

O/0829/26

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION
DESIGNATING THE UK NO. 1763238
IN THE NAME OF JIANGXI MAISI CLOTHING CO., LTD.:**

IMXS

IN CLASSES 14, 18, 25 & 30

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 447587
BY INXS INTERNATIONAL PTY LIMITED**

BACKGROUND AND PLEADINGS

1. On 14 September 2023, Jiangxi Maisi Clothing Co., Ltd. (“the holder”) registered the international trade mark displayed on the cover page of this decision under no. 1763238 (“the IR”). With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. Protection of the IR in the UK is sought for the following goods:

Class 14: Alloys of precious metal; boxes of precious metal; jewellery; works of art of precious metal; necklaces [jewellery]; watches.

Class 18: Imitation leather; travelling trunks; rucksacks; travelling bags; bags; trimmings of leather for furniture; shoulder belts [straps] of leather; umbrellas; saddlebags.

Class 25: Shoes; clothing; layettes [clothing]; hats; hosiery; gloves [clothing]; scarves; girdles; sleep masks.

Class 30: Coffee; tea; tea-based beverages; sugar; cereal preparations; condiments; pastries; freeze-dried dishes with the main ingredient being rice; pasta; cereal-based snack food; ice cream; vinegar.

2. Details of the IR were published for opposition purposes on 16 February 2024. On 16 May 2024, INXS International Pty Limited (“the opponent”) opposed the IR under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. For the purposes of its claims under sections 5(2)(b) and 5(3), the opponent relies upon its UK trade mark no. 904057766, **INXS** (“the opponent’s mark”).¹ The opponent’s mark was filed on 1 October 2004 and became registered on 4 November 2005. It claims a priority date of 27 April 2004 (Australia). It stands registered for the following goods and services:

¹ The opponent’s mark is a comparable mark based upon its EU trade mark no. 4057766. It was automatically created on 1 January 2021 in accordance with article 54 of the Withdrawal Agreement between the UK and EU.

- Class 9: Sound and/or moving picture recordings including compact discs (CD's), digital video discs (DVD's), audio tapes, cassettes and cartridges; magnetic tapes and discs all for bearing sound and/or image, moving picture or video recordings; eyeglasses, spectacles and sunglasses; telephones; mobile telephones; parts, fittings and accessories for all the aforesaid goods.
- Class 16: Paper, cardboard and goods made from these materials including printed matter, books, magazines, diaries, calendars, programs, souvenir guides, sheet music, leaflets, postcards, photographs, posters, stickers, car stickers, decalcomanias; flags and banners made of paper; carrier bags; stationery items including writing instruments, erasers, sharpeners, rulers, pencil cases; office requisites (except furniture).
- Class 25: Clothing, footwear, headgear including T-shirts, shirts, blouses, tops, coats, jackets, denim jackets, vests, sweatshirts, hooded sweatshirts, sweatpants, sports clothing, jeans, shorts, undergarments, boxer shorts, socks, hats, caps, peaks, beanies, scarves, bandannas, headbands, wristbands, gloves, belts, swimsuits.
- Class 26: Ornamental and novelty badges, buttons, brooches and pins; embroidered and printed patches and motifs made of textile materials; hair bands, clasps and clips; none of the foregoing goods being of precious metal.
- Class 41: Entertainment services including live entertainment, performances, concerts, shows, festivals; television programs, stage and musical entertainment; production of entertainment including television programs, films, videos, concerts, stage shows and music; publishing and music publishing services including on-line content; education and training services

including arranging and conducting seminars, conferences and exhibitions.

4. The opponent's mark qualifies as an 'earlier trade mark' in accordance with section 6 of the Act. As it had completed its registration process more than five years before the UK designation date of the IR, it is subject to the use requirements specified in section 6A of the Act.

5. In its statement of grounds, the opponent contends that the competing marks are similar and that the parties' goods and services are identical or similar. On this basis, it submits that there is a likelihood of confusion and requests that the IR be refused under section 5(2)(b).

