

BL O/0673/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3871728

ORIGINALLY IN THE NAME OF 1st PHORM INTERNATIONAL, LLC

NOW IN THE NAME OF 1st PHORM IP HOLDINGS, LLC

TO REGISTER UK TRADE MARK 3871728

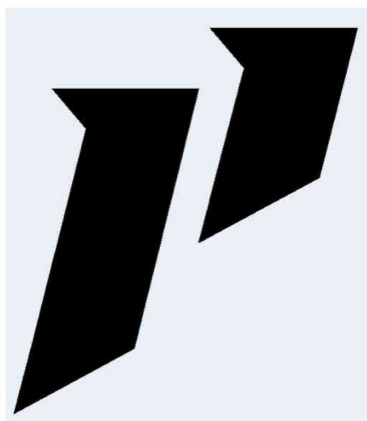
IN CLASSES 5, 9, 25, 29, 30, 32 & 41

AND IN THE MATTER OF OPPOSITION NO. 440723 THERETO

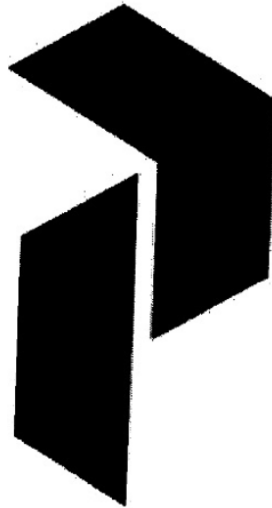
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DECISION

1. This is an appeal against the decision of Hearing Officer James Hopkins dated 18 February 2025 (“the Decision”) in which he allowed a partial opposition under s.5(2)(b) against the following mark UK 3871728 in class 25:



2. As noted above, the application for the mark has now been assigned to 1st Phorm IP Holdings, LLC, (“the Appellant/Applicant”). Nothing turns on this.
3. The Opponent/Respondent is the proprietor of the following UK mark 800989616, registered in, amongst others, class 25 for clothing, footwear, headgear:



4. The Hearing Officer's decision under s.5(2)(b) can be succinctly stated. He found that there were identical goods and that given the visual and aural similarities between the marks, there was a likelihood of direct confusion.
5. Before me at a hearing held on 16 July 2025 the Appellant was represented by Lee Curtis of HGF Limited and the Respondent by Daniel Ramos of Osborne Clarke LLP. I am grateful to them both for their concise written and oral submissions.

Standard of Appeal

6. There was no dispute as to this and I was referred to the well-known cases of *Axogen v Aviv Scientific* [2022] EWHC 95 (Ch) and *Lifestyle Equities v Amazon* [2024] UKSC 8. I was also referred to the recent Supreme Court decision in *Iconix v Dream Pairs* [2025] UKSC 25 where Lords Briggs and Stephens explained in relation to the infringement section s.10(2)(b) of the Trade Marks Act 1994, (equivalent to the validity provisions of s.5(2)(b)) (all emphasis added):

93. **The question whether there is a trade-mark infringement under section 10(2)(b) of the Act is a classic example of what has come to be known as a multi-factorial assessment. It involves the finding of primary facts, the application of relevant principles or rules of law to those facts and the evaluative decision whether, thus considered, something has happened which falls within (here) a statutory definition.** In the present case those definitions are similarity and confusion, and the existence of the requisite causative link between the two, as required by section 10(2)(b), as well as the artificial (largely judge made) construct of the average consumer, through whose eyes similarity and confusion have to be gauged.

94. **It is perhaps obvious, and certainly an inevitable conclusion drawn from experience, that reasonable minds, and in particular reasonable judicially**

trained minds, each faithfully applying the relevant law and principles, will come to different conclusions about the answer to these multifactorial questions. While of course the decision of an appellate court trumps that of the court below, the law has imposed structured constraints designed to prevent a free for all in a higher court whenever a party (with the necessary resources) wishes to challenge the first instance decision of the trial judge. The reasons for these constraints are set out in a string of well-known authorities including, in the intellectual property context, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5; [2014] FSR 29, per Lewison LJ at para 114. The reasons there set out relevantly include the following:

- (i) **The trial is not a dress rehearsal. It is the first and last night of the show.**
- (ii) **Duplication of the trial judge's role on appeal is a disproportionate use of the limited resources of an appellate court.**
- (iii) **In making his decisions the trial judge will have regard to the whole of the sea of evidence presented to him, whereas an appellate court will only be island hopping.**

95. In *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8; [2024] Bus LR 532 this court reviewed those constraints in a trade mark context. After citing from the *Fage* case this court in a joint judgment said, at paras 49-50:

