O-553-15

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO 2354659 IN THE NAME OF FITBUG LIMITED IN RESPECT OF THE TRADE MARK

FITBUG

IN CLASSES 9, 28 AND 41

AND AN APPLICATION REVOKE THE REGISTRATION UNDER NO 500378 BY FITBIT, INC

Background and pleadings

1) Fitbug Limited is the proprietor of UK registration 2354659 for the mark FITBUG ("the registration"). It applied for the registration on 29 January 2004 and the registration procedure was completed on 3 September 2004. The registration covers the following goods and services:

> **Class 9:** *Pedometers; electronic heart rate monitors (other than for medical use); electronic pedometers; weighing machines; docking stations adapted to receive any of the aforesaid goods and allow communication of any of the aforesaid goods with an electronic data transmission means; parts and fittings for the aforesaid goods; computer software; computer software relating to assessment of fitness, monitoring of fitness, proposing fitness training programmes, managing and monitoring fitness training programmes, monitoring recording and displaying historical fitness data about one or more individuals, provision of motivational information and statements to people in fitness training and/or provision of nutritional advice.*
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> **Class 28:** *Exercise equipment; sporting equipment; fitness training equipment; parts and fittings for the aforesaid goods.*
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> **Class 41:** *Provision of fitness training services; provision of fitness training services via a computer network, the Internet, electronic mail, telecommunications services, and/or SMS messaging; services in the provision of a computer website which assesses fitness, monitors fitness, proposes fitness programmes, manages and monitors fitness training programmes, monitors records and displays historical fitness data about one or more individuals, provides motivation and information to people in fitness programme and/or provides nutritional advice; personal training services; provision of non-medical nutrition advice; provision of non-medical nutrition advice relating to fitness and sporting performance.*

2) On 28 April 2014, Fitbit, Inc (hereafter "the applicant") filed an application to revoke the registration for reasons of non-use.

3) The applicant seeks revocation of the trade mark registration on the grounds of non-use based upon Section 46(1)(a) and (b) of the Trade Marks Act 1994 ("the Act"). Revocation is sought under Section 46(1)(a) in respect of the 5 year time period following the date of completion of the registration procedure, namely 4 September 2004 to 3 September 2009. Revocation is therefore sought from 4 September 2009.

4) Revocation is also sought under Section 46(1)(b) in respect of the following time periods:

> 25 May 2008 to 24 May 2011
>
> 28 April 2009 to 27 April 2014

5) Revocation is therefore sought from 25 May 2011 and 28 April 2014 respectively.

6) The proprietor filed a counterstatement denying the claims and stating that it has used its mark in respect of all of the Class 9 goods and Class 41 services listed in its registration since their launch in late 2004. It admits that there has been no use in respect of its Class 28 goods. It further claims that the applicant's action is frivolous and vexatious because the applicant is fully aware of the proprietor's use of its mark because the parties are competitors and have also been involved in proceedings before the OHIM where the proprietor provided evidence of use of its mark. Consequently, it requests costs off the scale.

7) Both sides filed evidence in these proceedings. Both sides ask for an award of costs (and as noted above, off scale costs have been requested by the proprietor). The matter came to be heard on 23 September 2015 together with a sister invalidation action between the parties, when the applicant was represented by Mr Philip Roberts of Counsel, instructed by Olswang LLP and the proprietor was represented by Mr Jonathan Moss of Counsel, instructed by Urquhart Dykes & Lord LLP.

Proprietor's evidence

8) This takes the form a witness statement by Paul Elliott Landau, founder and chief executive of the proprietor. He states that the proprietor was established in January 2004 (Exhibit PEL1 is an extract from the Companies House website verifying this) with the aim of encouraging "people to eat a little better and do a little more".

9) Mr Landau states that the proprietor has been using the mark FITBUG continuously since mid-2004. He also states that the proprietor operated under the domain names fitbug.co.uk, fitbug.net and myfitbug.com prior to the purchase of fitbug.com from the original proprietor.

