

O-365-12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 2567110  
BY OA INTERNET SERVICES LTD IN RESPECT OF THE FOLLOWING  
SERIES OF TWO TRADE MARKS IN CLASSES 5, 10 & 44:**

**VIMAX**  
**Vimax**

**AND**

**OPPOSITION THERETO (NO 102149) BY VIAMAX AB**

## **The background and the pleadings**

1) OA Internet Services Ltd (“OA”) applied for the series of two trade marks VIMAX & Vimax on 16 December 2010. They were published in the Trade Marks Journal on 8 April 2011. The goods and services for which registration is sought are:

**Class 05:** Dietary supplements; herbal supplements; mineral supplements; vitamin supplements; natural healthcare products and preparations; supplements, products and preparations for penis enlargement; virility enhancement pills.

**Class 10:** Medical apparatus, instruments and equipment; medical apparatus, instruments and equipment for penis enlargement; traction apparatus, instruments and equipment; traction apparatus, instruments and equipment for penis enlargement; parts and fittings for all of the aforesaid goods.

**Class 44:** Medical and healthcare services; information, advisory and consultancy services relating to all of the aforementioned services

2) Vimax AB (“AB”) opposes the registration of OA’s marks in respect of all of the above goods and services. Its opposition was filed on 11 July 2011 and is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”)<sup>1</sup>. Two earlier marks are relied upon, namely:

i) Community Trade Mark (“CTM”) registration 4619482 which was filed on 28 September 2005 and registered on 17 February 2009. The CTM is in respect of the word VIAMAX and it is registered for:

**Class 05:** Intimate creams, oils and gels.

ii) International registration (“IR”) 589773A which designated the UK for protection on 8 December 2006 with protection being conferred on 3 February 2008. The IR is in respect of the word Vimax and is protected in respect of:

**Class 05:** Intimate creams, intimate oils and intimate gel; herb based diet supplements.

3) Both marks constitute earlier marks as defined by section 6 of the Act. As neither mark completed its registration procedure or had its protection conferred before the five year period ending on the date of publication of OA’s mark, the use conditions do not apply to them.

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<sup>1</sup> A claim under section 5(4)(a) was also initially made, but this was subsequently withdrawn.

4) OA filed a counterstatement denying the grounds of opposition. Both sides filed evidence. A hearing took place before me on 25 July 2012 at which OA were represented by Ms Denise McFarland, instructed by Albright Patents LLP; AB were represented by Mr Ross Manaton of Bromhead Johnson.

### **The evidence**

#### *First Witness Statement of Ross Manaton dated 5 December 2012*

5) Mr Manaton is AB's trade mark attorney. His evidence contains, essentially, details of the earlier trade marks relied upon. I do not need to detail this evidence given what I have already set out above.

#### *Witness statement of Octav Moise dated 3 February 2012*

6) Mr Moise is OA's CEO. He states that OA has sold VIMAX products throughout the UK since at least 2002 and continues to do so. Sales figures are provided and example invoices provided. The sales figures between 2002 and 2010 amount to just over £1,000,000 in total. The sales figures relate to VIMAX pills, but Mr Moise does not give evidence about the exact nature and purpose of the pills.

7) OA's trade mark attorneys at Albright Patents LLP also provided written submissions which I will also bear in mind but will not summarise here.

#### *Second Witness Statement of Ross Manaton dated 4 April 2012*

8) In his second witness statement Mr Manaton provides various examples of AB's VIAMAX mark in use. This is as follows:

- Exhibit RTM3 – website prints (undated) showing the VIAMAX mark being used both as a plain word and in a stylized form. The goods sold under it are described as being based on aphrodisiac herbs which have been used for many years to enhance sexual pleasure, desire and performance. Various products are then depicted for both male and female use in the nature of supplements, gels, creams, lubricants and massage oils.
- Exhibit RTM4 – a brochure (containing both English and German text) showing a similar range of products, but aimed only at men.
- Exhibit RTM5 – a brochure (containing both English and German text) showing a similar range of products aimed only at women.
- Exhibit RTM6 – physical samples of the goods.

