

BL o/0280/23

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO 3589286  
IN THE NAME OF NICOLA BLAKELEY**

**-AND-**

**IN THE MATTER OF OPPOSITION NO. 425794  
BY LIFESTYLE EQUITIES C.V.**

**-AND-**

**AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF  
MS B HEDLEY DATED 27 SEPTEMBER 2022**

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**DECISION**



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1. This is an appeal from a decision of Ms Beverley Hedley, the Hearing Officer for the Registrar by the Opponent, Lifestyle Equities CV. In this judgment, I refer to Lifestyle Equities CV as “the Opponent,” and to Ms Blakeley as “the Applicant.”

**Background**

2. On 3 February 2021 the Applicant applied to register the mark shown below for goods and services in Classes 9, 16, 18, 21, 25, 28, 35 and 41, which are set out in full in Annex A to this decision.
3. The application was opposed by the Opponent on the basis of sub-sections 5(2)(b), 5(3) and 5(4)(a) of the 1994 Act. It relied upon a single earlier mark, registration number 915737653, shown below, which is registered for a range of goods and services in Classes 3, 9, 14, 18, 21, 24, and 25, as set out at Annex B to this judgment.

4. For the purpose of this judgment, it is helpful to look at the marks side-by-side:

Opponent's Mark	Applicant's Mark
 The logo for the Beverly Hills Polo Club. It features a silhouette of a polo player on a horse, swinging a mallet. The words "BEVERLY HILLS" are arched above the player, and "POLO CLUB" is written in a bold, sans-serif font below the player.	 The logo for Hipwood Polo. It features a silhouette of a polo player on a horse, swinging a mallet. The player's mallet and the horse's lower legs are highlighted in red. Below the player, the words "Hipwood Polo" are written in a serif font.

5. The opposition was brought against the whole of the Applicant's specification, and the Opponent claimed a reputation in respect of all of the goods in its own specification. That was also the basis of its claim to goodwill for the purposes of s 5(4)(a). Both parties filed evidence and written submissions in lieu of a hearing.
6. The Hearing Officer's findings, so far as it is necessary to set them out, were, in brief:
- 6.1 Some of the Applicant's goods (including those in Class 25) were identical to the Opponent's goods, other goods and the Class 41 services were similar to a greater or lesser degree to the Opponent's specification. But certain goods in Classes 9, 16, 18, 21, and the Class 35 services were not similar to any part of the Opponent's specification;
  - 6.2 The device and the words contribute to the overall impression of each of the marks;
  - 6.3 There was a medium degree of visual similarity but no aural similarity between the marks. There was a low degree of conceptual similarity between them;
  - 6.4 The earlier mark had low inherent distinctiveness for technical polo wear which was covered by the Opponent's broad term 'clothing,' but had average inherent distinctiveness for "non-technical polo-wear (i.e. casual

wear).” The evidence filed by the Opponent showed “an above average degree of enhanced distinctive character in relation to “casual clothing (i.e. general casualwear, not including technical polo-wear/sportswear)”;

- 6.5 There was no likelihood of confusion whether direct or indirect;
- 6.6 The Opponent’s mark had a reputation for casual clothing but there was no link liable to be made between the marks even when used on polo related goods, so that the s 5(3) objection failed;
- 6.7 The opposition based on s 5(4)(a) failed for lack of any likely misrepresentation; and
- 6.8 Ms Blakeney was entitled to a contribution of £1500 towards her costs, reflecting the fact that she had acted in person (though she is a solicitor) but had incurred costs in seeking the advice of a barrister.

### **Standard of appeal**

7. It was common ground that this appeal is by way of review, it is not a rehearing. The relevant principles were not in dispute. They have recently been conveniently summarised by Joanna Smith J. in *Axogen Corp v AVIV Scientific Ltd* [2022] EWHC 95 (Ch), [2022] ECC 19 at [24].
8. In addition, in this case it is helpful to bear in mind certain comments made by Mr Iain Purvis KC sitting as the Appointed Person. First in *Rochester* BL O/049/17, he said at [33]:

“... the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

  - (i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case
  - (ii) The legal test ‘likely to cause confusion amongst the average consumer’ is inherently imprecise, not least because the average consumer is not a real person.

(iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal.

(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. ... Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.”

