

O-088-18

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3161115,
BY TELEGRAPH MEDIA GROUP LIMITED
TO REGISTER THE TRADE MARK**

BE:FIT

IN CLASSES 5, 9, 16, 25, 32, 35, 36, 41, 43 & 44

&

**IN THE MATTER OF APPLICATION No. 3161117,
BY TELEGRAPH MEDIA GROUP LIMITED
TO REGISTER THE TRADE MARK**

BE:FIT LONDON

IN CLASSES 9, 16, 25, 35, 36, 38, 41, 42, 43 & 44

&

**IN THE MATTER OF APPLICATION No. 3161373,
BY TELEGRAPH MEDIA GROUP LIMITED
TO REGISTER THE TRADE MARK**



IN CLASSES 9, 16, 25, 35, 38 41, 42, 43 & 44

AND

**IN THE MATTER OF OPPOSITIONS THERETO
UNDER Nos. 407326, 407328 & 408230 BY
LIONS GATE ENTERTAINMENT INC.**

BACKGROUND

1) On 24 and 25 April 2016 Telegraph Media Group Limited (hereinafter the applicant) applied to register the three trade marks BE:FIT, BE:FIT LONDON and the device mark shown on the front cover above in respect of the following goods and services:

Class 9: Electronic publications; downloadable publications; downloadable audio-visual recordings; downloadable audio files; downloadable image files; computer software; application software; personal information management software; audio and video recordings; podcasts; recorded DVD's and CD's; electronic tags and sensing and checking apparatus therefor.

Class 16: Printed matter; printed publications; printed periodical publications; journals; magazines; directories; supplements; event programmes; teaching and instructional materials; books; booklets; manuals; calendars; diaries; photographs; certificates; vouchers; stationery.

Class 25: Clothing; headgear; footwear.

Class 35: Market research; marketing; event marketing; advertising and promotional services; compilation of directories; operation and supervision of incentive and loyalty schemes; organisation of exhibitions and trade fairs for commercial and advertising purposes; the bringing together for the benefit of other of a variety of goods enabling customers to conveniently view and purchase those goods, namely clothing, headgear, footwear, protective sporting clothing, headgear, footwear, nutritional and dietary supplements, food and drink, fitness, exercise and sporting equipment and accessories.

Class 36: Insurance services; financial advisory services; issuing of tokens of value in relation to incentive and loyalty schemes; issuing of vouchers.

Class 41: Education; providing of training; entertainment; cultural and sporting activities; arranging and conducting of events, seminars, conferences, conventions; workshops, exhibitions, shows and events for educational, entertainment and cultural purposes; organisation and arrangement of sporting events, exhibitions, and parties; prize draws; organisation of competitions and awards; organisation of live entertainment events, live performances and participation events; publishing services; providing on-line publications (non-downloadable);

provision of non-downloadable electronic journals; production and presentation of radio and television programmes; production, presentation and distribution of audio, video, still and moving images and text; educational demonstrations; demonstrations for entertainment purposes; instructional services relating to fitness, physical exercise, physical rehabilitation, diet, nutrition, health and beauty; fitness training; conducting fitness classes; fitness club services; running club services; sports club services; providing contest and incentive award programs designed to recognize, reward and encourage individuals and groups which engage in health and fitness.

Class 43: Providing food and drink; restaurant, bar and catering services; café services; snack bar and canteen services; organisation and conducting supper clubs; advisory and information services relating to restaurants and holiday accommodation; providing information relating to cooking; cookery demonstrations.

Class 44: Information, advisory and consultancy services relating to health and fitness; health assessment; dietary management and nutrition advisory and consultation services; slimming advisory and consultancy services; beauty services; beauty treatments; health and beauty salon and spa services; massage services; hair styling services.

2) In addition to the above goods and services the applicant sought to register its mark 3161115 BE:FIT in respect of the following goods and services:

Class 5 Dietary supplements; nutritional supplements; vitamins, minerals and food supplements; medical dressings, coverings and applicators; plasters.