## **Section 5(2)(b)**

9) Section 5(2)(b) of the Act reads:

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

(a) .....

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

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

10) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

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

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

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is

permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

### **The scope of the earlier marks**

11) Of its two earlier marks, AB's IR is widest in scope<sup>2</sup> in terms of its specification. As will become apparent, neither of the earlier marks is more similar or dissimilar to OA's marks than the other. My assessments and decisions will, therefore, focus on the IR which is protected in respect of:

Intimate creams, intimate oils and intimate gel; herb based diet supplements.

12) There was discussion at the hearing as to the scope of such goods. As can be seen from Mr Manaton's second witness statement, AB's goods are used for

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<sup>2</sup> Although in the specification of AB's CTM the word intimate does not precede the words "oils" and "gels", I take the phrase as a whole, in context, to mean that the oils and gels are also "intimate", so the goods are no wider than the IR.

various sex/sexual health purposes. Ms McFarland highlighted the lack of specificity in the goods as protected. She argued that it would be wrong to import the sex/sexual health angle into the specification and that AB could not restate its specification. She also argued that such specific goods may not even fall within the natural meaning of the goods as protected and, therefore, the uses set out in Mr Manaton's evidence should not be considered as a notional and fair use of the earlier mark. In support of this, it was argued that intimate oils and creams could be perceived as goods for use in the ear canal or eye area and that herb based diet supplements could be perceived as being for joint care, general health etc. Mr Manaton argued that the evidence showed the opponent's paradigm use and that the goods did fall within the specification as registered.

13) As Ms McFarland points out, the protected goods do not specifically mention sex/sexual health purposes. The specification is worded more generally. However, I do not agree that such functions/uses cannot be imported into the scope of the goods, so long as the specification as it stands encompasses such potential functions/uses within its ambit. However, I agree that if the specific does not fall within the general, then it does not matter what goods the mark has actually been used on, the claimed paradigm use would not be relevant. The case-law informs me that "in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade"<sup>3</sup> and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>4</sup>. In terms of the intimate creams, oils and gels, the use of the word "intimate" gives a clue as to the uses of the goods. The word intimate is a word often used in association with sexual acts and/or with what would be characterised as the private parts of the body. I have little hesitation in concluding that the goods as worded will encompass intimate oils, creams and gels for sex/sexual health purposes.

14) In relation to "herb based diet supplements", this is a broad term which will encompass goods for a variety of purposes. General health purposes may be the first thing to spring to mind, but this does not mean that the term should not be deemed to encompass supplements for other purposes. The evidence shows that the goods as used are herb based diet supplements, and that they are for sex/sexual health purposes. The potential use is not, therefore, a mere hypothetical one. In my view, the specific clearly falls within the general. The sex/sexual health purpose may therefore be considered as part of the scope of the earlier mark's goods. I should add, however, that none of what I have said limits the goods in this way. The sex/sexual health purpose is just but one type of

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<sup>3</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

<sup>4</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

potential purpose (although, as will be seen, this is the most relevant purpose), but others are also applicable.

### **The average consumer**

15) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or services can, however, vary depending on what is involved (see, for example, the judgment of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

16) Some of the goods (e.g. supplements, oils and creams etc) may be simple off the shelf (or virtual shelf) products. The average consumer will be a member of the general public who requires the goods for whatever purpose (which could vary but will include sex/sexual health purposes) they fulfil. Such goods will, though, be subject to a careful purchasing process on account of them being for ingestion or for use on intimate parts of the body and, also, on account of their purpose which may be carefully considered to ensure that the goods meet the consumer’s wishes. The goods may also be over the counter or even prescription only products – in such a case, healthcare professionals as well as the general public must be considered but, either way, a careful approach is still likely to be adopted in the purchasing process. This is also applicable to the medical devices (including OA’s penis enlargement devices) and medical services for which both the general public and medical professionals must be borne in mind.