9. In addition, in *Greybox BL O/106/20*, Mr Purvis said:

“7 ... I am forced to conclude that the Grounds of Appeal were in fact no more than a list of every point on which the Opponent disagreed with the Hearing Officer.

8. I do not regard it as helpful either for the conduct of appeals generally or for the chances of success of an appellant in an individual case to proceed in this way.

9. Most Opposition proceedings, including this one, involve evaluative, multi-factorial decisions, in which the Hearing Officer applies a 4 generalized legal test by weighing up the evidence and coming to a nuanced overall impression. It is well-established that a wide latitude is given to Hearing Officers in relation to such decisions and no appeal is likely to succeed unless the appellant demonstrates a distinct and material error of principle. This may involve an actual mistake of law, or it may involve an error in the way the legal test has been applied – for example taking into account irrelevant evidence, or failing to consider relevant evidence. When compiling Grounds of Appeal, it is important for Appellants to have this in mind. The Grounds should identify errors of principle which would provide a proper foundation for the Appointed Person to overturn the Decision.

In addition, at [23] in a passage highlighted by the Opponent here, he said:

“... I do not consider there is any great value in debating differences between ‘fairly low’ and ‘medium’ degrees of similarity in the context of the overall assessment of likelihood of confusion. Certainly, I do not consider that such fine

distinctions can properly be characterized as errors of principle. They are at best simply disagreements about the precise ‘weight’ to be given to a factor in the overall assessment, something which the Courts have consistently rejected as a proper ground of Appeal. Furthermore, given the lack of clarity and subjectivity of the terms in question, it is impossible to have any sensible debate on Appeal about whether the Hearing Officer was right.”

### **The Grounds of Appeal**

10. It is far from easy to summarise the main points of the Grounds of Appeal in this case, which were in some important respects rather impenetrable. However, the Opponent complained that the Hearing Officer had

- 10.1 erred in her assessment of the conceptual similarities between the marks,
- 10.2 misapplied the law on indirect confusion,
- 10.3 erred in assessing the similarity of the goods/services,
- 10.4 wrongly analysed the distinctiveness of the earlier mark, with an impact on her findings about likelihood of confusion and link, and
- 10.5 made an inappropriate costs order in the Applicant’s favour.

It was not clear to me from the Grounds whether the appeal was intended to cover the s 5(4)(a) objection as well as the objections under ss 5(2)(b) and 5(3), and there was nothing about it in the skeleton. At the hearing Mr Wood indicated that he was not intending to pursue any point on 5(4)(a), which he considered took matters no further than his points on s 5(2)(b).

### *Conceptual similarity*

11. The Hearing Officer's findings as to conceptual similarity were:

“41) Turning to the conceptual comparison, both marks share the concept of a polo player on horseback which, in turn, evokes the concept of the game of polo. I have no doubt that the average consumer will be well-aware that BEVERLY HILLS is a place in the United States of America. It follows that BEVERLY HILLS POLO CLUB is likely to immediately evoke the idea of a polo club in Beverly Hills in the USA. As for the words Hipwood Polo in the applicant’s mark, Hipwood is not, as far as I am

aware, the name of a place. Rather it has the appearance of a surname. In my view most average consumers are likely to perceive Hipwood as a surname. However, I acknowledge that there may be others who perceive it to be a place name, albeit an unfamiliar one. Hipwood Polo will, therefore, either be perceived as a polo business owned/run by a family/individual named Hipwood or as a polo business/club located in a place called Hipwood. Either way, this is a different concept to a polo club located in Beverly Hills in the USA. At best, there is a low degree of conceptual similarity between the marks." (This was the Hearing Officer's emphasis.)

12. Paragraph 10 of the Grounds of Appeal stated:

"Whilst the appeal is not that the Hearing Officer should have found a high level of visual similarity or a medium level of conceptual similarity, we submit that the erroneous appreciation of the conceptual similarity influenced the erroneous decisions under s.5(2)(b), 5(3) and 5(4)(a): this is because the Hearing Officer clearly concluded that the concepts were different: the use of the phrase "at best" should not be taken to suggest that the Hearing Officer gave real consideration to the prospect of the marks sharing the same concept: in fact, the Hearing Officer found that notwithstanding that the marks shared the same imagery and the concept of a polo club, they were conceptually dissimilar because the location of the club was different: that simply cannot be correct and it pollutes the rest of the decision."