Class 32: Mineral and aerated waters; non-alcoholic drinks; energy drinks; isotonic, hypertonic and hypotonic drinks; fruit drinks and fruit juices; syrups for making beverages.

3) In addition to the goods and services at paragraph 1 above the applicant sought to register its marks 3161117 BE:FIT LONDON and 3161373 device mark in respect of the following goods and services:

Class 38: Telecommunication services; communication services; transmission of sound and/or images; photo sharing and video sharing services ; chat room services; chat room services for social networking; e-mail and instant messaging services; providing online forums; electronic

bulletin boards for transmission of messages among users; communication by online blogs; broadcasting services; providing access to non-downloadable computer software programmes.

Class 42: Scientific and technological services and research and design relating thereto; design and development of computer software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services.

4) The applications were examined and accepted, and subsequently published for opposition purposes on 3 June 2016 in Trade Marks Journal No.2016/023.

5) On 5 September 2016 Lions Gate Entertainment Inc. (hereinafter the opponent) filed notices of opposition. The opponent is the proprietor of trade mark EU 14744171, LIONSGATE BEFIT. The mark was filed on 29.10.15 and registered on 10.02.17 in respect of the following goods and services:

- Class 5: Dietary supplements; nutritional supplements; food supplements; medicated treated muscle soaks; muscle relaxants; powdered nutritional supplement drink mix; powdered nutritional dietary drink mix; vitamins; pharmaceutical preparations for treating sports injuries.
- Class 9: Wearable computers; downloadable, non-downloadable, interactive and networked software, files and applications for computers, multi-function hand-held computers, electronic personal organizers, e-readers, tablet computers, personal audio players, personal electronic entertainment devices, game consoles and mobile phones; downloadable, non-downloadable, interactive and networked software, files and applications for computers, multi-function hand-held computers, electronic personal organizers, e-readers, tablet computers, personal audio players, personal electronic entertainment devices, game consoles and mobile phones and relating to sports, exercise, working out, fitness, motivation, coaching, competitions, celebrities, sports figures, tournaments, live events, televised events, health, diet, nutrition; downloadable, non-downloadable, interactive and networked software, files and applications for computers, multi-function hand-held computers, electronic personal organizers, e-readers, tablet computers, personal audio players, personal electronic entertainment devices, game consoles and mobile phones and relating to sports training, exercise, ticket sales, merchandise sales, education, coaching, motivation, health, nutrition, diet, sports events, exercise, fitness,

navigation; computer software; magnetic data carriers, audio CDs; compact discs, DVDs and other digital information carrying mediums, including with recordings; video games; video game discs, video game software; downloadable video games and video game software; coaching and teaching apparatus; downloadable digital animations and moving images; downloadable digital media and computer files being music files, video files, audiovisual files, text messages, video messages, musical messages and multimedia messages; downloadable digital educational media; electronic publications and downloadable electronic publications; interactive data media; podcasts; broadcasting apparatus and equipment; apparatus for recording, transmission or reproduction of sound and/or images; communications and telecommunications apparatus; computers; multi-media recordings and publications; electronic sports aids and electronic sports coaching aids being scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus; monitors and electronic monitors for measuring and recording events; electronic heart rate and electronic respiratory monitors (non-medical), swimming stroke counters; electronic timers; digital music players; eyewear for sport; earplugs for sports; nose clips for sports; life buoys; life belts; breathing apparatus to facilitate cardiovascular activity, not for artificial respiration; life-saving apparatus and equipment; teaching apparatus and instruments; headphones and ear buds; headphones and ear buds for sports; fitness tracker computers; helmets; crash helmets; sports helmets; cycling helmets; sports goggles, sports glasses, sports lenses for eyes; eye protection and eye protection for sports; eyewear with in-built computers; eyewear with built-on cameras; protective visors; protective face shields not for sport, athletics or cycling; protective face masks not for sport, athletics, or cycling; contact lenses, spectacles, eyeglasses, sunglasses, eyewear and their frames, cases, chains and lenses; cameras; portable cameras; sport cameras; camera mounts; camera mounts for sports; camera hoods, straps, slings, timers, view finders, flashes, filters, stands, cases; pre-recorded cds and dvds; audio/visual recordings featuring exercises, workouts, exercise programs, and information relating to exercise and well-being; kits comprising DVDs featuring exercises, workouts, exercise programs, and information relating to exercise and wellbeing, and workout plans, journals, nutritional guides and fitness tips; Downloadable audiovisual recordings featuring exercises, workouts, exercise programs, and information relating to exercise and well-being; downloadable electronic publications in the nature of journals, calendars, and guides in the field of fitness and nutrition; downloadable applications for mobile phones featuring exercises, workouts, exercise programs, and information relating to exercise and well-being; Computer application software for mobile