"49. That does not, however, mean the appeal court is powerless to intervene where the judge has fallen into error in arriving at an evaluative decision such as whether an activity was or was not targeted at a particular territory. It may be possible to establish that the judge was plainly wrong or that there has been a significant error of principle; but the circumstances in which an effective challenge may be mounted to an evaluative decision are not limited to such cases. Many of the important authorities in this area were reviewed by the Court of Appeal in *In re Sprintroom Ltd* [2019] 2 BCLC 617, paras 72–76. There, in a judgment to which all members of the court (McCombe, Leggatt and Rose LJJ) contributed, the court concluded, at para 76, in terms with which we agree, that **on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion.**

50. On the other hand, it is equally clear that, for the decision to be 'wrong' under CPR r 52.21(3), **it is not enough to show, without more, that the appellate court might have arrived at a different evaluation.**"
7. In *Iconix* the Supreme Court, in reversing the decision of the Court of Appeal and reinstating the decision of the trial judge, considered at §116 that "*there were not matters such as irrationality, error of principle or of law which justified the Court of Appeal in substituting their own different view of the answer to the multifactorial question facing the judge from that which he had reached*".
8. The passage bridging §§49 and 50 of *Lifestyle Equities* summarises the approach to appeals such as the present. I should allow the appeal if there is an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion. However, it is not enough to show, without more, that I might have arrived at a different evaluation.
9. In relation to this last point, Mr Curtis for the Appellant emphasised the observation of Daniel Alexander QC in *TT Education v Pie Corbett Consultancy* [2017] RPC 17 that "*in the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, **but not the very highest degree of reluctance**, to interfere in the absence of a distinct and material error of principle.*" I accept that too.
10. Finally, in relation to one of the specific grounds pursued in the present case, namely the "classification" of the similarity of the marks (which commonly arises on appeals from the Registry) I also bear in mind the guidance of Arnold LJ in *TVIS Ltd v Howserv Services Ltd* [2024] EWCA Civ 1103; [2025] ETMR 2 at §95 where he held at §§33-35 (emphasis added):

Ground 1: Visual and aural similarity

33. TVIS argues that the judge erred in holding that PETSURE is, visually and aurally, merely "similar" to VETSURE and that he should have held that it was highly similar.
34. I do not accept this argument for two reasons. The first is that no error of principle on the part of the judge has been identified. **The assessment of the degree of visual and aural similarity between a sign and a trade mark is a matter for the first instance tribunal.** Nor can it be said that the judge's assessment is plainly wrong.

35. **The second and more fundamental reason is that, while it is conventional for first instance tribunals in trade mark cases to articulate their assessment of the degree of visual and aural similarity between signs and trade marks using words such as “high”, “medium” or “low”, there is no legal requirement for tribunals to do so. All that is required is for the tribunal to assess the nature and extent of any similarities. This is because what matters is not the verbal label that is applied to the assessment, but whether the similarities in conjunction with the other factors which must be taken into account lead to a likelihood of confusion.** It is possible for there to be no likelihood of confusion despite a relatively high degree of visual and aural similarity. Equally it is possible for there to be a likelihood of confusion despite a relatively low degree of visual and aural similarity. It depends on the other factors that are in play.

The Appeal

11. The appeal is brought on a narrow basis and focuses on the Hearing Officer’s comparison of the marks. There is no challenge to the Hearing Officer’s conclusion that the Opponent had established proof of use (paragraph 38 of the Decision), that the class 25 goods under consideration are identical (paragraphs 41 & 42 of the Decision) or to the assessment of the average consumer (paragraph 44 of the Decision).

Ground 1

12. The Appellant’s first ground of appeal relates to the Hearing Officer’s assessment of the two marks. In short, the Appellant submits that the Hearing Officer failed to assess where the distinctive character lay in the mark applied for, and wrongly compared the marks, essentially as “letters P”. It is said that whilst the Hearing Officer properly assessed the distinctive character of the Opponent’s mark, he did not do so in relation to the mark applied for and rather jumped straight to the comparison step.
13. The Appellant is correct that in paragraph 47 of the Decision the Hearing Officer drew various conclusions in respect of the Opponent’s mark. He found that “*a significant proportion of consumers will perceive [it] as a stylised letter ‘P’.*” He went on to find that “*the letter ‘P’ is not particularly distinctive*” and that “*the distinctive character of the mark is largely attributable to its particular graphic representation, not the letter per se.*”
14. Pausing there, I think it is important to understand what the Hearing Officer was doing here. He was holding that the mark would be seen as a ‘P’ but that because

letters are not particularly distinctive, the distinctive character of the mark comes more from its graphical representation.

