

**O/621/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:  
TRADE MARK APPLICATION NO. 3476477  
BY 3DCP LIMITED TO REGISTER**

**PitchWiz**

**IN CLASS 28**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 421024  
BY WEST & BERGH HOLDING AB**

## BACKGROUND AND PLEADINGS

1. 3DCP Limited ('the applicant') applied to register the trade mark PitchWiz in the United Kingdom ('UK') on 20 March 2020. It was accepted and published in the Trade Marks Journal on 3 April 2020 in respect of the following goods:

**Class 28:** *Articles for playing golf.*

2. On 30 July 2020, West & Bergh Holding AB ('the opponent') opposed the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). This is on the basis of its UK Trade Mark that, given the date of its filing, qualifies as an 'earlier mark' in accordance with section 6 of the Act. Neither is the earlier mark subject to the proof of use provisions in section 6A of the Act. The opposition is directed against all goods in the application. The details of the earlier mark and the goods and services relied upon are as follows:

<b>Earlier Trade Mark</b>	EU Trade Mark ('EUTM') no. 18191653 for DEWIZ <sup>1</sup>
<b>Goods and services relied upon</b>	<b>Class 10:</b> <i>Apparatus for use in muscular training for medical purposes; computer controlled training apparatus for therapeutic use; computer controlled exercise apparatus for therapeutic use; physical exercise machines for medical purposes; exercise apparatus for medical rehabilitation purposes; physical exercise training articles for medical purposes; Apparatus for use in toning muscles for medical rehabilitation; medical rehabilitation apparatus; rehabilitation devices (body) for medical purposes; training equipment for medical rehabilitation purposes; physiotherapy and rehabilitation equipment; appliances for physical use [for medical purposes]; apparatus for the treatment of pressure ulcers;</i>

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<sup>1</sup> Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice ('TPN') 2/200 for further information.

	<p><i>apparatus for the treatment of leg ulcers; apparatus for electrical muscle stimulation; apparatus for electrical stimulation of muscle groups; apparatus for the prevention of leg ulcers; pressure ulcer prevention devices; Nervous stimulation devices; devices for orthopedic purposes; life signaling devices; apparatus for physiotherapy; apparatus for therapeutic muscle toning; apparatus for therapeutic stimulation of the body; apparatus for therapeutic stimulation of muscles; apparatus for transcutaneous electrical nerve stimulation; electrodes for use with medical devices; electromagnetic medical devices; electronic devices for medical purposes; physiological apparatus for medical use; medical devices; medical devices for pain relief; medical devices and instruments; medical and veterinary apparatus and instruments; orthodontic devices; orthopedic appliances; therapeutic devices for body wounding; vibration-generating apparatus for massage.</i></p> <p><b>Class 28:</b> <i>Aids for golf training; golf training apparatus; devices for adjusting golf swing for sport use.</i></p> <p><b>Class 44:</b> <i>Autogenous therapy; physical rehabilitation; rehabilitation of alcohol-abusing patients; rehabilitation of drug addicts; rehabilitation of drug users; rehabilitation for addicts; development of individual programs for physical rehabilitation; behavioral analysis for medical purposes; information related to behavioral change (psychological).</i></p>
<b>Relevant dates</b>	<p><b>Filing date:</b> 4 February 2020</p> <p><b>Date of Registration:</b> 22 May 2020</p>

- The opponent argues that the contested mark has a medium to high degree of visual and aural similarity and that they share a “*common conceptual significance*” surrounding the element ‘Wiz’. They further that the contested goods are identical and/or similar to their goods in class 28, in addition to being similar to the other goods and services their earlier mark protects. The opponent argues that there is

indirect confusion within which the average consumer will “*draw the conclusion that both marks are part of a WIZ family of marks; the DEWIZ mark is one mark (perhaps the core mark) whereas the PitchWiz is a particular WIZ product, presumably aimed at the enhancing consumer’s pitching [sic]*”. The opponent requests that the contested mark is refused protection and that they are awarded costs.

