BL O/0084/26

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3668640 BY PRAXIS42 LTD AND OPPOSTION THERETO UNDER NO 430604 BY SHINEVISION LTD

AND IN THE MATTER OF TRADE MARK REGISTRATION NO 2563951 IN THE NAME OF SHINEVISION LTD AND AN APPLICATION FOR REVOCATION THERETO UNDER NO 504481 BY PRAXIS42 LTD

AND IN THE MATTER OF TRADE MARK REGISTRATION NO 3420149 IN THE NAME OF PRAXIS42 LTD AND AN APPLICATION FOR INVALIDITY THERETO UNDER NO 505266 BY SHINEVISION LTD

DECISION

Introduction

1. This is an appeal against the decision of Leisa Davies, acting on behalf of the Registrar, dated 2 June 2025 (O-0498-25)("***the Decision***").

2. On 14 July 2021 Praxis42 Ltd ("***Praxis***") applied to register Trade Mark Application No. 3668640 for the word SHINE ("***the '640 mark***"). On 28 January 2022, ShineVision Ltd ("***Shinevision***") filed opposition proceedings under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("***the 1994 Act***").

3. For the purposes of (1) section 5(2)(b) Shinevision relied upon two trade marks (i) UKTM No 3186713 ("***the '713 mark***"); and (ii) UKTM No 2563951 ("***the '951 mark***"); and (2) for the purposes of section 5(4)(a) Shinevision relied upon its unregistered sign SHINE for '*the provision of software, advisory services, IT services, consultancy and training services in the field of health and safety, risk management and compliance*' and claimed that the use of the '640 mark would amount to passing off.

4. Praxis filed a defence and counterstatement denying the grounds of opposition and putting Shinevision to proof as well as requesting proof of use of the '951 mark.

5. On 6 January 2022 Praxis filed an application for revocation of the '951 mark on the grounds of non-use pursuant to section 46(1)(b) of the 1994 Act for the period 4 January 2017 to 4 January 2022. Shinevision filed a defence and counterstatement defending use of its mark.

6. On 22 July 2022 Shinevision issued invalidation against Praxis Trade Mark Registration No 3420149 ("***the '149 mark***") it did so on the basis of sections 47 and sections 5(2)(b) and 5(4)(a) of the 1994 relying on its '713 and '951 marks and its

unregistered mark SHINE. Praxis filed a defence and counterstatement and requested proof of use of the '951 mark. It did not request proof of use of the '713 mark (although it could have done).

7. These proceedings were consolidated.

8. Both parties filed evidence and submissions.

9. A hearing was requested which was heard by video conference on 17 January 2024. At that hearing Praxis was represented by Mr Silcock instructed by Birkett Long LLP and Ms Kendal Watkinson instructed by Ward Hadaway LLP appeared on behalf of Shinevision.

10. The Hearing Officer found that:

    (1) Praxis' application for revocation against Trade Mark Registration No 2563951 was refused.

    (2) Shinevision's opposition to Trade Mark Application No 3668640 succeeded and the application refused in its entirety.

    (3) The application for invalidity against Trade Mark Registration No 3420149 succeeds and the Trade Mark Registration No 3420149 was invalidated and deemed never to have been made

    (4) Praxis42 was ordered to pay Shinevision £3,700 as a contribution towards its costs.

The appeal

11. Praxis filed an appeal in accordance with section 76 of the 1994 Act. In paragraphs 15 and 16 of the Grounds of Appeal dated 30 June 2025 it was stated:

> 15. No appeal is made by [Praxis] against the Decision insofar as it held that the Dissimilar Services were dissimilar, to one another, nor insofar as it held that Shinevision had failed to prove use or establish relevant goodwill in respect of "*training services in the field of health and safety, risk management and compliance*" (see Decision at para. [80]), nor insofar as it rejected the Opposition under section 5(2)(b) of the Dissimilar Services.
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> 16. Rather by, this Appeal [Praxis] requests the reversal of, and hereby appeals, those parts of the Decision that rejected the Revocation Application, that upheld the Opposition and Invalidity Application under section

> 5(2)(b) (to the extent that they were upheld in relation to that section) and section 5(4)(a), and that ordered costs against [Praxis]. . . .

12. In summary the Grounds of Appeal relied upon are:

    (1) That the delay by the Hearing Officer in issuing the Decision, the Decision being issued 16 months after the Hearing, was unreasonable and constituted a significant procedural injustice was such that the Decision should be set aside.

    (2) That the Hearing Officer misunderstood and/or wrongly assessed the evidence of use such that they should have found there was no or insufficient proof of use, and no or insufficient evidence of goodwill, in respect of all or any of the services in suit at the relevant dates.