13. To me, the obvious reading of the first two lines of that paragraph, is that the Opponent was not seeking to suggest that the Hearing Officer had gone wrong in finding that there was only a low level of conceptual similarity between the marks. That was reinforced by the Opponent's reference at paragraph 6 of the Grounds to the decision in *Greybox* and what was described as "the common (and flawed) approach of appealing on the basis that a Hearing Officer should have ascribed a different level of similarity." The thrust of paragraph 10 appears to me to be a criticism of the Hearing Officer for having analysed the likelihood of confusion and 'link' on the basis that the

concepts of the marks were different, despite having found that there was a low level of conceptual similarity between the concept of the marks.

14. The position set out in the Opponent's skeleton argument for the appeal was rather different. This suggested that the Hearing Officer's error in paragraph 41 was an "error of appreciation" in taking the consideration of conceptual similarity at too detailed level. The Opponent also submitted in the skeleton that "the Hearing Officer was incorrect to conclude that the concepts of the two marks were different. The concepts are identical in that they are concepts of a polo club, and any finding to the contrary is simply irrational and represents a clear error."
15. At the hearing of the appeal, Mr Wood accepted that the Opponent was not in a position in the light of the Grounds of Appeal to submit that the Hearing Officer should have found the marks to be conceptually identical. That left the Opponent with the point that the Hearing Officer had wrongly concluded that the concepts of the two marks were different, which in my view properly reflects the wording of paragraph 10 of the Grounds. However, I do not consider that there are any merits in that criticism for the reasons below.
16. The Hearing Officer's conclusion was not that the marks were conceptually different. Paragraph 41 of her Decision took the issue in stages. She held that the marks shared the concept of a polo player on horseback and the game of polo. That part of her decision was not challenged, and her conclusion seems to me to have been inevitable given the similarity of the device elements of the marks. However, she then identified a difference in concept which arose out of the impact which she thought would be made upon the average consumer by the word elements of the marks. That led her to find that there was a low degree of conceptual similarity between them.
17. The Opponent suggested at the hearing of the appeal that the Hearing Officer applied too "granular" a test and gave too much weight to the impact of the words in each of the marks upon their level of conceptual similarity. It submitted that she should have stopped her analysis at the point of finding that both marks might be seen as referring

to a polo club. I should say, first of all, that I am far from persuaded that any such error was identified in paragraph 10 of the Grounds of Appeal, which I set out above. Even if it can be found somewhere in that paragraph, this argument appears to me to be just the kind of approach deprecated by Mr Purvis KC in *Greybox*.

18. In any event, in my judgment, the “granularity” point is not a fair criticism of the Hearing Officer's decision. It was plainly incumbent upon the Hearing Officer to consider the impact of the words in each of the marks upon the concept of each mark, especially as she had found (and this point was not challenged on the appeal) that in each of the marks the visual and word elements contributed roughly equally to their overall impression. She would have been wrong to mentally divide the marks into their component parts, losing the overall impression given by the combination of those parts, and to give greater weight to the device elements, or ignore the words altogether. This is contrary to the approach which the case-law establishes would be taken by the notional average consumer.
19. Moreover, the Hearing Officer did not say that the words had such an impact upon the concept of the marks as to render them completely different conceptually, but said that the concept of a polo club located in Beverly Hills, USA was different from a concept of a polo business owned by someone called Hipwood, or even a polo business/club located in somewhere called Hipwood. The “granularity” point was not (to my mind) part of the Grounds of Appeal. Even had it been, it seems to me that her analysis could not have been challenged.
20. The Hearing Officer did not, as the Opponent pleaded, find that the marks were, overall, conceptually different. On the contrary, she concluded that there was a low degree of conceptual similarity between them. I accept that it is a little difficult to know what the Hearing Officer meant by the words "at best" in the last sentence of paragraph 41, but it does not seem to me that those words affect her finding that there was a low degree of conceptual similarity overall. Rightly, it seems to me, she balanced her view of the identity of concept arising from the similarity of the device elements against the difference in concept arising from the word elements, and she

came to the conclusion that there was overall a low degree of conceptual similarity between the marks.