10) Mr Landau describes the FITBUG device as being pocket-sized and when combined with an online program it is used to assist individuals manage and monitor their nutrition and activity. He explains that the devices offered by the proprietor have evolved over the years, becoming smaller and can be worn in a variety of ways, including as a wristband. He states that the proprietor also offers weighing scales that sync to the device via *Bluetooth* technology.

11) Mr Landau explains that, in addition to individual members, the proprietor works with employers to encourage teamwork and help prevent illness and absenteeism with personalised programs, challenges, activity tracking and social media tools. Customers have included *BP*, *London 2012*, *NHS Redbridge* and *Oxera*.

12) At Exhibit PEL3 there is an undated brochure provided to employees of corporate customers detailing the benefits of the proprietor's goods and services. On page two of the exhibit, this document includes a reference to motivation and advice being provided to users via its website, text messages and email.

13) At Exhibit PEL4, Mr Landau provides evidence of the FITBUG mark in use. Some of these exhibits are undated, but where they are dated I indicate the date when summarising the exhibits below:

- A page of unknown origin promoting the FITBUG goods and services. A stylised version of the mark is used as is the word, as registered, in statements such as “Partner with Fitbug” and “Fitbug enhances your wellness solution by getting people walking and talking” as well as numerous references to FITBUG in the promotional text. Under the heading “Why choose Fitbug?” the following text appears:

    > “Fitbug motivates and embeds behaviour change. Our range of activity trackers, motivational nuggets via email or text and virtual challenges have encouraged people to make realistic changes to their lifestyles”

Later on the same page, the following statements are made:

> “Fitbug can provide an API, help build tailored microsites, embed Fitbug functionality into your website, create virtual challenges or set up use of our activity devices and data feeds”

- Three further pages in the same format as the first promote the *Fitbug Orb* and *Fitbug Flex* devices that track activity and monitor sleep. The *Fitbug Orb* can be worn on the wrist, or using a belt or underwear clip. It “also comes with its own digital coach” called *KiK*;

- Two pages from the proprietor’s website (carrying a 2014 copyright notice) promoting the *Fitbug WoW* weighing scales that uploads its data via *Bluetooth* technology to the *Fitbug* app.

- A page where a user goes to sets up their new *Fitbug* device, carrying a 2014 copyright notice;

- Screen prints of web pages offering the Fitbug Orb fitness, sleep and activity tracker device for sale;

- The following pages from the proprietors Fitbug.com website, obtained from the Internet archive “waybackmachine”:

    - 9 March 2013: a page headed “How Fitbug Works” where the device called the “bug” and is described as a “pocket-sized personal coach” and states that “Fitbug tailors targets and creates charts based on [...] daily activity”;
    - 11 August 2011: “sign up” page and makes numerous references to FITBUG in word form, as registered;
    - 23 November 2010: “healthy living” page referencing Fitbug recipes, a FITBUG recipe book, a FITBUG newsletter as well as a testimonial to the benefits of FITBUG in losing weight;
    - 11 February 2009: “how it works “ page where the question “So how does Fitbug work?” is asked. Four stages are identified:
        (1) “get your bug and move”
        (2) “connect your bug” “Connect your Bug to your PC and send Fitbug your achievements...”;

(3) “track and motivate” “...mingle [online] with other Fitbug members”;
(4) “get on target” “Achieve your personal goals by following realistic weekly activity and healthy eating targets which advance at a pace that suits you”;

- 27 June 2008: “about fitbug” page where the question “What is Fitbug” is posed. In answer the following text appears: “Fitbug is your online personal health and well-being coach ... Fitbug’s coaching system brings together the web and a little gadget we fondly call the “Bug” which allows both you and Fitbug to keep track of every step you take, calories burned and a whole lot more”;
- 1 July 2008: “home” page highlighting some of the features shown on the previous pages;
- 5 March 2007: This page is entitled “Welcome to Fitbug...” and contains the sub-headings “Fitbug for business”, “Fitbug for individuals”, “Fitbug for PCTs and schools” and “Fitbug for gyms and PTs”.