6. In respect of section 5(3), the opponent claims that it has a substantial reputation in the UK in relation to all the goods and services of its mark. It argues that use of the IR, without due cause, would take unfair advantage of, and be detrimental to, the repute and distinctive character of its mark. The opponent also claims that the relevant public will mistakenly believe that there is an economic connection between the users of the competing marks.

7. As for section 5(4)(a), the opponent claims that it has significant goodwill in its business in relation to which it has used the sign **INXS** throughout the UK since 1981. The sign is said to have been used in relation to the following goods and services:

Sound and/or moving picture recordings including compact discs (CD's), digital video discs (DVD's), audio tapes, cassettes and cartridges; magnetic tapes and discs all for bearing sound and/or image, moving picture or video recordings; eyeglasses, spectacles and sunglasses; telephones; mobile telephones; parts, fittings and accessories for all the aforesaid goods; paper, cardboard and goods made from these materials including printed matter, books, magazines, diaries, calendars, programs, souvenir guides, sheet music, leaflets, postcards, photographs, posters, stickers, car stickers, decalcomanias; flags and banners made of paper; carrier bags; stationery items including writing instruments, erasers, sharpeners, rulers, pencil cases; office requisites (except furniture);

clothing, footwear, headgear including t-shirts, shirts, blouses, tops, coats, jackets, denim jackets, vests, sweatshirts, hooded sweatshirts, sweatpants, sports clothing, jeans, shorts, undergarments, boxer shorts, socks, hats, caps, peaks, beanies, scarves, bandannas, headbands, wristbands, gloves, belts, swimsuits; ornamental and novelty badges, buttons, brooches and pins; embroidered and printed patches and motifs made of textile materials; hair bands, clasps and clips; none of the foregoing goods being of precious metal; entertainment services including live entertainment, performances, concerts, shows, festivals; television programs, stage and musical entertainment; production of entertainment including television programs, films, videos, concerts, stage shows and music; publishing and music publishing services including on-line content; education and training services including arranging and conducting seminars, conferences, exhibitions; phonographic records (vinyls); television program/broadcasts; postcards, fan letter reprints; guitar picks; polaroids/photos; pin badges; keyrings; certificates of authenticity; phone cases; bottles; mugs; art prints; embroidered logo patches; show passes and lanyards.

8. The opponent argues that use of the IR would constitute a misrepresentation to the public resulting in damage to its goodwill. On this basis, the opponent submits that protection of the IR in the UK would be contrary to the law of passing off.

9. The holder filed a counterstatement, denying the grounds of opposition. It also indicated that it would require the opponent to provide proof of use of its mark.

10. Both parties filed evidence. A hearing was requested and held before me, by video conference, on 30 June 2026. The opponent was represented by Philip Harris of Abion UK Limited.² The holder was represented by Valentin Kieffer of euromaier AG.³

² The opponent was previously represented by Sheridans. On 3 February 2025, Abion UK Limited filed a Form TM33(P) to record a change of representation.

³ The holder was previously represented by Isabelle Bertaux. On 22 June 2026, euromaier AG filed a Form TM33 to record a change of representation.

EVIDENCE

11. The opponent's evidence is given in the witness statement of Kirk Pengilly, dated 23 September 2024, together with 14 exhibits (KP1-KP14). Mr Pengilly is a director of the opponent, a musician and member of the Australian rock group INXS. He provides the opponent's evidence of use, reputation and goodwill. Mr Pengilly's evidence was accompanied by written submissions prepared by the opponent's then legal representatives, Sheridans.

12. The holder's evidence comprises a witness statement from Sulan Wu, dated 23 November 2024, and four annexes. Ms Wu is President of the holder, a position she has held since 5 June 2020. She provides evidence regarding the development, protection and use of the IMXS brand.

13. I have taken all the evidence and submissions into account in reaching my decision and will refer to them below where necessary.

MY APPROACH

14. At the hearing, Mr Harris submitted that the opponent's claim under section 5(4)(a) represents its best case. I agree and, as such, I will begin by considering that ground.

