

O-039-19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3254980

BY MARK SATTERTHWAITE TO REGISTER:



AS A TRADE MARK IN CLASS 41

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 410924 BY

MCFIT GLOBAL GROUP GMBH

BACKGROUND & PLEADINGS

1. On 6 September 2017, Mark Satterthwaite (“the applicant”) applied to register the trade mark shown on the cover page of this decision for services in class 41, details of which can be found in the Annex to this decision. The application was published for opposition purposes on 22 September 2017.

2. The application has been opposed in full by McFIT Global Group GmbH (“the opponent”). The opposition is based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon the same trade mark, details of which are as follows:

European Union Trade Mark (“EUTM”) no. 5673165 for the trade mark **McFit** which was applied for on 26 January 2007 and entered in the register on 20 December 2007. The opponent indicates that it relies upon the services in class 41 of its registration, details of which are also shown in the Annex to this decision.

3. In relation to its objection under section 5(2)(b) of the Act, the opponent focuses its attention on the comparison between its trade mark and the words in the applicant’s trade mark, stating: “It is of no consequence that there are differences in the other elements of the signs”. Proceeding on that basis (a point to which I will return later in this decision), it claims that the respective trade marks are visually, aurally and conceptually highly similar and that the competing services are either identical or strikingly similar.

4. Insofar as its objection based upon section 5(3) of the Act is concerned, the opponent states its trade mark enjoys a reputation in relation to all the services upon which it relies, adding that it considers all the services for which registration is sought would take unfair advantage of, or be detrimental to the distinctive character or reputation of its trade mark. It further claims that “the similarity between the [trade mark being relied

upon] and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks”.

5. The applicant filed a counterstatement in which the basis of the opposition is denied. .

6. In these proceedings both parties have represented themselves. Only the opponent filed evidence (accompanied by written submissions). Whilst neither party asked to be heard, the opponent elected to file written submissions in lieu of attendance at a hearing. I shall refer to these submissions, as necessary, later in this decision.

7. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK), 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.”

8. The opponent is relying upon the trade mark shown in paragraph 2, which qualifies as an earlier trade mark under the above provisions. Given the interplay between the date on which the opponent’s trade mark was registered and the publication date of the application for registration, the EUTM being relied upon is subject to the proof of use provisions contained in section 6A of the Act. In its Notice of opposition, the opponent

indicates that its trade mark has been used in relation to all of the services upon which it relies, and in his counterstatement, the applicant asked the opponent to make good that claim.

The opponent's evidence

9. It is at this point in my decision I would normally provide a summary of the opponent's evidence. However, for reasons which will shortly become clear, it is not necessary for me to do so. For the avoidance of doubt, I should make it clear that I have read the witness statements of Rainer Schaller (the opponent's founder and Chief Executive Officer) and Tobias Arens (who is employed by the opponent) and have borne their comments in mind in reaching the conclusions which follow.

DECISION

10. The opposition is based upon sections 5(2)(b) and 5(3) of the Act which read as follows:

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

(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.”

And:

“(3) A trade mark which is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

The opposition based upon section 5(2)(b) of the Act

Case law

11. The following principles are gleaned from the decisions of the courts of the European Union 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 the earlier mark to mind, is not sufficient;

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

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

My approach to the proceedings


12. I intend to proceed on the basis most favourable to the opponent i.e. that: (i) its evidence demonstrates that within the relevant period it has made genuine use of its EUTM in relation to all the services upon which it relies, (ii) the competing services are identical, (iii) the average consumer is a member of the general public paying only a low degree of attention during the selection process (thus making him/her more prone to the effects of imperfect recollection), and (iv) its earlier trade mark is possessed of a high degree of distinctive character. If the opponent cannot succeed on that basis, it will be in no better position if, for example: (i) it is not entitled to rely upon all of the services upon which it claims to have used its trade mark, (ii) some of the services are only similar (to varying degrees), (iii) the average consumer pays a more than low degree of attention when selecting the services, and (iv) its earlier trade mark has a lower degree of distinctive character than mentioned above.

Comparison of trade marks

13. Notwithstanding the opponent's approach to the comparison of the trade marks at issue, 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 them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("CJEU") stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

14. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are:

Opponent’s trade mark	Applicant’s trade mark
McFit	

15. The opponent’s trade mark consists of a single word presented in normal typeface, in which the letters “M” and “F” are presented in upper case. The presentation of the letters “M” and “F” serves to split the word into two elements i.e. “Mc” and “Fit”. While the letters “Mc” have surnominal significance and the word “Fit” is clearly meaningful for the service at issue, the overall impression conveyed by the trade mark and its distinctiveness lie in the totality it creates, rather than in the elements of which it is composed.

