

O/0446/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003468845

IN THE NAME OF AMIT POPAT

FOR THE FOLLOWING TRADE MARK:

Yoga Man

IN CLASSES 9, 16, 28, 38 AND 41

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 420590

BY LENOVO (BEIJING) LIMITED

BACKGROUND AND PLEADINGS

1. On 21 February 2020, Mr Amit Popat (“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 10 April 2020 and registration is sought for the following goods and services:

Class 9 Cartoons (Animated -); Animated cartoons; Animated cartoons in the form of cinematographic films; Video games [computer games] in the form of computer programs recorded on data carriers; Video games on disc [computer software]; Video games programs [computer software]; Video games software; Downloadable electronic books.

Class 16 Books; Books for children; Educational books.

Class 28 Children's multiple activity toys; Children's toys; Crib mobiles [toys]; Crib toys; Cuddly toys; Developmental toys; Educational toys; Fabric toys; Fantasy character toys; Fluffy toys; Model toys; Models being toys; Modular toys; Toys adapted for educational purposes; Toys for infants; Toys made of plastics; Toys made of rubber; Toys presented in an advent calendar; Toys relating to magic; Toys, games, and playthings.

Class 38 Transmission of videos, movies, pictures, images, text, photos, games, user-generated content, audio content, and information via the Internet.

Class 41 Creating animated cartoons; Providing online video games; Electronic online publication of periodicals and books.

2. On 23 June 2020, the application was partially opposed by Lenovo (Beijing) Limited (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Only those goods and services underlined above are opposed. The opponent relies upon EUTM no. 11229085 for the trade mark **YOGA**, which was filed on 1 October

2012 and registered on 30 January 2013. The opponent relies upon all goods for which the earlier mark is registered, namely:

Class 9 Computers, namely portable computers and tablet computers, including software and peripherals for use therewith.

3. The opponent claims that the marks are similar and that the goods and services are identical or similar, with the result that there is a likelihood of confusion.

4. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use.

5. A decision was issued in the opposition by Ms Rosie Le Breton (“the original hearing officer”), acting on behalf of the Registrar, on 28 January 2022. The original hearing officer rejected the opposition. That decision was appealed and, as a result of that appeal, the case was remitted to the Registry to be determined by a different hearing officer by Mr Philip Harris, as the Appointed Person. Mr Harris noted that a new hearing officer should assess the comparison of marks and likelihood of confusion, in particular:

- “a) The overall impression of the Contested Mark.
- b) Conceptual comparison.
- c) The likelihood of confusion, direct or indirect, taking into account the reconsideration of the aforesaid matters.”

It now falls to me to determine the opposition anew.

6. The applicant is unrepresented and the opponent is represented by HGF Limited.

7. Only the opponent filed evidence. Neither party requested a hearing and only the opponent filed written submissions in lieu. Following the remittal, the parties were given the opportunity to request a hearing. Neither party did so, but the opponent did file further written submissions in lieu.

EVIDENCE AND SUBMISSIONS

8. The opponent filed evidence in chief in the form of the witness statement of Becky Williams dated 8 April 2021, accompanied by 10 exhibits. Ms Williams is Senior Counsel and Director of Trademarks for the opponent.

9. The opponent filed written submissions in lieu dated 18 November 2021.

10. The opponent filed further (undated) written submissions on 20 February 2023.

RELEVANCE OF EU LAW

11. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

12. 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.”

13. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

14. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had completed its registration process more than 5 years before the application date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act.

Proof of use

15. Section 6A states as follows:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

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

16. Section 100 of the Act states that:

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

17. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the date of the application in issue i.e. 22 February 2015 to 21 February 2020.

18. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the

characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

19. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

20. I note the following from the opponent’s evidence:

- a) The opponent’s “worldwide market share for personal computer unit shipments during the Relevant Period varied between approx. 20%-25%.”¹
- b) The opponent sells tablets and laptop computers under the marks LENOVO IdeaPad YOGA 11, ThinkPad YOGA, LENOVO YOGA 2 PRO, IDEAPAD

¹ Exhibit BW1

YOGA 11 S, IDEAPAD YOGA TABLET, YOGA 900, YOGA BOOK, YOGA 730, YOGA 3 Pro and YOGA 920 Vibes.

