

O/784/18

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3261802 BY
MATCHFIT CONDITIONING LIMITED**

TO REGISTER:



AS A TRADE MARK IN CLASS 41

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 411436 BY**

McFIT GLOBAL GROUP GMBH

Background and pleadings

1. Matchfit Conditioning Limited (“the applicant”) applied to register the trade mark shown below in the United Kingdom on 6 October 2017.



It was accepted and published in the Trade Marks Journal on 20 October 2017 in respect of the following services:

Class 41

Strength and conditioning training

2. The application was opposed 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”). The opposition concerns all services in the applicant’s specification.
3. The opponent is relying upon EU (formerly Community) Trade Mark No. 5673165: **McFit**. This mark was applied for on 26 January 2007 and registered on 20 December 2007 in respect of the following services:

Class 35

Advertising, business administration, business management.

Class 41

Providing sporting facilities, sports studios and sports camp, rental of sports equipment (except vehicles), organisation of sports competitions, entertainment.

Class 44

Solariums

For both grounds, the opponent is relying upon the services proper to Class 41.

4. The opponent claims that the marks are similar and that the services covered by the applicant's specification are the same as, or similar to, the services in Class 41 covered by the earlier mark, leading to a likelihood of confusion under section 5(2)(b) of the Act.
5. For section 5(3) of the Act, the opponent claims that use of the applicant's mark for the services in the application would take unfair advantage of the reputation of the earlier mark and cause detriment to the distinctive character of this mark. It states the mark has a reputation for all the services in Class 41 for which it is registered.
6. The applicant filed a defence and counterstatement, denying all the grounds.
7. Both the opponent and the applicant filed evidence in these proceedings. This will be summarised to the extent that is considered necessary. The opponent filed written submissions alongside its evidence on 15 May 2018 and 29 August 2018. No hearing was requested and only the applicant filed written submissions in lieu of a hearing, on 11 October 2018. The parties' submissions will not be summarised but will be referred to as and where appropriate during this decision, which has been taken following a careful perusal of the papers.
8. In these proceedings, the opponent is self-represented, and the applicant is represented by Graham Coles & Co.

Relevant dates

9. The opponent's earlier mark had been registered for more than five years on the date on which the contested application was published. It is, therefore, subject to the proof of use provisions under section 6A of the Act, and the applicant has requested such proof for services in Class 41. The opponent has stated that it has made genuine use of the marks in the EU, in the relevant period for all the services upon which it is relying. The relevant period for these purposes is the five years prior to and ending on the date of publication of the contested application: 21 October 2012 to 20 October 2017. The relevant date for the purposes of sections 5(2)(b) and 5(3) is the date the application was filed: 6 October 2017.

Evidence

10. The opponent's evidence in chief comes from Rainer Schaller, founder and Chief Executive Officer of McFIT Global Group GmbH. It is dated 7 May 2018. Some of the exhibits supporting Mr Schaller's witness statement have been translated by Tobias Arens. He has submitted a separate witness statement confirming that he is qualified to do so. This is also dated 7 May 2018.
11. The opponent operates gyms in a number of EU Member States. Its first gym opened in 1997 and Mr Schaller states that as of 30 June 2017 it was running 163 gyms in Germany. The opponent is also the proprietor of affiliates who run gyms under the opponent's mark in Austria, Spain, Italy and Poland. A list of the location of these gyms is provided in Exhibit MF3.

Member State	Number of Gyms on 30 June 2017
Austria	10
Italy	26
Poland	10
Spain	34

12. According to a newspaper article dated 25 July 2013 and supplied as Exhibit MF2, the opponent had an annual turnover of €236.5 million, 1.2 million customers and sees itself as “the number one in Europe”. The opponent’s Wikipedia entry, last modified on 11 April 2015, states that the chain has a “no-frills policy”, with membership at a relatively low cost, and no “wellness area or courses (e.g. Aerobics)” offered.¹
13. The opponent has entered into partnerships with sports nutrition company Qi² and clothing supplier Adidas, which have been promoted via email advertising to the opponent’s customers.²
14. The final exhibit, MF10, contains an extract from market research undertaken for the opponent by puls Marktforschung GmbH to evaluate the success of an advertising campaign. I shall consider this exhibit later in the decision.
15. The applicant submitted evidence in the form of a witness statement from Simon Coles, Chartered Trade Mark Attorney, and the applicant’s representative. The witness statement is dated 29 June 2018. This evidence deals with the pronunciation of the prefix “Mc-” and prompted further evidence from the opponent dated 29 August 2018. I will not summarise this material here but will consider it later in my decision.