phones featuring exercises, workouts, exercise programs, and information relating to exercise and well-being; downloadable video recordings featuring exercise programs and exercises; pre-recorded electronic media featuring audio and video and exercises and exercise programs; photographic stills and artwork downloadable via the internet and mobile devices in the fields of fitness and nutrition; audio-visual recordings featuring exercises, workouts, exercise programs, and information relating to exercise and well-being; instructional yoga DVDs.

- Class 25: Clothing, footwear, headgear; clothing, footwear and headgear for sport; sportswear; exercisewear; infantwear, jackets, jerseys, loungewear, pants, sleepwear, scarves, shirts, socks, sweatshirts, sweatpants, t-shirts, tank tops, and undergarments; aprons; belts; costumes for Halloween or for use in role-playing games; footwear; headwear; mittens or gloves; and wristbands (clothing) made of cloth, leather, or imitation leather; clothing for yoga and pilates.
- Class 28: Sporting articles and equipment; sporting articles and equipment, namely exercise articles and apparatus; sporting articles and equipment, namely gymnastic articles and apparatus; toy sporting apparatus; fitness articles and apparatus; sporting articles and apparatus; fitness exercise machines; body toning, building and training apparatus; bathing floats; protective face shields and protective face masks for sports, exercise and athletics; protective pads and padding for sports, exercise and athletics; athletic protective pads for sports and athletics; exercise equipment and sporting goods, namely, exercise balls, ball chairs, foam yoga blocks, exercise rings, yoga straps, dumbbells and free weights, toning balls, push up bars, twist and balance boards and discs, mini trampolines, skipping ropes, aerobic steps, resistance cords, yoga and Pilates bands, abdominal exercise rolling devices, Pilates and exercise rings, exercise foam rollers; exercise equipment and sporting goods, namely, exercise sliders, exercise gliders, exercise discs, exercise training belts, weight lifting training belts, balance pads, carrying case for yoga mats, straps used for carrying yoga mats, hand and foot pumps especially adapted for use with balls for fitness, stress balls for hand exercise, and yoga kits comprised primarily of a yoga mat, foam blocks, yoga strap and carry bag.
- Class 38: Audio, video and multimedia broadcasting via the internet and other communications networks; webcasting services; transmission of messages, data and content via the Internet and other communications networks; providing online forums and chat rooms for the transmission of messages, comments and multimedia content among users in the field of

