

O/013/19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003251516 BY
U FIT GROUP LIMITED
TO REGISTER:**

U FIT

AS A TRADE MARK IN CLASSES 5, 9, 27, 28, 41, 42 AND 44

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 411011 BY
ICON HEALTH & FITNESS INC**

BACKGROUND AND PLEADINGS

1. On 21 August 2017, U Fit Group Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 8 September 2017. The applicant seeks to register its mark for the following goods and services:

Class 5 Nutritional supplements for human consumption, protein dietary supplements for human consumption, pharmaceutical preparations containing caffeine for human consumption, and electrolytic dietary supplements for human consumption, all in the form of bars, gels, beverages, and pharmaceutical preparations for making beverages.

Class 9 Heart rate monitors (other than for medical use).

Class 27 Yoga mats; personal exercise mats.

Class 28 Foam rollers for exercise; exercise bands; exercise balls; exercise weights.

Class 41 Personal fitness training services; yoga instruction; provision of gym facilities; gyms; gym services; gym activity classes; exercise classes; health club services (exercise); provision of information relating to physical exercise via an online web site.

Class 42 Blood analysis services.

Class 44 Sports massage; nutritional advice; physiotherapy; exercise facilities for health rehabilitation purposes.

2. The application was opposed by ICON Health & Fitness Inc (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following earlier marks:

IFIT

(International Registration designating the EU no. 1308187)

Registration date of 21 March 2016; Protection granted in the EU on 10 February 2017

("the First Earlier Mark")

The opponent relies on all of the goods and services for which the First Earlier Mark is registered:

Class 9 Web-based, downloadable software for the collection, storage and display of personal performance data from various fitness activities, display of nutritional information and fitness and athletic programs and workouts, software for tracking, monitoring and planning fitness training activities; pedometers; altimeters; multifunctional electronic devices for displaying, measuring, and uploading to the Internet and computer networks information including time, date, heart rate, global positioning, direction, distance, altitude, speed, steps taken, calories burned, navigational information, weather information, temperature, wind speed, changes in heart rate, activity level, hours slept, and quality of sleep; computer software for wireless data communication for receiving, processing, transmitting and displaying information relating to fitness and heart rate; electronic monitoring devices incorporating microprocessors, digital display, and accelerometers, for detecting, storing, reporting, monitoring, uploading and downloading sport, fitness training, and activity data to the Internet, and communication with personal computers, regarding time, steps taken, calories burned, distance; computer software and computer application software for mobile phones and personal digital devices that provides tips, coaching, and personalized workouts, to improve the user's fitness level.

Class 28 Fitness and exercise machines.

- Class 41 Personal fitness training services and consultancy; physical fitness instruction; physical fitness training services; providing exercise and fitness information through an on-line computer database; providing information in the field of exercise training; educational services, namely, conducting personal training in the field of health and fitness.
- Class 42 An application service provider (ASP) featuring software for use with mobile devices, tablet, and computers for tracking, storing, and displaying personal performance data for various fitness activities; ASP featuring application programming interface (API) software for connecting and interacting with software applications on mobile devices, tablets, and computers to track, store, and display personal performance data for various fitness activities.



(EU registration no. 15269749)

Filing date of 23 March 2016; registration date of 18 July 2016

(“the Second Earlier Mark”)

The opponent relies on all of the goods and services for which the Second Earlier Mark is registered:

- Class 29 Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.
- Class 30 Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

Class 32 Mineral and aerated waters, non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

IFIT

(EU registration no. 15269715)

Filing date of 23 March 2016; registration date of 18 July 2016

("the Third Earlier Mark")

The opponent relies on all of the goods and services for which the Third Earlier Mark is registered:

Class 29 Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.

Class 30 Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

Class 32 Mineral and aerated waters, non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

IFIT

(EU registration no. 12546016)

Filing date of 29 January 2014; registration date of 23 June 2014

("the Fourth Earlier Mark")

The opponent relies on all of the services for which the Third Earlier Mark is registered:

Class 44 Providing a website featuring information regarding nutrition, dieting, and health.

IFIT

(EU registration no. 12545976)

Filing date of 29 January 2014; registration date of 23 June 2014

("the Fifth Earlier Mark")

The opponent relies on all of the services for which the Fifth Earlier Mark is registered:

Class 41 Provide information regarding sports, athletic skill development, and fitness training via an online website and other computer and electronic communication networks; entertainment services, namely, contest and incentive award programs designed to reward program participants who exercise, participate in sports activities, engage in health-promoting activities, make achievements in exercise and sports activities, and reach personal goals regarding exercise, sports activities, and fitness; provide an interactive web site and other computer and electronic communication networks, namely, mobile device networks, that enables users to compete and compare athletic information and achievements with other users; provide a website and other computer and electronic communication networks, namely, mobile device networks, featuring information, online links, and electronic resources in the field of sports and fitness; provide pre-recorded athletic challenges, training, fitness sessions and challenges, and workouts via an online website, other computer and electronic communication networks, and via computer software for personal digital devices, and smart phones; Providing a website featuring information regarding fitness training.