- c) The opponent has won various awards for its YOGA laptops/notebooks such as the CES Best of Innovation and Honoree awards in 2019.²
- d) Sales figures for YOGA branded products sold in Europe, the Middle East and Africa were as follows:³

2012/2013	\$4,312million
2013/2014	\$4,749.5million
2014/2015	\$5,358.2million
2015/2016	\$4,578million
2016/2017	\$4,761.5million
2017/2018	\$2,045.9million (incomplete data)

- e) A sample of invoices dated between June 2019 and January 2021 have been provided which show sales of over 1,800 laptops/notebooks to recipients located in countries including the UK, Germany, Denmark and Slovakia under the YOGA mark.⁴
- f) The opponent has spent approximately £8.6million on advertising/marketing YOGA products in Europe during the months January to March 2019 alone.
- g) Ms Williams gives narrative evidence that “during the relevant period, products bearing the Earlier Mark were sold to consumers within all member states of the EU”.
- h) Screenshots from the Wayback Machine show goods on sale in the EU under the mark YOGA during the relevant period.⁵

² Exhibit BW3

³ Exhibit BW4

⁴ Exhibit BW5

⁵ Exhibit BW6

- i) The opponent's Instagram account had 960,000 followers, its Facebook account had over 6.8million followers, its Twitter account had over 691,000 followers, its YouTube account had 273,000 followers and its TikTok had 593,500 followers.

21. The original hearing officer found the above uses of the mark YOGA to be use upon which the opponent could rely. I agree. This is because the mark YOGA retains an independent distinctive role within the above composite marks.⁶ In relation to genuine use, the original hearing officer found as follows (footnotes omitted):

“31. The opponent's evidence is not without its flaws. Firstly, although I note the market share shown for the Lenovo Group Limited is considerable, this is of little relevance here as it is not shown in relation to the YOGA mark, or the relevant territory. I also note that whilst the sales figures provided for sales of products under the YOGA brand are also high, these figures relate to sales within the EMEA [Europe, the Middle East and Africa] and in are [sic] in respect of 'products' generally. The figures are not broken down any further into territory and they clearly include sales to considerable regions outside of the EU. It is therefore impossible to determine the exact level of sales that took place within the EU from the figures provided. In addition, several of the screenshots provided, including those from the opponent's website, and some of the articles and promotional material discussing the YOGA products are not dated within the relevant timeframe. The details of the awards won appear to be global awards, and nothing in the location of the awards or the press reporting ties the products to the relevant territory. This is also true for much of the evidence relating to social media accounts, and although it is clear that many of these accounts have a considerable following, particularly the Facebook account which is nearing 7 million likes and followers, and also sometimes references YOGA products, I cannot attribute any particular portion of the activity specifically to the EU. Whilst the advertising spend referenced by Ms Williams is again high at approximately 8.6million GBP for a short period, this is provided

⁶ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

for a period of three months in 2019 only, and it is provided in respect of Europe in general, rather than in respect of the EU specifically.

32. That being said, Ms Williams states in her witness statement that products bearing the YOGA trade mark had been sold in every member state in the EU during the relevant time period, and the geographical extent of the use has been supported by way of the invoices provided including territories such as Germany, Denmark, Slovakia and Croatia, in addition to the evidence of stockists in the UK, France, Spain and Ireland referencing YOGA products. I do note however, that the invoices are limited in numbers, and the relevant invoices are also dated from 2019 only. However, I note that there is also evidence of the goods on sale in the EU territories between 2016 – 2019, coupled with Ms Williams' statement that the goods under the mark had been on sale consistently in the EU since 2012.

33. I have no evidence of the size of the EU market for the goods for which use has been shown, namely laptops and tablets, I have no doubt that this will be very large. Although no particular sales figures can be attributed to the mark in the EU only, the invoices provided do show large volumes sold in each transaction.

34. I also note the statements and evidence in respect of the marketing campaigns that took place in the EU during the relevant time. It is also my view that, considering the sum of the evidence, the reference to the large advertising spend for 'Europe' can at least partly be attributed to the territory of the EU, in addition to at least some of the significant sales figures within the EMEA, although it is not clear exactly how much, and I keep in mind the advertising spend only represents a short window in 2019. Considering the evidence as a whole, I consider this is sufficient to show that there has been real commercial use of the mark YOGA within the EU in respect of laptops and tablets, for the purpose creating [sic] and maintaining a market share, and that as such genuine use has been shown in this respect."

22. The findings of the original hearing officer in relation to genuine use were not appealed. In any event, they accord with my own view and I find that the opponent has demonstrated genuine use in relation to laptops and tablets.