16. The applicant’s trade mark consists of a number of components. The first, is what he describes as a “swirl”; a description I am happy to adopt. This swirl device is

presented in black and white, is distinctive and is by far the largest component of the trade mark. As a consequence, it will have a high relative weight in the overall impression the trade mark conveys. The second component, which appears within the centre of the device of a swirl, is also presented in black and white and consists of the yin and yang symbol. However, as the yin and yang symbol forms an integral part of the swirl device, I think it is likely that its presence may go undetected. However, even if it is noticed, given its ubiquitous nature, it is unlikely to make a significant contribution to either the overall impression the trade mark conveys or its distinctive character. The final components, consist of the words “MIX” and “FIT” presented one above the other in an unremarkable upper case script and in contrasting colours to the parts of the yin and yang symbol upon which they appear. The word “MIX” (and its various meanings) will be very well-known to the average consumer and, as I mentioned when considering the opponent’s trade mark, the word “FIT” is clearly meaningful for the services at issue. Given the size and positioning of these words within the context of the trade mark as a whole, they will make an important contribution to the overall impression conveyed and its distinctiveness.

17. I will now compare the competing trade marks with those conclusions in mind. While in doing so I will, of course, keep in mind the parties’ competing submissions on this aspect of the case, I do not intend to record all of those submissions here.

Visual similarity

18. The competing trade marks consist of, inter alia, a word consisting of five letters and a combination of two words consisting of six letters, respectively. Both begin with an upper case letter “M” and end with the letters “Fit”/“FIT”. The second letter in the opponent’s trade mark consists of a lower case letter “c”, whereas the second and third letters in the applicant’s trade mark consist of the letters “IX”. The applicant’s trade mark also contains the device of a swirl and, less importantly in my view, the yin and yang

device. Considered overall, I regard the degree of visual similarity between the competing trade marks as very low.

Aural similarity

19. It is well established that when a trade mark consists of a combination of words and figurative components, it is by the word component(s) that it is most likely to be referred to. As the two words appearing in the applicant's trade mark will be very well-known to the average consumer, their pronunciation is entirely predictable, i.e. as the two syllable combination "MIX FIT". In its submissions, the opponent submits that its trade mark will be pronounced as either "MACFIT" or "MEC(S)FIT", the latter of which is, in my view, unlikely.

20. While the average consumer is, in my view, most likely to pronounce the opponent's trade mark as "MUK-FIT", I accept that it may also be pronounced as "MAC-FIT". Although the word "Fit"/"FIT" will be pronounced in an identical fashion, given what I regard as the significant aural differences at the beginning of the competing trade marks, i.e. "MIX" as opposed to "MUK" or "MAC", it still only results in a low to medium degree of aural similarity between the competing trade marks.

Conceptual similarity

21. The concept conveyed by the word "MIX", the yin and yang device and any concept which may be conveyed by the swirl device in the applicant's trade mark are alien to the opponent's trade mark. Similarly, the letters "Mc" in the opponent's trade mark (which are likely to have surnominal significance for the average consumer), find no counterpart in the applicant's trade mark. However, as both trade marks contain the word "Fit"/"FIT" as an identifiable element, I agree with the opponent that they are conceptually similar to the limited extent that they evoke the concept of fitness. I shall return to this point when I consider the likelihood of confusion.

Likelihood of confusion

22. In determining whether there is a likelihood of confusion, 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 services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and 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 he has retained in his mind.

23. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and services down to the responsible undertakings being the same or related.

24. In reaching a conclusion, I begin by reminding myself of the basis on which I am proceeding (paragraph 12 above refers). To that, I add the conclusions I have reached on the similarity in the competing trade marks i.e. they are visually similar to a very low degree and aurally similar to a low to medium degree, respectively. Having identified the various conceptual differences between the competing trade marks, I accepted that the trade marks at issue are conceptually similar to the limited extent that they both evoke the concept of fitness. However, as that concept is, when considered in relation to the services at issue, entirely descriptive and non-distinctive, that degree of conceptual similarity does not assist the opponent.

25. Even allowing for, inter alia, the effects of imperfect recollection, I have no hesitation concluding that the significant differences I have identified earlier between the competing trade marks, are more than sufficient to avoid a likelihood of direct confusion.

26. Insofar as indirect confusion is concerned, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained the difference between direct and indirect confusion stating:

“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.”

27. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

28. Other than the shared reference to the descriptive and non-distinctive word “Fit”/“FIT”, there is, in my view, no other feature present in the competing trade marks that is likely to prompt the average consumer into the thought process suggested by Mr

Purvis. Not only do I think there is no likelihood of indirect confusion, I do not think the applicant's trade mark would even call the opponent's trade mark to mind. As a consequence of the above conclusions, the opposition based upon section 5(2)(b) of the Act fails and is dismissed accordingly.

