

O/624/19

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001386594

DESIGNATING THE UNITED KINGDOM

IN THE NAME OF ISODYNAMICS CORPORATION PTY LTD:

REVIVER

IN CLASSES 10 AND 28

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 413324 BY

ZEN LIFESTYLES UK LIMITED

BACKGROUND AND PLEADINGS

1. International trade mark 1386594 (“the IR”) consists of the following sign:

REVIVER

2. The holder is Isodynamics Corporation Pty Ltd. The IR is registered with effect from 6 December 2017. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The holder seeks protection for the mark in relation to:

Class 10 Exercise apparatus for medical rehabilitative purposes; exercise apparatus, specifically adapted for medical purposes; exercise machines for medical rehabilitative purposes; portable exercise apparatus for medical use; apparatus for use in exercising muscles for medical use; apparatus for use in toning muscles for medical rehabilitation; muscle building apparatus for medical use.

Class 28 Gymnastic and sporting articles; exercise apparatus, other than for medical rehabilitative purposes; exercise equipment, other than for medical rehabilitative purposes; exercise machines, other than for medical rehabilitative purposes; weights for physical exercise (other than adapted for medical use); muscle building apparatus (other than for medical use); muscle exercising apparatus (other than for medical use); apparatus for use in toning muscles, other than for medical rehabilitation.

3. The request to protect the IR in the UK was published for opposition purposes on 4 May 2018. Zen Lifestyles UK Limited (“the opponent”) originally opposed the protection of the IR in the UK based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). However, the opponent did not file any evidence in chief to support its claim under sections 5(3) and 5(4)(a) of the Act. Consequently, as the Registry informed the parties in official correspondence, the opposition proceeds only on the basis of the section 5(2)(b) ground.

4. The opponent relies upon EUTM no. 12575213 for the trade mark **REVIBER**, which was filed on 7 February 2014 and registered on 1 July 2014. The opponent relies upon all goods and services for which the earlier mark is registered, as set out in paragraph 14 below.

5. The opponent claims that there is a likelihood of confusion because the respective marks are similar, and the goods are identical or similar.

6. The opponent is represented by Mathys & Squire LLP and the holder is represented by Wildbore & Gibbons. During the evidence rounds, the opponent filed written submissions and then filed evidence in reply to evidence filed by the holder. No hearing was requested and only the holder filed written submission in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

7. As noted above, the opponent filed written submissions during the evidence rounds (dated 24 January 2019). Whilst I have taken those submissions into consideration in reaching my decision, I do not propose to summarise them here and will refer to them below as necessary.

8. The holder's evidence consists of the witness statement of Geoffrey Redmond dated 23 April 2019, which is accompanied by 3 exhibits. Mr Redmond is the director of the holder, a position he has held since 8 December 2013. I have read Mr Redmond's evidence in its entirety. I note that it is directed at identifying the different markets within which the parties operate i.e. that the holder targets professional users and the opponent targets members of the general public. Mr Redmond also references the fact that, in practice, the mark in issue will be used in conjunction with the holder's other marks.

9. The opponent's evidence in reply consists of the witness statement of Paul Rudge dated 22 August 2019, which is accompanied by 2 exhibits. Mr Rudge is the Managing Director of the opponent, a position he has held for 10 years. Mr Rudge's evidence is

predominantly focused upon answering the points raised by Mr Redmond regarding the parties' targeting different markets. Mr Rudge has also provided examples (most of which are undated) which show the opponent's customers mistakenly referring to their product as "reviver", which Mr Rudge states shows how easily confusion may arise between the marks in issue.¹

10. The holder filed written submissions in lieu of a hearing. Whilst I do not propose to summarise those submissions here, I have taken them into consideration and will refer to them below where necessary. However, in particular, I note that the holder has filed an amendment to their specification at WIPO. I will return to this point later in my decision.

DECISION

11. Section 5(2)(b) of the Act states 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."

12. The trade mark upon which the opponent relies qualifies as an earlier trade mark under section 6 of the Act. As the opponent's trade mark had not completed its registration process more than 5 years before the UK publication date of the IR in

¹ Exhibit PR2

issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods it has identified.

Section 5(2)(b) – case law

13. 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:

(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 goods and services

14. As noted above, the holder has sought to amend the goods and services for which it seeks protection in the UK. This amendment has not yet, to my knowledge, been accepted by WIPO. I will, therefore, compare the original goods and services for which protection was sought, turning to the specification as amended below. The competing goods and services in the original specification are as follows:

Opponent's goods and services	Holder's goods
<p data-bbox="193 255 794 293"><u>Class 10</u></p> <p data-bbox="193 300 794 1055">Apparatus for the therapeutic toning of muscles and the body; apparatus for the therapeutic stimulation of muscles and the body; therapeutic body toning and/or training apparatus and/or appliances; massage apparatus and/or appliances; exercise apparatus, equipment and machines for therapeutic and/or medical rehabilitative purposes; exercise simulating apparatus, equipment and machines for medical purposes; apparatus and/or appliances for physical training for medical use; parts and fittings for all the foresaid.</p> <p data-bbox="193 1133 794 1171"><u>Class 28</u></p> <p data-bbox="193 1178 794 1939">Sporting apparatus and/or appliances; sports training apparatus and/or appliances; physical exercise articles for physical training [other than for medical purposes]; training apparatus and/or appliances for sportsmen and sportswomen; exercise apparatus, devices, equipment and/or machines, other than for medical rehabilitative purposes; fitness and conditioning apparatus, devices, equipment and/or machines; muscle exercise apparatus, devices, equipment and/or machines; apparatus for use in toning muscles,</p>	<p data-bbox="799 255 1393 293"><u>Class 10</u></p> <p data-bbox="799 300 1393 898">Exercise apparatus for medical rehabilitative purposes; exercise apparatus, specifically adapted for medical purposes; exercise machines for medical rehabilitative purposes; portable exercise apparatus for medical use; apparatus for use in exercising muscles for medical use; apparatus for use in toning muscles for medical rehabilitation; muscle building apparatus for medical use.</p> <p data-bbox="799 976 1393 1014"><u>Class 28</u></p> <p data-bbox="799 1021 1393 1771">Gymnastic and sporting articles; exercise apparatus, other than for medical rehabilitative purposes; exercise equipment, other than for medical rehabilitative purposes; exercise machines, other than for medical rehabilitative purposes; weights for physical exercise (other than adapted for medical use); muscle building apparatus (other than for medical use); muscle exercising apparatus (other than for medical use); apparatus for use in toning muscles, other than for medical rehabilitation.</p>

other than for medical rehabilitation;
parts and fittings for all the foresaid.

Class 35

Retail services connected with the sale of apparatus for the therapeutic toning of muscles and the body, apparatus for the therapeutic stimulation of muscles and the body, therapeutic body toning and/or training apparatus and/or appliances, massage apparatus and/or appliances, exercise apparatus, equipment and machines for therapeutic and/or medical rehabilitative purposes, exercise simulating apparatus, equipment and machines for medical purposes, apparatus and/or appliances for physical training for medical use, sporting apparatus and/or appliances, sports training apparatus and/or appliances, physical exercise articles for physical training (other than for medical purposes), training apparatus and/or appliances for sportsmen and sportswomen, exercise apparatus, devices, equipment and/or machines, other than for medical rehabilitative purposes, fitness exercise apparatus, devices, equipment and/or machines, muscle exercise apparatus, devices, equipment and/or machines, apparatus for use in toning muscles, other than for medical rehabilitation, parts and fittings

for all the foresaid; information, advisory and consultancy services relating to all the foregoing.	
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15. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 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.”

16. 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.

17. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“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.”

18. The holder makes much of the fact that the parties target different markets. However, whilst this may be the case now, the parties may elect to target different markets in the future. My assessment must be based upon all possible uses of the marks within the scope of their registrations.² Differences in the markets targeted by the parties in practice are, therefore, irrelevant to the decision I must make.

Class 10

19. All of the holder’s class 10 goods fall within the broader category of “exercise simulating apparatus, equipment and machines for medical purposes” in the opponent’s specification. These goods are identical on the principle outlined in *Meric*.

Class 28

20. “Sporting apparatus and/or appliances” in the opponent’s specification falls within the broader category of “gymnastic and sporting articles” in the holder’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

² In *O2 Holdings Limited, O2 (UK) Limited v Hutchinson 3G UK Limited*, Case C-533/06

21. “Exercise apparatus, other than for medical rehabilitative purposes”, “exercise equipment, other than for medical rehabilitative purposes”, “exercise machines, other than for medical rehabilitative purposes”, “weights for physical exercise (other than adapted for medical use)”, “muscle building apparatus (other than for medical use)”, “muscle exercising apparatus (other than for medical use)” and “apparatus for use in toning muscles, other than for medical rehabilitation” in the holder’s specification will overlap in nature with “exercise apparatus, equipment and machines for therapeutic and/or medical rehabilitative purposes” in the opponent’s specification. Whilst they may be targeted at different users (the opponent’s being for medical use and the holder’s being for specifically non-medical use), there may still be overlap in nature of the goods. Further, there may be overlap in trade channels as undertakings may sell sports equipment which is both for therapeutic and non-therapeutic purposes. The opponent’s goods are most likely to be purchased by medical professionals. However, it is not uncommon for members of the general public to purchase apparatus and equipment needed for their own therapy or medical reasons and so there may be some overlap in user. The specific uses of the goods will differ, although the method of use will overlap. I consider the goods to be similar to between a medium and high degree.

22. As noted above, the holder has applied to amend the goods for which they seek protection in the UK. It has sought to delete its class 28 goods entirely and to amend class 10 of its specification as follows:

Class 10 Whole body tilting radial motion machine directed to the specialised medical practitioner, hospital procurement officer and government procurement officer markets, that puts the user’s whole body through movement of pivoting axial tilt, comprising a pivotal inclining and declining platform on which the user sits or stands within a surrounding body support cage fixed to the platform, or bed on which the user lies, all to allow the user to undergo varied and controllable movements of pivotal axial tilt, resulting in isometric exercise induced through the off balance sensation produced by the body’s counter reaction to gravitational forces, the aforesaid machine being for therapeutic

rehabilitation purposes of patients who have traumatic injury or have suffered significant illness, such as stroke and neurological disorders or from loss of mobility and loss of strength due to muscle wastage.