general interest via the Internet and other communications networks; transmission of electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, audio content, and information via the Internet and other communications networks; messaging services; providing downloadable ring tones, music, multimedia, audiovisual media, MP3s, graphics, games, videos, images and information for wireless mobile communication devices; providing wireless transmission of uploading ring tones, voice, music, multimedia, audiovisual media, MP3s, graphics, games, videos, images via a global computer network to a wireless mobile communication device; sending and receiving voice, sound, image, audiovisual, multimedia and text messages between communication devices; news agency services; internet portal services; provision of information, advisory and consultancy services in relation to the aforementioned services. Audio, video and multimedia broadcasting via the internet and other communications networks; webcasting services; transmission of messages, data and content via the Internet and other communications networks; providing online forums and chat rooms for the transmission of messages, comments and multimedia content among users in the field of general interest via the Internet and other communications networks; transmission of electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, audio content, and information via the Internet and other communications networks; messaging services; providing downloadable ring tones, music, multimedia, audiovisual media, MP3s, graphics, games, videos, images and information for wireless mobile communication devices; providing wireless transmission of uploading ring tones, voice, music, multimedia, audiovisual media, MP3s, graphics, games, videos, images via a global computer network to a wireless mobile communication device; sending and receiving voice, sound, image, audiovisual, multimedia and text messages between communication devices; news agency services; internet portal services; provision of information, advisory and consultancy services in relation to the aforementioned services.

- Class 41: Entertainment services; education and training services; cultural activities; sports; sports and fitness; sports tournaments; extreme sports; rental of athletic equipment; providing facilities for sports, athletic and awards events and competitions; sports, fitness and physical training refereeing, officiating, training, tuition, coaching, information, instruction, clubs, camps, facilities; booking of events and competitions, tickets and seats for events and competitions; gyms; provision of gym facilities; provision of exercise facilities; provision of track and field and cycling facilities; training services relating to sports, cycling, health and fitness; health club services; gym services; organisation and conducting of races; provision of advisory,

consultancy and information services relating to the aforementioned services; video and film entertainment services; producing video compilations; selection and compilation of video and sound recordings; arranging and conducting colloquiums, exhibitions, concerts, entertainment events, conferences, congresses, seminars, symposiums, festivals, fairs (being fairs for entertainment, cultural, educational, sporting and/or learning purposes); shows, workshops, fashion shows and contests; scriptwriting services; news reporter services; entertainment by way of pre-recorded messages and video messages; music, video and media recording, recording studio, and production services; publication and publishing services, including online and over the internet; cinema presentations; disc jockey and dj services; organizing, producing, arranging and curating entertainment, recreational, educational, sports, athletic and cultural events; game shows, reality shows; provision of games and competitions; games equipment rental; games offered on-line and from a computer network; gambling services and betting services; entertainment services being provision of virtual or online environments within which users can interact for recreational, competition, gaming, leisure or entertainment purposes; entertainment services provided by way of blogs and online forums; entertainment services provided by way of podcasts; provision of web based programmes for mobile communications devices, being nondownloadable media, multimedia, audiovisual media, games and publications; entertainment services by way of music and media provided through the internet or mobile telephone communication; entertainment services on social networking websites; the provision of on-line electronic publications and digital music (not downloadable) from the Internet; production, preparation, exhibition, distribution and rental of video, audio, audiovisual and radio programmes and of films, animated films, sound and video recordings and live events, including through interactive media, including on the internet; provision of recreational and entertainment facilities; creation of formats for media, television, music and video; providing digital music (not downloadable) supplied from MP3 websites on the Internet; fan club services; providing digital music (not downloadable) from MP3 Internet websites; booking agencies; text, image, sound and video editing services; music, video and photographic composition services; provision of sports and entertainment information through podcasting; providing information and news via a global computer network to a wireless mobile communication device; video recording, taping, editing, production, exhibition; advisory and consultancy services relating to the aforementioned services.

- Class 42: Providing a website featuring non-downloadable software that enables a community of users to post, search, watch, share, critique, rate, and comment on, videos and other

multimedia content via the Internet and other communications networks; internet search engine services; provision of downloadable software; provision of space on the internet for online video, web logs, blogs, and user-generated content; hosting of online media; providing an online website for creating and hosting micro websites; hosting online video platforms and channels; technical maintenance and updating of online video platforms and channels; hosting digital content; design, drawing and commissioned writing for compilation of websites; online provision of web-based applications and software; software-as-service services; research and analysis services, and sociological research and analysis services; new product research and testing; designing, managing and monitoring online forums for discussion; provision of information, advisory and consultancy services in relation to the aforesaid services.