DECISION

Section 5(4)(a)

Legislation and case law

15. Section 5(4)(a) of the Act states as follows:

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

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

16. Subsection (4A) of section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

17. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

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

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

Relevant date

18. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Daniel Alexander QC, sitting as the Appointed Person, endorsed the Registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

"43. In *SWORDSERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

19. The prima facie relevant date is the UK designation date of the IR, namely 14 September 2023. Ms Wu provides evidence of sales under the IR in the UK.⁴ Whilst some of it is either undated or from 2024, I note that UK customers placed orders for IMXS branded coffee on 2 March 2021, IMXS branded jewellery on 15 September 2021, an IMXS branded women's top on 25 April 2022, IMXS branded leather jackets on 17 August 2022, 11 January 2023 and 23 February 2023, and an IMXS branded bag on 21 June 2023. The first public-facing use of the IR must have occurred before the earliest evidenced order. However, the evidence does not demonstrate when or how that occurred; it is not clear when the goods were first offered for sale in the UK. Without such evidence, I will treat the date of the earliest order itself as the start of the behaviour complained of. As such, I will consider the position at 2 March 2021 ("the earlier relevant date"), as well as the prima facie relevant date.

⁴ Annex 4

Goodwill

20. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (at 223-224):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

21. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

22. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

23. In *Ad Lib Club Limited v Granville* [1971] FSR 1 (HC), Vice Chancellor Pennycuik stated that:

“It seems to me clear on principle and on authority that where a trader ceases to carry on his business he may nonetheless retain for at any rate some period of time the goodwill attached to that business. Indeed it is obvious. He may wish to reopen the business or he may wish to sell it. It further seems to me clear in principle and on authority that so long as he does retain the goodwill in connection with his business he must also be able to enforce his rights in respect of any name which is attached to that goodwill. It must be a question of fact and degree at what point in time a trader who has either temporarily or permanently closed down his business should be treated as no longer having any goodwill in that business or in any name attached to it which he is entitled to have protected by law.

In the present case, it is quite true that the plaintiff company has no longer carried on the business of a club, so far as I know, for five years. On the other hand, it is said that the plaintiff company on the evidence continues to be regarded as still possessing goodwill to which this name AD-LIB CLUB is attached. It does, indeed, appear firstly that the defendant must have chosen the name AD-LIB CLUB by reason of the reputation which the plaintiff company's AD-LIB acquired. He has not filed any evidence giving any other

reason for the selection of that name and the inference is overwhelming that he has only selected that name because it has a reputation. In the second place, it appears from the newspaper cuttings which have been exhibited that members of the public are likely to regard the new club as a continuation of the plaintiff company's club. The two things are linked up. That is no doubt the reason why the defendant has selected this name."

24. Mr Pengilly says that he has been a member of INXS since 1979 and that the band has sold over 70 million records and generated 4 billion music streams in its near 50-year career. The name INXS is said to have been in continuous use since 1979 in respect of, *inter alia*, music recordings, live entertainment, television shows, films and merchandise. Mr Pengilly says that the band has maintained its commercial success and prominence through music releases, collaborations, commercial projects and the sale of band merchandise.

25. According to Mr Pengilly, the band's discography includes 12 studio albums, 71 singles, 12 compilations, four live albums and five EPs. It is said to have performed thousands of live shows between 1979 and 2012, including in the UK. A list of these has been provided.⁵ This shows that the band performed many times between 1 September 1979 and 11 November 2012 in, *inter alia*, Australia, New Zealand, the USA, Canada, Japan, France, Germany, and the UK.⁶

26. The first show in the UK was on 26 May 1984 at The Astoria in London. This was followed by shows in London (including at Royal Albert Hall and Wembley Stadium), Manchester, Leeds, Edinburgh, Sheffield, Birmingham, Guildford, Nottingham and Norwich in 1986. There were further runs of shows across the UK in November 1987 to February 1988, June 1988, November and December 1990, July 1991 (including at Wembley Stadium), November 1992, July 1993, October 1994, February and March 1997, May and June 1997, December 2002, October and November 2006, May and June 2007, and June 2011. There were also TV appearances on *The Tube*, *Saturday*

⁵ Exhibit KP4

⁶ Although there are some earlier shows in the list, these appear to have been under the band's previous name (The Farriss Brothers).