4. The applicant filed a counterstatement denying that the two marks are similar and that any of the respective parties’ goods are identical or similar. They deny that there is any likelihood of confusion between the respective marks and they request that their application is allowed to proceed to registration and that they are awarded costs in their favour.
5. On 16 November 2020, the Tribunal wrote to the parties to provide them with a preliminary indication. The finding, of which I confirm is not binding upon me, was that there is an insufficient similarity between the competing trade marks to give rise to a likelihood of either direct or indirect confusion. On 16 December 2020, the opponent responded to the Tribunal and filed a Form TM53 requesting that the opposition proceedings continued to the evidence rounds.
6. Both parties filed submissions (including final written submissions) and evidence in these proceedings. Whilst I will not summarise any of these fully, I have taken them all into account and I will refer to them as necessary in my decision.
7. As no hearing was requested, this decision is taken following a careful perusal of the papers to which I refer, as necessary, below.
8. Both parties have had professional representation in these proceedings. The opponent is represented by Haseltine Lake Kempner LLP and the applicant has been represented by Bawden & Associates.
9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from

an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

## EVIDENCE

10. The opponent filed evidence in the form of a Witness Statement of Martin Krause (a partner at the opponent's representative), dated 4 March 2021, with 3 exhibits attached. By way of a brief summary of the attached exhibits, I note that;

- a. Exhibit MK1 is an undated website screenshot from the Dun & Bradstreet online business directory. Whilst I do not have access to the website address, the witness states that the screenshot is from [www.dnb.com](http://www.dnb.com). The screenshot shows that "deWiz Golf AB" is a company incorporated in Sweden and is a subsidiary of the opponent.
- b. Exhibit MK2 is an undated screenshot entitled "Golf Instruction Book", with a "PGA Professional" logo to the left. I provide an extract below:

Post rounds and get an  
**Golf Instruction Book**

**The ABC's of Golf**  
by PGA Professional, Mark Blakemore

[Introduction](#)  
[Part A - All About How to Get Started in Golf](#)  
[Part B - Basic Fundamentals and Concepts in Golf Swing Technique](#)  
[Part C - Common Golf Words and Phrases - Glossary](#)  
[Conclusion](#)

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**Glossary of Golf Terms and Phrases**  
Golf Terminology - Definitions and Usages

Golf words or phrases beginning with the letter  
**P**

Choose a tab above to find words that begin with that letter.

Or enter the word in the form below. If the word you're looking for cannot be found it will automatically be suggested to the Glossarymaster (MB) for review and inclusion.

**pace of play**  
time taken to play a stroke, hole or round, usually thought of in terms of maximum allowable time with an associated penalty for exceeding that time; covered by rule 6-7 of the USGA Rule book  
Example: The committee of any given tournament is in charge of setting any specific *pace of play* guidelines.

