

O-554-15

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 FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 500379 BY FITBIT, INC**

Background and pleadings

1) Fitbug Limited is the proprietor of UK mark 2354659 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.*

Class 28: *Exercise equipment; sporting equipment; fitness training equipment; parts and fittings for the aforesaid goods.*

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 for the registration to be declared invalid. The grounds of the application are that:

“the [mark] consists of two elements, ‘Fit’ and ‘Bug’; and it consists of a sign which is merely a description of goods and services for someone who has been ‘bitten by the fit (or fitness) bug’ or is carrying a ‘fit bug’ (a device which monitors fitness data).”

3) It submits that, for these reasons, the proprietor’s mark cannot fulfill its function as a trade mark in respect to all or any of the goods and services of the registration and cannot act as an indication of origin and should be declared invalid under Section 3(1)(b) and Section 3(1)(c) of the Trade Marks Act 1994 (“the Act”) that are relevant in invalidation proceedings because of the provisions contained in Section 47(1) of the Act.

4) The applicant subsequently filed a counterstatement denying that its mark is devoid of any distinctive character or that it is descriptive, but rather it is a clever use of words to allude to the nature of the goods and services. It denies that the mark is

used by others in a descriptive sense in respect of devices which monitor fitness data.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs (off scale costs have been requested by the proprietor). The matter came to be heard on 23 September 2015, together with a sister case based upon non-use, 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.

Applicant's evidence

6) This consists of a witness statement by Paul Anthony Stevens, partner at Olswang LLP, the applicant's representative in these proceedings. Mr Stevens explains that the purpose of his witness statement is to explain why the term FITBUG is devoid of distinctive character and inherently descriptive of the goods and services covered by the registration.

7) Mr Stevens provides the following definitions from the Oxford English Dictionary (10th (revised) edition 2001):

FIT: "in good health, especially because of regular physical exercise"

FITNESS: "the state of being fit"

BUG: "an enthusiasm for something: 'they caught the sailing bug'; " a concealed miniature microphone as used for secret recording."

8) Mr Stevens also provides the following definition obtained from the Collins Dictionary of the English Language, 1986:

BUG: "an obsessive idea, hobby etc; craze"; "a person having such a craze; enthusiast"; "a concealed microphone used for recording conversations, as in spying"

9) Extracts from these dictionaries are provided at Exhibit PAS1 and PAS2 respectively and at Exhibit PAS3 he provides extracts from dictionaries published after the relevant date illustrating that the meaning of BUG remains largely unchanged.

10) Mr Stevens also provides a further definition of BUG as contained in the book "Speaking of Animals, A Dictionary of Animal Metaphors", published in 1995. One of a number of definitions provided in an extract as Page 7 of Mr Steven's Exhibit PAS57 is:

"A *bug*. A tiny electronic listening device [...] Bug was first applied to surveillance equipment in the 1920s, [...] By the late 1940s it had come to mean a wireless microphone hidden under a desk, above a lamp [...etc...]. Now it is thought of as any tiny intruder that is as obnoxious as the bedbug."

11) Mr Stevens provides a plethora of exhibits showing third party use of the word BUG in the print media, online, by book authors, phrase books and other third party use. It is not necessary for me to summarise these other than to observe that there is clear evidence to support that the word BUG is used to describe enthusiasm for something such as a particular hobby or activity. In particular, I note examples such as “got the walking bug”, “get the cricket bug”, “got the workout bug” and many, many other similar references.

12) At Exhibit PAS40, Mr Stevens provides copies of press articles using the term “fitness bug” such as in phrases like “the new year fitness bug bites”, “caught the fitness bug”, “have the fitness bug”. In addition, there are a few examples of the term “fit bug” being used, namely: “get the keep-fit bug”; “contracted the get-fit bug”; “got the keep-fit bug”.

13) In the same exhibit is the example “Getting the fit bug” from *The Mirror* newspaper, dated 12 January 2012. This appears as a sub-title in an article where the celebrity Davina McCall “shares her shape-up secrets to help you shed that festive flab”.