6) The opponent contends that its mark and the marks applied for are very similar as they all have the element "BEFIT" within them. They also contend that the goods and services applied for are similar to the goods and services for which the earlier mark is registered. As such the marks in suit offend against Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent also contends that it has, since January 2012, made substantial use of its earlier mark in the UK, and has marketed and promoted its mark and has acquired reputation and goodwill in its mark such that use of the marks in suit will dilute its mark, free ride on its marketing and cause misrepresentation which will affect the economic behaviour of consumers. It also contends that, in addition to its registered mark, it has used the mark BEFIT and relies upon this unregistered mark under its section 5(4)(a) claim. The marks in suit therefore offend against section 5(3) and 5(4)(a) of the Trade Marks Act 1994. The opponent also claims that its mark enjoys protection under section 56 of the Act.

7) On 7 November 2016 the applicant filed counterstatements, basically denying that the marks are similar and stating that a large number of goods and services for which it seeks registration are in completely different classes to those of the opponent's mark. Whilst it acknowledges that being in different classes is not determinative of whether goods and services are similar it points out that the opponent has failed identify which of the goods and services for which its earlier mark is registered it believes are similar to the goods and services applied for and the reasons why the opponent holds this view. It also contests that the opponent's mark has reputation and goodwill.

8) Both parties filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 11 January 2018 when Mr Tritton of Counsel instructed by Messrs Squire Patton Boggs

(UK) LLP represented the applicant; the opponent chose not to attend, although they did provide skeleton arguments which I shall refer to as and when required.

OPPONENT'S EVIDENCE

9) The opponent filed a witness statement, dated 18 April 2017, by Aaron Newell the opponent's Trade Mark Attorney. He states that he has represented the opponent in previous trade mark disputes and provides at exhibit AN1 a copy of a witness statement provided by Ms Tahndi Campbell, the Executive Director of the opponent company. Mr Newell states that in order to save money he is simply refileing this witness statement in the instant case. In addition, he has filed a number of exhibits which he states existed at 26 April 2016 and which he describes as "relevant to the UK market". He provides the following exhibits:

- UK1: This consists of a witness statement, dated 22 April 2016, by Tahndi Campbell, an executive Director of the opponent a position she has held for one year, having worked with the BEFIT brand for five years. She states that she monitors the 24 Youtube channels that the company owns that fall under the BEFIT brand. Attached to the statement are a set of pages referred to as "analytics" which detail how many times a particular video has been watched and the geographical location of the viewer. These are not referred to as "Befit" but have the name of the trainer or the area of the body to be affected; e.g. "Jillian Michaels 30 day shred" and "30 day fat burn: legs & butt shaper workout". The figures show significant viewers watching the videos in the UK (approximately 8.7 million views) and the EU. However, it is unclear how prominent the BEFIT mark is and how it is used e.g. whether it is on-screen all the time or whether it features as a background.
- UK2: A website blog is running a competition where the prize is a basket of items such as a yoga mat, water bottle, towel, shirts and dvds with the word BEFIT upon them. This is only open to residents in the USA. The date for mother's day is the American date not that of Mothering Sunday in the UK.
- UK3: A fashion magazine featured a BEFIT personal trainer. It is not clear what the readership numbers are or if this is actually circulated in the UK.