29. Having reached the above conclusion on the basis indicated, inter alia, it follows that if, as is likely to be the case, the average consumer pays at least a normal degree of attention during the selection process, they will be even less susceptible to the effects of imperfect recollection and the likelihood of confusion will be even more remote.

The opposition based upon section 5(3) of the Act

30. I can deal with this ground of objection quite briefly. In its evidence, the opponent explains that it has made use of its trade mark in Germany, Austria, Spain, Italy and Poland. Consequently, I shall, once again, proceed on the basis most favourable to it i.e. that its evidence is sufficient to establish a reputation in the European Union (*Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07 refers). However, in *China Construction Bank Corporation v Groupement Des Cartes Bancaires*, (Case BL O/281/14), Mr Purvis Q.C. again acting as the Appointed Person, stated:

“40. ...I believe that the ultimate decision under s5(3) was nonetheless correct. In order to succeed under s5(3), the opponent has to show either that the distinctive character or repute of its earlier mark would be damaged by reasonable and fair use of the mark applied for, or that such reasonable and fair use would take unfair advantage of the reputation of its earlier mark. The reasonable and fair use of the mark applied for can only be use in the United Kingdom, since this is the entire territorial scope of the application.

41. If the reputation of the earlier mark does not extend to the United Kingdom, it is difficult to see how (at least in the usual case) it could be damaged by use of a

mark in the United Kingdom, or that such use could be said to take unfair advantage of the earlier mark. For one thing, the necessary 'link' between the marks in the mind of the average consumer which must be established in any case which relies on the extended protection (see Adidas-Salomon v Fitnessworld [2004] ETMR 10) would not exist. **There is certainly no evidence in the present case which explains how any 'link' could be made in the UK absent a reputation here.**(my emphasis).

31. As the passage I have highlighted applies with equal force to these proceedings, the absence of the necessary "link" is fatal to the opponent's case, and the objection fails accordingly.

Overall conclusion

32. The opposition has failed on all grounds and, subject to any successful appeal, the application will proceed to registration.

Costs

33. The tribunal wrote to the parties at the conclusion of the evidence rounds. As the applicant is unrepresented, his letter included the following paragraph:

"If you intend to make a request for an award of costs, complete and return the attached pro-forma by 30 October 2018. If it is not completed and returned, no costs, other than official fees arising from the action (excluding extensions of time), will be awarded. You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs. Please note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of

compensation for litigants in person in Court proceedings at £19.00 an hour” (my emphasis).

34. As the applicant did not respond to that invitation (either by the deadline mentioned or prior to the issuing of this decision) and as he has not incurred any official fees in the defence of his application, I make no order as to costs.

Dated this 21st day of January 2019

C J BOWEN

For the Registrar

Annex

Opponent's services	Applicant's services
<p>Class 41 - Providing sporting facilities, sports studios and sports camp, rental of sports equipment (except vehicles), organisation of sports competitions, entertainment.</p>	<p>Class 41 - Exercise classes; Exercise [fitness] advisory services; Exercise [fitness] training services; Exercise instruction; Fitness club services; Gym activity classes; Gymnasium club services; Gymnasium facilities (Provision of -); Gymnasium services; Gymnasium services relating to body building; Gymnasium services relating to weight training; Gymnasiums; Health and fitness club services; Health and wellness training; Health club [fitness] services; Health club services [exercise]; Health club services [health and fitness training]; Health education; Recreation and training services; Recreation facilities (Providing -); Recreation facilities (Provision of -); Recreation information; Recreation (Information relating to -); Recreation information services; Recreation services; Recreational camp services; Recreational camps; Recreational facilities; Recreational facilities (Provision of -); Recreational services; Sport camp services; Sport camps; Sporting activities; Sporting and cultural activities; Sporting</p>

	<p>and recreational activities; Sporting competitions (Arranging of -); Sporting competitions (Organising of -); Sporting education services; Sporting event organization; Sporting results services; Sports activities; Sports and fitness; Sports and fitness services; Sports camp services; Sports club services; Sports coaching; Sports coaching services; Sports competitions (Organising of -); Sports education services; Sports entertainment services; Sports equipment (Rental of -), except vehicles; Sports events (Timing of -); Sports facilities (Hire of -); Sports facilities (Leasing of -); Sports facilities (Provision of -); Sports information services; Sports instruction services; Sports officiating; Sports refereeing; Sports refereeing and officiating; Sports training; Sports tuition; Sports tuition, coaching and instruction; Sports-park services.</p>
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