    (3) That the Hearing Officer failed to direct themselves properly on the law as to the significance of the absence of any evidence of actual evidence or deception; and otherwise failed in the assessment of the likelihood of confusion or deception on the basis that they did not give sufficient weight to the various factors relevant to such an assessment. In particular, it is said that the Hearing Officer failed to take into account the relatively low level of distinctive character of the word element SHINE,

    (4) That the Hearing Officer wrongly failed to reach the same conclusion under section 5(4)(a) of the 1994 Act with respect to the Dissimilar Services as they reached in respect of the likelihood of confusion under section 5(2)(b) of the 1994 Act. In doing so it was said that the Hearing Officer had erred in the approach to the relevant legal test and incorrectly weighed the different factors already identified in the Decision when reaching the Decision under section 5(4)(a) of the 1994 Act and failed to given any or any sufficient weight to the fact that the burden was on Shinevision to establish that there was a likelihood of deception.

13. In a Respondent's Notice dated 22 July 2022 the Respondent averred for the purposes of responding to the appeal that the Hearing Officer correct for the reasons given but also for additional or alternative reasons in relation to (1) the findings of genuine use; (2) the similarity of goods/services; and (3) section 5(4)(a) of the 1994 Act.

14. At the hearing of the appeal which took place by video link Praxis was represented by Mr Ian Silcock instructed by Knight Professional Services Limited and Shinevision was represented by Thomas St Quintin instructed by Ward Hadaway LLP.

Standard of Review

15. The Supreme Court most recently restated the approach to appeals of this kind in its judgment in Iconix Luxembourg Holdings SARL v. Dream Paris Europe Inc [2025] UKSC 25 at [93] to [95] as follows:

> 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.
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> 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:
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> > (i) The trial is not a dress rehearsal. It is the first and last night of the show.
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> > (ii) Duplication of the trial judge's role on appeal is a disproportionate use of the limited resources of an appellate court.
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> > (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.
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> 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.
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> 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."

16. I have kept these principles, which were not in dispute, firmly in mind when considering the present appeal.

Decision

The Grounds of Appeal

17. The first ground of appeal raises a complaint with respect to the length of time, in this case 16 months, that it took the Hearing Officer to deliver the Decision. This is said to be unreasonable and to constitute a significant procedural injustice. It is said that as a result the test to be applied by the Appointed Person hearing the appeal is affected. What is maintained on behalf of Praxis is that the delay is such that either the consolidated proceedings should be remitted to be reheard by another Hearing Officer or that I should conduct the appeal by way of a rehearing and not by way of review.

18. I do not accept that any different approach to the test on appeal should be applied in the present case.

19. In Phones 4U v. EE and others [2025] EWCA Civ 869 the Court of Appeal considered the effect of delay in producing a judgment. This was addressed in paragraphs [216] to [228] of the judgment of Falk LJ with whom Sir Julian Flaux C and Phillips LJ agreed.

20. What is clear from this Judgment is that delay in itself is not a sufficient ground to impugn a judgment (see [218 a)]). The Judgment also confirmed that the approach taken by an appellate court to challenges to findings of fact and the evaluation and inferences to be drawn from them is that set out in Fage UK Ltd v Chobani UK Ltd [2014] EWCA Civ 5 at [114] referred to above in Lifestyle Equities CV v Amazon UK Services Ltd. It is also clear from this Judgment that particular considerations may arise in circumstances where live evidence has been given at trial which will be the subject of assessment by the trial judge (see [218 c) and d)].

21. It is of course deeply regrettable that it took 16 months for a Decision to be issued in this case and all the more so given the various indications of timing given by the Hearing Officer. However, the timings taken from the case law in the High Court which refer to a general rule of judgments being delivered within three months is not one that can be equated with the position in the UKIPO as Praxis seeks to do. In this connection it was confirmed at the hearing before me that no enquiries were made at any stage on behalf of Praxis with respect to the timing of the delivery of the Decision.

22. In addition, in the context of the present proceedings there was no cross-examination of witnesses. The evidence was entirely in written form. Therefore, the considerations referred to above with respect to the assessment of live witness evidence are simply inapplicable to the present appeal.

23. It is also maintained on behalf of Praxis that the delay affected the Hearing Officer's recollections on the parties' submissions in relation to the evidence. However, there is nothing in this point either. Both parties made submissions in writing and made submissions at the hearing which were recorded in a transcript that was available to the Hearing Officer when writing the Decision.

24. In any event at the hearing of the appeal no part of the Decision could be identified by Praxis in which the Hearing Officer's recollection of the evidence was at fault or wrong.