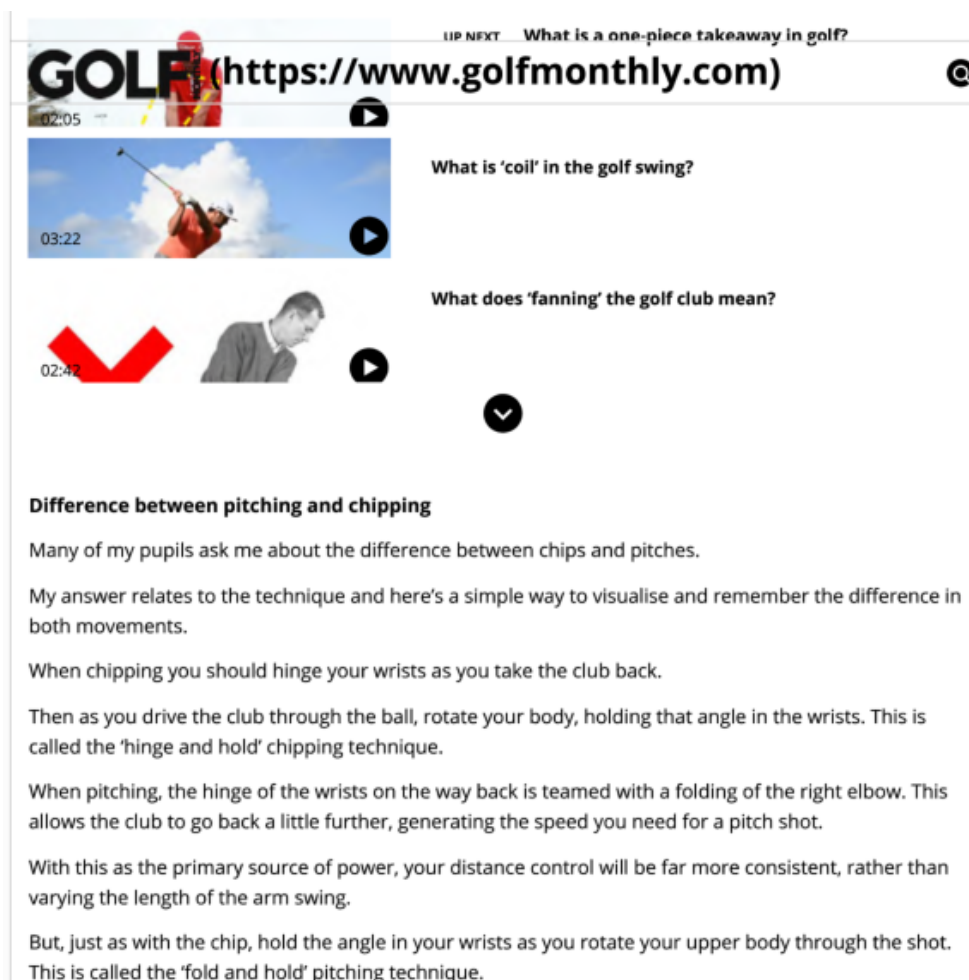
**pairing**  
1. a group of two (or more) players 2. the process of forming player groups  
Example: 1. *Pairings* for the first two rounds of the event were random, or blind draw 2. The *pairing* was done with consideration to marquis value or prominence.

**par**  
1. the standard number of strokes in which a scratch player would be expected to complete a hole or course 2. (also "even, even par, level, level par") to score par on a course, or the state of being at that score during or at the conclusion of play  
Example: 1. *Par* for a hole is based on the length of the hole plus two putts (e.g., a *par* four hole would be one that an

Whilst I am unable to see the website address, the witness states it is from [www.pgaprofessional.com](http://www.pgaprofessional.com). This screenshot contains a glossary of golfing terms beginning with the letter 'P', including the word 'Pitch' which is defined as follows:

**pitch**  
("pitch shot") a relatively short, lofted shot designed to land softly and not roll much (differs from a chip in its trajectory and amount of roll)  
Example: The **pitch/pitch shot** is very valuable from the short side of the green.

- c. Exhibit MK3 is an undated website screenshot from Golf Monthly ([www.golfmonthly.com](http://www.golfmonthly.com)). I am not aware where Golf Monthly operates. The screenshot is of an article published on 28 July 2015 that explains the difference between pitching and chipping. One page of the screenshot is depicted below:



UP NEXT... What is a one-piece takeaway in golf?

**GOLF** (<https://www.golfmonthly.com>)

02:05

03:22

02:42

What is 'coil' in the golf swing?

What does 'fanning' the golf club mean?

**Difference between pitching and chipping**

Many of my pupils ask me about the difference between chips and pitches.

My answer relates to the technique and here's a simple way to visualise and remember the difference in both movements.

When chipping you should hinge your wrists as you take the club back.

Then as you drive the club through the ball, rotate your body, holding that angle in the wrists. This is called the 'hinge and hold' chipping technique.

When pitching, the hinge of the wrists on the way back is teamed with a folding of the right elbow. This allows the club to go back a little further, generating the speed you need for a pitch shot.

With this as the primary source of power, your distance control will be far more consistent, rather than varying the length of the arm swing.