14) In support of the applicant’s contention that the word BUG is used to describe any concealed device that monitors, tracks and records information, as opposed to the proprietor’s suggestion that it is a reference to a covert listening device, Mr Stevens provides very many examples of what he contends is a broader use by third parties in Exhibits 41 to 58. Whilst the examples provided suggest that modern day bugs collect information rather than being merely listening devices, all the examples provided still indicate the word is used to describe covert surveillance devices monitoring conversations, illegal activity or for detecting espionage-type communication. The last of these exhibits provides examples of press articles referring to the fitting of bugs and using phrases such as “fitted with a bug and tracking device”; “should fit a bug”; “fitted with a bug which broadcast their conversations to a satellite”; “van was left unattended so Erin could fit a bug”; “her car was fitted with a bug”.

15) At Exhibits PAS59 and PAS60, Mr Stevens provides extracts from the proprietor’s website to illustrate that it calls its own device a “bug”. These illustrate use of the word “bug” in the following phrases: “your Bug”; “Bug holder”; “Bug device”; “the Bug”; “Bug setup” and “Our ‘Bug’ is a clever little gadget that records every step you take, calories burned and more”.

16) Quotes from users of the proprietor’s device are provided at Exhibit PAS61, obtained from the proprietor’s website. These include: “feel awesome after three months with my bug”; “I call it ‘feeding the bug’...”

Proprietor’s evidence

17) This takes the form of a witness statement by Anna Teresa Szpek, trade mark attorney with Urquhart-Dykes & Lord LLP, the proprietor’s representative in these proceedings. The purpose of the statement was to introduce evidence of use of its mark submitted in the co-pending revocation action in order to demonstrate that its

FITBUG mark is capable of, and has distinguished the products and services of the proprietor. I will return to this evidence later if required.

DECISION

Legislation

18) The relevant parts of Section 3(1) of the Act are as follows:

3. - (1) The following shall not be registered –

(a) [...],

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) [...]

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

19) Section 3 is relevant in invalidation proceedings because of Section 47, which reads:

47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2)* The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A)* But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless -

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if -

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has 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, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes -

(a) 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

(b) 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.

(2D) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

** Note: Sub-sections 2A to 2E are an addition to the original Act, by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004 (SI 2004/946) which came into force 5th May 2004.*

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(3) An application for a declaration of invalidity may be made by any person, and may be made either 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.

** Note: This section has been amended by virtue of The Trade Marks (Relative Grounds) Order 2007 which came into force 1st October 2007*

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.

20) At the hearing Mr Roberts confirmed that the applicant's grounds based upon Section 3(1)(b) and Section 3(1)(c) of the Act are founded upon the proprietor's mark designating characteristics of the goods and services and that there was no additional submissions in respect of distinctive character. Therefore, the Section 3(1)(b) and Section 3(1)(c) claims stand or fall together. If I find that the proprietor's mark designates a characteristic of the goods and services it will be caught by both Section 3(1)(b) and Section 3(1)(c). If I do not, then both the Section 3(1)(b) and Section 3(1)(c) grounds will fail. In light of this, I will begin by considering the Section 3(1)(c) grounds.

Section 3(1)(c)

21) As explained by the Court of Justice of the European Union ("the CJEU") in *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case C-191/01 P ("Doublemint")*, at paragraphs 30 and 31, the purpose of this exclusion from registration of such signs is the public interest in precluding any individual trader from obtaining a monopoly in a sign which other traders might legitimately wish to use because of its descriptiveness.

22) The proviso to section 3(1) of the Act provides an exception to this exclusion. If a trader can demonstrate that through the use made of it his mark has become sufficiently distinctive so that it does in fact serve as an indication of origin in the minds of the relevant public or a significant proportion thereof (see *Windsurfing Chiemsee C-108/97*) then registration may be granted. I will return to this issue only if I am with the applicant regarding the *prima facie* case.