IFIT

(EU registration no. 12544425)

Filing date of 29 January 2014; registration date of 23 June 2014

("the Sixth Earlier Mark")

The opponent relies on all of the services for which the Sixth Earlier Mark is registered:

Class 38 Provide a forum, chat rooms, and electronic bulletin boards for registered users for transmission of messages and sharing information regarding health and fitness, sport activities, and social networking via an online website and other computer and electronic communication networks; streaming of audio and video material related to athletic activities on the internet and other computer and electronic communication networks; Providing online chat rooms and electronic bulletin boards for registered users for transmission of messages concerning food, nutrition, personal activities, general interest, classifieds, virtual community, and social networking.

IFIT

(EU registration no. 12543682)

Filing date of 29 January 2014; registration date of 22 December 2017

("the Seventh Earlier Mark")

The opponent relies on all of the goods for which the Seventh Earlier Mark is registered:

Class 9 Pedometers; altimeters; multifunctional electronic devices for displaying, measuring, and uploading to the Internet and computer networks information including time, date, heart rate, global positioning, direction, distance, altitude, speed, steps taken, calories burned, navigational information, weather information, temperature, wind speed, changes in heart rate, activity level, hours slept, and quality of sleep; computer software for wireless data communication for receiving, processing, transmitting and displaying information relating to fitness, body fat, body mass index; computer software for managing

information regarding tracking, compliance and motivation with a health and fitness program; electronic monitoring devices incorporating microprocessors, digital display, and accelerometers, for detecting, storing, reporting, monitoring, uploading and downloading sport, fitness training, and activity data to the Internet, and communication with personal computers, regarding time, steps taken, calories burned, distance; computer software for fitness; computer software and computer application software for mobile phones and personal digital devices for monitoring, uploading, and downloading data regarding sport activity, fitness training, and fitness level to the internet and other computer and electronic communication networks; computer software and computer application software for mobile phones and personal digital devices that monitor, track, and compare sport activity and fitness level; computer software and computer application software for mobile phones and personal digital devices that provides tips, coaching, and personalized workouts, to improve the user's fitness level.

3. The opponent argues that the respective goods and services are identical or similar and that the marks are similar.

4. The applicant filed a counterstatement denying the claims made.

5. The opponent is represented by Urquhart-Dykes & Lord LLP and the applicant is represented by Serjeants LLP. The opponent's evidence consists of the witness statement of John McHale dated 31 January 2018. No evidence was filed by the applicant. A hearing took place by telephone on 24 July 2018, with the opponent represented by Mr Fiddes of Urquhart-Dykes & Lord LLP. The applicant filed written submissions in lieu of attending the hearing.

6. A decision was issued by the Tribunal on 4 October 2018. In that decision, the applicant's mark was referred to, in error, as "UFIT" (rather than U FIT) during the mark comparison undertaken by the Hearing Officer. The applicant, therefore, requested

that the decision be set aside. A Case Management Conference was held on 26 October 2018 (by a different Hearing Officer). On 1 November 2018, the Tribunal wrote to the parties stating as follows:

“After discussing the various issues, it was agreed by both sides that an error of this nature had the capacity to be treated as a procedural irregularity under rule 74(1) and that I had the power to set the decision aside subject to being satisfied that the error was material. The parties disagree, though, on whether the error was material.

Mr Fiddes argued that the hearing officer always had in mind that UFIT (the mark erroneously used as the basis of the comparison) would be seen as two words U FIT (the mark that should have been compared) and, therefore, the error was not material. Mr Cadman argued that as a point of principle, the applicant had not received a decision based on the mark that had been applied for and that, in any event, the reasons given by the hearing officer were predicated upon the mark being one word, which it clearly was not.

My decision is that the error is material. Whilst the error would have had no impact on the aural and conceptual comparison (because the finding was that the average consumer would appreciate that UFIT comprised two words, U and FIT conjoined), it would have had an impact on the visual comparison because the separation between the words was not factored into the assessment. Whether the hearing officer would have reached the same decision if the correct mark had been compared is impossible to know, however the error is certainly material enough to give doubt and to render the decision procedurally irregular.

To rectify matters, my directions are:

- The substantive decision is set aside.
- The extension of time to appeal recently filed by the applicant is therefore moot.
- A fresh decision will be issued by a different hearing officer.

- 14 days (by 16 November) is permitted for the parties to say whether they wish to be heard by the new hearing officer.
- If neither party wishes to be heard, written submissions can instead be filed by 30 November.”

7. Neither party subsequently requested to be heard and neither party filed further written submissions. I have reached this decision afresh following a careful perusal of the papers.

EVIDENCE

8. The opponent’s evidence consists of the witness statement of John McHale dated 31 January 2018, with 7 exhibits. Mr McHale is the Financial Controller of the opponent, a position he has held since 2006. Exhibits 8, 9 and 10 to Mr McHale’s statement have not been admitted as evidence in these proceedings. The parties have agreed that references to them in Mr McHale’s statement should be disregarded and I will not consider these in reaching my decision.