23. I must now consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

24. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme

Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

25. The opponent's specification reads "computers, namely portable computers and tablet computers, including software and peripherals for use therewith". Given that the opponent has only demonstrated genuine use for laptops and tablet computers, both of which are categories of portable computers, it seems appropriate to me for the opponent to retain the broader term "portable computers". Clearly, the opponent can also retain the term "tablet computers", for which it has shown use. Consequently, I consider a fair specification to be:

Class 9 Portable computers and tablet computers.

Section 5(2)(b) – case law

26. 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

27. The competing goods and services are as follows:

Opponent's goods	Applicant's goods and services
<u>Class 9</u> Portable and tablet computers.	<u>Class 9</u> Video games [computer games] in the form of computer programs recorded on data carriers; Video games on disc [computer software]; Video games programs [computer software]; Video games software.

	<u>Class 38</u> Transmission of videos, movies, pictures, images, text, photos, games, user-generated content, audio content, and information via the Internet.
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28. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the 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.”

29. 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.

Video games [computer games] in the form of computer programs recorded on data carriers; Video games on disc [computer software]; Video games programs [computer software]; Video games software.

30. The nature of the goods will clearly differ to those covered by the opponent's specification. The method of use of the goods will also differ, as will the purpose. There may be an overlap in trade channels, as businesses specialising in computer goods may sell both games software and the computers on which they are used. The users of the goods will clearly overlap. I accept that there may be some complementarity, as the goods are clearly important or indispensable to each other. However, in my view, the average consumer is only likely to believe that they originate from a common undertaking in certain circumstances (such as where the opponent's goods are specifically targeted at the gaming market). Overall, I consider the goods to be similar to between a low and medium degree.

Transmission of videos, movies, pictures, images, text, photos, games, user-generated content, audio content, and information via the Internet.

31. The nature and method of use of the goods and services clearly differ. In my view, the goods and services do not overlap in purpose because the specific purpose of the opponent's goods is to enable to user to perform various tasks that require a computer, whereas the applicant's services are the transmission of content. There may be an overlap in user. In my view, there is no overlap in trade channels and, as it is a requirement for complementarity that the average consumer believe the goods/services originate from the same undertaking, there also cannot be complementarity. Consequently, any similarity is, in my view, low. However, I note that the original hearing officer found the similarity to be between low and medium. As this is the opponent's best case (compared to my view) and this finding was not appealed, I will carry out my assessment on that basis.

The average consumer and the nature of the purchasing process

32. As the above case law 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 (as he then was) 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.”

33. The original hearing officer found that the average consumer would include members of the general public and professional users. I agree. The opponent's goods may attract a reasonably high price point (although not the highest) and are unlikely to be purchased particularly frequently. Bearing this in mind, and the fact that the average consumer will take factors such as functionality, speed and storage into account, I consider that between a medium and high degree of attention will be paid during the purchasing process. The applicant's goods are likely to be lower in cost and purchased more frequently. However, various factors will be taken into account such as game experience, functionality and suitability for devices. I consider that a medium degree of attention will be paid during the purchasing process. The services are unlikely to attract a particularly high cost, if any, but factors such as type of content, ease of use and reliability are likely to be taken into account. I consider that a medium degree of attention will be paid during the purchasing process.

34. Both the goods and services are likely to be purchased following perusal of signage on websites and at physical premises. Consequently, visual considerations are likely to dominate the selection process. However, given that advice may be sought from retail assistants and word-of-mouth recommendations may be made, I do not discount an aural component.

Comparison of trade marks

35. 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 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.”

36. 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.

37. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
YOGA	Yoga Man

38. The opponent's trade mark consists of the word YOGA. There are no other elements to contribute to the overall impression, which lies in the word itself. The applicant's trade mark consists of the words YOGA MAN, in title case. The opponent submits as follows:

“12. The word MAN, on the other hand, will be perceived as a descriptive indication of the target consumer of the Contested Goods and Services. It is submitted that this will be the case for at least a significant proportion of the relevant public (if not all). When interpreted in this way, it is clear that the word MAN does not add to the distinctive character of the Contested Mark and is likely to go unnoticed by the average consumer.”

I recognise that there are some goods which are often broken down into gendered categories (such as cosmetics or clothing). However, I have no evidence before me to suggest that the goods in issue are sold as such and, in the absence of any such evidence or any basis for taking judicial notice of the same, I am unable to find that the word MAN would be seen as indicating a particular category of the goods by reference to the target consumer. In my view, the overall impression lies in the combination of these words, which form a unit, with neither word dominating.