25. In the circumstances the first ground of appeal is dismissed.

26. Turning to the second and third grounds of appeal it is convenient to consider these together as this was the approach taken by Praxis at the hearing before me. Both grounds are directed to the Hearing Officer's approach to the evidence before them and the application of those findings to the assessments that they were required to make.

27. First there is the question of proof of use both in support of the use of the '951 mark and the claims with respect to goodwill and enhanced distinctive character. At paragraphs [34] to [62] the Hearing Officer set out a detailed summary of the evidence filed in support of the claim for use. Having considered that evidence the Hearing Officer specifically addressed the issue of use of the mark as registered or in variant form at paragraphs [63] to [70]. In this connection I note that the Grounds of Appeal made no reference to the findings made with respect to variant use. It therefore seems to me that any challenge to such findings is outside the scope of the appeal.

28. The gravamen of the appeal on the issue of use is that the Hearing Officer should not have taken a holistic approach to the evidence of use and failed to have regard to the particular services which were the subject to the proof of use requirement. It was maintained on appeal that by taking the holistic approach the Hearing Officer had failed to give adequate reasons for the findings that were made.

29. It is important to note that the relevant goods and services for which proof of use was required was as recorded in paragraph [4] of the Decision:

> Class 9: Health and Safety, Risk Management software packages, products, programmes and applications.
>
> Class 42: Software creation, design, development, installations, maintenance and computer programming in the area of Health and Safety, Risk Management.

30. Having set out the evidence filed on behalf of both parties the Hearing Officer set out the assessment of the evidence in some detail at paragraphs [71] to [80] of the Decision. In doing so the Hearing Officer clearly identified the issues or deficiencies in the evidence filed on behalf of Shinevision and dealt with the criticisms raised on behalf of Praxis by reference to different goods and services. The Hearing Officer also noted that (1) some of the evidence filed on behalf of Praxis bolstered the position of Shinevision (paragraph [76]); and correctly noted that in making the assessment fore genuine use that it is necessary to look at the evidence as a whole and not whether each individual piece of evidence shows use by itself.

31. The approach to the way appellate courts should approach the writing of judgments was recently set out by the Court of Appeal in Unik Bond SA v. Catbalogan Holdings SaRL [2025] EWCA Civ 1594 as follows:

> 59.In *Re Portsmouth City Football Club Ltd (in liquidation)* [2013] EWCA Civ 916, [2013] Bus LR 1152 Mummery LJ (with whom Rimer and Underhill LJJ agreed) posed the question at [36]:
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> > "What sensible purpose could be served by this court repeating in its judgments detailed discussions of every point raised in the grounds of appeal and the skeleton

> arguments when they have already been dealt with correctly and in detail in the judgment under appeal? No purpose at all, in my view."

60.He continued at [38]:

> "The proper administration of justice does not require this court to create work for itself, for other judges, for practitioners and for the public by producing yet another long and complicated judgment only to repeat what has already been fully explained in a sound judgment under appeal. If the judgment in the court below is correct, this court can legitimately adopt and affirm it without any obligation to say the same things over again in different words. The losing party will be told exactly why the appeal was dismissed: there was nothing wrong with the decision appealed or the reasons for it."

32. Having regard to this guidance I have reviewed the Hearing Officer's Decision in the light of the criticisms made and it seems to me that in expressing the assessment of the evidence in the way that the Hearing Officer did it is clear that they had clearly in mind the specific goods and services in Class 9 and 42 that were the subject of proof of use. In the circumstances I do not accept the criticisms made on this appeal. I am fortified in this view by the fact that the Hearing Officer at paragraph [79], albeit in the context of the claim under section 5(4)(a), expressly made findings as to what had not been shown on the evidence.

33. Turning to the criticisms of the Hearing Officer's assessment of the likelihood of confusion under section 5(2)(b) of the 1994 Act I note that this is precisely the type of appeal with which Iconix (above) was concerned.

34. Two points were relied upon in the skeleton of argument. First that the Hearing Officer failed to take into account or properly to take into account the absence of confusion relying on the principle as set out in Match Group, LLC v. Muzmatch Ltd [2023] EWCA Civ 454 at [64] to [122]. However, this issue was specifically addressed in the Decision at paragraph [122] and it was accepted before me on behalf of Praxis that the absence of actual confusion was not determinative. In the circumstances I do not accept the criticisms made of the Hearing Officer's approach in this regard.

35. Second, it is said that the Hearing Officer had failed to take into account the relatively low level of distinctive character possessed by the word element SHINE as part of the overall mark SHINEVISON and/or the consider the issue of independence of the word SHINE in the mark SHINEVISION. Again, I do not accept this.