9. Mr McHale states that the opponent was originally founded in 1977 and is now “one of the world largest manufacture [(sic)] of exercise equipment and employs over 1,000 people in manufacture, sales and support facilities in the United States, China, Brazil, France, United Kingdom and Italy”. Mr McHale states that the opponent introduced its IFIT product range in 1989 which includes fitness/gym machines, a range of fitness wearables (such as GPS locators and monitors which collect data relating to the wearer) and subscription services and applications which allow consumers to upload information from their IFIT products.

10. Exhibit 1 to Mr McHale’s statement is a print-out from the opponent’s website. The print-out is undated and provides prices in dollars rather than pounds sterling.

11. Exhibit 2 to Mr McHale’s statement consists of various print-outs from the opponent’s websites which show that IFIT products can be used in conjunction with products sold by the opponent under its other marks. These are all undated save for

a print date of 22 March 2016. Some of these print-outs show products being offered for sale in pounds sterling, indicating that they are targeted at the United Kingdom market. Others show products being offered for sale in dollars and state “Prices Valid in U.S. Only”, indicating that they are targeted at the United States market.

12. Mr McHale states that Exhibit 3 to his statement is a print-out from the opponent’s website which lists the services offered under the IFIT mark. These show that, consumers can sign up to a membership which gives them access to various services such as personalised workouts and challenges and weight loss programmes. These print-outs are all undated save for a print date of 30 November 2015.

13. Mr McHale states that the IFIT mark is used in relation to various products. Exhibit 4 to his statement consists of various photographs of such products. The photographs show various exercise machines which all display the marks PRO-FORM and NordicTrack and are marked as being IFIT compatible. These display the opponent’s Second Earlier Mark and are all undated.

14. Mr McHale states that Exhibit 5 to his statement consists of various examples of product literature which the opponent has used in relation to the products shown in Exhibit 4. These documents all provide product specification information for various PRO-FORM and NordicTrack products, all of which state that they are IFIT compatible. Again, they all display the Second Earlier Mark and its word only form. They are all undated.

15. Exhibit 6 consists of print-outs of the opponent’s various trade mark registration details. Mr McHale goes on to state that:

“13. With respect to showing sales of products and services on which the IFIT mark has been applied or has been used in relation to, my Company’s accounting system does not provide for the identification of the product by use of the IFIT name in invoices. This is my Company’s practice to refer to individual items which it sells by a code reference and an abbreviated product description.”

16. Exhibit 7 to Mr McHale's statement also shows examples of product literature which the opponent states "allows for the identification of products to which the IFIT mark is applied or has been used in relation to". Again, these are undated. They show various exercise machines sold under the PRO-FORM and NordicTrack marks which are marked as being IFIT compatible.

17. Mr McHale provides a table showing the marketing expenditure in relation to IFIT products in the European Union over the last 3 years. However, these are taken from a spreadsheet which had previously formed Exhibit 10 and which no longer forms part of the evidence in these proceedings. As noted above, the parties agreed that any reference in Mr McHale's statement to the exhibits which are no longer relied upon in these proceedings should be disregarded. As this is a clear reference to Exhibit 10, I will disregard this information.

18. Mr McHale states that the opponent uses social media such as Facebook, Twitter, YouTube and Instagram to provide forums for users to discuss IFIT products and services and to promote its products and services. Exhibit 11 to Mr McHale's statement consists of various reviews of IFIT products and services.

19. I do not propose to summarise the opponent's Skeleton Argument or the applicant's written submissions in lieu. However, I have taken them into account and will refer to them below as appropriate.

DECISION

20. Section 5(2)(b) of the Act 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.”

21. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

22. All of the trade marks upon which the opponent relies qualify as earlier trade marks under the above provisions. As the trade marks had not completed their registration process more than 5 years before the publication date of the application in issue in these proceedings, they are not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services it has identified.

Section 5(2)(b) – case law

23. 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 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 globally, taking account of all relevant factors;

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

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

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

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may 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 greater 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the trade marks

24. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“the CJEU”) states 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.”

25. 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.

26. The respective trade marks are shown below:

Applicant's trade mark	Opponent's trade marks
<p>U FIT</p>	<p>IFIT (the First, Third, Fourth, Fifth, Sixth and Seventh Earlier Marks)</p>  <p>(the Second Earlier Mark)</p>

27. In its Notice of Opposition, the opponent stated:

“3....Further, it is submitted that the dominant feature of the mark which is the subject of the Application is visually, phonetically and conceptionally (sic) similar to the Earlier Trade Marks as can be seen when comparing the marks in issue...”