21. The Hearing Officer's careful analysis cannot in my view be faulted. I do not accept that her reasoning turned on applying too granular an analysis and I consider that the conclusion which she reached was plainly open to her.
22. Secondly, however, the Opponent sought to persuade me that the Hearing Officer had, in effect, only paid lip service to there being some level of conceptual similarity between the marks, and had really approached her analysis of the likelihood of confusion, etc on the basis that the marks were different. Again, I am not convinced that this argument was properly foreshadowed by paragraph 10 of the Grounds of Appeal, which referred to the Hearing Officer concluding that the concepts were different, contrary to the last sentence of paragraph 41. However, for completeness I will deal with the point, which is certainly closer to the pleaded Grounds.
23. The Opponent submitted that the Hearing Officer's real view that the marks are conceptually different was reflected in paragraph 53 of the decision where she dealt with indirect confusion. She had therefore misdirected herself on indirect confusion because of her error as to conceptual similarity.
24. In my view it is helpful to start with what she said about direct confusion:

"48) I will first consider the likelihood of direct confusion. In relation to casual clothing, the earlier mark, as a whole, has an above average degree of distinctiveness and those goods are highly similar to the applicant's goods in class 25. The marks are visually similar to a medium degree. However, aurally they share no similarity, or at best, a very low degree of aural similarity and the conceptual similarity between the marks, as wholes, is, at best, low. Weighing these factors, I find that an average consumer paying at least a medium degree of attention is unlikely to mistake one mark for the other, even allowing for imperfect recollection. There is no likelihood of direct confusion on the basis of the earlier mark's casual clothing."

25. The Hearing Officer went on to consider whether there was a likelihood of indirect confusion at paragraphs 50-53 of her Decision. She set out the well-known passage from paragraphs 16-17 of the decision in *L A Sugar*, but also mentioned more recent decisions, including *Liverpool Gin Distillery Limited v Sazerac Brands LLC*, [2021] EWCA Civ 1207, and she noted Arnold LJ's view that there must be a proper basis for making a finding of a likelihood of indirect confusion where there is no likelihood of direct confusion. The Opponent did not contend that the Hearing Officer had misdirected herself as to the law or applicable principles, but criticised her findings at paragraph 53. There she said:

"53) I do not consider that an average consumer, having noticed that the marks are different, would put the similarities between them down to the respective goods or services coming from the same undertaking because i) the common element is not "so strikingly distinctive" for any of the relevant goods or services, and especially those which directly relate to the game of polo, ii) the later mark does not simply add a non-distinctive element to the earlier mark and iii) a change from using the place name Beverly Hills to the entirely different place/surname Hipwood appears to me to be far from entirely logical and consistent with a brand extension of the earlier mark. I, of course, bear in mind that the categories highlighted by Mr Purvis do not constitute an exhaustive list of all the ways in indirect confusion can occur. However, I cannot see that there is likely to be any other kind of mental process on the part of the consumer, falling outside of those categories, that is likely to lead them to believe that the respective goods and services come from the same or linked undertaking(s). I make this finding in respect of all the relevant contested goods and services, regardless of the degree of similarity/identity between them and the opponent's goods, and even where the earlier mark, as a whole, has an above average degree of distinctiveness. There is no likelihood of indirect confusion."

26. The Opponent submitted that the Hearing Officer erred in that analysis because she treated the marks as lacking conceptual similarity. I am unable to identify any part of paragraph 53 which demonstrates any such mistake on the Hearing Officer's part. In

paragraph 53 (iii) she pointed to the difference in the wording of the marks as a factor militating against the Applicant's mark being taken as a brand extension of the Opponent's mark. That does not seem to me to indicate that the Hearing Officer erred in her approach to the analysis of a likelihood of indirect confusion in thinking or saying that there was no conceptual similarity at all between the marks, but merely shows her (quite properly) taking into account the difference(s) in the meaning of the words in the marks. She had, after all, just set out at paragraph 48 her conclusions as to the similarities between the marks, making express reference to the low level of conceptual similarity that she thought there was between them.

27. I do not consider that the Opponent has identified any appealable error relating to or arising from the Hearing Officer's consideration of the conceptual similarity of the marks and I therefore reject this Ground of Appeal.