(1) The Hearing Officer made assessments of the inherent distinctive character of the '951 and '713 marks at paragraphs [114] to [119] of the Decision. To the extent that this ground of appeal seeks to challenge any of those findings I do

not accept that this is within the scope of the Grounds of Appeal before me. However, even were that not the position the particular point that Praxis has sought to maintain before me was considered and rejected by the Hearing Officer in paragraph [117] of the Decision.

(2) The Hearing Officer referred to and was clearly aware of the issue that arises where one element of a composite mark is similar or identical to the mark which is being compared for the purpose of assessing conflict which was put on behalf of Praxis below. Reference was made to the relevant case of Whyte and Mackay Limited v. Origin Wine UK Limited [2015] EWHC 1271 at paragraph [128] of the Decision and considered by the Hearing Officer at paragraph [129] of the Decision.

36. Having reviewed the paragraphs in the light of the submissions made on behalf of Praxis I do not consider that the Hearing Officer can be said to have made a significant error of principle or was clearly wrong in the conclusions reached as to the likelihood of confusion with respect to either the '951 mark or the '713 mark. I am fortified in my view that the Hearing Officer was considering each on its own terms by the fact that the basis or the finding of a likelihood of confusion was different in each instance.

37. In the premises the second and third grounds of appeal are dismissed.

38. Lastly, I turn to the fourth ground of appeal. This was an appeal against the finding of conflict under section 5(4)(a) of the 1994 Act specifically directed to the Dissimilar Services.

39. It was quite rightly not suggested on this appeal that as a matter of law that the Hearing Officer should reach the same conclusion under section 5(2)(b) and sections 5(4)(a) of the 1994 Act. Indeed, it is clear from the Decision at paragraphs [144] to [145] and [161] to [162] that the Hearing Officer was well aware of the issues in play. Nor is it suggested that the Hearing Officer had incorrectly identified the relevant law.

40. Instead it is maintained that the Hearing Officer wrongly (1) assessed the parties' respective services in the round; (2) failed to given any weight or sufficient weight or consideration to the factors already identified with respect to the finding of no likelihood of confusion with respect to the dissimilar services under section 5(2)(b) of the 1994 Act; and (3) failed to have regard to the heavy evidential burden that lay on Shinevision to establish a likelihood of deception exited with respect of the dissimilar services.

41. Again, this is a challenge to a multifactorial assessment that was made by the Hearing Officer. I have reviewed the relevant parts of the Decision of the Hearing Officer, which although not perhaps expressed as fully as they might have been, do not seem to me to contain any error of principle or to be clearly wrong such as to vitiate the conclusions reached. I am fortified in that view given the findings in paragraph [162]

of the Decision that make clear that the Hearing Officer was well aware that the fact that there were findings that certain goods of services were not similar required particular consideration.

42. I therefore dismiss the fourth ground of appeal.

The Respondent's Notice

43. Turning to the Respondent's Notice. As noted in the skeleton of argument filed on behalf of (1) Shinevision made clear that its primary position was that the points raised in the Respondent's Notice only arose for consideration in the event that any part of the appeal was successful; (2) Praxis noted that there was no cross-appeal or challenge advanced by the Shinevision with respect to the Hearing Officer's ultimate order. In this connection it is to be noted that to the extent that the Respondent's Notice, if at all, raised any points that should be the subject of a cross-appeal then such an application would be out of time. This was accepted on behalf of Shinevision during the hearing before me.

44. In any event, in this case nothing turns on this as, for the reasons set out above, the appeal is dismissed and it is therefore not necessary for me to consider the contents of the Respondent's Notice.

Conclusion

45. On the basis of my findings above it does not seem to me that Praxis has identified any error of principle or material error in the Decision. Moreover, it is not in my view appropriate to interfere with the evaluations that the Hearing Officer made in reaching the conclusion that they did. In the result appeal fails and is dismissed.

46. As the appeal had been dismissed Shinevision is entitled to a contribution towards the costs of the appeal. Shinevision filed a Respondent's Notice, filed written submissions and appeared at the hearing of the appeal. It therefore seems to me in the exercise of my discretion that Praxis should pay a contribution of £1,500 to Shinevision's costs of the appeal.

47. The Hearing Officer ordered Praxis to pay Shinevision a contribution of £3,700 with respect to its costs at first instance. In those circumstances I order Praxis42 Limited to pay to ShineVision Limited the total sum of £5,200 on or before 20 February 2026.

EMMA HIMSWORTH KC

Appointed Person

30 January 2026