28. In its Counterstatement (and repeated in its written submissions in lieu), the applicant stated:

“3.2 The current trade mark differs from the Opponent's trade marks in two important ways:

3.2.1 First the initial letter of the trade mark is “U” rather than “I”. “U” (unlike “I”) has no accepted meaning according to the Manual of Trade Marks Practice but, if any meaning is assigned to the letter, it could be considered to relate to a person i.e. a replacement for the word “you”. The letter “U” definitely has no meaning related to the internet or to

interactivity. Thus U FIT has a completely different conceptual meaning to IFIT. Further, “U” is pronounced in a completely different way to “I” and is in no way visually similar. Therefore, U FIT differs from IFIT both visually and aurally in a significant way.

3.2.2 Second, the current trade mark is two words, rather than a single word. This introduces a further important visual and conceptual difference between the trade marks. The visual difference between two words and a single word is significant (especially in light of the negligible distinctive character of the Opponent’s trade marks) and also leads to a significant conceptual difference.

3.3 In light of all of the above, it is clear that the trade marks are not at all similar and there is no likelihood of confusion on the part of the public between the trade mark U FIT and the trade mark IFIT for any goods or services.”

29. In its Skeleton Argument, the opponent stated:

“On the question of visual similarity the Applicant’s (sic) point to the space between the U & FIT as a sufficient distinguishing factor between the marks. Clearly, the established case law suggests that as it is the overall impression created by the marks in issue which needs to be considered this minor variation should not be taken into consideration. On the issues of aural and conceptual similarity the average consumer would be aware that both the Mark and the Opponent’s earlier trade marks consist of the personal pronoun “I” and the phonetic equivalent of the personal pronoun YOU prefixing the word FIT which is the identical element of both marks. It is our submissions that taking into consideration all of the relevant factors the Mark must be seen as confusingly similar to the Opponent’s earlier trade marks. The average consumer would connect the two marks IFIT and UFIT (sic) as being connected with one another. In particular, there is a risk of association between the two marks because of their conceptual similarities.”

Overall Impression

The Applicant's Mark

30. The applicant's mark consists of the letter "U" and the ordinary dictionary word "FIT" presented in capital letters. The word FIT is descriptive of the goods and services for which the mark is applied for and so will play a lesser role in the overall impression of the mark.

The First, Third, Fourth, Fifth, Sixth and Seventh Earlier Marks

31. The earlier marks all consist of the made-up word IFIT. Although conjoined, the consumer is likely to separate the word into the letter 'I' and the ordinary dictionary word FIT. As FIT is descriptive of the goods and services for which the marks are registered it will play a lesser role in the overall impression.

The Second Earlier Mark

32. The Second Earlier Mark also consists of the made-up word IFIT, with the first letter presented in lower case and the remaining letters capitalised. The letter "I" in the Second Earlier Mark is presented in a light blue colour and the other letters are presented in black. There is a thin curved line through the letter "T", although it is still recognisable as the letter "T". This mark will be seen as two separate elements because the 'I' is presented in lower case and the FIT in uppercase. Again, the word FIT will play a lesser role in the overall impression because it is descriptive. The stylisation and use of colour will also play a lesser role.

Visual Comparison

The Applicant's Mark and the First, Third, Fourth, Fifth, Sixth and Seventh Earlier Marks

33. Visually, the last three letters of both marks are the same – FIT. The marks differ because the beginning of the applicant's mark is the letter 'U' and the word FIT in the opponent's mark is combined with the letter 'I' to create a made-up word. As a general

rule, the beginnings of marks tend to make more of an impact than the ends¹ and the parties' marks start with a different letter. The importance of the beginning of the marks is likely to be further increased by the fact that the letters at the end of the marks – FIT – will be recognised by the consumer as descriptive of the goods and services for which they are registered/applied for meaning it will be attributed less trade mark significance. Overall, I consider the marks to share a medium degree of visual similarity.

The Applicant's Mark and the Second Earlier Mark

34. Visually, notional and fair use means that differences created by capitalisation of the marks are not relevant. The same similarities between the marks apply as described above. I do not consider that the use of colour in the Second Earlier Mark creates a significant difference between the marks, as registration in black and white covers use of the mark in colour and so the applicant's mark could be used in colour. However, the stylisation does create a point of further difference (although slight). In my view, there is no more than a medium degree of visual similarity between the marks.

Aural Comparison

35. All of the opponent's marks will be pronounced identically. I consider that the opponent's marks will be broken down into the letter "I" and the ordinary dictionary word "FIT". The word FIT in all of the marks will be given its ordinary English pronunciation. The letter "I" in the opponent's marks and the letter "U" in the applicant's mark will also be given their ordinary English pronunciation. It is the different letter at the start of each mark that, therefore, creates the only point of aural difference. However, as the word FIT is descriptive of the goods and services for which the marks are applied for/registered the difference between the letters at the start of the marks will be given greater significance by the consumer. In my view, the marks share a medium degree of aural similarity.

¹ *El Corte Ingles, SA v OHIM* Cases T-183/02 and T184/02

Conceptual Comparison

36. Conceptually, the applicant's mark is likely to be seen as the words "you" and "fit", creating the conceptual impression of a product or service which is intended to help the user improve their personal fitness. In my view, the letter "I" in the opponent's marks could either be perceived as referring to the wearer or user or to a product or service which is intended to be used via the internet. For those consumers who recognise the former meaning, there will be at least a medium degree of conceptual similarity, notwithstanding the differing personal pronouns. For those consumers who recognise the latter meaning, there will be a low degree of conceptual similarity.