13) Mr Landau provides the following turnover and advertising expenditure figures relating to business conducted under the FITBUG mark in the UK:

Year	Turnover (£)	Advertising Spend (£)
2005	241,100	365,700
2006	494,300	65,000
2007	550,000	64,900
2008	2,030,000	267,500
2009	1,050,000	95,500
2010	1,130,000	49,400
2011	1,270,000	14,300
2012	1,334,000	34,900
2013	749,000	199,400

14) Exhibit PEL5 consists of a selection of invoices showing sales of the device itself as well as sales in respect of a number of corporate deals. Mr Landau states that these deals include providing the organisation’s staff with access to the proprietor’s device and associated services, including being able to download an app to access the FITBUG services.

15) In his reply evidence, Mr Landau states that the turnover figures are a combination of sales of devices and monthly subscriptions of corporate users. He also explains that the marketing and advertising has taken various forms including newspaper advertising and editorials, printed flyers, online and London Underground billboards. A selection of these are shown in Exhibit PEL6 and some of these are summarised below:

- A *Daily Mirror* newspaper article, dated 24 January 2005, describing FITBIG as “an online gym” and also states “You simply wear a matchbox-sized gadget called The Bug (its similar to a pedometer), which tracks your activity levels”, explaining that you then download the information and FITBUG

"provides you with exercise and dietary advice". It notes that membership costs from £9.95 for a month's membership;

- A *Metro* newspaper article, dated 2 February 2006, entitled "The Best Exercise Gadgets for People on the Move" and includes the following: "...The Fitbug is an interactive pedometer that records your daily aerobic activity, uploading the data to a secure website when you connect it to a PC";

- Some articles similar to the above are shown in the following publications:

    - *Evening Standard*, 8 February 2005;
    - *Daily Express,* 5 March 2005;
    - *Sky News* website, 20 January 2006;
    - *The Times*, undated;
    - *The Guardian Supplement*, 29 July 2006;
    - *Woman* magazine, 14 March 2008.

- A series of three advertisements that appear to be on a wall adjacent to an escalator on the London Underground. A stylised FITBUG mark is visible. The exhibit is undated;

- A number of monthly PR highlights report in respect to FITBUG for October 2013 listing publications where FITBUG has been promoted. These include numerous national publications such as *Cosmopolitan* and *Slimming World*;

- Discussions about the Fitbug Air device on a website entitled *Mum Friendly* making reference to the device connecting by *Bluetooth* to the FITBUG app "where it breaks down what you're walking into ...data...". This extract is dated 6 August 2013. Screen shots of the app pages shows a calendar of activity, a table of activity as well as links to "today", "history" and "goals";

- A similar extract from the same website dated 20 July 2013;

- An print of a page from a website *Mum of One*, dated 22 August 2013 is a report of someone trialling "the new Firbug Air". Screenshots of the app show nutritional information being displayed showing the users food intake in terms of actual versus target for categories such as "carbohydrate", "protein", "fat" and "cals consumed";

- An extract from an unknown website, dated 10 September 2010, makes a reference to the FITBUG device sending "all the details of your activity top a free iPhone app [...] which maps it all out on a graph.

16) Mr Landau also provides a list of 19 trade shows/conferences held in the UK between May 2006 and April 2014 that the proprietor attended to promote its goods and services sold under the FITBUG mark. Invoices relating to the cost of attending these events are provided at Exhibit PEL7.

Applicant's evidence

17) This takes the form of a witness statement (entitled "Second Witness Statement") of Paul Anthony Stevens, partner at Olswang LLP, the applicant's representatives in these proceedings. Mr Stevens identifies what he characterises as "a number of discrepancies in the assertions made by Mr Landau and the supporting documents attached to his statement". I will not detail these submissions here, but summarise them briefly as suggesting some of the exhibits do not fully support Mr Landau's statements and also a claim that Mr Landau's evidence fails to support use in respect of all the Class 9 goods or in respect of any of the Class 41 services.

Proprietor's evidence-in-reply

18) This takes the form of a second witness statement by Mr Landau. He points out that the invoices provided at his Exhibit PEL5 are printed on FITBUG headed paper.

19) Mr Landau states that the proprietor trades under the name FITBUG, therefore, all of the marketing and advertising spend carries the mark FITBUG and relates to the goods and services offered by the proprietor.