But, just as with the chip, hold the angle in your wrists as you rotate your upper body through the shot. This is called the 'fold and hold' pitching technique.

11. The applicant filed evidence in the form of a Witness Statement of Samuel Jonathan Linn (an Associate Trade Mark Attorney at the applicant's representative), dated 4 May 2021, with 1 exhibit attached. To briefly summarise the exhibit, I note that;

- a. Mr Linn states that the exhibit is to support the applicant's submission that *"there are quite a number of registered trade marks, owned by different proprietors, consisting of or based conspicuously on the word "WIZ" or "WIZZ" or "WHIZZ" (or close visual or phonetic variants) in respect of goods in the sporting sector in class 28"*.
- b. Exhibit SJL1 is a website screenshot dated 5 April 2021 from the Intellectual Property Office 'Search for a trade mark' function available at <https://trademarks.ipo.gov.uk/ipo-tmtext/page/Results>. The screenshot notes that the search performed found 26 marks; details of those marks are contained in the screenshot. The applicant submits that the search performed was under the term *"wiz" OR "wizz" OR "whiz", looking for "similar" marks, limited to marks with goods in class 28, and only those registrations which are currently live/in-force*". The witness set out the results in the following table:

UK TM Registration No.	Mark	Relevant goods within class 28 covered ( <i>inter alia</i> ) by the registration
UK00801452533	"WIZ"	Toys, games, playthings and novelties; sporting articles and equipment.
UK00003542416	"WRAP WIZ"	Sports equipment.
UK00003066319	"GEE WHIZZ"	Toys; games; playthings.
UK00002643157	"WHIZZ BANG"	Toys, games and playthings.

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UK00913945721	"STAR WIZ"	Games and playthings.
UK00801123661	"CLUB WHIZZ"	Apparatus for use in golfing; apparatus for use in the game of golf; articles for playing golf; articles for use in playing golf; bag stands for golf bags; caddie bags for golf clubs; covers for golf club heads; divot repair tools (golf accessories); golf apparatus; golf bag travel covers; golf bags, with or without wheels; golf ball markers; golf ball retrievers; golf ball spotters; golf balls; golf buggies (hand propelled); golf club bags; golf club covers; golf club grips; golf club head covers; golf club heads; golf club shafts; golf clubs; golf gloves; golf irons; golf mats; golf practice apparatus; golf putters; golf swing alignment apparatus; golf tee bags; golf tees; golf training aids; golfing apparatus; grips for golf clubs; handles for golf clubs; head covers for golf clubs; heads of golf iron sets; nets for practising golf; pitch mark repair tools (golf accessories); portable golf driving ranges; shafts for golf clubs; shaped covers for golf bags; shaped covers for golf clubs; sporting articles for playing the game of golf; stands for golf bags; trolley bags for golf equipment.
UK00914481758	"WHIZZ WORLD"	Toys; games and playthings; sporting articles; parts and fittings for all the aforesaid goods.
UK00002619975	"whizz ACADEMY" [figurative]	Games and playthings.
UK00801402334	"wizz" [figurative]	Toys, games, playthings and novelties; sporting articles and equipment.
UK00801402586	"WIZZ"	Toys, games, playthings and novelties; sporting articles and equipment.
UK00801411437	"wizz" [figurative]	Toys, games, playthings and novelties; sporting articles and equipment.
UK00801411927	"wizz" [figurative]	Toys, games, playthings and novelties; sporting articles and equipment.
UK00002598954	"WIZZ TOYS"	Toys, games and playthings.
UK00801161014	"WIZZY"	Balls for practising team sports.
UK00904594271	"WIZZY WOO"	Games and playthings; toys and sporting goods; sporting articles.

## PRELIMINARY ISSUE

### *State of the Register*

12. The applicant submits that their evidence shows that "WIZ" is not a unique element but is used by many other entities in the sports sector. Thus, the existence of other marks "*substantially weakens – and indeed negates - any argument the Opponent may attempt to make that any commonality between the Applicant's and the Opponent's marks lies in a verbal element (namely "WIZ") which they themselves have any exclusivity*".