23. Clearly, the holder has sought to provide a more specific description of the goods it actually provides or intends to provide under the mark. Whilst I recognise that the goods covered by the amendment are very specific, they would be covered by the broader term of “exercise apparatus, equipment and machines for therapeutic and/or medical rehabilitative purposes” in the opponent’s specification. The goods would, therefore, remain identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

24. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which these goods 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”.

25. The average consumer for the goods will be either a medical professional or a member of the general public. Purchases of the goods are likely to vary significantly in cost. Some apparatus may be of very low value whilst some items of machinery may be particularly expensive. However, even where the cost is low, a variety of factors will still be taken into account such as ease of use and suitability for the consumer’s needs. This will particularly be the case where goods are for medical

purposes and relate to the user's health and wellbeing. I consider that at least a medium degree of attention will be paid during the purchasing process for the goods, although I recognise that a higher degree of attention may be paid.

26. The goods are likely to be purchased from specialist or high street retail outlets or their online or catalogue equivalents. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods given that advice may be sought from specialist representatives and/or orders placed by telephone.

Comparison of the trade marks

27. 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 marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

28. 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.

29. The respective trade marks are shown below:

Opponent's trade mark	Holder's trade mark
REVIBER	REVIVER

30. The holder has made reference to the fact that its mark is used, in practice, in combination with other marks. As noted above, it is clear from *O2 Holdings* that it is only differences that are apparent from the trade marks as registered which are relevant to the assessment I must undertake. Differences that result from use of the marks in practice are irrelevant.

31. The opponent's mark consists of the word REVIBER. There are no other elements to contribute to the overall impression which lies in the word itself. The holder's mark consists of the word REVIVER. There are, again, no other elements to contribute to the overall impression which lies in the word itself.

32. Visually, the marks share six of the same letters – REVI-ER. They differ in the fifth letter, which is B in the opponent's mark and V in the holder's mark. As a general rule, the beginnings of marks tend to make more impact than the ends³. I consider the marks to be visually highly similar.

33. Aurally, the opponent's mark is likely to be pronounced REE-VIBE-ERR. The holder's mark is likely to be pronounced REE-VIVE-ERR. Two of the three syllables are identical, and the third syllables sound similar. I consider the marks to be aurally highly similar.

34. Conceptually, the opponent's mark is an invented word with no particular meaning. The word REVIVER does not appear in the Cambridge English Dictionary, but the holder notes that it derives from the word REVIVE. I agree; the average consumer is

³ *El Corte Ingles, SA v OHIM*, Cases T-183/02 and T-184/02

likely to view this as a noun, referring to someone who (or something that) revives. The marks are, therefore, conceptually dissimilar.

Distinctive character of the earlier trade mark

35. 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 promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

36. 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.

37. The opponent has not claimed that its mark has acquired enhanced distinctiveness through use and has filed insufficient evidence to support such a finding. Consequently, I have only the inherent position to consider. The opponent's mark is an invented word with no particular meaning. Consequently, I consider it to be inherently distinctive to a high degree.

Likelihood of confusion

38. 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 mark, the average consumer for the goods 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.

39. I have found the marks to be visually and aurally highly similar and conceptually dissimilar. I have found the earlier mark to have a high degree of inherent distinctiveness. I have identified the average consumer to be a member of the general public or a medical professional who will purchase the goods primarily by visual means (although I do not discount an aural component). I have concluded that at least a medium degree of attention will be paid during the purchasing process. I have found the parties' goods to range from identical to similar to a medium degree.

40. I recognise that the marks are conceptually dissimilar. However, I do not consider that this is sufficient to overcome the visual and aural differences between them. When presented on similar goods, the average consumer is likely to overlook the different fifth letter in each mark. I consider this to be the case notwithstanding the fact that at least a medium degree of attention will be paid during the purchasing process. I consider that the marks will be misremembered or mistakenly recalled as each other. I consider there to be a likelihood of direct confusion.

CONCLUSION

41. The opposition has been successful and the application for designation of the IR in the United Kingdom is refused.

COSTS

42. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I note that the official fee paid by the opponent was £200 because it initially sought to rely on sections 5(3) and 5(4)(a) of the Act in addition to section 5(2)(b). However, the opponent elected not to pursue those grounds and filed no evidence in relation to them. I will, therefore, only award the opponent the official fee in respect of the ground that was pursued. In the circumstances, I award the opponent the sum of **£1,100** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the holder's statement	£200
Preparing written submissions, considering the holder's evidence and preparing evidence in reply	£800
Official fee	£100
Total	£1,100

43. I therefore order Isodynamics Corporation Pty Ltd to pay Zen Lifestyles UK Limited the sum of £1,100. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 16th Day of October 2019

S WILSON

For the Registrar