20) Mr Landau states that the proprietor with the loyalty programme Nectar in 2009 and emails were sent out to 2.8 million Nectar card holders in December 2009, June 2010 and October 2010, Examples of such emails are provided at Exhibit PEL8 and refer to Nectar Fitbug.

21) Further examples of marketing activities in 2010 are provided at Exhibit PEL9 showing case studies sent to Lambeth, Bradford and Airedale and Wolverhampton Primary Care Trusts being potential corporate customers. All prominently include use of the proprietor's mark.

22) Mr Landau provides photographs at Exhibits PEL11 and PEL12 illustrating the proprietor's stands at a "Talking Obesity" event held in London in March 2010, the Great North Run (sharing a stand with *BUPA*) in 2008, Vitality Show at Olympia. Presentations were given by Mr Landau at events such as at "Health & Wellbeing" in 2009, "Preventative Health" in June 2010 and "Health Live" in November 2011 with photographs of these being provided at Exhibit PEL 13. All of these exhibits show use of the proprietor's stylised mark and sometimes the domain name fitbug.com. At Exhibit PEL14, Mr Landau provides copies of brochures distributed at these events. These variously show use of the proprietor's stylised mark, the mark FITBUG in ordinary typeface and the domain fitbug.com.

23) In response to a criticism by the applicant that the proprietor has failed to provide any evidence of use in respect of *docking stations* and also *computer software* (at large), Mr Landau explains that all early versions of "the bug" device were connected to a computer by a USB cable and that it was always necessary to physically connect (or dock) the device to the computer. In respect to computer software, Mr Landau explains that the broad term was included to provide broader cover than the additional defined term in order to cover computer applications such as one called "Bug Manager" that is installed onto the users' computer to read the data off a device and to send it to the proprietor's servers.

24) Mr Landau identifies a number of services available on the proprietor's website that are freely available without the need of a device. By way of example, he identifies the nutrition advice, recipes and activity and work out programmes shown at the screenshot dated November 2010 at page 4 of his Exhibit PEL4.

25) Member's packs referred to in the exhibits in PEL5 include an app that members can download

DECISION

Legislation

26) Section 46(1) of the Act states that:

> "The registration of a trade mark may be revoked on any of the following grounds-
>
> > (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
> >
> > (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
> >
> > (c).....
> >
> > (d).....
>
> (2) For the purpose of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
>
> (3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.
>
> (4) An application for revocation may be made by any person, and may be made to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or
(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date."

27) Section 100 is also relevant, which reads:

"If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

28) In *Stichting BDO v BDO Unibank, Inc.,* [2013] EWHC 418 (Ch), Arnold J. stated as follows:

"51. Genuine use. In *Pasticceria e Confetteria Sant Ambreoeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3)The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]–[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimus* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]".

29) Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that "*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question".* The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

30) As identified in paragraphs 3 and 4, above, the proprietor is required to demonstrate genuine use for the three five year periods 4 September 2004 to 3 September 2009, 25 May 2008 to 24 May 2011 and 28 April 2009 and 27 April 2014.

31) I observe that the evidence illustrates that the proprietor uses FITBUG in a word only form as well as being part of a stylised version of the mark as shown throughout the evidence and I conclude that whatever the breadth of use shown, it is in respect of the mark as filed. Mr Landau, in his witness statement, explains that the mark has been use continuously since mid-2004 and that all of his company's business is conducted under the FITBUG mark. Turnover peaked in 2008 with over £2 million of sales. Between 2009 and 2011 it remained over £1 million a year and in 2012 it was

just under £750,000. Mr Landau has stated that these sales are made up of a combination of sales of the FITBUG devices and monthly subscriptions from corporate users (that was £9.95 per month according to the *Daily Mirror* in 2005 (Exhibit PEL6). Invoices to support this are provided at Exhibit PEL5, and these illustrate use of the mark appearing in the header. Such a turnover shows a level and length of sales that is more than token and clearly not sham use.

32) The primary issue between the parties is in respect of the breadth of goods and services illustrated in the evidence. The applicant concedes that there has been use by the proprietor of its mark, but only in respect of 'electronic pedometers'. Whilst conceding that there has been no use in respect of any Class 28 goods, the proprietor submits that there has been use in respect of the other goods and services listed in its specifications. I will therefore consider what goods and services the proprietor's mark has been used and also having considered this, identity what would constitute a fair specification.