Night Live, and *Old Grey Whistle Test* (all 1986), *Top of the Pops* (1992 and 1997), *Later with Jools Holland* (1994) and *TFI Friday* (1997).

27. Mr Pengilly says that the band operates a website (inxs.com), as well as Facebook, Instagram and X (formerly Twitter) accounts. He provides printouts of these, but they are not dated.⁷ I note that Mr Pengilly has included a report of the band's social media performance.⁸ This says that the Facebook page had 75,443 followers and the Instagram page had 13,354 followers. These figures were correct "*as of the last day of the reporting period*". Given that the report is for 2022 and 2023, I infer that this was 31 December 2023.

28. Mr Pengilly says that the official INXS YouTube channel has 639,000 subscribers and 177 available videos, whilst its top eight videos each have between 26 million and 114 million views. These statistics can all be seen in printouts of the band's YouTube page.⁹ Mr Pengilly has provided reports regarding the page, which show that the band's videos had 29,991,543 views from the UK between 14 September 2018 and 14 September 2023 and 55.7 million views from the UK in total (between 1 April 2007 and 18 September 2024).¹⁰

29. In addition, Mr Pengilly provides a list of UK radio plays of INXS songs from 2020 to 2024.¹¹ This shows eight songs with a combined 41,128 plays on numerous radio stations, including Nation Radio, Virgin Radio and Absolute Radio. Some have an audience reach figure. For instance, 'Need You Tonight' had 885 plays on Absolute Radio 80s with an audience reach of 46.74 million.

30. As for streaming, Mr Pengilly says that the UK is the second largest market for INXS. Based upon official data taken from music streaming platforms, he says that the band's songs had 42.1 million streams in 2022, 53.8 million streams in 2023 and 41.4 million streams in 2024. Printouts of the band's Spotify, Apple Music and Amazon

⁷ Exhibit KP5

⁸ Exhibit KP5

⁹ Exhibit KP6

¹⁰ Exhibit KP6

¹¹ Exhibit KP7

Music pages are included in the body of Mr Pengilly's statement, as they appeared at the date of his statement.

31. Mr Pengilly says that the opponent sells a wide range of merchandise through Amazon and its own official store. These are global websites which, Mr Pengilly says, deliver to the UK. According to Mr Pengilly, the opponent's merchandise includes t-shirts, hoodies, caps, bags, water bottles, books, key rings, jewellery, phone cases and plectrums. He has provided printouts of INXS merchandise which was on sale at the date of his statement (including through other third parties).¹² Goods such as those described by Mr Pengilly can be seen in the printouts, but none is dated. Mr Pengilly says that a deal has recently been signed with a third party to sell INXS merchandise globally (outside Australia). He says that, between January 2020 and September 2023, the opponent's merchandise partner made sales of £1,106.12 in the UK (from 31 orders), and £2,963.22 from September 2023 to the date of his statement.

32. In 2023, Mr Pengilly says that INXS released a book called 'Calling All Nations – A Fan History of INXS', which he describes as "*a collective love letter from the fans*". It was produced in three formats: standalone hardback (retailing at \$49.99), deluxe (\$169.99) and super deluxe (\$449.99). In support, Mr Pengilly provides a still of a video about the book from YouTube; it is dated 18 July 2023 and refers to it as a new book.¹³ Also exhibited is a printout from the INXS official store showing each format of the book offered for sale.¹⁴ I note that the deluxe and super deluxe formats of the book include other (sometimes signed) items of merchandise. The printout is not dated. Mr Pengilly says that the opponent has sold 149 copies of the hardback, 45 copies of the deluxe version and 48 copies of the super deluxe version in the UK.