### **Comparison of goods**

17) When making the comparison, all relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

18) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(a) The respective uses of the respective goods or services;

- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

19) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* it was stated:

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

#### OA's class 5 goods

20) OA seeks registration in respect of:

**Class 05:** Dietary supplements; herbal supplements; mineral supplements; vitamin supplements; natural healthcare products and preparations; supplements, products and preparations for penis enlargement; virility enhancement pills.

21) This is to be compared with AB's:

**Class 5:** Intimate creams, intimate oils and intimate gel; herb based diet supplements.

22) OA's "Dietary supplements" could be herb based and, so, can be considered identical to "herb based diet supplements". To the extent that they are not herb based then they are, nevertheless, highly similar when the nature, purpose, methods of use, channels of trade etc. are considered – the goods will also compete.

23) "Herbal supplements" are identical to "herb based diet supplements"; by their very nature, supplements supplement a person's diet.

24) "Mineral supplements" and "vitamin supplements" are not necessarily herb based, but, nevertheless, they are likely to be sold in tablet or capsule form, and will be ingested. Mineral and vitamin supplements may be used to boost a particular mineral or vitamin that is deficient in a person's body. This is not the same exact purpose as an herb based supplement but, they are all still used for health (and other) purposes so there is still similarity on this level. Furthermore, taking a particular mineral or vitamin supplement may be done for a specific purpose other than to treat simple deficiency. For example, a particular vitamin supplement may be taken to boost the body's immune system. Similar purposes could also apply to herb based supplements; on this level, the goods have a more similar purpose and an aspect of competition is introduced. I consider the goods to be similar to a reasonably high degree.

25) "Natural healthcare products and preparations" could be "herb based diet supplements" so are to be considered identical. To the extent that they are not identical, the goods are likely to have similarities in nature, purpose, methods of use and channels of trade, and may compete. They would still, therefore, be similar to a reasonably high degree.

26) "Supplements, products and preparations for penis enlargement" serve a specific purpose. There is no reason why the "herb based diet supplements" covered by AB's mark (which are not limited in any way) could not be for the same or very similar purpose. Indeed, as already observed, the scope of the goods should be deemed to cover goods for sex/sexual health purposes. To illustrate the point, one of AB's physical samples is for its MAXIMISER product which "engorges and enlarges penile erectile tissues..". I consider the goods to be identical in so far as supplements are considered. In terms of the "products" and "preparations", these could also be supplements so the same applies; if they are not supplements then the purpose, channels of trade and potential competition will still combine to create a high degree of similarity.

27) That leaves “virility enhancement pills”. For similar reasons to that expressed above, I consider the goods to be identical (to the extent that the pills are supplements) or highly similar if they are not pills.

OA’s class 10 goods

**Class 10:** Medical apparatus, instruments and equipment; medical apparatus, instruments and equipment for penis enlargement; traction apparatus, instruments and equipment; traction apparatus, instruments and equipment for penis enlargement; parts and fittings for all of the aforesaid goods.

28) Some of the above goods are specifically for penis enlargement. I discussed at the hearing whether such goods were simply highly specialist devices used by healthcare professions for, e.g., undertaking operations to increase penis length and/or would require specialist fitting by a healthcare professional in the medical arena. Ms Macfarland felt that this was the correct approach whereas Mr Manaton expressed a view that whilst this could be one interpretation, such goods could also be more rudimentary in nature and could be subject to, effectively, DIY application. I agree with Mr Manaton that both possibilities ought to be considered. There is no reason why the devices in question could not be quite simple products which a man wishing to increase the size of his penis may obtain and use at home. From this perspective, it must be observed that the nature and methods of use of such devices are quite different from those of the earlier mark. However, penis enlargement is the purpose of such devices which has the potential to coincide with herb based supplements (to the extent that they also serve a purpose of penis enlargement). The goods could compete in that a man who wishes to increase the size of his penis may opt for a device or, alternatively, a supplement. In terms of channels of trade, there is no evidence directed to this, but, I consider it likely that a company specializing in the provision of penis enlargement solutions may offer both options. I consider there to be a reasonable (but not high) degree of similarity.