- UK4: Gizmodo magazine mentions BEFIT in an article on using the internet to get fit. Judging from the advertisement selling tickets to NHL games, this is an American magazine.
- UK5: A popular fitness blog for mothers mention BEFIT and rates the BEFIT Youtube channel as one of the best five for workouts. This is written by Katie who describes herself as “a food obsessed urban gardener, new mum and professional book lover”. No viewing figures are provided.
- UK6 / 8 / 27: BEFIT videos are featured in an aggregate on youvideos.uk. Exhibit 8 has advertisements in dollars. No viewing figures are provided.
- UK7: This is claimed to be a UK based online fitness magazine which mentions the BEFIT diet supplements. It is dated 4 June 2016.
- UK9: A video sale and review page features BEFIT, all prices are in dollars.
- UK10: This is said to be a website by a UK based bridal planner featuring BEFIT protein supplements on her blog. However it is clearly an American website judging from the comments on the page.
- UK11 / 18: BEFIT products available via Amazon. I note that the dvd at exhibit 11 is a region 1 copy suitable only for the USA unless you have a multi-region dvd player. Dated 4 July 2016 and 4 November 2013 respectively.
- UK12: A “women’s issues” blog rates BEFIT as the number 1 online fitness workout. This is based in the USA as it has an advertisement asking for “city, state or Zip”.
- UK13: BEFIT is featured on a video aggregator. This is simply a page which shows a number of potential videos. No viewing figures are provided.
- UK14: BEFIT is featured on another youtube site which is said to be link-farm site. This has advertisements in English and Spanish, which suggests an American audience.

- UK15 / 26: BEFIT is featured on a specialist fitness video aggregator site. Exhibit 26 has advertisements priced in US\$.
- UK16: The Telegraph lists BEFIT as one of the top ten online workouts.
- UK17: BEFIT is featured on a health and fitness blog. I note that the date is shown as Sunday April 12, 2015 in the blog. This is not the way that someone in the UK would normally write the date.
- UK19 - 24: BEFIT products are offered for sale on eBay. Exhibits 19, 20, 23 & 24 are priced in US\$. Exhibit 21 is priced in £ but is a region 1 or USA dvd. Exhibit 22 is priced in Australian \$.
- UK25: BEFIT is featured on a health and fitness blog. No viewing figures are provided.
- UK29: A management company website (IQI.net) features BEFIT as a case study. Actually it is a study on how Weightwatchers is losing business to wearable technology, fitness apps and videos in general. It also references the USA and Germany but not the UK.
- UK30: Befit protein offered for sale in the UK on Google. With the exception of one advertisement these are all from countries other than the UK.
- UK31: This is said to show two BEFIT workout programmes being featured by Women's Health magazine in their "7 best Youtube workouts list. However, the twenty pages filed do NOT show such a list.

APPLICANT'S EVIDENCE

10) The applicant filed two witness statements. The first, dated 24 July 2017, is by Harry Rowe, the applicant's Trade Mark Attorney. He provides the following exhibits, but apart from exhibit 1 he makes no comment upon their contents:

- HR1: A print out of the Wikipedia entry for the opponent company which does not mention its BEFIT brand.

- HR2: An extract from the opponent's website regarding the opponent's financial results.
- HR3: An extract from the website imdb.com, the internet movie database, which gives details of the opponent's filmography.
- HR4: An extract from the UKIPO website which relates to the opponent's EU registration of LIONSGATE.
- HR5: An extract from www.leisuredb.com regarding the UK health and fitness market.

11) The second witness statement, dated 13 July 2017, is by Christopher Stevens-Smith, a trainee solicitor for the opponent's Trade Mark Attorney. He points that the opponent has claimed to have unregistered rights in LIONSGATE BEFIT and BEFIT, and that in order to succeed under sections 5(4)(a) and 56 the opponent must have goodwill in the UK. He points out that the Youtube analytics relied upon fail to explain how the term BEFIT is used. He then points out that a number of the exhibits provided by the opponent are for the USA market.

12) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

13) In written submissions prior to the hearing the opponent withdrew its ground of opposition under Section 56 and its opposition to the services applied for in class 36. I note that the ground of opposition under section 5(3) was not commented upon. As such I will regard this ground as not being pursued. The first ground of opposition is under section 5(2)(b) which 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.”

14) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

15) The opponent is relying upon its trade mark listed in paragraph 5 above which is clearly an earlier trade mark. Given the interplay between the date that the opponent’s mark was registered (10 February 2017) and the date that the applicant’s marks were published (3 June 2016), the proof of use requirements do NOT bite.