33. As for awards and accolades, Mr Pengilly has provided printouts of the INXS website showing a full list of awards and nominations from 1980 to 2023.¹⁵ Only a small number appear to have been from a UK-specific body, such as the BRIT Awards. However, there would have undoubtedly been an awareness of some of the other

¹² Exhibit KP8

¹³ Exhibit KP9

¹⁴ Exhibit KP9

¹⁵ Exhibit KP10

awards and nominations amongst the UK public, such as the MTV Awards and GRAMMY Awards. Quite a large proportion are specific to Australia, or lesser-known global bodies, and I am less sure that consumers in the UK would have been aware of them. As for the years leading up to the relevant dates, I note that INXS won ARIA awards for its 'THE VERY BEST' album (2020), two members of the band received an APRA BILLIONS Award for their songwriting contributions to a Dua Lipa song (2021), and INXS received an outstanding achievement award for its song catalogue hitting 4 billion streams and its 'THE VERY BEST' album spending 585 weeks in the ARIA Album Charts (2023). I also note that its greatest hits and live albums went platinum in the UK.¹⁶

34. Mr Pengilly says that Giles Martin (son of The Beatles' Sir George Martin) undertook a remastering of all INXS' albums in 2011. Further mixes of previously released albums were conducted by Mr Martin in 2017, including at Abbey Road Studios. In 2018, Mr Martin became Executive Music Director for the band, as is shown in a printout of the Abbey Road Studios website included in the body of Mr Pengilly's statement. In 2022 and 2023, Mr Martin mixed the band's 'THE VERY BEST' and 'FULL MOON DIRTY HEARTS' albums, respectively.

35. On 13 July 1991, over 74,000 people are said to have attended an INXS concert at Wembley Stadium. In 2018, Universal, Petrol Records, INXS and Mr Martin undertook a restoration of the film of the concert. A 4K film was created from 64 cans of 35mm film, with Mr Martin restoring and mixing the audio at Abbey Road Studios. The film is said to have premiered in London and then been released in over 100 cinemas throughout the UK and Ireland in 2019. Two articles are provided in support.¹⁷ The first is from *Forbes*, dated 13 July 2019. It is entitled "*INXS Concert Film Further Extends The Band's Legacy And Brand*". It says that the concert in 1991 represented INXS at the "*height of their popularity*" but that the band were "*still in the public eye through a variety of projects*". The second is from *NME*, dated 24 September 2019. It is entitled "*Live Baby Live: INXS' classic Wembley concert movie restored and to return to cinemas*".

¹⁶ Exhibit KP11

¹⁷ Exhibit KP12

36. Mr Pengilly provides press articles in which INXS has featured.¹⁸ These include articles in *NME* (said to be from September 2019), *The Guardian* (6 March 2022), *Far Out Magazine* (19 April 2022) and *The Sun* (19 October 2023), as well as an article on the Virgin Radio website (12 October 2022). The articles discuss the band's songs and albums, Mr Martin's involvement, the band reuniting in 2023, and a documentary about its former singer, Michael Hutchence. Further examples are included in the evidence, but they are not from UK press outlets. I do note, however, that *Reuters* stated on 23 October 2023 that the band "*reunited for the first time in over six years*" the previous week. A list of hyperlinks to what appear to be other online articles is included in the evidence, but it is not for me to conduct independent research; the articles themselves, or extracts thereof, have not been provided.

37. Mr Pengilly also describes how INXS' songs have been used in films, television programs and commercials. In 2024, he says that 'Never Tear Us Apart' was used in a Super Bowl commercial and as the launch soundtrack of a new Lamborghini car. This song is said to have been the Coral Racing theme song in 2022. Chevrolet, too, used an INXS song as the launch soundtrack of its new car in 2025. According to Mr Pengilly, one of the *Voice UK* blind auditions, with over 56 million views, was a rendition of 'Never Tear Us Apart'. He does not say when it aired or provide any other information about it.

38. Finally, Mr Pengilly says that the parties have been engaged in a trade mark dispute in Australia. In this connection, he provides a copy of his witness statement and exhibits filed in those proceedings.¹⁹ Whilst I note the contents, this evidence takes the opponent's case no further than the evidence filed specifically for these proceedings (and already summarised).