Comparison of goods and services

37. In light of my comparison of the parties' respective marks above, I consider that the Second Earlier Mark shares the lowest degree of similarity with the applicant's mark. The goods covered by the specification for the Second Earlier Mark are duplicated in the specifications of the opponent's other marks in any event. I will, therefore, limit my comparison of the goods and services to those of the First, Third, Fourth, Fifth, Sixth and Seventh Earlier Marks:

Opponent's goods and services	Applicant's goods and services
The First Earlier Mark <u>Class 9</u> Web-based, downloadable software for the collection, storage and display of personal performance data from various fitness activities, display of nutritional information and fitness and athletic programs and workouts, software for tracking, monitoring and planning fitness training activities; pedometers; altimeters; multifunctional electronic devices for displaying, measuring, and uploading to the Internet	<u>Class 5</u> Nutritional supplements for human consumption, protein dietary supplements for human consumption, pharmaceutical preparations containing caffeine for human consumption, and electrolytic dietary supplements for human consumption, all in the form of bars, gels, beverages, and pharmaceutical preparations for making beverages.

and computer networks information including time, date, heart rate, global positioning, direction, distance, altitude, speed, steps taken, calories burned, navigational information, weather information, temperature, wind speed, changes in heart rate, activity level, hours slept, and quality of sleep; computer software for wireless data communication for receiving, processing, transmitting and displaying information relating to fitness and heart rate; electronic monitoring devices incorporating microprocessors, digital display, and accelerometers, for detecting, storing, reporting, monitoring, uploading and downloading sport, fitness training, and activity data to the Internet, and communication with personal computers, regarding time, steps taken, calories burned, distance; computer software and computer application software for mobile phones and personal digital devices that provides tips, coaching, and personalized workouts, to improve the user's fitness level.

Class 28

Fitness and exercise machines.

Class 41

Personal fitness training services and consultancy; physical fitness instruction; physical fitness training services; providing

Class 9

Heart rate monitors (other than for medical use).

Class 27

Yoga mats; personal exercise mats.

Class 28

Foam rollers for exercise; exercise bands; exercise balls; exercise weights.

Class 41

Personal fitness training services; yoga instruction; provision of gym facilities; gyms; gym services; gym activity classes; exercise classes; health club services (exercise); provision of information relating to physical exercise via an online web site.

Class 42

Blood analysis services.

Class 44

Sports massage; nutritional advice; physiotherapy; exercise facilities for health rehabilitation purposes.

exercise and fitness information through an on-line computer database; providing information in the field of exercise training; educational services, namely, conducting personal training in the field of health and fitness.

Class 42

An application service provider (ASP) featuring software for use with mobile devices, tablet, and computers for tracking, storing, and displaying personal performance data for various fitness activities; ASP featuring application programming interface (API) software for connecting and interacting with software applications on mobile devices, tablets, and computers to track, store, and display personal performance data for various fitness activities.

The Third Earlier Mark

Class 29

Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.

Class 30

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and

confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

Class 32

Mineral and aerated waters, non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

The Fourth Earlier Mark

Class 44

Providing a website featuring information regarding nutrition, dieting, and health.

The Fifth Earlier Mark

Class 41

Provide information regarding sports, athletic skill development, and fitness training via an online website and other computer and electronic communication networks; entertainment services, namely, contest and incentive award programs designed to reward program participants who exercise, participate in sports activities, engage in health-promoting activities, make achievements in exercise and sports activities, and reach personal goals regarding exercise, sports activities, and fitness; provide an interactive web site and other computer and electronic communication networks, namely, mobile device networks, that enables users to

compete and compare athletic information and achievements with other users; provide a website and other computer and electronic communication networks, namely, mobile device networks, featuring information, online links, and electronic resources in the field of sports and fitness; provide pre-recorded athletic challenges, training, fitness sessions and challenges, and workouts via an online website, other computer and electronic communication networks, and via computer software for personal digital devices, and smart phones; Providing a website featuring information regarding fitness training.

The Sixth Earlier Mark

Class 38

Provide a forum, chat rooms, and electronic bulletin boards for registered users for transmission of messages and sharing information regarding health and fitness, sport activities, and social networking via an online website and other computer and electronic communication networks; streaming of audio and video material related to athletic activities on the internet and other computer and electronic communication networks; Providing online chat rooms and electronic bulletin boards for registered users for transmission of messages concerning food, nutrition, personal activities, general interest,

classifieds, virtual community, and social networking.

