

O-055-13

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2597124
BY MYTIME ACTIVE TO REGISTER THE FOLLOWING TRADE MARK IN
CLASSES 16 & 41:**



AND

OPPOSITION THERETO (NO 103240) BY ANYTIME FITNESS LLC

The background and the pleadings

1) Mytime Active (“Mytime”) filed application 2597124 on 4 October 2011. The application was published for opposition purposes on 20 January 2012. The mark and the class 16/41 goods/services for which registration is sought are:



Class 16: Indexed books for the recordal of information relating to fitness training; indexed books for the recordal of information relating to sports; periodical publications relating to sporting activity; printed publications relating to outdoor sporting activities; instructional charts for use in relation to exercise.

Class 41: Education services relating to physical fitness; educational services relating to physical fitness; exercise [fitness] advisory services; exercise [fitness] training services; health club [fitness] services; instruction courses relating to physical fitness; physical fitness centres (Operation of -); physical fitness education services; physical fitness instruction; physical fitness instruction for adults and children; physical fitness training services; physical fitness tuition; provision of educational services relating to fitness; training services relating to fitness; tuition in physical fitness; booking of exercise facilities; Conducting classes in exercise; exercise classes; exercise instruction; health club services [exercise]; instruction in group exercise; provision of apparatus for exercise; provision of educational services relating to exercise; provision of exercise facilities; provision of facilities for group exercise; provision of health club [physical exercise] facilities; provision of instruction relating to exercise; services for the provision of exercise; services for the provision of exercise equipment; supervision of physical exercise; gym activity classes; gymnasium club services; gymnasium facilities (Provision of -); gymnasium services; gymnasium services relating to body building; gymnasium services relating to weight training; gymnastic instruction; gymnastics (Instruction in -); gymnastics displays (Organising of -); gymnastics events (Organising of -); gymnastics instruction; instruction in gymnastics; organising gymnastics events; organising of gymnastic displays; provision of gymnasium facilities; provision of gymnastic instruction; rental of equipment for use at gymnastic events; tuition in gymnastics.

2) Anytime Fitness, LLC (“Anytime”) opposes the registration of the above mark. Its opposition was filed on 19 April 2012 and is based on a ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Anytime rely on two trade marks of which it is the proprietor, as follows:

International registration (“IR”) 937323 which designated the EU for protection on 11 September 2011; the mark and the services for which it is protected are:

ANYTIME FITNESS

Class 41: Health and fitness club services

A disclaimer is recorded in the International Register in respect of the word FITNESS.

IR 1062821 which designated the EU for protection on 22 December 2010; the mark and the services for which it is protected are:



Class 41: Health and fitness club services, namely providing facilities, instruction and equipment in the field of physical exercise and fitness.

3) Both of Anytime’s marks designated the EU for protection before the filing date of the applied for mark (and there are no relevant priority claims that affect the position). This means that Anytime’s marks constitute earlier marks as defined by section 6 of the Act. Furthermore, given that protection had not even been designated more than five years prior to the publication of Mytime’s mark, the earlier marks are not subject to the proof of use provisions set out in section 6A of the Act; there is no dispute about this.

4) Mytime filed a counterstatement denying the grounds of opposition. It makes various arguments based primarily on the differences between the marks. Only Anytime filed evidence. Neither party requested a hearing. Anytime filed submissions in lieu of attending a hearing. Although Mytime did not file written submissions, its counterstatement contains detailed arguments which will be borne in mind.

Anytime’s evidence

5) This consists of a witness statement from Ms Catherine Wiseman, a trade mark attorney working for Barker Brettell, Anytime’s representatives in this matter. One part of Ms Wiseman’s evidence is to furnish the results of a straw

poll of 7 attorneys working at Barker Brettell. This evidence will be given no weight for the following reasons:

- i) Trade mark attorneys, given their job, can hardly be said to be representative of the average consumer.
- ii) The straw-poll is statistically irrelevant.
- iii) The question asked was whether the marks are similar for identical services. Whether two marks are similar is not dependant on whether the services are identical. If the attorneys were commenting on whether there was a likelihood of confusion then they do not appear to have considered the nature of the actual goods/services in question and the nature of the selection process involved.

6) The remainder of Ms Wiseman's evidence consists of Internet prints showing how Anytime uses its marks in practice, which includes use in the colour purple and wording in white on a purple background. The colour involved can be seen in the following example of the use of Anytime's figurative mark:



Section 5(2)(b)

7) Section 5(2)(b) of the Act reads:

“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.”

8) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the

Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 great 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The average consumer

9) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, vary depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). Both sides' specifications focus on fitness type service including the provision of fitness classes and gymnasiums. Mytime's specification also includes goods in Class 16 which relate to fitness such as publications, instructional charts and indexing books for recording fitness information. The average consumer is a member of the general public. In terms of the services, I do not consider that the selection of an appropriate service provider is a casual process. However neither is it likely to be a highly considered process. Therefore, whilst some care will be taken to ensure, for example, that a gym possesses the required facilities, or that a fitness class is suitable for the individual, the degree is essentially a reasonable one, not materially higher or lower than the norm. In terms of the goods, the same applies – whilst publications, for example, may strike one as a fairly casual purchase, the consumer will still consider what is on offer and what the publication (or other goods) is offering and whether it is suitable for the individual's needs. There may be slightly less care and attention involved than the services, but still not materially lower than the norm.

10) In terms of the selection process, I consider that this will be predominantly a visual act, selecting the goods from a shelf or a online equivalent, and, in respect of the services, selection after perusal of brochures, websites etc. Aural similarity will not though be ignored from the assessment.

The distinctiveness of the earlier mark

11) The degree of distinctiveness of the earlier mark(s) must be assessed. This is because the more distinctive the earlier mark(s) (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). Anytime's evidence contains nothing to indicate the significance of its business in the UK before the relevant date – all it has filed are examples of its actual use with no historical relevance or detail. Although it tried to slip some facts into its written submissions, this does not count as evidence and, in any event, it still lacks real detail. The earlier marks are not entitled to an enhanced degree of distinctive character so, therefore, I have only their inherent characteristics to consider.

12) The word mark ANYTIME FITNESS is not a strong mark. It is suggestive of a fitness based service which may be provided at any time. The earlier mark must be assumed to possess some distinctive character¹. In my view, it is a mark possessed of a low degree of distinctiveness. In relation to the earlier figurative mark, the device element and the overall presentation adds some distinctiveness. The device element is, though, not highly distinctive. Whilst there is no evidence directed at this from either party (despite Anytime, again, trying to slip some in in its written submissions), such devices clearly have allusive qualities. The earlier figurative mark is a mark possessed of no more than an average degree of distinctive character.

Comparison of goods/services

13) When making the comparison, all relevant factors relating to the goods in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“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.”

14) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(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;

¹ See Case C-196/11 P, *Formula One Licensing BV v OHIM, Global Sports Media Ltd*

(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.”

15) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

16) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”² and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning³.

17) Mytime seeks registration in respect of:

Class 16: Indexed books for the recordal of information relating to fitness training; indexed books for the recordal of information relating to sports; periodical publications relating to sporting activity; printed publications relating to outdoor sporting activities; instructional charts for use in relation to exercise.

Class 41: Education services relating to physical fitness; educational services relating to physical fitness; exercise [fitness] advisory services; exercise [fitness] training services; health club [fitness] services; instruction courses relating to physical fitness; physical fitness centres

² See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

³ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

(Operation of-); physical fitness education services; physical fitness instruction; physical fitness instruction for adults and children; physical fitness training services; physical fitness tuition; provision of educational services relating to fitness; training services relating to fitness; tuition in physical fitness; booking of exercise facilities; Conducting classes in exercise; exercise classes; exercise instruction; health club services [exercise]; instruction in group exercise; provision of apparatus for exercise; provision of educational services relating to exercise; provision of exercise facilities; provision of facilities for group exercise; provision of health club [physical exercise] facilities; provision of instruction relating to exercise; services for the provision of exercise; services for the provision of exercise equipment; supervision of physical exercise; gym activity classes; gymnasium club services; gymnasium facilities (Provision of -); gymnasium services; gymnasium services relating to body building; gymnasium services relating to weight training; gymnastic instruction; gymnastics (Instruction in -); gymnastics displays (Organising of -); gymnastics events (Organising of -); gymnastics instruction; instruction in gymnastics; organising gymnastics events; organising of gymnastic displays; provision of gymnasium facilities; provision of gymnastic instruction; rental of equipment for use at gymnastic events; tuition in gymnastics

18) Anytime's services are:

Health and fitness club services (IR 937323)

Health and fitness club services, namely providing facilities, instruction and equipment in the field of physical exercise and fitness (IR 1062821).

19) In relation to the services of the applied for mark, they are, effectively, all for providing of health and fitness facilities and health and fitness training. This appears to me to fall within the ambit of the services of the earlier marks and, therefore, the services are considered identical. If there are any differences then it must be wafer thin and the services would nevertheless be highly similar.

20) In relation to the goods of the applied for mark, the goods are similar in that they are intended to facilitate exercise. There could be a competitive relationship because a consumer may choose to purchase a publication or chart which instructs on how to exercise rather than attend an exercise class. The nature and methods of use differ, as do the trade channels. I consider the goods to possess a reasonable (neither high nor low) degree of similarity to the services of the earlier marks.