39. The evidence shows that INXS was a very successful band. It released numerous records and played a large number of shows in the UK, predominantly in the 1980s and 1990s. It appeared on several television shows in the UK during that time and received many industry awards, some of which are specific to (or at least known of in)

¹⁸ Exhibit KP13

¹⁹ Exhibit KP14

the UK. By the time of its last show in the UK, in London in June 2011, it is my view that the band had generated a strong goodwill in connection with the core activities of the band. Although the band does not seem to have been active for some time after that, there is no indication in the evidence that the goodwill was ever abandoned. Moreover, the band's YouTube videos had around 50 million views from the UK from April 2007 onwards, including nearly 30 million from 18 September 2018 onwards. Songs continued to be played on radio stations, with a significant number of plays from 2020 onwards. The band's songs had over 42 million streams in 2022 and over 53 million streams in 2023. Some of its previously released albums had been re-mixed and re-released in more recent years. A film of its sell-out Wembley Stadium concert was released in UK cinemas in 2019, and the band continued to feature in the UK press. Clearly, the band was still popular in the UK and remained, to some extent, in the public eye. On the basis of all the evidence, I find that the band retained a significant residual goodwill connected with musical recordings and musical performances at both relevant dates. I am also satisfied that the INXS sign has been distinctive of the goodwill at all relevant times.

40. I do not consider that the opponent owned any goodwill in respect of any other goods or services. This is because there is either no evidence of them being provided or because the trade in them was too small to be considered more than trivial in nature. In particular, I acknowledge Mr Pengilly's evidence about the opponent's merchandising operation and accept that merchandising may form part of the business of a band. However, the evidence before me is too limited to demonstrate protectable goodwill extending to the merchandising goods, such as clothing. Firstly, the printouts showing INXS merchandise on various websites are from after both relevant dates. Moreover, the turnover generated through the sale of merchandise totalled £4,069.34 between January 2020 and 23 September 2024. This reflects an extremely low level of trade. Not only that, but most of the turnover is likely to have been from after the earlier relevant date; the actual turnover from before that time is likely to have been much smaller still. It is also the case that the figure covers a list of several different goods. I acknowledge that, when assessing goodwill, it is not necessary to break the business in question down at the same level of granularity as is done under trade mark

law.²⁰ However, I am unable to determine from the evidence how significant the opponent's trade in each product was. The opponent's failure to break down the merchandising turnover may not have been as much of an issue had the level of business been on a larger scale but, since the collective turnover was extremely small, the evidence is insufficient to demonstrate anything other than a trivial level of trade in respect of each product.

41. I also accept that the opponent has sold copies of its book. However, I am of the view that selling 242 copies and generating a total turnover of \$36,682.58 was insufficient to generate a protectable goodwill in such goods. In any event, the book was released in 2023. This means that no copies of the book could have been sold before the earlier relevant date. In addition, the evidence suggests that the book was considered new on 18 July 2023, which was only around two months before the prima facie relevant date. The evidence does not identify how many of the sales occurred before that date, but at least some of them are likely to have been after.

42. I should add that, whilst I note the opponent's submission that it could not sell any merchandise between 2019 and 2022 due to the impact of the COVID-19 pandemic, I have not placed any weight on it. There is no evidence explaining how the pandemic prevented the sale of goods such as clothing, particularly where sales of such goods could potentially have continued through online channels. Indeed, Mr Pengilly has provided evidence of some merchandising turnover during this period. The mere fact that the pandemic occurred does not automatically explain low, or an absence of, sales. Nor has it been explained why the entire three-year period was said to have been affected, given that the most significant restrictions in the UK were in force for only part of that period. Finally, even if I were to accept that the pandemic adversely affected merchandise sales between 2019 and 2022, that would not explain the complete absence of any turnover figures or evidence of sales of merchandise prior to that period.