The Seventh Earlier Mark

Class 9

Pedometers; altimeters; multifunctional electronic devices for displaying, measuring, and uploading to the Internet and computer networks information including time, date, heart rate, global positioning, direction, distance, altitude, speed, steps taken, calories burned, navigational information, weather information, temperature, wind speed, changes in heart rate, activity level, hours slept, and quality of sleep; computer software for wireless data communication for receiving, processing, transmitting and displaying information relating to fitness, body fat, body mass index; computer software for managing information regarding tracking, compliance and motivation with a health and fitness program; electronic monitoring devices incorporating microprocessors, digital display, and accelerometers, for detecting, storing, reporting, monitoring, uploading and downloading sport, fitness training, and activity data to the Internet, and communication with personal computers, regarding time, steps taken, calories burned, distance; computer software for fitness; computer software and computer

application software for mobile phones and personal digital devices for monitoring, uploading, and downloading data regarding sport activity, fitness training, and fitness level to the internet and other computer and electronic communication networks; computer software and computer application software for mobile phones and personal digital devices that monitor, track, and compare sport activity and fitness level; computer software and computer application software for mobile phones and personal digital devices that provides tips, coaching, and personalized workouts, to improve the user's fitness level.	
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38. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, 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.”

39. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

40. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

41. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

42. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as the then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

43. 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. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) 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 the responsibility for those goods lies with the same undertaking.”

44. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

45. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC 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 for 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.”

46. For the purposes of considering the issue of similarity of services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons (see *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

47. In its Notice of Opposition, the opponent stated:

“3. The Application has been filed in relation to goods and services that are either identical or similar, to the extent that they would be associated with the goods and services for which the Earlier Trade Marks are registered.”

48. In its Counterstatement, the applicant stated:

“2.1 The Opponent has relied upon a number of earlier trade mark registrations as the basis for their opposition. Generally these registrations are all for the trade mark IFIT in various forms for various goods and services, all of which generally relate to health and fitness. We do not intend to comment on each individual trade mark. Instead we accept that the Opponent’s trade mark registrations cover the trade mark IFIT in relation to a variety of fitness related goods and services.”

49. In its Skeleton Argument, the opponent stated that this statement by the applicant should be viewed as an admission of the similarity of the goods and services in issue. However, in its written submissions in lieu, the applicant stated:

“5.2 The above comparison was carried out on the basis of identical goods. As there is no likelihood of confusion for identical goods there cannot be any likelihood of confusion for similar goods. On that basis we have not carried out any comparison of the similarity of the goods and services covered by the “Earlier Marks” and the goods and services covered by the present application”.

50. I will, therefore, not treat the applicant’s statement as an admission and will proceed to conduct a full comparison of the goods and services in issue.

Class 5

51. All of the applicant’s class 5 goods are nutritional or dietary supplements in the form of “bars, gels, beverages and pharmaceutical preparations for making beverages”. In my view, the opponent’s best case in respect of these goods lies in its goods in classes 29, 30 and 32. For example, there will be some similarity in nature and method of use between these goods and the opponent’s “non-alcoholic drinks” and “flour and preparations made from cereals, bread, pastry and confectionary, ices”. There may be some overlap in users for these goods on a general level as they will all be used by members of the general public and they may be available generally in the same retail outlets (such as supermarkets). The intended purposes of these goods are different as the applicant’s goods will be used for the specific dietary or nutritional

purposes for which they are designed. In my view, there is a medium degree of similarity between the applicant's class 5 goods and the opponent's goods.

Class 9

52. "Multifunctional electronic devices for displaying, measuring and uploading to the Internet and computer networks information including... heart rate" in the opponent's specification falls within the broader category of "Heart rate monitors (other than for medical use)" in the applicant's specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

Class 27

53. In my view, "Yoga mats" and "personal exercise mats" in the applicant's specification share some similarity with "Fitness and exercise machines" in the opponent's specification. These are all pieces of equipment that will be used during the course of exercise and are therefore similar in their intended purpose. They are likely to be sold through the same trade channels and they will be used by members of the general public with an interest in personal fitness. However, they differ in their nature and method of use. In my view, these goods are similar to no more than a medium degree. I have considered the opponent's other goods and services and I see no further point of similarity which would put the opponent in a better position.

Class 28

54. "Foam rollers for exercise", "exercise bands", "exercise balls" and "exercise weights" in the applicant's specification also share some similarity with "Fitness and exercise machines" in the opponent's specification. Again, these are all pieces of equipment that will be used during exercise and are therefore similar in their intended purpose. They are likely to be sold through the same trade channels and they will be used by members of the public who are interested in fitness. However, they differ in their nature and method of use. In my view, these goods are similar to no more than a medium degree. I have considered the opponent's other goods and services and I see no further point of similarity which would put the opponent in a better position.

Class 41

55. “Personal fitness training services” in the applicant’s specification is plainly identical to “Personal fitness training services and consultancy” in the opponent’s specification.

56. “Yoga instruction”, “gym activity classes” and “exercise classes” in the applicant’s specification fall within the broader category of “Physical fitness instruction” in the opponent’s specification. These services can be considered identical on the principle outlined in *Meric*.