Proof of Use

16. Section 6A of the Act states that:

“(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 –

¹ Exhibit MF4.

² See Exhibits MF7-MF9.

(a) within the period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

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

(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 Union.

(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.”

17. The case law on genuine use was summarised by Arnold J in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch):

“114. *The law with respect to genuine use.* 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 Radetzky-Orden v Bundersvereinigung Kameradschaft 'Feldmarschall Radetzky'* [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 [132].”

18. The onus is on the opponent, as the proprietor of the earlier mark, to show use. Section 100 of the Act states that:

“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.”

19. As the earlier mark is an EU Trade Mark, the relevant territory in which use is required to be shown is the European Union (section 6A(5) of the Act).

20. The applicant claims that the opponent has failed to prove use of the mark in the form registered: **McFit**. The exhibits show that the company has used the word “McFIT”, often in combination with a figurative device, on its signage and promotional material. I have reproduced some examples below:³



³ Images are taken from Exhibits MF2, MF7 and MF8.

Gehe zur [Online-Version](#), wenn diese E-Mail nicht richtig dargestellt wird.



[TRAINING](#)

[STUDIOS](#)

[FAQ](#)

Hallo [REDACTED],

gemeinsam mit unseren Partnern Qi² und adidas zeigen wir dir, wie du fit durch den Herbst kommst und dabei einfach gut aussiehst: Qi² unterstützt dich mit gezielter Sporternährung, adidas mit einem Trainingsschuh der besonderen Art. Darüber hinaus warten noch viele weitere Überraschungen auf dich – und auch auf deine Freunde.

DER McFIT-WEIHNACHTSGUTSCHEIN

**DAS GESCHENK
FÜR ALLE,
DIE NICHTS
GESCHENKT
WOLLEN.**
#DERWILLEINDIR

**2 MONATE TRAINING
FÜR 29,90 €**
Inklusive Aktivierung der Membercard

Mehr erfahren

Alle Jahre wieder! Der McFIT-Weihnachtsgutschein ist zurück – exklusiv für McFIT-Mitglieder und nur für kurze Zeit. Ab dem 20.11. in allen Studios oder auf [McFIT.com](#).



21. Use of a mark generally includes its use as part of a composite mark or in conjunction with another mark, as long as the registered mark continues to fulfil its function of indicating the origin of the goods or services: see *Colloseum Holdings AG v Levi Strauss & Co*, C-12/12, paragraphs 31-35 and the case law cited therein. The applicant also takes issue with the capitalisation of the final three letters in the mark as used. Professor Ruth Annand, sitting as the Appointed Person, in *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, stated that word mark registration protects the word written in any normal font and irrespective of capitalisation. Consequently, I do not accept the applicant's claim that the opponent has failed to use the mark in the form registered.
22. I must now consider whether the opponent has shown use of the earlier mark for the services upon which it seeks to rely: *Providing sporting facilities, sports studios and sports camp, rental of sports equipment (except vehicles), organisation of sports competitions, entertainment*.
23. The applicant submits that:
- “...the Opponent has not made it clear, with any precision, what specific use there has been. Furthermore, the ‘services of gyms, especially the use of the gym’s equipment (e.g. exercise machines, dumbbells)’ are much narrower in

scope than the services of the EUTM in Class 41 (although it is admitted that some of the latter services might conceivably include some of the former services) and the Opponent has provided no justification for their claim that the alleged narrow use should be considered to be use in relation to all the specified services.”