29) Of the terms not limited to penis enlargement (“medical apparatus, instruments and equipment” and “traction apparatus, instruments and equipment” at large) such terms include within their ambit goods for penis enlargement. As such, they may be considered to have the same degree of similarity as that assessed in the previous paragraph. Obviously, the terms will, notionally speaking, also cover goods for purposes other than for penis enlargement. However, at no point has a fall back specification been put forward by OA, neither did Ms MacFarland suggest that anything else was required, focusing, as OA have done throughout the proceedings, on penis enlargement devices; there is nothing to suggest that there is anything else which is commercially relevant. Furthermore, as the earlier mark’s goods are not limited to the sex/sexual health field, then notionally speaking, other non-specified purposes of its goods could notionally clash with the other non-specified purposes of OA’s broad terms.

## OA's class 44 services

**Class 44:** Medical and healthcare services; information, advisory and consultancy services relating to all of the aforementioned services

30) Similar reasoning runs through this assessment. Whilst the above terms are broad, they could, notionally speaking, cover services relating to sex/sexual health, such as services in the field of sexual enhancement, including penis enlargement. From this perspective, the services are similar to the goods in that they may both be used by people wishing to improve sexual performance or have other sexual health issues resolved. Whilst they are obviously different in nature and methods of use, there could be a degree of competition as a person may either take a supplement for such an intended purpose, or, alternatively, avail themselves of a service which may deliver the same results. In terms of channels of trade, without evidence, it is difficult to see if they really overlap. All things considered, my view is that there is a low to moderate degree of similarity. The comments made in the preceding paragraph about the other notional uses of both the services and the goods apply equally here.

### **Comparison of the marks**

31) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. I have focused so far on the earlier IR which is registered in sentence case. OA's marks are in sentence case and upper case. However, notional use of all of these marks would include use in both sentence and upper case. There is no material difference in terms of which forms of the mark I consider. I will focus upon:

## **Vimax v Viamax**

32) Neither mark breaks down into separate components, the words VIMAX/VIAMAX form the respective dominant and distinctive elements.

33) In terms of concept, neither mark has a meaning which is likely to be appreciated by the average consumer. In coming to this view, I have not ignored Ms McFarland's submission that the VIAMAX mark has a concept based on the word VIA (e.g. through) and MAX (e.g. maximise) which, therefore, alludes to maximisation (presumably of the penis/sexual desire) via the goods sold under the mark. Whilst this is noted, I consider this too analytical a concept – it is not a concept that the average consumer will immediately perceive. My view is that there is neither conceptual similarity or dissimilarity.

34) From an aural and visual perspective, both marks begin with “Vi” and end in “max”. The only difference is the additional A in Viamax. Ms McFarland submitted

that the most likely pronunciation of Viamax would be VEE-AH-MAX or V-EYE-AH-MAX and that VIMAX would most likely be pronounced as VIM-AX. Mr Manaton submitted that VIMAX would be pronounced as VEE-MAX or VI-MAX and VIAMAX as VI-AH-MAX. Ms MacFarland also submitted that the marks look different whereas Ms Manaton argued that the marks were visually very similar.

35) There are clearly variations on a theme possible in terms of how the average consumer is likely to pronounce the marks. For my part, I consider the most likely pronunciations to be: VIMAX as VIGH-MAX and VIAMAX as VIGH-UH-MAX. However, even with variations on a theme, I do not consider the aural differences between the marks to be particularly acute and they will not have a significant impact on the average consumer. This also applies to the visual comparison; in my view the differences do not stand out greatly. I consider there to be a high degree of both aural and visual similarity. Overall the marks are highly similar.