#### *Indirect confusion*

28. In paragraphs 17-18 of the Grounds of Appeal the Opponent made further criticisms of the Hearing Officer's analysis of the likelihood of indirect confusion, under the heading "Misapplication of LA Sugar."
29. First, in paragraph 17 it was suggested that the Hearing Officer wrongly limited herself to a consideration of the three possible kinds of indirect confusion identified by Mr Purvis KC in *L A Sugar*, as if this were equivalent to a statutory test, and it was contended that had she taken into account all relevant factors (including "the conceptual identity of the marks") she would have found a likelihood of indirect confusion, at the least for the goods in Class 25.
30. In my view, it cannot possibly be right to criticise the Hearing Officer for having treated *L A Sugar* as providing an exhaustive list of all the ways in which indirect confusion can occur. She expressly stated that she had taken into account that these are not the only kinds of indirect confusion. Moreover, she was careful not to give more weight to the categories of indirect confusion identified by Mr Purvis than was appropriate. She said that she had considered whether there was any other way in which a consumer might

be led to believe that the goods/services came from the same or linked undertakings, indicating that she had looked at more than just the 3 categories of confusion identified by Mr Purvis. I do not consider that there was any error in the Decision in this respect, and (as already discussed) there was nothing in the conceptual similarity point.

31. In paragraph 18 of the Grounds, the Opponent complained that it was unclear how (if at all) technical sports clothing differs from clothing generally, and the “lack of clear logic” makes it impossible fully to understand the Hearing Officer’s reasoning. I am unsure how this point relates either to a misapplication of *L A Sugar*, or to anything that the Hearing Officer said in paragraph 53 as to indirect confusion. All that she said towards the end of paragraph 53 was that she found no likelihood of indirect confusion even where there was identity of goods (such as the Applicant’s ‘technical sports clothing’ as a sub-set of the Opponent’s ‘clothing’). I can discern no error in this. Paragraph 18 appears essentially to be a complaint about a lack of reasoning in paragraph 53, but it seems to me that the Hearing Officer expressed her views clearly and with sufficient reasoning. I reject this Ground of Appeal.

#### *Similarity of the goods/services*

32. In paragraphs 12-16 of the Grounds of Appeal, the Opponent criticised the Hearing Officer’s findings to the extent that she did not find any similarity between the parties’ specifications, and the Grounds challenged those findings across the board. At the hearing of the appeal, Mr Wood moderated that approach, and accepted that he could not push the point so far as to claim similarity for the Applicant’s goods in Class 9 or the services in Class 35 which the Hearing Officer had found to be dissimilar to the Opponent’s specification. However, he argued that the Hearing Officer should have found similarity for those goods in Classes 16, 18 and 21 which the Hearing Officer had found dissimilar.
33. In the Grounds, the Opponent claimed that the Hearing Officer should have found similarity for the additional goods because the Applicant’s goods/services were all

polo-related, and she had accepted that the Opponent's clothing in Class 25 covered technical polo clothing. Mr Wood told me that the Applicant's evidence was that she intended to provide "a coherent offering" of goods and services related to polo, which, he said, would lead the average consumer to make a trade connection between the parties' goods/services. In my judgment, this point boils down to a complaint that the Hearing Officer should have found the remaining goods to be similar to the Opponent's specification because there was a potential overlap of trade channels. The difficulty for the Opponent is that the Hearing Officer expressly took that possibility into account in all of her reasoning. So for instance in paragraphs 23-4 she dealt with the Applicant's Class 18 goods. Having found, at 23, that the Applicant's 'polo mallet bags' were identical to the Opponent's 'sport bags' she went on:

"24) Turning to the applicant's 'polo whips', 'polo harness equipment', 'polo saddlery equipment' and 'polo saddles' in class 18, the respective nature, intended purpose and methods of use are entirely different to all the opponent's goods (including its 'technical polo-wear' covered by its 'clothing') and they are not in competition or complementary in the sense described in the case law. Whilst I accept, as the applicant's evidence shows, that the goods may sometimes share trade channels (e.g. all sometimes being sold by polo clubs/businesses), this factor alone is not sufficient to conclude that the respective goods are similar overall. I find no similarity between the applicant's whips, harnesses and saddlery and the opponent's goods."