23) Other relevant case law of the CJEU is summarised below:

(i) The court in *Doublemint* went on to state:

“32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94 [the equivalent provision to Section 3(1)(c) in the Community Trade Mark Regulation], it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

(ii) In *Matratzen Concord AG v Hukla Germany SA*, (Case C- 421/04) the court stated:

“In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

(iii) In *Ford Motor Co v OHIM*, Case T- 67/07:

“there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics”

24) The applicant’s case can be summarised as follows:

- (i) That the proprietor’s mark designates a characteristic of the goods and services, namely the user who is bitten by the fitness bug or the “fit bug”. It therefore describes the user (someone who has the “fitness bug” or “fit bug”);
- (ii) That the proprietor’s mark designates a characteristic of the goods and services, namely that the device used is a “bug” that monitors an individual’s activities. It is a hidden device (“a bug”) that monitors fitness.

25) Mr Roberts relied upon the CJEU’s comments in *Doublemint* (as set out in paragraph 23(i) above) that it does not matter if a mark has a multiplicity of meaning, as long as one designates a characteristic of the goods and services at issue, then it is open to objection. Therefore, it is open to the applicant to plead that the contested mark has more than one meaning that designates a characteristic of the goods and services. I do not understand this point to be contentious.

26) I will begin by considering the applicant's submission that the proprietor's mark is descriptive of the user of the proprietor's goods and services, namely someone who has the fitness bug. As I have stated in paragraph 11, there is little doubt in my mind that the word BUG is commonly understood to describe an enthusiasm for something, particularly a hobby or activity. By extension, when the word BUG is preceded by the word FITNESS, the term is understood to mean an enthusiasm for keeping fit. None of this is contentious and there is a plethora of evidence submitted by the applicant that confirms this. However, the applicant submits that the same meaning is extended to the words FIT BUG. This is where the views of the parties diverge.

27) Despite there being a plethora of evidence illustrating use of the term FITNESS BUG, there is only one example of the term FIT BUG being used in the same descriptive way. This is a sub-title of an article that appeared in *The Mirror* newspaper in January 2012. The sub-title proclaims "Getting the fit bug" and relates to the celebrity, Davina McCall, sharing her "shape-up secrets". One single example within a plethora of evidence that overwhelmingly points to an enthusiasm for fitness activities being described as a "fitness bug", is not persuasive that the term FIT BUG designates the user of the proprietor's goods and services.

28) Even if I am with the applicant (and I am not) and the evidence demonstrates that the term is descriptive of an enthusiasm for fitness, it still does not describe the user. Rather it is further removed, as it would be describing an enthusiasm rather than the user. At best it would designate a characteristic of the user rather than a characteristic of the goods and services. So even if it was descriptive in this way, it would still be no more than allusive of the goods and services. Therefore, whilst I do not dispute Mr Roberts' submission that a mark that designates the end users of goods and services can be considered as a characteristic of those goods and services, this argument cannot support the applicant's submissions here because the description would be one removed from describing the user.

29) Mr Roberts provided examples of marks considered by the European courts that, he contended, support the applicant's arguments. Whilst I note these, I must assess the facts of the current case in order to reach a conclusion. As the CJEU said in *Campina Melkunie BV v Benelux-Merkenbureau (BIOMILD)*, Case C-265/00, para 43, if each word in a mark is descriptive then the whole is descriptive unless it forms an unusual combination. To my mind, the contested mark DOES consist of an unusual combination. The word FIT and the word BUG, when combined provide no more than an allusion to a "fitness bug". To borrow a phrase from Mr Roberts, there is some "syntactical innovation". There is no pressing need to keep this term free and others would not wish to use the phrase in order to describe someone who has the "fitness bug".

30) Mr Moss pointed out that you may have a distinctive sign that conveys a non-distinctive message. This is exactly what an allusive mark does. Such marks are not debarred from registration under Section 3(1)(c) of the Act.

31) For all of the above reasons, I dismiss the applicant's argument that the proprietor's mark FIT BUG is descriptive of the user of the goods and services.