57. Part of the “Provision of gym facilities”, “gyms”, “gym services” and “health club services (exercise)” in the applicant’s specification will be fitness instruction (such as induction or classes). These goods can be considered identical to “physical fitness instruction services” in the opponent’s specification on the principle outlined in *Meric*. If I am wrong in my finding that they are identical then the services will be highly similar as their intended purpose, users and method of use will overlap.

58. “Provision of information relating to physical exercise via an online web site” in the applicant’s specification falls within the broader category of “Provide information regarding sports, athletic skill development, and fitness training via an online website and other computer and electronic communication networks” in the opponent’s specification. These services can be considered identical on the principle outlined in *Meric*.

Class 42

59. I can see no reason why “Blood analysis services” in the applicant’s specification should be considered similar to any of the opponent’s goods and services. There may be some overlap in users on a superficial level in circumstances where the applicant’s services and the opponent’s services are used by members of the general public. However, the uses of the applicant’s services are very specific and do not overlap with the uses of the opponent’s goods and services. The nature of the services is different

and they will be available through different trade channels. “Blood analysis services” will generally be provided by medical practitioners whereas the opponent’s services are all more general fitness based goods and services. There will be no competition between them and I do not consider them to be complementary. In the absence of any substantive submissions to assist me, I am not satisfied that there is any similarity between “Blood analysis services” in the applicant’s specification and any of the opponent’s goods and services. As some degree of similarity is necessary to engage the test for a likelihood of confusion², the opposition must fail in respect of the applicant’s class 42 services.

Class 44

60. “Providing a website featuring information regarding nutrition, dieting, and health” in the opponent’s specification falls within the broader category of “nutritional advice” in the applicant’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

61. “Personal fitness training services and consultancy”, “physical fitness instruction” and “physical fitness training services” in the opponent’s specification are all services offered by gyms and health clubs. Such facilities also sometimes offer “sports massage” services. Personal training-type services are often holistic in nature and will include advice on after-care following physical training (such as the need for a sports massage). The use of a sports massage may improve long-term physical fitness and ability by improving a person’s ability to train regularly. The uses, trade channels and users of such services will, therefore overlap. However, the nature and method of use differ. The services will not be in competition with each other and they are not complementary. I consider these services to be similar to “sports massage” in the applicant’s specification to a low degree.

62. “Physiotherapy” in the applicant’s specification are services offered to assist people in re-building physical fitness which would normally follow an accident or some sort of physical injury. There may be some overlap in trade channels with “physical

² *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

fitness instruction” in the opponent’s specification, because some gyms may offer both services. There may be some overlap in use and users on a superficial level as they will all be used by members of the general public and will involve advice on physical training. However, they will differ because the advice provided during the course of physiotherapy will be tailored to the injury sustained by the consumer. One is a general fitness service and the other is a type of therapy. The services will not be in competition with each other and they are not complementary. I consider these services to be similar to only a low degree. I have considered the opponent’s other goods and services and I can see no further point of similarity which puts the opponent in a better position.

63. “Exercise facilities for health rehabilitation purposes” in the applicant’s specification will involve the provision of gym and fitness machines and equipment to use during the rehabilitation process. “Personal fitness training services and consultancy”, “physical fitness instruction” and “physical fitness training services” in the opponent’s specification may also involve the provision of gym and fitness equipment, but they are more specifically directed at how to use such equipment. There is, therefore, some overlap in nature. The uses will overlap in that they are both provided for improvement of fitness and physical wellbeing, although the applicant’s services are more specifically tailored to rehabilitation. The trade channels may overlap to a limited degree as some gyms for general public use may also be used during the course of rehabilitation. However, it is more likely that specialist facilities will be used for rehabilitation purposes. I consider these services to be similar to a low degree. I have considered the opponent’s other goods and services and I can see no further point of similarity which puts the opponent in a better position.

The average consumer and the nature of the purchasing act

64. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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 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 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.”

65. I have no substantive submissions from the applicant on the average consumer or the nature of the purchasing process for the goods and services in issue. In its Skeleton Argument, the opponent stated:

“In light of the goods and services covered by the Mark, the Opponent’s earlier trade marks as supported by the Opponent’s evidence submitted in this matter, we submit that the average consumer is the person who is interested in utilising health and fitness facilities and purchasing related goods. It is therefore submitted that taking into consideration the nature and value of the products in issue the average consumer has only an average level of recollection of the mark in relation to the goods and services they are purchasing.”

66. In my view, the average consumer will be a member of the general public. Purchases are likely to vary in frequency and cost depending on the specific goods and services in issue. For example, a person may attend multiple fitness classes each week and pay a small amount for each of these. Conversely, an exercise machine is likely to be an infrequent and fairly costly purchase. In the case of all of the goods and services in issue, the consumer is likely to exercise some care in its selection to ensure that its specific requirements are met. I, therefore, consider that the level of attention paid by the average consumer during the purchasing process will vary from average to relatively high.