34. The Hearing Officer therefore expressly took into account both the impact of the technical polo-wear covered by the Opponent's 'clothing' and the possible shared trade channels. In those circumstances, in my view it cannot be said that she erred in concluding that the goods were not similar overall, even though I accept that she had reached the contrary conclusion in paragraph 21 for various goods in Class 28. Both of those conclusions were open to her on the facts of this case. Similarly, no error has in my view been identified in the similar analysis carried out by the Hearing Officer for the remaining disputed goods. The Opponent is essentially asking me to substitute my own view for that of the Hearing Officer, without there having been any error on her part.

35. At the hearing, Mr Wood raised a further point about the analysis of similarity of the goods. He said that the Hearing Officer had erred in paragraph 21 of the Decision in not comparing the Opponent's casual clothing to the Applicant's Class 28 goods, though she had found similarity between those goods and the Opponent's clothing, which included technical polo-wear. I am again doubtful that this point was raised in the Grounds of Appeal, nor can I discern it in the Opponent's skeleton argument. Raising a point late in this manner is unfair to a Respondent, which has no opportunity to consider its merits. Even had the point been raised properly, however, I would reject it. It is plain, in my view, that the Hearing Officer only found the similarity for the Class 28 goods because the Opponent's specification included technical polo-wear, and it is implicit in that finding that she would have rejected similarity based only upon casual clothing. The potential sharing of trade channels which the Opponent relied upon was a factor which she had already taken into consideration.
36. In paragraph 15 of the Grounds the Opponent said that the Hearing Officer had erred in concluding at paragraph 58(ii) of the Decision that there was no similarity between the Opponent's casual clothing and any of the contested goods outside Class 25, because casual clothing included technical sportswear. Mr Wood gave the example of the production/sale of rugby shirts for fans and for players.
37. Again, in my judgment this point is wrong. First, the Hearing Officer had found at paragraph 18 that technical sportswear was a sub-set of 'clothing,' not of 'casual clothing,' and her unchallenged finding at paragraph 57 was that the Opponent had proved a reputation for the purposes of s 5(3) for "casual clothing (not including technical polo-wear/sportswear)." She therefore drew a distinction between casual clothing on the one hand and clothing of all kinds, including technical sportswear, on the other. For the purposes of considering whether there was a potential 'link' for s 5(3) in paragraph 58 she was right, on the basis of her earlier findings, to restrict her reasoning to casual clothing and not to take into account clothing at large or technical clothing. In paragraph 58(ii), dealing with 'link,' she said, "The opponent's casual clothing is highly similar to the applicant's polo-related goods in class 25." There was

thus no error in assessing similarity for the purposes of examining any link. The Opponent's real complaint was that she found no similarity between the Opponent's casual, non-technical clothing and the contested goods outside Class 25. I do not consider that the Opponent has identified any error in that respect.

38. For all of these reasons, I reject the Grounds relating to the similarity of the goods and services.

*Distinctiveness of the earlier mark*

39. Paragraph 11 of the Grounds of Appeal was set out under the heading of errors in the appreciation of the marks. The Opponent said that although the Hearing Officer found its mark distinctive of the Class 25 goods other than technical clothing, that was not followed through into the assessment of the likelihood of confusion, and in particular for the casual clothing for which the Opponent's mark had enhanced distinctiveness.

40. It was in paragraph 43 of the Decision that the Hearing Officer found that the earlier mark was of very low distinctiveness for technical polo-wear, as "it merely evokes the idea of the game of polo." In paragraph 11, the Opponent complained of the "surprising" finding that its mark was found to lack distinctiveness for technical clothing, yet at the hearing Mr Wood told me that no challenge was made to paragraph 43. Instead, he submitted that the Hearing Officer had erred in paragraph 44:

"44) I now turn to consider the inherent distinctiveness of the earlier mark for non-technical polo-wear (i.e. casual wear) which is also covered by the opponent's 'clothing'. For those goods, the device element is not so obviously non-distinctive given that the goods are not specifically intended to be worn during the game of polo. I find that both the device and the words BEVERLY HILLS POLO CLUB have average inherent distinctiveness for such goods which, in turn, means that the mark, as a whole, is averagely distinctive for the same."