43. At the hearing, Mr Kieffer criticised the opponent's evidence on the basis that there was an absence of an evidential link between the members of the band and the

²⁰ *Mercis B.V. v Bunnyjuice Inc*, BL O/0064/24, paragraph 57

opponent. This was raised for the first time at the hearing; it was not raised in the evidence rounds or even foreshadowed in a skeleton argument (one having not been filed). I do not consider it appropriate for the holder to only seek to raise this issue at such a late stage in the proceedings. If the holder wished to take issue with the ownership of the band's goodwill, then it should have raised it in the evidence rounds. The opponent could then have directly addressed the issue in reply. In his witness statement, Mr Pengilly states as follows:

“7. The Opponent is the company responsible for the business affairs of the rock band INXS, which holds among other things the registered trade marks including UK trade mark registration no. UK00904057766 for INXS in Classes 9, 16, 25, 26, 41.”

44. The holder did not challenge this statement or suggest during the evidence rounds that the opponent's responsibility for the business affairs of the band did not extend to owning its goodwill. On the basis of Mr Pengilly's evidence, and in the absence of an appropriate challenge thereto, I am satisfied that the opponent is the owner of the goodwill generated by the band.

Misrepresentation

45. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt LJ stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

46. Later in the same judgment, it was stated that:

"[...] for my part, I think that references, in this context, to "more than *de minimis*" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

47. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lloyd LJ commented on the paragraph above as follows:

"64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the "substantial number" of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small."

48. *Halsbury's Laws of England* Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

49. The signs to be compared are as follows:

The opponent's sign	The IR
INXS	IMXS

50. In its written submissions, the opponent referred to previous decisions of the Tribunal involving four-letter marks/signs. Whilst these are noted, it suffices to say that I am not bound by them.

51. At the hearing, Mr Harris and Mr Kieffer both made submissions on the comparison of the signs. I do not intend to reproduce those here but confirm that I have taken them into account in the following comparison.

52. The opponent's sign consists of the word INXS. In my view, the sign is likely to be perceived as an abbreviation of the words 'in excess'. This is because it is a known phrase, the word IN at the beginning of the sign is immediately recognisable, and the letters XS are likely to be perceived as an abbreviation for the word 'excess'. It is possible that some members of the relevant public will simply see INXS as an initialism. However, it is my view that such individuals would not constitute a significant proportion of the relevant public.

53. The IR comprises the word IMXS in a block typeface. The sign is likely to be seen as an initialism. The letters will not be separated or perceived in any other way, given that, for instance, there is no natural break between IM and XS or an apostrophe between the I and M (to give the impression of 'I'm', being a shortening of 'I am'). The typeface used is, ultimately, unremarkable; any impact it has is minimal.

54. Visually the competing signs are similar in that they both consist of four letters and share three of those letters in the same order. Although the IR is presented in a particular typeface, I do not consider that this represents a point of significant visual difference. The stylisation is very slight and has minimal impact. Moreover, notional and fair use of the opponent's sign would cover use in a very similar (if not the same)

typeface. The competing signs differ in their respective second letters. While I accept that there is no special test in this regard, the competing signs consist of only four letters and, therefore, the differences between them are more likely to be noticed.²¹ In light of all this, I find that there is between a medium and high degree of visual similarity between the competing signs.

55. In accordance with my assessment as to how the opponent's sign is likely to be perceived, it is likely to be pronounced as the words 'in excess'. Conversely, the IR is likely to be articulated as an initialism, i.e. "EYE-EM-EX-ESS". For the reasons already given, it is unlikely to be pronounced as two words. In the circumstances, the competing signs aurally overlap in their identical endings, since the letters XS will be pronounced in the same way as the word 'excess'. The competing signs aurally differ in the pronunciation of the word 'in' and the letters I-M. The difference appears at their respective beginnings, a position which tends to have most impact.²² Moreover, I again bear in mind that the differences are more likely to be noticed due to the competing signs being only three and four syllables long. Overall, I find that there is a medium degree of aural similarity between the competing signs.

56. Conceptually, the opponent's sign is likely to be seen as an abbreviation of the words 'in excess', meaning 'more than', whereas the IR is likely to be perceived as an initialism with no known or obvious meaning. There is no conceptual similarity between the competing marks. I should add that there would still be no conceptual similarity if the opponent's sign was also seen as an initialism; the position in such circumstances would be effectively neutral.