13. Regarding the applicant's state of the register evidence, I first highlight the decision of *Zero Industry Srl v OHIM*, Case T-400/06. Here, the General Court stated that:

*"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II 4865, paragraph 68, and Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71). "*

14. As the above caselaw establishes, the state of the register (alone) is not enough to establish that the distinctive character of the word "WIZ" is weak because of any frequent use in the field concerned. There is no evidence that the registrations cited by the applicant are in use. However, whilst this evidence has no real value, I will, though, keep in mind that the inherent distinctiveness of the word 'WIZ' still needs to be kept in mind when considering whether there is a likelihood of confusion.

## **DECISION**

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

15. The opposition is based upon section 5(2)(b) of the Act. This section reads as follows:

*"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”.*

## **Case law**

16. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('OHIM')*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### *The principles*

- (a) The likelihood of confusion must be appreciated, 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 be dominated by one or more of its components;
- (f) however, it is also 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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **Comparison of goods and services**

17. The opponent contends that their goods and services are identical and/or similar to the applicants' goods. However, in their final submissions, the opponent accepts that the strongest case rests with their goods in class 28; respectively, they submit that *"if it cannot succeed in respect of these goods, it will not succeed with any of the others and so these submissions focus solely on the goods in class 28"*. They submit that the parties' goods in class 28 are identical. In doing so, they highlight that their *"devices for adjusting golf swing for sport use"* are not limited to being for training purposes and that, regarding the remaining goods, *"any training aid can in principle be used in the playing of a sport"*.
18. The applicant denies that there is any similarity between their goods with the opponent's class 10 goods and class 44 services. However, I find no need to consider such submissions more fully given that the opponent accepts that if they do not succeed in class 28, then they will not succeed here. In relation to the opponent's goods in class 28, the applicant states that the goods are not identical because the opponents are *"all of the nature of golf training aids/apparatuses/devices"* whereas the applicant's goods *"are actually for the purpose of playing golf"*. They submit that the opponent's *"golf training/practising" goods ... are still quite distinct in their physical natures, the manners in which each are used, and the environments in which they are used"* to the applicant's goods.
19. At the outset, I find it useful to highlight that section 60A of the Act provides that whether the goods and services are in the same or in different classes is not decisive in determining whether they are similar or dissimilar. What matters is the actual goods and services at issue and whether they are similar or not having regard to the case law that I refer to below.
20. In the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*, Case C-39/97, the court stated at paragraph [23] of its judgment that:

*"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”.*

21. The relevant factors for assessing similarity were identified by Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At paragraph [296], he identified the following:

*“(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.”*

22. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

*“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.*

23. Regarding the complementarity of goods (and, by extension, services), in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods/services. Also, in *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court stated that ‘complementary’ means:

*“...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.”*

24. The goods for comparison are as depicted below. I agree with the opponent that their best case rests with their goods in class 28 and, thus, with the above factors in mind, this is where I will base my analysis.

<b>Opponent’s goods</b>	<b>Class 28:</b> <i>Aids for golf training; golf training apparatus; devices for adjusting golf swing for sport use.</i>
<b>Applicant’s goods</b>	<b>Class 28:</b> <i>Articles for playing golf</i>

25. The applicant’s “*Articles for playing golf*” broadly encapsulates various goods, such as golf clubs, golf bag trolleys and golf gloves, but are not limited to such and other golf playing apparatus is covered by the term . The opponent has coverage of “*devices for adjusting golf swing for sport use*”. Whilst I do not have the benefit of any evidence confirming the exact nature of such devices, I expect that a person playing golf who is looking and/or training to adjust their golf swing would use the device, including at the same time they are playing the game. The device, therefore, could be an article used for playing golf and the respective parties’ goods are identical on the basis outlined in *Meric*.