33) In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law in respect of fair specifications as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

34) In *Roger Maier and Another v ASOS,* [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

> "63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:
>
> > "… I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. … Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average

> consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."
>
> 64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.
>
> 65. It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered."

35) At the hearing, Mr Roberts also referred to the findings of the GC in *Reckitt Benckiser (Espana) SL v OHIM (ALADIN)*, T-126/03 and in particular the following passages:

> "45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it

to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

36) When considering what use has been shown, I keep in mind that all of the proprietor's goods and services are provided under the FITBUG mark and that its turnover and advertising spend reflect a continuous trade in respect of the mark since 2005.

The Class 9 goods

37) The proprietor's Class 9 specification, as registered, reads:

> *Pedometers; electronic heart rate monitors (other than for medical use); electronic pedometers; weighing machines; docking stations adapted to receive any of the aforesaid goods and allow communication of any of the aforesaid goods with an electronic data transmission means; parts and fittings for the aforesaid goods; computer software; computer software relating to assessment of fitness, monitoring of fitness, proposing fitness training programmes, managing and monitoring fitness training programmes, monitoring recording and displaying historical fitness data about one or more individuals, provision of motivational information and statements to people in fitness training and/or provision of nutritional advice.*

38) It is clear from the evidence that an important part of the proprietor's package provided to its customers is the FITBUG device itself. The applicant submits that this is no more than an "electronic pedometer" and the Class 9 specification should be limited to just this term. Taking due account of the guidance from the courts, I do not agree.

39) The applicant concedes that the term “electronic pedometer” may describe the FITBUG device. However, I also need to consider whether it should also be able to retain the broader term *pedometers*. Taking account of the guidance referred to above, I find that such use is sufficient to for the proprietor to retain *pedometers* within its specification. The term *pedometers* accurately describes the category of goods in which the FITBUG device belongs. The consumer, when asked to describe such a device, is likely to refer to it solely as a pedometer. The term *electronic pedometers* limits down to the specific goods rather than the category of goods. Therefore, with Mr Hobbs’ guidance in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* in mind, I find that the proprietor can rely on both terms *pedometers* and *electronic pedometers*.

40) In Exhibit PEL4, there is a page that includes the statement that the proprietor can assist clients in building tailored microsites and embed FITBUG functionality into the client’s website. Such a provision would appear to describe the making available of software for access via the client’s website. However, this page is of unknown origin and is undated. Therefore, this evidence fails to illustrate use in respect of software in the form of microsites during the relevant period. However, at the hearing, Mr Moss also directed me to Mr Landau’s second witness statement, paragraph 2, where he explains that a FITBUG device enables users not only to access the members’ area of the FITBUG website but also a mobile app. References to customers using the FITBUG app during the latest of the three five year periods are shown in Exhibit PEL6 and detailed in paragraph 15, above.

41) This use has been shown at a time that falls within the latest of the relevant five year periods and under the provisions set out in Section 46(3) is use that can serve to save the registration from revocation. The availability of the app for users of FITBUG devices to download is evidence of the proprietor using its mark in respect of such goods. The proprietor’s specification includes the following term:

> C*omputer software relating to assessment of fitness, monitoring of fitness, proposing fitness training programmes, managing and monitoring fitness training programmes, monitoring recording and displaying historical fitness data about one or more individuals, provision of motivational information and statements to people in fitness training and/or provision of nutritional advice*

42) Whilst the functions of the FITBUG app appear to be described by this term, there is no evidence within the relevant periods of use in respect of software other than the application software referred to above. Taking account of the guidance the average consumer would consider application software to be a discreet sub-group of software and I find it appropriate to limit the term as follows:

> C*omputer* ***application*** *software relating to assessment of fitness, monitoring of fitness, proposing fitness training programmes, managing and monitoring fitness training programmes, monitoring recording and displaying historical fitness data about one or more individuals, provision of motivational information and statements to people in fitness training and/or provision of nutritional advice*

43) In his second witness statement, Mr Landau explains that the broad term *computer software* was included in the specification in order to cover computer applications such as one called “Bug Manager” that reads the data off the FITBUG device. However, in the absence of any corroboratory evidence, I am unable to find use in respect of this type of software or any other type other than the app.