24. In *Property Renaissance Ltd (trading as Titanic Spa) v Stanley Dock Hotel Ltd (trading as Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Carr J summed up the law where use has been shown on some, but not all, goods and services in a specification:

“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.”⁴

25. The opponent’s evidence shows that it operates gyms. The promotional material indicates the presence of exercise equipment, such as running machines and weights. Training courses appear to be provided, not by an instructor present in the studio, but virtually, with the instructor appearing on a screen.⁵
26. Having identified the services that the opponent has provided under the mark, I must consider how the average consumer of those services would describe them. In this instance, the average consumer is a member of the general public who is interested in improving or maintaining his or her fitness, or a business providing gym membership as part of a package of employee benefits.
27. The specification contains several broad terms that, in my view, would not be used by the average consumer to describe the services shown to be provided. In *Awareness Limited v Plymouth City Council (Plymouth Life Centre)*, BL O/236/13, Mr Daniel Alexander QC, sitting as the Appointed Person, said:

“I ... suggest that, for the future, if a broad class, such as ‘tuition services’, is sought to be defended on the basis of narrow use within the category (such

⁴ Paragraph 47.

⁵ See Exhibit MF9.

as for classes of a particular kind) the evidence should not state that the mark has been used in relation to 'tuition services' even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted. Excising the unjustifiable is as much a part of the exercise of dotting the i's and crossing the t's of the evidence (referred to in *Laboratoires Goemar*) as is reinforcing the justified."⁶

28. I do not believe that the average consumer would use the word "Entertainment" to describe the services that are provided. This is a broad term that encompasses a wide range of very different activities, from theatrical performance to funfairs to sport. Based on the evidence submitted, it would not be fair to allow the opponent to rely on such a broad category.
29. The other terms in the specification all contain the word "sport" or a variant thereof. There is no evidence that the opponent has organised any sports competitions or provided sports camps, which consist of a supervised programme of sporting activities generally over a number of days. Neither does it appear to provide a rental service for sports equipment. Membership of a gym is not the same thing; rather, it is a contract to use the facilities. Availability of particular items of equipment is not guaranteed, as it would be under a rental contract. In my view, the opponent cannot rely on these terms.
30. "Sport" is a broad term, covering many different types of physical activity, requiring different facilities: swimming pools, dry ski slopes, squash courts, football pitches, to name but a few. It seems to me that the average consumer, when describing the opponent's services, would use the word "gym" and if they were to talk of a "sporting facility" or "sports studio" would be describing a place that could offer a

⁶ Paragraph 28.

variety of different activities. In my view, then, a fair specification to reflect the opponent's use of its mark is for the following services:

Providing sports facilities and sports studios, in the nature of gyms.

Decision

Section 5(2)(b) ground

31. Section 5(2)(b) of the Act states that:

“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.”

32. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the courts of the European Union in *SABEL BV v Puma AG* (C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (C-425/98), *Matratzen Concord GmbH v OHIM* (C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (C-334/05 P) and *Bimbo SA v OHIM* (C-519/12 P):

(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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone 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.

Comparison of services

33. When comparing the services, all relevant factors should be taken into account, per *Canon Kabushiki Kaisha*:

“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 complementary.”⁷

34. A further factor to be considered is the channels of trade of the respective goods or services: see the guidance given by Jacob J (as he was then) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281.

35. The services to be compared are shown in the table below:

Opponent’s services	Applicant’s services
<u>Class 41</u> Provision of sporting facilities and sports studios, in the nature of gyms.	<u>Class 41</u> Strength and conditioning training

⁷ Paragraph 23

36. When construing these terms, I must keep in mind the ordinary and natural meanings of the words, and neither interpret them so broadly that they lose all precision nor unnaturally narrow them: see *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) and *Avnet Incorporated v Isoact Limited* [1998] FSR 16.
37. The opponent's services relate to the provision of gym facilities. The applicant's service, on the other hand, is a form of training. This training may take place in a gym, but could also be given elsewhere. The users of the services are the same and their end purpose is highly similar: with strength and conditioning training, the aim is to improve or maintain fitness through making the body stronger and more toned. This is also an aim of the gym user, but it is not the only one: cardiovascular fitness is an important goal as well. The nature of the service and the trade channels may overlap: the strength and conditioning training could be provided by an instructor in a gym.
38. To my mind, the services have a degree of complementarity. The General Court clarified the meaning of "complementary" goods or services in *Boston Scientific Ltd v OHIM*, T-325/06:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."⁸

Strength and conditioning training requires some equipment and, as I have noted, often takes place within the environment of a gym and customers could reasonably expect both services to be provided by economically connected undertakings. Consequently, it is my view that *strength and conditioning training* is highly similar to the *provision of sporting facilities and sports studios, in the nature of gyms*.