26. The opponent’s “*Aids for golf training*” and “*golf training apparatus*” cover various apparatus and aids that are used within golf training. I expect this would include

apparatus that can help a user perfect their swing and clubs that are designed for training. A person is likely to be playing golf whilst training to play golf. Therefore, the applicant's "*Articles for playing golf*" may include identical (albeit also broader) goods. I, therefore, consider the respective goods to be identical on the principle outlined in *Meric* above.

27. Nevertheless, if it is considered that any of the opponent's goods are more niche to training and the applicant's goods do not extend to goods that facilitate golf training, then the goods are alternatively highly similar on the basis of a shared user, use and trading channels. Whilst it may be considered that the goods have a different purpose and thus do not directly compete, some goods could also be complementary in that they are imperative to one another. For example – there could be a golf training article that attaches to a non-training specific golf club, and the nature of that relationship is one whereby the consumer may think that the responsibility for the goods lies with the same undertaking.

### **Average consumer and the purchasing act**

28. I next consider who the average consumer is for the contested goods and the way in which those goods are purchased. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question<sup>2</sup>.

29. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

*"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the*

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<sup>2</sup> See *Lloyd Schuhfabrik Meyer*, Case C-342/97

*relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”*

30. The average consumers of golfing aids and articles are members of the general public, professional golf coaches, golf clubs and professionals. The price of the contested goods will vary depending on the nature of the goods – I expect they are generally either inexpensive (golf gloves, for instance) or of a middle price range (such as golf clubs and golf training apparatus). I consider such goods will be purchased reasonably frequently, on a basis somewhere in between frequent and infrequent, although this will vary depending on the precise item concerned. The average consumer will often take account of the size, price, colour and overall aesthetic impact of the goods, but also with a focus on performance characteristics. For the more specialist goods, such as golf clubs and training devices, the technical functions and constructions are additionally important – and, thus, slightly more attention to such goods will be paid. While the purchase of the contested goods will be a primarily visual experience, I nevertheless bear in mind that the marks are spoken. For example, they may be recommended by golf professionals and players on a golf course and sales assistants in a retail establishment or when making a purchase from a catalogue or over the telephone. However, in such circumstances, the consumer will likely have had an opportunity to view the goods, perhaps electronically via an app, website or online catalogue, or on paper in the traditional sense of catalogue shopping.

31. I find that the average consumer will typically pay a medium degree of attention when purchasing the majority of the goods. When more specialist goods are purchased, and especially by the professional consumer or trade, then I consider a slightly higher than medium (though not of the highest) degree of attention will be paid during the purchasing process.

### **Comparison of marks**



32. It is clear from *Sabel BV v Puma AG* (particularly paragraph [23]) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph [34] of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

*“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”*

33. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

34. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
DEWIZ	PitchWiz

35. The opponent submits that the respective marks are similar because they “*share the identical and highly distinctive ending “Wiz”*”. The opponent submits that the marks have a medium to high degree of visual and aural similarity and that there is a common conceptual significance. They submit that the common element ‘Wiz’ “*will likely be perceived as a made-up word that is very similar to “whizz” or a contraction of the word “wizard”*”. They also submit that the average consumer may

attribute the “prefix “DE-” in the earlier mark to “meaning “of” or perhaps the rather more colloquial equivalent of the word “the” or the phonetic equivalent of the letter “D””. Additionally, since the “Pitch” element in the contested mark is “entirely descriptive ... for any golf articles that are used for pitching”, then the element is a descriptor for the “only distinctive element of the mark, ... “WIZ””, which is a “distinctive ... and unusual” element shared with the earlier mark.