15. The Appellant is also correct that the Hearing Officer's assessment of the mark applied for was carried out as part of the comparison exercise. In particular the Hearing Officer found at paragraph 55 (emphasis added):

55. The parties' marks consist of two geometric shapes. I have already found that a significant proportion of consumers are likely to perceive the opponent's mark as a stylised letter 'P'. Whilst there are other possibilities, due to the way in which the shapes are configured, it is my view that **this is equally applicable to the applicant's mark. In respect of each mark, the letter 'P' and the way in which it is presented will dominate the overall impression.**

16. I do not see anything contradictory in this. The Hearing Officer was saying that the mark applied for will also be seen as a 'P' and that its impact as a letter *and* the way in which it is presented will dominate the overall impression. This is consistent with his findings in paragraph 47. Just because he found that the *distinctive character* of the marks were more attributable to their graphic representation does not mean that the marks would not still be perceived as the letter P. Further, although the Hearing Officer could have assessed the distinctive character of the mark applied for separately before commencing the comparison process, I do not consider that he committed an error of principle in jumping straight to the comparison.

17. The Appellant then submits that the Hearing Officer fell into error when assessing visual similarity in paragraph 56 because he wrongly focussed on the "letter 'P'" and did not compare the marks as a whole.

18. I do not accept this. Paragraph 56 reads as follows:

56. Visually, the competing marks are similar in that they both comprise two geometric shapes presented in a single colour. In both marks, one of the shapes is offset to the top right of the other. As wholes, both will be perceived as representations of the letter 'P'. Whilst I acknowledge that visual similarity does not automatically follow where two marks share representations of the same thing,²⁴ it is my view that there are stylistic commonalities between the letters in this instance. The competing marks are visually different in that the particular shapes used are somewhat different. Moreover, the alignment of the shapes differs (roughly vertical in the opponent's mark and more diagonal in the applicant's mark). Bearing in mind my assessment of the respective overall impressions, I find that there is between a medium and high degree of visual similarity between the competing marks.

19. [Footnote 24 is a reference to the decision of Iain Purvis QC in *The Royal Academy of Arts v Errea Sport S.P.A.*, BL 0/010/16. I return to this below.]
20. It can be seen from the above that the Hearing Officer did compare the geometric shapes of the marks and so did not only treat them as letter 'P's. He also treated them "[a]s wholes". He identified visual differences between the shapes and alignment of their individual features, and made a comparison of the respective overall impressions. This was all in line with the authorities which the Appellant accepted that he correctly cited.
21. The Appellant relied on paragraphs 26-27 of *Iconix* in the Court of Appeal for Arnold LJ's criticisms in that case of the way in which the judge dealt with the comparison of signs. Although those paragraphs were not central to the Supreme Court's reversal, I do not get any assistance from them as each case must turn on its own facts.
22. Nor do I get any assistance from the Respondent's attempt to rely on a parallel decision between the parties arising from the Australian Delegate of the Registrar of Trade Marks dated 3 June 2025 in *Peak Performance v 1 Phorm International* 2025 ATMO 98. This was not before the Hearing Officer and was not the subject of any Respondent's Notice. Nor do I know what evidence or arguments were before that tribunal or the precise test used under the Australian legislation. Most significantly, it is no more than an attempt to influence me when, in the words of the Supreme Court, "*reasonable judicially trained minds, each faithfully applying the relevant law and principles, will come to different conclusions about the answer to these multifactorial questions*". I must look only at the decision before me and apply the appellate test which I have set out above.
23. Doing that, I can see no error in the way the Hearing Officer assessed the visual impact of the marks. For the above reasons I dismiss the first ground of appeal.

Ground 2

24. The second ground of appeal relates to the allegation that the Hearing Officer over emphasised the aural comparison of the marks. The Appellant noted the Hearing Officer's citation of *The Royal Academy of Arts* case referred to above, but submitted that he then failed to apply it. In particular, the Appellant relied on paragraph 15 of that decision, where Mr Purvis QC explained:

In essence [the opponent's] argument was that there was bound to be a likelihood of confusion in this case because of the aural 'identity' between the marks (if one

tried to ask for goods using an aural version of the earlier mark, one would ask for 'RA' goods, just as one would ask for the applicant's goods). This argument seems to me to fly in the face of the necessary 'global' assessment, bearing in mind the visual, conceptual and aural similarities, which the tribunal must carry out. Particularly in the case of an earlier mark which is a heavily stylised device mark, taking the aural similarities alone tends to ignore the real substance and distinctive character of the mark and is likely to lead to an erroneous result.

25. This argument that the Hearing Officer over-relied on the aural similarity is difficult to square with the finding of the Hearing Officer in paragraph 44 of the Decision that "visual considerations will dominate".