Comparison of the marks

21) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:



v



and **ANYTIME FITNESS**

22) The dominant and distinctive element of the word mark ANYTIME FITNESS are the words themselves. They hang together so they are not individual components. Nevertheless, given the relevance of the word FITNESS to the services for which the mark is protected, more focus will be placed on the word ANYTIME. The same applies to the figurative ANYTIME FITNESS mark, at least in terms of its verbal element; the device component is a further dominant and distinctive element, although, when considered as whole, the words are more dominant than the device. In relation to Mytime's mark, the words also hang together, but, again, despite fitness being in larger font, the word MYTIME will have more focus; the device component is a further dominant and distinctive element, although, when considered as whole, the words are more dominant than the device. Despite my finding that more focus will be placed upon the MYTIME/ANYTIME aspects, it is still, as Anytime submit, a whole mark comparison that is to be made.

23) From a visual perspective, and comparing the two figurative marks in the first instance, both have their verbal elements one above the other. One of those verbal elements is the same (FITNESS) and in relation to the other verbal elements (MYTIME/ANYTIME) there are some coincidences in relation to the make-up of those words. For example, both end in -YTIME, and, as argued by Anytime, there is a degree (but not a high one in the context of the marks compared) of similarity in the preceding letters N/M. There is a further similarity in that both marks also contain a stylized person. There are, though, some differences - the letter A in ANYTIME, the fact that the device elements look different (despite being stylised persons) and that they are positioned on different sides of the words. The earlier mark is presented in upper case whereas the

applied for mark is in lower case, although I do not consider that this difference should be overplayed. There is also a difference created by the stylisation of the earlier mark which gives it a somewhat different look. These visual similarities and differences push and pull against each other. I consider the net effect to be that the marks are visually similar but only to a moderate level.

24) Both sides mention colour in their submissions/counterstatement. Mytime highlights the colour in its mark as, presumably, something that may assist in distinguishing. Anytime highlights in its evidence that its mark is actually used in a purple colour, as depicted earlier. The earlier marks are not protected with regard to colour. The colours actually used by Anytime are borne in mind, but although it can be described as a purple colour, it is not that similar to the colour of the applied for mark. However, this does not mean that the colour of the applied for mark serves as a distinguishing feature. As was stated by the Court of Appeal in *Specsavers International Healthcare Ltd, Specsavers BV, Specsavers Optical Group Ltd and Specsavers Optical Superstores Ltd v Asda Stores Ltd* [2012] EWCA Civ 24 a mark registered in black and white is, effectively, capable of being used in any colour.

25) In relation to the visual comparison of the applied for mark with the word mark ANYTIME FITNESS, this comparison is similar to that already made albeit some of the differences and similarities mentioned above are not applicable. Nevertheless, I also consider this mark to be visually similar but, again, only to a moderate level.

26) From an aural perspective, the comparison is the same for each earlier mark as the verbal elements are the same. There are some similarities based on the overall construction of the words ANYTIME FITNESS/MYTIME FITNESS, and that they both contain -TIME FITNESS in their respective articulations. However, I agree with Mytime that the different first syllables ANY-/MY- create a reasonably acute difference. I do not agree with Anytime who submitted that such a difference is less noticeable because the letters are “soft”. I consider there to be only a low degree of aural similarity.

27) In terms of concept, ANYTIME FITNESS will form a conceptual hook based on fitness services that may be used at any time. Although TIME is also a feature of MYTIME FITNESS, the true conceptual significance differs. As has been stated many times by the courts, conceptual differences may have a counteractive effect on the other aspects of similarity (see, for example, Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-643). However, I will, of course, bear in mind that conceptual differences do not always succeed in having a counteractive effect (see the GC’s judgment in *Nokia Oyj v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-460/07).

Likelihood of confusion

28) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

29) The earlier word mark is low in distinctiveness, the earlier figurative mark is averagely distinct. There are some visual and aural similarities as assessed earlier, but also some differences. I have found the conceptual hooks to be different. I have assessed the average consumer as being a member of the general public and that a reasonable (no higher or lower than the norm) degree of care and attention will be used when selecting the goods/services in question. I must bear in mind the concept of imperfect recollection and, as Anytime submit, the interdependency principle (which is particularly relevant given that at least the services are identical). Having weighed all these factors, my view is that the average consumer, when adopting a reasonable degree of care and consideration, will be able to identify the differences between the ANYTIME and MYTIME aspects of the marks notwithstanding the other similarities from the marks as a whole. The differences stand out sufficiently enough. I do not consider that MYTIME or ANYTIME, which will be the primary focus of the respective marks, will be imperfectly recalled as each other. **I do not consider that there is a likelihood of direct confusion.** In relation to indirect confusion (where the differences are noticed but the similarities are put down to the same or an economically linked undertaking being responsible for the goods/services), I see no reason, once the average consumer has noted the differences between the marks (particularly the difference between MYTIME/ANYTIME), for the remaining similarities to be put down to a same stable assumption. **There is no likelihood of indirect confusion.**

30) The opposition is rejected.

Costs

31) Mytime has been successful and is entitled to a contribution towards its costs. I hereby order Anytime Fitness LLP to pay Mytime Active the sum of £600. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£350

Considering (but not filing) evidence
£250

32) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 1st day of February 2013

**Oliver Morris
For the Registrar,
The Comptroller-General**