44) I have not identified in the evidence any other instances of use of the mark in respect of software and neither has any other been brought to my attention. I should say here that I do not consider the fact that members can access the proprietor’s website as evidence of use of the mark in respect of software. Such website access relates to the access to online services and is relevant to my considerations in respect of the Class 41 services. Consequently, I conclude that there is no use shown in respect of *software* at large.

45) There are several other areas where I am unconvinced by the proprietor’s submissions. Firstly, I reject the proprietor’s claim that selling of USB cables amounts to use in respect of *docking devices*. Mr Moss submitted that because USB cables connect (or “dock”) the FITBUG device with a computer then they are included within the term *docking devices*. I do not agree. The use in the term of the word “device” suggests something more than a mere cable. Consequently, I find that there has been no use shown in respect of *docking devices*.

46) There is evidence (Exhibit PEL4) in respect of a set of weighing scales that communicates wirelessly with the FITBUG device via *Bluetooth* technology and Mr Moss submitted that I should accept this as use in respect of the term *weighing machines*. However, as Mr Roberts submitted, this evidence does not assist as it carries a 2014 copyright notice and, therefore, may relate to a time after the relevant periods in these proceedings. Consequently, I cannot take this as evidence of use during the relevant periods.

47) Finally there is no evidence before me that the proprietor’s mark has been used in respect of *electronic heart rate monitors (other than for medical use)*.

48) In light of all my findings, above, the proprietor is entitled to retain the following list of goods in Class 9:

> *Pedometers; electronic pedometers; computer application software relating to assessment of fitness, monitoring of fitness, proposing fitness training programmes, managing and monitoring fitness training programmes, monitoring recording and displaying historical fitness data about one or more individuals, provision of motivational information and statements to people in fitness training and/or provision of nutritional advice*

The Class 41 services

49) The proprietor’s Class 41 specification, as registered, reads:

> *Provision of fitness training services; provision of fitness training services via a computer network, the Internet, electronic mail, telecommunications services, and/or SMS messaging; services in the provision of a computer*

website which assesses fitness, monitors fitness, proposes fitness programmes, manages and monitors fitness training programmes, monitors records and displays historical fitness data about one or more individuals, provides motivation and information to people in fitness programme and/or provides nutritional advice; personal training services; provision of non-medical nutrition advice; provision of non-medical nutrition advice relating to fitness and sporting performance.

50) Mr Landau, in his witness statement, describes the FITBUG device and being combined with an online programme to assist individuals to manage and monitor their nutrition and activity. Mr Roberts submitted that I should treat the proprietor's claim of use in respect of the services listed in its specification as "peripheral fluff" to support the core device, described by the applicant as an "electronic pedometer". Mr Stevens, in his witness statement, also characterised the proprietor's use in respect of its Class 41 services as merely services ancillary to the FITBUG device because they cannot be accessed without the device and that these services can only be accessed when the device has been purchased.

51) Mr Roberts' characterisation of the proprietor's services as "peripheral fluff" is unhelpful. The question I must address is not whether use of the registrant's mark in respect of the services is "peripheral" to its core activity, but rather whether use in respect of these services is genuine, whether "peripheral" or not. Further, I reject the submissions made by Mr Stevens. It is not relevant to the issue of genuine use, whether the consumer accesses the services directly or via the FITBUG device. Access via either method can qualify as genuine use.

52) Mr Landau describes the FITBUG device as being small and combined with an online program to assist individuals to manage and monitor their nutrition and activity. A similar characterisation of the registrant's activities are used by third parties, such as the *Daily Mirror* newspaper in 2005 that informs that the FITBUG device "tracks your activity levels" and explains that the user downloads the information to the website and receives exercise and dietary advice. Extracts (at Exhibit PEL4) from the proprietor's website and obtained from the online archive *Waybackmachine* refers indicate that the services available to FITBUG users also include tailoring targets, charting activities (both March 2013) and healthy living advice and information including recipes (November 2010). Taken altogether, I accept that the term *services in the provision of a computer website which assesses fitness, monitors fitness, proposes fitness programmes, manages and monitors fitness training programmes, monitors records and displays historical fitness data about one or more individuals, provides motivation and information to people in fitness programme and/or provides nutritional advice* describes the services shown in the evidence as being provided from the proprietor's website to its FITBUG device users and in respect of nutritional advice, to any visitor to the website.