26. Moreover, it seems the Hearing Officer was relying on the *The Royal Academy of Arts* case for the earlier passage at paragraph 13 which reads:

"Thirdly, I do not have any difficulty with the notion (which Mr Stobbs appeared to be contending was illogical) that two representations of the same thing may have no visual similarity. In the world of art, the visual representation of a horse in Picasso's *Guernica* has little or nothing in common with the visual representation of a horse in one of George Stubbs' portraits. I do not think it unreasonable to say that they have no visual similarity, whilst having some limited conceptual similarity (they are both paintings of horses)."

27. So what the Hearing Officer was doing in paragraph 56 was noting the principle that the same thing may be represented visually differently, but then finding on the facts of this case that the visual representations had similarities. I agree with this and can see no error in his reference to or application of the principle.

28. It was said by the Appellant that the Hearing Officer, having found that visual considerations will dominate, was mistaken to then place weight on the aural similarities. I do not think he fell into error in this regard. His overall analysis of likelihood of confusion took place in two stages. First, he summarised his findings in paragraph 61, as follows (emphasis added):

- The parties' goods are identical;
- The average consumer is likely to be a member of the general public, who will demonstrate a medium level of attention;
- **The purchasing process is predominantly visual in nature**, though aural considerations have not been discounted;
- The opponent's mark has a medium level of inherent distinctive character;
- For a significant proportion of consumers, the overall impression of each mark **is dominated by the letter 'P' and the way in which it is presented**;

- The competing marks are visually similar to between a medium and high degree and aurally identical, whilst the conceptual position is neutral.

29. Then in paragraph 62 he reached his overall conclusion on the multifactorial issue of likelihood of confusion based on these findings, in the following terms:

62. I acknowledge that there are differences between the competing marks. As previously outlined, the shapes are not precisely the same and neither is their alignment. Nevertheless, considering the overall levels of visual and aural similarity between the competing marks, the identity between the parties' goods, and the distinctiveness of the opponent's mark, it is my view that the differences between the marks may not be sufficient to distinguish the applicant's goods from those of the opponent. The competing marks will be perceived by a significant proportion of consumers as representations of the same letter ('P') presented in a similar manner, i.e. in two parts made up of angular geometric shapes. The slight differences in, for instance, the alignment or the specific design features of the shapes, may, when viewing the competing marks as wholes, go unnoticed by the average consumer. In consideration of all the above, and factoring in the principles of imperfect recollection and interdependency, it is considered that the average consumer, paying no more than a medium level of attention, may not recall the competing marks with sufficient accuracy to differentiate between them. Consequently, I find that there is a likelihood of direct confusion.

30. Note his repeated references to the differences he identified between the visual presentation of the marks as well as to a comparison of the marks as a whole. I cannot find any error based on any misapplication of any principle (as opposed to a finding on the facts) in *Royal Academy of Arts*.

31. Indeed, paragraph 62 represents a classic multifactorial analysis based on individual findings which the Hearing Officer was entitled to reach. In the absence of any error of principle, interference with the conclusion would be contrary to the authorities I have referred to above. I also dismiss the second ground of appeal.

Grounds 3 & 4

32. Under the third ground of appeal it is said that the Hearing Officer fell into error because he found a medium to high degree of visual similarity between the marks when he should have found a lower degree.

33. As the quote from *TVIS* makes clear above, this ground of appeal on its own is hopeless. The assessment of the degree of visual and aural similarity between a sign and a trade mark is a matter for the first instance tribunal. Moreover, what matters is not the verbal label that is applied to the assessment, but whether the

similarities in conjunction with the other relevant factors lead to a likelihood of confusion. Attempts by appellants to tinker with individual assessments of similarity (high, medium, low etc.) get nowhere unless it can be shown that overall there is an error in the multifactorial assessment of the likelihood of confusion.

34. This is the fourth and final ground of appeal – that the earlier errors “either collectively or individually” resulted in error in the overall assessment.
35. But I have rejected each of the individual grounds, either because there was no error, or because even if a different tribunal might have come to a different decision about e.g. visual similarity, the Hearing Officer was entitled to reach the conclusion he did. For those reasons the fourth ground must also fail. There is no basis to interfere with the conclusions of the Hearing Officer.
36. The appeal is dismissed.

Costs

37. The parties were agreed that standard costs on the scale should follow the result.
38. Bearing in mind the concise nature of the written documents, but also attendance at the hearing, I make an award of £1200 to the Opponent/Respondent made up of £300 for the TM55 and £900 for preparing for and attending the hearing before me.
39. The Hearing Officer awarded £2200 to the Opponent.
40. I therefore order the Appellant to pay to the Respondent a total of £3400 within 21 days of the date of this decision, namely by 4pm on 8 August 2025.

Thomas Mitcheson KC
The Appointed Person
18 July 2025