41. It is not clear to me that paragraph 11 of the Grounds seeks to challenge paragraph 44 of the Decision, as it complained that the Hearing Officer failed to follow her finding of the mark's distinctiveness for non-technical clothing goods into her assessment of the likelihood of confusion. If the conclusion in paragraph 44 itself was also intended to be challenged, there is no pleaded basis for saying that the Hearing Officer erred in reaching that conclusion. Certainly, I consider that the finding as to the level of distinctiveness of the earlier mark for clothing other than technical polo-wear was well within the range of options open to the Hearing Officer.
  
42. The question of the level of distinctiveness of the earlier mark was also raised in paragraphs 19-21 of the Grounds of Appeal. The Opponent pleaded (echoing the complaint in paragraph 11 of the Grounds) that the decision under s 5(2)(b) was predicated on the basis of the earlier mark being of low (or no) distinctiveness for technical clothing. So far as other goods were concerned, it appears that its complaint was that the Hearing Officer should have concluded that the earlier mark was inherently distinctive, that its distinctiveness had been enhanced through use, and that this would have led to a likelihood of confusion of some kind. I think that these points were aimed at paragraphs 48-49 of the Decision as well as paragraph 53 which I have already discussed.
  
43. I have set out paragraph 48 above. Looking at it, I do not understand the criticism in paragraphs 11 and 21 of the Grounds: the Opponent says that the Hearing Officer should have found the mark inherently distinctive, as if she had not done so, and failed to give proper weight to its distinctiveness in assessing the likelihood of confusion. But she had found it distinctive, both in paragraph 44 (set out above) and in paragraph 46 where she concluded, after considering the Opponent's evidence, that the mark had an enhanced level of distinctiveness in relation to "casual clothing (i.e. general casual wear, not including technical polo wear/sportswear)." She then repeated in both paragraphs 48 and 53 (dealing with direct and indirect confusion respectively) that the mark had above average distinctiveness for casual clothing. It seems to me that the suggestions in the Grounds of Appeal that she did not treat the mark as distinctive or take that distinctiveness into account in assessing the likelihood of confusion are

unjustified. The Hearing Officer set out her reasoning: taking into account her views on distinctiveness and the low level of similarity of the marks she found no likelihood of confusion, direct or indirect. Those were findings which it was plainly open to the Hearing Officer to make and I do not consider that the Opponent has identified any error in that regard. I reject that element of the appeal.

#### *Link*

44. Paragraphs 22-24 of the Grounds allege that the Hearing Officer erred in her analysis of the link necessary for the sub-section 5(3) objection. In paragraph 23 it is said that the depictions of the riders in the marks are so similar that a link would be made. This seems to me a complaint that the Hearing Officer did not give more weight to the device elements than to the words in the marks, and goes no further than the points I have already considered on conceptual similarity. Otherwise, it does not seem to me that these paragraphs of the Grounds take matters further than the points which I have dealt with under the headings of similarity of the goods/services and distinctiveness above.
45. The Grounds relating to link are therefore also rejected.

#### *Costs*

46. Lastly, the Grounds deal with the Hearing Officer's findings on costs. They set out the gist of the complaint which was made in additional written submissions to the Hearing Officer prior to her handing down the Decision. The Grounds do not identify any error in the Hearing Officer's analysis of the issue at paragraphs 66-68 of the Decision, and the skeleton argument did no more than draw my attention to another earlier UKIPO decision which took a different approach to this Hearing Officer on what the Opponent contended was a similar point.
47. It seems to me that this is another example of the Opponent inviting me to substitute my own view for that of the Hearing Officer, without there having been any error on her part. I decline to interfere with her costs award.

## Conclusion

48. The appeal therefore fails on all bases. The Applicant is entitled to a contribution towards her costs of the appeal, and both sides agreed that there was no reason to depart from the usual scale of costs on the appeal. On that basis, I will order the Opponent to pay the Applicant the sum of £1750 as a contribution towards her costs of the appeal, in addition to the sum of £1500 awarded by the Hearing Officer, both sums to be paid by 5 pm on 5 April 2023.

**Amanda Michaels**  
The Appointed Person  
14 March 2023

**Mr AARON WOOD** of **Brandsmiths** appeared for the Appellant/Opponent

**Mr ANDREW NORRIS KC** (instructed by the Applicant) appeared for the Applicant/Respondent

## Annex A

### Applicant's specification

**Class 9:** Apparatus for recording, transmission and reproduction of sound, transmission and reproduction of images; polo helmets; all used within a polo business.