32) The second submission by the applicant is that the words FIT BUG, in combination, are descriptive of a hidden device (“a bug”) that monitors fitness. Mr Landau explains it in his statement as someone who is carrying a FIT BUG, i.e. a device which monitors and transmits fitness information. The applicant therefore submits that the mark is descriptive of a “bug” that monitors fitness information.

33) Mr Roberts claims that the evidence illustrates that the meaning of BUG goes beyond the ordinary surveillance meaning. To support this position, Mr Stevens, in his witness statement referred to his Exhibit PAS57 (see paragraph 10, above).

34) He then states that “[a]lthough BUG originally referred to a concealed microphone, it is now widely used to refer to any concealed device which monitors, records and transmits data”. I partially agree with this analysis insofar that, with modern technology, bugs can now do far more than transmit sound. They can be used to track a person or vehicle and to transmit this location data as well as other kinds of data. This is very clear from the evidence. What is equally clear is that the term “bug” is still used to describe some kind of covert data collection device. Merely because a device is not visible on the wearer does not mean it is being used covertly and therefore it is not naturally described as a “bug”. The goods in question in these proceedings are for the purposes of monitoring the users own activities and there they are not used covertly, even if they are not visible (however, I do not know whether they are or not).

35) Therefore, whilst all the examples provided in the evidence illustrate a broad range of different types of bugs and uses for bugs, the key element is that they are all used covertly to monitor or track the position or activity of individuals. There is no evidence to demonstrate that a device that records data about the user themselves would be referred to as a bug. This concurs with the definitions provided in the evidence. Such a device is NOT a “tiny intruder that is as obnoxious as the bedbug”, a description used in a definition of a BUG referred to by Mr Stevens (see paragraph 10, above). As Mr Moss submitted, the normal meaning of BUG is of “James Bond style covert surveillance”.

36) The proprietor’s reference to its own device as a “bug” does not change the perception of the average consumer. Such use is a coined phrase by the proprietor and not a normal description of the goods.

37) Taking all of this together, I dismiss the claim that the words FIT BUG would be understood as designating the nature of the goods, namely a device that monitors fitness data.

38) I have dismissed both the arguments of the applicant and, consequently, the grounds based upon Section 3(1)(c) of the Act fail in their entirety. In light of this, it is not necessary for me to consider the proprietor’s counterclaim that its mark has acquired distinctive character because of the use made of it.

Section 3(1)(b)

39) As I noted in paragraph 20 above there is no separate claim to the mark being devoid of distinctive character distinct from the claim that this is because it designates a characteristic of the goods and services. Consequently, the Section 3(1)(b) stands or falls with the grounds based upon Section 3(1)(c). I have found that the ground claimed under Section 3(1)(c) has failed and therefore, the claim under Section 3(1)(b) also fails.

COSTS

40) The applicant has been totally unsuccessful and the proprietor is entitled to an award of costs. At the hearing, Mr Moss submitted that costs should be made above the normal scale of costs in respect of Mr Steven's witness statement that ran to some 19 folders in total and a conservative estimate of about 4000 pages. Whilst I note Mr Roberts's comments that it was filed to prove the proposition in dictionaries, that it was not in breach of any rules, and that it was not unreasonable because the proceedings are in the form of an invalidation action and that it would not be possible to re-run the case with more evidence later. I note this defence, but it is my view that none of these reasons justify the volume of evidence filed and I find that, in respect of this evidence, an award of costs above scale is appropriate.

41) In light of the above, I invite the proprietor to submit a schedule of costs in respect of the work undertaken to consider Mr Steven's witness statement. All other aspects of the case can be dealt with based on the normal scale of costs and the schedule should relate only to the consideration of this evidence. I allow 21 days for the proprietor to submit the schedule of costs and a further 14 days for the applicant to make submissions regarding the schedule. I will then issue a supplementary decision making the award of costs.

42) The appeal period in respect of the substantive decision begins from the date of the main decision and a separate appeal period will apply to the supplementary decision.

Dated this 25TH day of November 2015

**Mark Bryant
For the Registrar,**

