in mind the principle of interdependency, I find that a significant proportion of the average consumer will simply mistake one mark for the other and will therefore be directly confused as to the origin of the goods as a result, even where goods similar to a low degree are involved.

46. Where a proportion of the average consumer recognises the difference between the marks created by the word BAR in Bargain's mark, and THE, PRO and MAX in PAX's mark, they are nonetheless likely to be indirectly confused. This is because the distinctiveness of the shared element CRYSTAL is sufficiently strong in the context of the goods at issue that consumers are likely to perceive those differences as variations of the kind which one would expect to find in a sub-brand or brand extension, rather than as indicating that the goods come from different traders.

OUTCOME

47. The application to invalidate UK trade mark registration number 3839659 is successful. Subject to any appeal against my decision, the contested mark will be declared invalid. Under section 47(6) of the Act, the registration is deemed to have never been made provided that this shall not affect transactions past and closed.

COSTS

48. Bargain has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £900, which is calculated as follows:

Official fee for filing Form TM26I	£200
Preparing the Statement of Grounds and considering the Counterstatement	£200
Preparing for and attending a hearing	£500
TOTAL	£900

49. I therefore order PAX Innovations (Shenzhen) Limited to pay Bargain Busting Limited the sum of **£900** within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 11th day of June 2026

Daniela Ferrari

For the Registrar