**Class 16:** Paper goods, namely, letterheaded paper, postcards, flyers, posters, printed advertisements, books, instruction manuals, chukka lists, tournament lists, paper bags; Cardboard goods, namely, cardboard gift boxes for prizes; all used within a polo business.

**Class 18:** Leather goods and imitations of Leather goods namely: polo whips; polo harness equipment; polo saddlery equipment; polo saddles; polo mallet bags; all used within a polo business.

**Class 21:** Equestrian combs; equestrian sponges; equestrian brushes; all used in the context of a polo business.

**Class 25:** Technical sports clothing worn by polo professionals within the sport of polo including technical polo shirts, technical polo white jeans, polo belts, polo base layers, polo gloves; polo boots; all used within a polo business.

**Class 28:** Polo balls, polo mallets; protective knee pads for use when playing polo; all used within a polo business.

**Class 35:** Advertising; business management; business administration; all used within a polo business.

**Class 41:** Education; providing of polo training; sporting activities; cultural activities; for use in a polo business.

## **Annex B**

### **Opponent's specification:**

#### **Class 3:**

Perfumes; colognes; body sprays; toilet water; soap; skin moisturizers and creams; shower gels, shaving creams, shaving lotions, shaving gels; shampoos; hair gels, hair creams; nail polish, nail polish remover; lipsticks, lip gloss, lip balms; skin lotions, facial lotions, body lotions, hand creams; deodorants and anti-perspirants; after shave lotions; home fragrances.

#### **Class 9**

Eyewear; eyeglasses and sunglasses; eyeglass- and sunglass frames; eyeglass- and sunglass cases; binoculars.

#### **Class 14**

Watches; watch straps, watch bands; jewelry; earrings, necklaces, rings, bracelets and pendants; cuff links.

#### **Class 18**

Luggage; hand bags; sport bags; beach bags; carry-on bags; clutch bags; trunks and travelling bags; school bags; shoulder bags; shopping bags; tote bags; rucksacks; backpacks; duffel bags; cosmetic bags, briefcases; suitcases; holdalls; purses; wallets; leather key chains; business card cases; umbrellas; parasols; walking sticks.

#### **Class 21**

Glassware for household purposes; household or kitchen utensils and containers (not of precious metal or coated therewith); crystal [glassware]; coffee sets; ceramics for household purposes; kitchenware, cooking pot sets; dishware; porcelain and earthenware, all the aforesaid goods included in class 21; tableware, other than knives, forks and spoons; services [dishes]; tea services [tableware]; pots; crockery; pottery; cups; teapots; table plates; drinking vessels; beverage glassware; saucers; plates; dishes; bowls; mugs; coolers; corkscrews; decanters.

#### **Class 24**

Towels; bath towels; hand towels; kitchen towels; Beach towels; bath linen; bed blankets; bed clothes; bed covers; bedspreads; duvet covers; bed linen; pillowcases; pillow covers; face towels of textile; handkerchiefs of textile; household linen; linen cloth; place mats, not of paper; sheets [textile]; tablecloths, not of paper; table linen, not of paper; tablemats, not of paper; table napkins of textile; textile material; towels of textile; curtains.

#### **Class 25**

Clothing; suits; tuxedos; blazers; vests; blouses; overalls; pullovers; sweaters; sweater vests; sweatpants; sweatshirts; T-shirts; shirts; polo-shirts; shirts and casual tops with long and short sleeves; halter tops; sleeveless shirts; sport shirts; tops for exercise; jeans; pants; trousers; shorts; skirts; coats; jackets (clothing); outerclothing; ponchos; raincoats; sport

coats; bathing suits; swimsuits; bikinis; bikini tops; Bermuda shorts; beach clothes; bath robes; body linen (garments); underwear; undergarments; undershirts; bodysuits; boxer shorts; bras; bustiers; hosiery; stockings; lingerie; leggings; night clothes; nightgowns; nightshirts; pajamas; panties; dresses; dressing gowns; belts (clothing); socks; footwear; athletic shoes; beach shoes; booties; espadrilles; flip-flops; gym boots; heels; pumps; sandals; shoes; slippers; sporting and gymnastic shoes; headwear; bandannas; baseball caps; caps; hats; headbands.