⁸ Paragraph 82.

Average consumer and the purchasing act

39. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, I must bear in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: see *Lloyd Schuhfabrik Meyer*.

40. 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:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”⁹

41. The average consumer of the services in question is a member of the public. In addition, access to gyms may be procured by businesses for their staff as an employee benefit. Joining a gym tends to require a commitment to pay a monthly fee for a set period of time before the contract can be ended. Strength and conditioning training is also likely to involve a commitment to a relatively long-term relationship. These are not one-off purchases. In such circumstances, the average consumer can be expected to be paying an average level of attention.

42. The visual element will be important during the selection process. The consumer may search for websites, look at brochures, or visit premises. I do not ignore the aural element, as word-of-mouth recommendations may also play a part in influencing the consumer's choice.

⁹ Paragraph 60.

Comparison of marks

43. It is clear from *SABEL BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 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 in *Bimbo* that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”¹⁰

44. It would be wrong, therefore, artificially to dissect the 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 created by the marks.

45. The respective marks are shown below:

Earlier mark	Contested mark
McFit	 The logo for MatchFit Conditioning. It features a green circular icon with a white power symbol (⏻) above the word "MATCHFIT" in a bold, black, sans-serif font. Below "MATCHFIT" is the word "CONDITIONING" in a smaller, grey, spaced-out, sans-serif font.

¹⁰ Paragraph 34.

46. The applicant's mark consists of the words "MATCHFIT CONDITIONING" presented in capital letters and with the first word in a slightly stylised format and darker text. The letters "FIT" are in green. Above the words is a circular green device, containing white lines and a small circle. It is the word "MATCHFIT" which stands out most to the viewer, but the device also makes a contribution to the overall impression of the mark. The word "conditioning" will also play a role, although its position and the relative size and faintness of the letters make it a lesser one.
47. The opponent's mark consists of the word "McFit" presented in a standard font with no stylisation. The overall impression of the mark rests in the word itself.
48. The opponent claims that the marks have a high degree of visual similarity and considers that the differences in the marks are "of no consequence" and will be unnoticed by the average consumer. Its mark is a five-letter word, while the applicant's mark is made up of an 8- and a 12-letter word on separate lines, together with a circle that is green with white lines. Stylisation of these two words is limited to the second letter of "MATCHFIT", where the vertical line has been omitted. The green colour of the letters "FIT" emphasise this word, which is also found at the end of the opponent's mark. I find that the marks are visually similar, but only to a low degree.
49. Both the opponent and the applicant have made detailed submissions and provided evidence on the aural aspects of the marks. The first word in the applicant's mark would be articulated as "MATSH-FIT" and it is my view that the second word "CONDITIONING" would often not be said, particularly as this word alludes to the services provided by the applicant. Turning my attention to the earlier mark, I note that the opponent states that this will be articulated as "MAC-FIT", while the applicant argues it would be pronounced as "MUK-FIT". Both parties have provided extracts from websites and reference books in support of their position. What matters for the present purposes is how a UK average consumer would pronounce the syllable. The opponent has provided me with evidence from the *Collins Dictionary* (of the pronunciation in American English)

and websites with user-generated content, such as Wiktionary,¹¹ while the applicant has submitted entries from the *Oxford Dictionary of English*, *Merriam Webster Dictionary*, the *Collins Dictionary*, and the *Cambridge Dictionary*.¹² I find that the applicant's evidence is more persuasive. In most cases, a British-English speaker would not stress "MAC", but pronounce it as "MUK". Both marks as pronounced would have two syllables, begin with the same letter and end in "FIT". Consequently, I find that they are similar to a medium degree.