57. The opponent is known for its activities as a band. Protection of the IR is sought for various goods, broadly consisting of jewellery, watches, items of precious metal, goods of leather or imitation leather, umbrellas, clothing, clothing accessories, footwear, and food and drink products. Those goods are entirely dissimilar to musical recordings and performances. There is an element of overlap insofar as it is not

²¹ See *Robert Bosch GmbH v Bosco Brands UK Limited*, BL O/301/20. Although this was a trade mark case, I can see no reason why it would not apply to a comparison with an unregistered sign.

²² *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02. Again, whilst this was a trade mark case, I can see no reason why the principle would not apply here.

uncommon for bands to have a merchandising operation, and such merchandise may comprise some of the designated goods. However, I find that such an overlap is tenuous: the business of a band is entirely different to that of, for instance, a clothing manufacturer. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet LJ made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

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

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

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

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

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

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

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

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

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

‘...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully

appreciated. If he had, he might not have granted the respondents relief. When the alleged “passer off” seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.”

58. Whilst there is no requirement for the parties to offer similar goods or services, or to operate in a common field of activity, the proximity of the respective fields remains a highly relevant consideration. As the authorities above make clear, the burden of establishing a likelihood of confusion and any resulting damage is a heavy one where there is no, or only a tenuous, overlap between those fields. No direct evidence going to misrepresentation has been filed. I have already found that any overlap between the parties' respective fields of activity is tenuous. Whilst the opponent's business retained significant residual goodwill at the relevant dates, I do not consider that goodwill sufficient to overcome the distance between the parties' respective fields of activity, notwithstanding the levels of visual and aural similarity between the competing signs. Taking all of the above into account, I do not consider that a substantial number of the opponent's actual or potential customers would be deceived. The relevant public is unlikely to believe that the holder's goods originate from, or are otherwise commercially connected with, the band INXS. There will be no misrepresentation and, therefore, no risk of damage. This finding is made in respect of both relevant dates.

Conclusion

59. The opponent's claim under section 5(4)(a) is dismissed.

Sections 5(2)(b) and 5(3)

60. The opponent has been unsuccessful on what it identified as its strongest ground. Therefore, I do not consider it necessary to determine the remaining grounds. Nevertheless, I record here for completeness that they would not have placed the opponent in a better position. The opponent's mark is subject to the use requirements.

The relevant period for that assessment would have been 15 September 2018 to 14 September 2023. Having already reviewed the evidence in full, it is my view that it would not have been sufficient to establish genuine use within that period. The evidential position is much weaker for that period than it was for the assessment of goodwill. Much of the evidence falls outside of it and, to my mind, the evidence which falls within it would not have been sufficient to demonstrate that the opponent attempted to create or maintain a market under INXS at that time. Even if the evidence were sufficient, any finding of genuine use could only be confined to the goods and services corresponding with the core activities of the band. The distance between those and the goods of the IR is such that it would render the opposition under sections 5(2)(b) and 5(3) unsuccessful.

OVERALL OUTCOME

61. The opposition has failed in its entirety. Subject to any appeal against this decision, the IR will become protected in the UK for all the designated goods.

COSTS

62. The holder 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 holder the sum of **£1,400**, which is calculated as follows:

Considering the opponent's statement and preparing a counterstatement	£350
Preparing evidence and considering the opponent's evidence	£800
Preparing for and attending a hearing ²³	£250

²³ In arriving at the award for this activity, I have taken into account that the hearing was held on a 'short form' basis and lasted only around an hour and 15 minutes. I have also reduced the award for this activity because Mr Kieffer filed no skeleton argument in advance of the hearing (as he was required to do as a professional representative) and gave no real explanation for not filing one.

63. I order INXS International Pty Limited to pay Jiangxi Maisi Clothing Co., Ltd. the sum of **£1,400**. This sum is to be paid within 21 days of the expiry of the appeal period, or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 14th day of September 2026

James Hopkins
For the Registrar