39. Visually, the marks coincide in that the opponent's mark is replicated at the beginning of the applicant's mark. However, the addition of the word MAN in the applicant's mark acts as a point of visual difference. The marks are visually similar to between a medium and high degree.

40. Aurally, the marks coincide in the presence of the word YOGA, which will be articulated the same in both marks. The word MAN in the applicant's mark will be given

its ordinary English pronunciation, and will act as a point of aural difference. The marks are aurally similar to between a medium and high degree.

41. Conceptually, the opponent's trade mark will be understood to refer to the practice of yoga. The applicant's trade mark will be understood to refer to a man that practices yoga. The marks are conceptually similar to a medium degree, at best.

Distinctive character of the earlier trade mark

42. 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).”

43. 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 and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

44. The original hearing officer's findings on distinctive character were not appealed. She stated as follows:

“69. The earlier mark comprises the single English word YOGA. Whilst I note the opponent states this alludes to the flexibility of its goods, in that they may be used in a number of positions, I do not find this to be obvious from the mark alone, without reference to the opponent's wider marketing materials. As such I do not find the mark is allusive or descriptive of the goods inherently. In the context of the opponent's goods as registered, I find the mark to be inherently distinctive to a medium degree.

70. It is the distinctiveness of the mark to the UK consumer that is to be considered within this opposition. Although the opponent has filed evidence of use of its mark, the extent of its presence in the UK is unclear. Turnover and advertising spend for the UK alone are not provided. I note the existence of the marketing campaigns which took place in the UK, including those in London train stations, in addition to the goods being for sale on some UK websites, however, with consideration to the sum of the evidence, I do not find that this shows the distinctiveness of the earlier mark has been enhanced above its inherent level through the use of the same.”

45. This accords with my own view. Consequently, I consider the earlier mark to be inherently distinctive to a medium degree and the opponent has not demonstrated any enhanced distinctiveness through use.

Likelihood of confusion

46. 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 earlier mark, the nature of the purchasing process and the average consumer for the goods and services. 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.

47. I have found as follows:

- a) The goods and services are similar to between a low and medium degree (at best).
- b) The average consumer is a member of the general public or a professional user, who will pay a medium degree of attention or between a medium and high degree of attention during the purchasing process.
- c) The purchasing process will be predominantly visual, although I do not discount an aural component.
- d) The marks are visually and aurally similar to between a medium and high degree, and conceptually similar to a medium degree.
- e) The earlier mark is inherently distinctive to a medium (or average) degree.

48. Whilst I recognise that the marks are visually and aurally similar to between a medium and high degree, I consider it unlikely that they will be mistakenly recalled or misremembered as each other when factoring in the interdependency principle and the relatively low degree of similarity between the goods and services. This is

particularly the case given that the average consumer will be paying at least a medium degree of attention during the purchasing process and the marks are only conceptually similar to a medium degree (at best). I find there is no likelihood of direct confusion.

49. I will now consider whether there is indirect confusion. 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 that:

“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’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand

extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

50. These examples are, clearly, not intended to be an exhaustive list but illustrate some of the circumstances in which indirect confusion may arise. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor KC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

51. I have already explained above why I do not consider that the word MAN will be seen as a non-distinctive element being added to the earlier mark. The common element, YOGA, is inherently distinctive to a medium (or average) degree and the opponent has not demonstrated any enhanced distinctiveness through use. Consequently, I do not consider this to be a case where the common element is so strikingly distinctive that no other undertaking could be using it in relation to goods and services that are only similar to between a low and medium degree. In my view, the addition of the word MAN is not logical or consistent with a brand extension in the context of these particular goods and services, particularly given that it changes the meaning of the mark from one referring to a fitness practice to one referring to an individual (albeit one who engages with that practice). I can see no other basis for indirect confusion to occur. Consequently, I do not consider there to be a likelihood of indirect confusion.

CONCLUSION

52. The opposition is unsuccessful, and the application can proceed to registration.

COSTS

53. The applicant has been successful and would ordinarily be entitled to a contribution towards his costs. At all stages of these proceedings the applicant has been invited to claim his costs using a costs proforma, as he is unrepresented. However, no costs proformas have been filed. The most recent letter sent by the Registry to the applicant stated as follows:

“If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not 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.”

54. As no costs proforma has been filed and the applicant has not incurred any official fees, I make no order as to costs.

Dated this 12th day of May 2023

S WILSON

For the Registrar