50. The opponent claims that the marks share a high conceptual similarity, on account of the presence in each of the marks of the word "FIT", which it states "will be ascribed by the relevant public with the meaning of 'fitness' and/or 'sports'". The applicant denies this claim, pointing to the other elements of its mark. The opponent's mark will bring to mind a Scottish surname, but it is unlikely that the average English-speaking consumer will believe that anyone genuinely has that name. The use of "Mc-" in a playful context is not uncommon: one needs only recall "Boaty McBoatface". To my mind, the opponent's mark would be seen as a (Scottish surnominal) play on the concept of "fitness".
51. The word "MATCHFIT" in the applicant's mark also brings to mind the concept of "fitness" and the word is often used to describe someone who has reached a level of fitness that would enable them to perform effectively in a competitive match. I must also consider the device. The opponent argues that this "will be perceived by the relevant public as a normal ball, which is only descriptive to sports relating services". The applicant notes that "the series of white lines and geometrical shapes contained within the device are not 'normal' markings for balls". I agree with the applicant here. The markings on the device more closely resemble markings on a sports playing field than they do any markings on balls. The use of green in the mark to my mind suggests an outside environment, reinforcing the message of the name: that this is strength and conditioning training to enable the customer to reach the right level of fitness to compete. What the marks have in common conceptually is fitness, but that is all. Consequently, I find them to be conceptually similar to a low degree.

¹¹ See Exhibits MF11-MF14.

¹² See Exhibits SC02 and SC03.

Distinctiveness of the earlier mark

52. There is, as has already been noted, a greater likelihood of confusion if the earlier mark is highly distinctive. The CJEU provided guidance on assessing a mark's distinctive character in *Lloyd Schuhfabrik Meyer*.

“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-0000, 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).”

53. The opponent claims that the earlier mark has enhanced distinctiveness owing to its reputation in Germany, Austria, Spain, Italy and Poland. All this use is outside the UK and consequently the opponent has not shown that the mark has acquired distinctive character in the UK by virtue of the use made of the mark. The likelihood of confusion is based upon the UK average consumer, therefore, I must only consider its inherent distinctiveness.

54. The earlier mark is an invented word in, as has already been noted, the form of a Scottish surname. Invented words are generally deemed to be relatively high in distinctiveness. However, I must also bear in mind that it is the distinctiveness of the common element that counts, as emphasised by Mr Iain Purvis QC, sitting as the Appointed Person, in *Kurt Geiger Limited v A-List Corporate Limited*, BL O/075/13:

“It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”¹³

The common element here is “FIT”, which is a dictionary word and alludes to the services provided under the mark. What gives the whole mark distinctiveness is the prefix “Mc-”. Overall, I find that the earlier mark has a medium level of distinctiveness.

Conclusions on likelihood of confusion

55. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred in paragraph [33]. I must also have regard to the interdependency principle, that a lesser degree of similarity between the services may be offset by a greater degree of similarity between the marks, and vice versa.¹⁴ The distinctiveness of the earlier mark must also be taken into account.

56. Such a global assessment does not imply an arithmetical exercise, where the factors are given a score and the result of a calculation reveals whether or not there is a likelihood of confusion. I must keep in mind the average consumer of the services and the nature of the purchasing process. I note that it is generally

¹³ Paragraph 39.

¹⁴ *Canon Kabushiki Kaisa*, paragraph 17.

accepted that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture he has kept in his mind.¹⁵

57. My key findings are as follows:

- The earlier mark has a medium degree of inherent distinctive character.
- Visually and conceptually, the marks are similar to a low degree; aurally, the marks are similar to a medium degree.
- The services have a high degree of similarity.
- The average consumer is a member of the public or a business wanting to provide employee benefits. The visual element will be most significant, and the consumer will be paying an average level of attention during the selection process.

58. There are two types of confusion: direct and indirect. These were explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10:

“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 recognised 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.’”¹⁶

¹⁵ *Lloyd Schuhfabrik Meyer*, paragraph 27.

¹⁶ Paragraph 16.

59. I shall deal first with direct confusion. Although I found the marks to have a low level of visual similarity, I must take account of the likelihood that the average consumer may only imperfectly recollect the marks. The General Court stated in *El Corte Inglés v OHIM*, Joined Cases T-183/02 and T-184/02, that:

“...it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word.”¹⁷

This is not a fixed rule. However, I found that the distinctive element of the earlier mark was the first syllable, which would also place greater emphasis on the beginning of the word. I also found that the device in the applicant's mark contributed to the overall impression of that mark. Taking these factors together, I find that there is no likelihood of direct confusion.