53) The terms *Provision of fitness training services* and *personal training services* are broad in nature and include the conducting of classes or personal tuition as well as providing users of such services with training programmes. At the hearing, submissions from both sides were focussed on what the proprietor provides, and what it does not provide online to its users of the FITBUG device. Nothing was submitted regarding whether the proprietor also delivered group or personal tuition

regarding fitness training. Rather, the focus was on the advice and encouragement provided remotely via the proprietor's website. Whist some of these online services may be covered by one of both of these terms, it is only insofar as the services listed in paragraph 54, above. In considering the business model operated by the proprietor, it would be wrong to provide it with cover for such a broad scope of services. Consequently, I find there is no genuine use in respect of the *Provision of fitness training services* and *personal training services* beyond those services listed in the previous paragraph.

54) The same applies to the term *provision of fitness training services via a computer network, the Internet electronic mail, telecommunications services, and/or SMS messaging*. There is a reference to emailing health measurements to users (see page 10 of Exhibit PEL3) dated 27 July 2009 and an undated reference to sending motivational content and advice by text message and email (see page 2 of Exhibit PEL4). Whilst this as sparse evidence that email and text messaging are used by the proprietor, these examples fall short of illustrating they are used for dispensing fitness training (as opposed to communicating health information of dietary advice for example. There is no other evidence of providing any information or services via these modes of communication during the relevant periods. In conclusion, no use is shown in respect of these services.

55) As I have already mentioned in paragraph 40 above, the application software provided by the proprietor to its customers delivers nutritional advice and from the evidence it is clear this mirrors the advice available on its website, Therefore, I find that genuine use has been made in respect of *provision of non-medical nutrition advice; provision of non-medical nutrition advice relating to fitness and sporting performance.*

56) In summary, I find that the proprietor is entitled to retain the following Class 41 specification:

> *Services in the provision of a computer website which assesses fitness, monitors fitness, proposes fitness programmes, manages and monitors fitness training programmes, monitors records and displays historical fitness data about one or more individuals, provides motivation and information to people in fitness programme and/or provides nutritional advice; provision of non-medical nutrition advice; provision of non-medical nutrition advice relating to fitness and sporting performance.*

Conclusion

57) I have found that the registration is retained in respect of the following goods and services:

> **Class 9:** *Pedometers; electronic pedometers; computer application software relating to assessment of fitness, monitoring of fitness, proposing fitness training programmes, managing and monitoring fitness training programmes, monitoring recording and displaying historical fitness data about one or more individuals, provision of motivational information and statements to people in fitness training and/or provision of nutritional advice*

Class 41: *Services in the provision of a computer website which assesses fitness, monitors fitness, proposes fitness programmes, manages and monitors fitness training programmes, monitors records and displays historical fitness data about one or more individuals, provides motivation and information to people in fitness programme and/or provides nutritional advice; provision of non-medical nutrition advice; provision of non-medical nutrition advice relating to fitness and sporting performance.*

58) The registration is revoked in respect of all other goods and services from the earliest of the dates claimed by the applicant, namely, 4 September 2009, in respect of all other goods and services.

COSTS

59) The proprietor characterises the applicant's action as frivolous and vexatious because it has pursued the action despite being fully aware of the proprietor's use of the mark. Consequently, it claims costs off the scale. I do not agree. The applicant acknowledges use by the proprietor (as reflected by its concession in respect of *electronic pedometers*) and the dispute is one related to the scope of the use. The fact that the applicant has been partially successful, indicates that there was some merit to its case. Therefore, I reject the claim for costs to be made off the published scale.

60) In fact, as both sides have achieved a measure of success, I find that each side bears its own costs.

Dated this 25TH day of November 2015

Mark Bryant
For the Registrar,