### **The distinctiveness of the earlier mark**

36) The degree of distinctiveness of the earlier mark(s) must be assessed. This is because the more distinctive the earlier mark(s) (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). Mr Manaton's evidence provides no detail about the level of use made of the mark before the relevant date. In view of this, there can be no finding of the earlier mark having an enhanced degree of distinctiveness. However, from an inherent perspective, and as an invented word, I consider the earlier mark to be high in inherent distinctive character.

### **Concurrent use**

37) In AB's statement of case in relation to its now withdrawn ground under section 5(4)(a), it was stated that the earlier mark had been used throughout the UK since 2001. As stated in my evidence summary, Mr Manaton's evidence contained examples of AB's mark in use. However, none of this was dated nor is it claimed to represent the use from 2001 onwards. In OA's evidence, Mr Moise stated that OA's mark had been used throughout the UK since 2002 and in written submissions filed on OA's behalf it is stated that despite these statements (relating to the respective sides' use) OA was unaware of any instances of confusion. Ms McFarland sought to rely on this so-called peaceful co-existence as being indicative that there was no likelihood of confusion, because there had been none so far. I roundly reject this argument. AB has filed no evidence as to the extent of its use, all it has filed are examples of use which may or may not reflect its claimed use from 2001. AB has filed no examples of its mark in use, nor true extent etc. Confusion-free parallel trade is a factor to be approached with a good deal of caution<sup>5</sup>. There is so little evidence before the tribunal that it is not possible to make any form of inference. This argument is dismissed. I also dismiss Ms McFarland's argument that AB's failure to raise any claims against

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<sup>5</sup> See, for example, *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283

OA's use (such as infringement/passing-off proceedings) is a relevant factor to consider – I see no relevance in this.

### **Other MAX marks**

38) In its written submissions, OA refers to a number of MAX suffixed marks which co-exist on the register, being indicative, it is argued, that the MAX based marks in conflict here can also co-exist. Whilst MacFarland did not abandon this argument, she did not overly rely on it. Mr Manaton felt that the argument was simply not relevant. Mr Manaton is correct for a number of reasons. Firstly, there is no evidence of the actual use of such marks in the marketplace. State of the register evidence alone is indicative of little<sup>6</sup>. Furthermore, the marks in conflict here have similar beginnings (as well as sharing the MAX suffix) and they are highly similar as a whole. This is in stark contrast to the types of mark referred to in the submissions. This argument is dismissed.

### **Likelihood of confusion**

39) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

40) In class 5, the goods are either identical or similar to at least a reasonably high degree. The marks are visually and aurally similar to a high degree with no conceptual difference to counteract this. The earlier mark is distinctive to a high level. Whilst I bear in mind that the purchasing process is likely to be a careful one, I have little hesitation in concluding that there is a likelihood of confusion.

41) In class 10, the goods are reasonably similar but not highly so. The other factors remain the same. I come to the view that the average consumer would believe that the same economic undertaking is responsible for the respective goods. They will see one as a product extension of the other, part of the same line. A related product with the same end goal. There is a likelihood of confusion.

42) In class 44, and although the goods and the services are only similar to a low to moderate level, I consider, again, an average consumer encountering the applied for services would believe, if they were to encounter the goods of the earlier mark, that the same or a related undertaking is responsible for both. The similarity between the marks, when the link between the goods and services in question is considered, will be put down to economic connection and not co-incidence. There is a likelihood of confusion.

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<sup>6</sup> See, for example, *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281

43) Bringing all my findings together, the opposition succeeds in its entirety.

**Costs**

44) AB has been successful and is entitled to a contribution towards its costs. Ms McFarland referred to the withdrawal of AB's 5(4)(a) claim as a factor to be borne in mind (against AB). That the ground was pleaded, but withdrawn before the parties filed evidence, is not something that in my view should be penalized. I make no adjustment for this. I hereby order OA Internet Services Limited to pay Viamax AB the sum of £1500. This sum is calculated as follows:

*Preparing a statement and considering the other side's statement*  
£300

*Considering and filing evidence*  
£600

*Attending the hearing*  
£600

45) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

**Dated this 28th day of September 2012**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**