67. The goods are, in my experience, most likely to be obtained by self-selection from a retail outlet or from an online or catalogue equivalent. Consequently, I consider that visual considerations are likely to dominate the selection process. However, I do not

discount an aural component as advice may be sought from a retail assistant and orders may be placed by telephone. The services are likely to be purchased from specialist retail outlets or their online equivalent. The purchasing process for the services is likely to be dominated by visual considerations, as the average consumer is likely to select the services at issue following inspection of the premises' frontage on the high street or on websites or advertisements (such as flyers, posters or online adverts). However, given that word-of-mouth recommendations may also play a part, I do not discount that there will be an aural component to the selection of the services.

Distinctive character of the earlier mark

68. 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-2779, 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 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 promotion of 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).”

69. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

70. The opponent claims, in its Skeleton Argument, that the distinctiveness of its marks have been enhanced through use. However, the opponent did not plead enhanced distinctiveness in its Notice of Opposition. In any event, the opponent's evidence falls short of demonstrating that the distinctiveness of its marks has been enhanced through use. Parts of the opponent's evidence relate to the United States market which is irrelevant in determining whether there is enhanced distinctiveness because the test for confusion will be assessed by reference to the average consumer who is a member of the UK general public. Further, the opponent has provided no turnover figures, invoices, indication of market share or evidence of how geographically widespread use of its marks has been.

71. I can, therefore, only consider the inherent distinctiveness of the earlier marks. The applicant has argued that the opponent's marks should be considered to have only minimal inherent distinctive character. It has also questioned why the mark IFIT was granted registrations. However, the applicant has not sought to invalidate the opponent's marks and these proceedings are not concerned with the validity of the opponent's registration. Registered trade marks must be assumed to have "at least some distinctive character"³. I do agree with the applicant that the word "FIT" is descriptive of goods and services intended to improve fitness. The distinctive character of the mark lies in the conjoining of the word FIT with the letter "I". I consider the inherent distinctive character of the earlier marks to be low. I do not consider that the stylisation and use of colour in the Second Earlier Mark increases its inherent distinctiveness significantly.

72. For the avoidance of doubt, even if I had taken the table of marketing figures included in Mr McHale's statement into account, this would not (in the absence of any turnover figures, indication of market share or invoices provided by the opponent) have

³ *Formula One Licensing BV v OHIM*, Case C-196/11P

altered my finding that the distinctiveness of the opponent's marks have not been enhanced through use.

Likelihood of confusion

73. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. 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. The first 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade marks, the average consumer of the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

74. I have found the marks to be visually and aurally similar to a medium degree. I have found the marks to be either conceptually similar to at least a medium degree or a low degree, depending on the consumer's perception of the use of the letter "I" in the opponent's marks. I have found the opponent's marks to have a low degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who will select the goods and services primarily by visual means (although I do not discount an aural component). I have concluded that the level of attention paid during the purchasing process will vary from average to relatively high. I have found the parties goods and services to vary from being similar to only a low degree to identical (except where they share no similarity).

75. I will carry out my assessment on the basis of those goods and services which are identical as, if there is no likelihood of confusion in respect of those, it follows that there

will be no likelihood of confusion in respect of those goods and services which share a lesser degree of similarity.

76. I bear in mind the decision of the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion. However, it is clear from the judgment of the CJEU in *Lloyd* (cited above), that descriptive matter should be given less weight when comparing trade marks. Further, I bear in mind the comments of Mr Iain Purvis Q.C., sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

77. In other words, it is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out. In my view, the distinctiveness of the earlier mark does not lie in the use of the word FIT but in the conjoining of FIT with the letter ‘I’.

78. Because the common element of the marks is descriptive of the goods and services for which they are applied for/registered, greater weight will be attributed to the letter used at the start of each mark by the average consumer. The applicant’s mark combines a different letter with the word FIT and in a different form (with the opponent’s marks being the letter ‘I’ conjoined with the word FIT and the applicant’s

mark being presented as two separate words). Whilst the marks may have similar conceptual meanings, the visual and aural differences are sufficient to differentiate between them. Notwithstanding the principle of imperfect recollection, I consider that the different letters at the start of each mark will be sufficient to enable the consumer to differentiate between the marks. This is particularly the case in circumstances in which the consumer will be paying at least an average degree of attention when selecting the goods and services in issue. I do not, therefore, consider that there is a likelihood of direct confusion.

79. I will now consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by 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.”

80. If the consumer recognises the difference between the marks, I see no reason why the average consumer would assume that the marks come from the same or economically linked undertakings. The common element – the word FIT – is descriptive of the goods and services for which the marks are applied for/registered. The consumer would have no reason to believe that only one undertaking would use this word in relation to fitness based goods and services. I do not, therefore, consider there to be a likelihood of indirect confusion.

CONCLUSION

81. The opposition has been unsuccessful and the application will proceed to registration.

COSTS

82. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £700 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement and consider the opponent's statement	£200
Considering the opponent's evidence and preparing written submissions in lieu of a hearing	£500
Total	£700

83. I therefore order ICON Health & Fitness Inc to pay U Fit Group Limited the sum of £700. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 10th day of January 2019

S WILSON

For the Registrar