36. The applicant denies that the respective marks are similar. They submit that the marks are “significantly different in conceptual terms and make-up”. They consider that the applicant’s “Pitch” verbal element is “a normal English word with a clear meaning, which in sporting connotations typically means a throw, toss, fling or loft of a ball or object, especially in such a way that it lands in a desired place or position” and “Wiz” is “likely to be perceived as a shortened form of “wizard”, meaning a person who is exceptionally clever, gifted or skilled in a particular area”. When the words are combined, the applicant submits that the idea is “connected with pitching and wizardry”. The applicant submits that the opponent’s mark is conceptually different since the element “DE” is without a conceptual impact and “the suffix ‘WIZ’ ... means little or nothing of any discernible significance”. Alternatively, the average consumer may see the element “DEW” meaning “moisture from the atmosphere condensed by cool bodies upon their surfaces” and the suffix “IZ” which has no meaning and still differs to the applicant’s mark. Visually, the applicant submits, *inter alia*, that the syllable “Pitch” in the applicant’s mark and “DE” in the opponent’s mark are the most dominant elements. Whilst the marks share the suffix “WIZ”, due to the use of capitalisation, the applicant states that the applicant’s mark appears to be made up of two verbal elements, whilst the opponent’s does not. They submit the two marks are visually different and highly dissimilar aurally.

### Overall impression

#### *The applicant’s contested mark*

37. The contested mark is a word mark consisting solely of the word “DEWIZ” in normal black font. The overall impression lies in the word itself. I note from the opponent’s

evidence that one of its subsidiaries is named “*deWiz Golf AB*”, with, arguably, ‘Wiz’ standing out more in the overall impression (or at least showing that it is a separate component to the letters ‘DE’). However, such a formulation would not, in my view, represent notional and fair use of the word mark “*DEWIZ*”, which would ostensibly be seen as an invented single word.

#### *The opponent’s earlier mark*

38. The opponent’s mark is a word mark consisting solely of the word “*PitchWiz*” in normal black font. The overall impression lies in the word itself, with neither of the elements standing out more than the other.

#### Visual comparison

39. There is clearly some similarity between the two marks as they both contain the letters “*WIZ*” at their end. However, the beginning element of both marks differ considerably; the earlier mark is “*DE*” whereas the contested mark is “*Pitch*”. Further, it is noticeable that one mark comprises a single word, whereas the other comprises two words which have been brought together in presentation. I consider the visual similarity is of a low degree.

#### Aural comparison

40. The opponent’s mark will be articulated in two syllables, as ‘dew-iz’, ‘duh-wiz’ or ‘de-wiz’. The contested mark will be articulated as ‘pich-wiz’, which is also two syllables. The first syllable of the respective marks differ, though they may share a final syllable. The aural similarity is of a low to medium degree.

#### Conceptual comparison

41. The mark “*DEWIZ*” appears to be an invented word and, thus, I consider it most likely that the average consumer will consider the mark is without a meaning. However, I leave open the possibility that some (albeit a small number) average consumers may see an evocative reference to the word “*WIZ*” being a

slang/informal word for wizardry/a wizard (i.e. someone who practices magic) and/or being a whizz (i.e. expert) in something. The contested mark also shares the “WIZ” element and any meaning it evokes; though that word is conjoined with the word “Pitch”. The latter word “Pitch” has various definitions, including a sports field, level/degree, type of movement<sup>3</sup> and, as the opponent submitted in its evidence, a type of shot in golf. When I also consider the goods in question, I consider the latter conceptual message most likely. When the “Pitch” and “Wiz” elements are combined in the contested mark, I consider the mark most likely alludes to being an expert or having some special skills in a type of golf shot. There is a medium conceptual similarity between the marks, but only for an average consumer who ascribes an evocative meaning to “WIZ” in the earlier mark. However, I consider it most likely that the marks are deemed conceptually dissimilar by the average consumer.

### **Distinctive character of the earlier trade mark**

42. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

*“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).*

*23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been*

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<sup>3</sup> See the definition of ‘Pitch’ by Cambridge Dictionary  
<<https://dictionary.cambridge.org/dictionary/english/pitch>> Accessed 16 August 2021

*registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51).”*

43. Registered trade marks possess varying degrees of inherent distinctive character, ranging from low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use made of it.
44. The opponent submits that “Wiz” is highly distinctive. In response, the applicant stated that this ignores that this word is likely to be *“perceived as a shortened form of “wizard”*” and that the UK Register of Trade Marks *“contains quite a number of registered trade marks, owned by different proprietors, consisting of or based conspicuously on the word “WIZ” or “WIZZ” or “WHIZZ” (or close visual or phonetic variants) in respect of goods in the sporting sector in class 28”*. The applicant submits that, therefore, *“the commonality in the element “WIZ”/“Wiz” is far less significant, and it therefore shifts the emphasis for where the real test for “similarity” lies onto the respective prefixes “DE-“ vs “Pitch-”*”. The applicant also submits that the opponent’s earlier mark has *“overall a relatively low or no more than average level of inherent distinctiveness”*.
45. As the opponent has filed no evidence showing the extent of its use, I only have the inherent position to consider. As I have touched upon already, the state of the register evidence is not telling. That said, I accept that the word ‘WIZ’ *per se* would not be the most distinctive of components given that it has some suggestive qualities relating, essentially, to the quality of the goods. However, the earlier mark is the word “DEWIZ”, which I have held will be seen predominantly as an invented word with no evocative or suggestive meaning. I, therefore, consider the mark has a relatively high degree of inherent distinctiveness. However, for the small number

of average consumers that see an evocative meaning, the mark as a whole will have only a medium degree of distinctiveness, but whilst recognising that 'WIZ' per se is a weaker component.

### **Likelihood of confusion**

46. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. I point particularly to the principles I referred above in paragraph 16. One of these is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services and the nature of the purchasing process.

47. There are two types of possible confusion: direct (where the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). The distinction between these was explained by Mr Iain Purvis Q.C (sitting as the Appointed Person) in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10:

*“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the*

*common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.*

*17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:*

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).*
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.)*
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”*

For the avoidance of doubt, I acknowledge that these three categories are just illustrative – Mr Purvis QC stated that indirect confusion ‘tends’ to fall in one of them.

48. I also find it important to mention the case of *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch). Here, Arnold J. (as he then was) considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

*“18 The judgment in Bimbo confirms that the principle established in Medion v Thomson is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark*

*contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.*

*19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In Medion v Thomson and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.*

*20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).*

*21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”*

49. I will first analyse whether there is a likelihood of direct confusion. The opponent submits that the consumer will not directly confuse the respective marks - I agree. Notwithstanding imperfect recollection and the identity of the class 28 goods, the marks contain too many visual, aural and conceptual differences for the mere similarity of the “WIZ”/“Wiz” endings to prevail and likely confuse the average consumer.



50. I now turn to consider indirect confusion. Although I acknowledge the identity, or else high similarity, between the parties' respective goods, I find the marks to be too different for the average consumer to consider them sharing an economic connection of some kind. For those average consumers (who I consider to be the majority) who see "DEWIZ" purely as an invented word, there is no reason at all why they would believe that the goods sold under the "PitchWiz" mark come from the same or a related undertaking. Even if some average consumers recognise that the two marks share the "WIZ"/"Wiz" element, I still find it unlikely that the average consumer would consider that the marks are related. This is particularly because of the different beginnings of the marks ("DE" vs "Pitch"), the whole mark construction ('WIZ' built into an invented word in the earlier mark, but as a two component mark in the contested mark) together with the fact that 'WIZ' is unlikely to be seen as a particularly distinctive component. I consider that the average consumer will attribute the shared aspects to being a coincidence, not an indicator of an economic connection. Bearing in mind the interdependency principle and notwithstanding the possibility of imperfect recollection, I nevertheless find that there is no likelihood of indirect confusion.

## **CONCLUSION**

51. The opposition under section 5(2)(b) of the Act fails. Subject to any successful appeal against my decision, the application is allowed to proceed to registration for the full range of goods applied for.

## **COSTS**

52. The applicant has been successful and is entitled to a contribution towards their costs.

53. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. Using that TPN as a guide, I award the applicant the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement: £200

Preparing evidence and considering and commenting on the other side's evidence: £500

Preparing written submissions: £300

54. I therefore order West & Bergh Holding AB to pay 3DCP Limited the sum of £1000.

The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 20th day of August 2021**

**B Wheeler-Fowler  
For the Registrar**