60. I turn to consider indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor QC, sitting 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 case, the syllable “FIT”. He pointed out that it is not sufficient that a mark calls to mind another mark; that is mere association, not indirect confusion. Instead, the average consumer must assume that the marks are owned by undertakings that are economically connected. The common element to both marks is a word that alludes to the services provided under the marks and that will in all likelihood be used by other undertakings offering those services, without the average consumer assuming there is an economic connection between any of them. The distinctiveness of the earlier mark derives from the prefix “Mc-”. I refer again to the decision of Mr Iain Purvis QC, in *Kurt Geiger Limited*. The distinctiveness of the element that is not shared reduces the likelihood of confusion.

61. The section 5(2)(b) ground falls.

¹⁷ Paragraph 83.

Section 5(3) ground

62. Section 5(3) of the Act states that 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 Community trade mark or international trade mark (EC), in the European Community) 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”.

63. The conditions of section 5(3) are cumulative:

- 1) The opponent must show that the earlier mark has a reputation.
- 2) The level of reputation and the similarities between the marks must be such as to cause the public to make a link between the marks.
- 3) One or more of three types of damage (unfair advantage, detriment to distinctive character or repute) will occur.

It is not necessary for the goods or services to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

64. The test for a qualifying reputation was set out by the CJEU in *General Motors v Yplon SA*, C-375/97:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

65. As the earlier mark is an EUTM, the relevant territory for an assessment of reputation is the EU. Earlier in this decision, in paragraph [11], I noted that the opponent ran over 200 gyms in EU Member States, including 163 in Germany. The opponent also provided the results of market research conducted with its target market (15-35 year olds) in Germany. Participants were asked which gyms came to mind first. There are three data points: 2010, 2012 and 2013. Unprompted recognition of the opponent’s mark increased from 55.2% to 67.2% since December 2012, following an advertising campaign.¹⁸ The CJEU has ruled that, depending on the facts of the case, the territory of a single Member State may be considered to constitute a substantial part of the territory of the EU: see *Pago International GmbH v Tirolmilch registrierte GmbH*, C-301/07. In my view, Germany would in this case be a substantial part of the territory of the EU. There is, in any event, use in other EU member states which supplements this. I find that the opponent has shown that it has a reputation in the EU.

66. My assessment of whether the public will make the required mental link between the marks must take account of all relevant factors. The CJEU identified these in *Intel Corporation Inc v CPM United Kingdom Limited* (C-252/07) as:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;

¹⁸ See Exhibit MF10.

- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use.

67. The applicant denies that the relevant public in the UK would make a link between its mark and that of the opponent and refers me to the CJEU's judgment in *Iron & Smith Kft v Unilever NV*, C-125/14:

"... if the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3) of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future."¹⁹

68. The opponent has not shown that it has any business in the UK or that any part of the relevant public in the UK may be familiar with the mark to be able to make the required mental link. There is no evidence to suggest that a commercially significant part of the UK public is familiar with the mark. For this reason alone, the Section 5(3) ground therefore falls. However, even if I had found that the opponent had a reputation in the UK, the differences between the marks would lead me to find that the public would not make a link between the marks.

¹⁹ Paragraph 34.

Conclusion

69. The opposition has failed. The application by Matchfit Conditioning Limited may proceed to registration in respect of all the services in the application.

Costs

70. The applicant has been successful. In the circumstances, I award the applicant the sum of £1000 as a contribution towards its costs. The sum is calculated as follows:

<i>Preparing a statement and considering the other side's statement</i>	<i>£200</i>
<i>Preparing evidence and considering and commenting on the other side's evidence</i>	<i>£500</i>
<i>Preparation of written submissions in lieu of a hearing</i>	<i>£300</i>
<i>Total</i>	<i>£1000</i>

71. I therefore order McFIT Global Group GmbH to pay Matchfit Conditioning Limited the sum of £1000. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of December 2018

Clare Boucher
For the Registrar,
Comptroller-General