16) When considering the issue under section 5(2)(b), I take into account the following principles which 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 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 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.

The average consumer and the nature of the purchasing decision

17) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

18) To my mind, the average consumer for the goods and services applied for by the applicant would be the general public for some items (clothing) and businesses for others (market research). The goods and services vary enormously in terms of complexity and price. Some of the goods would be sold in retail outlets or via the internet, whilst a number of the services (market research or insurance) would, on occasion, require the purchaser to provide information to the service provider necessitating a conversation be it face to face, over the telephone or on-line. Even if the goods or services require the provision of information the initial selection is likely to take place from advertisements online, in printed advertisements or from a compendium of information such as yellow pages, although I must also take into account word of mouth recommendations. Therefore, I consider the visual aspect as being the most important in selection although aural considerations also apply. The prices of the goods and services will vary enormously as will the level of attention which the average consumer will pay to the selection, but to my mind it will range from a low to a medium degree of attention and when I consider the likelihood of confusion I will adjust the level of attention that the consumer for the relevant goods and/or services will take in respect of those goods and/or services.

19) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment 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”.

20) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(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.

21) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...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”.

22) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

Whilst on the other hand:

".....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

23) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

24) In its statements of grounds the opponent had not set out in anything other than the vaguest detail as to what goods and services it thought were either identical or similar (and to what degree) and had provided no reasons why it reached such a conclusion. It merely baldly stated that the goods and services of the two parties were identical or similar. Prior to the hearing, on 25 December 2017 I wrote to the opponent's Trade Mark Attorney and required them to provide a table setting out the goods and services which they regarded as identical and or similar and the reasons why unless the wording was such that it was obvious. I required an answer to this issue by Noon on Friday 5 Jan 2018. In this letter I also stated:

“I remind the opponent of the comments in *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, where the General Court pointed out that:

“43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

Thus where the similarity between the respective goods or services is not self - evident, the opponent must show how, and in which respects, they are similar.”

25) The opponent’s representatives chose not to respond to this letter, and instead in their skeleton arguments merely repeated the allegations regarding identity/similarity without, for the most part, providing either the details of which goods/services it considered to fall into such categories or reasons why other than in broad terms. At the hearing Mr Tritton made a number of highly relevant points on this topic:

“If you take Class 5 as an example, he says that these are clearly identical and highly similar. Well, I am sorry, but with medical dressings, coverings and applicators, and plasters, not only are they not identical, but to say that they are highly similar is just an affront to common sense. Bearing in mind what you have just told me, I must accept that dietary supplements and nutritional supplements are the same, and indeed vitamins, but it would have been courteous at the very least if I had had a list, which is exactly what I would have done, with some sort of easily cross-reference basis. Plainly, half of those goods and services are not only not identical, but they are not highly similar. I cannot see what the argument is and no argument is put forward as to why they are.”

And:

“If we take the Class 9 specification, I slightly lost the will to live on this one because it is so long. I accept that there are electronic publications buried away in that long specification. It took me some time to find it. For instance, on the assertion that these are clearly identical, I have not

found personal information management software in their specification. I have not found electronic tags and sensing and checking apparatus. I am not sure if I have found audio recordings in there either. I really do not think it is your job, or indeed my job, to work it all out for ourselves. I think there is a need here for a tribunal practice note to say that in these sorts of cases, it is incumbent upon the opponent not to make the Registry or the applicant do all the work. They must identify, in a clear schedule, by cross-referring (easily done) how the goods or services are identical, which they say are similar and which they say are not similar. You cannot just say, "These are clearly identical" in a manner where that appears to be just false as an assertion. As I say, I have not found electronic tags and sensing apparatus.

The onus lies here on the opponent. That is not just an evidential onus, but an onus to make your case so that the applicant can answer that case. It is not to say that they are identical and then for everybody else to do the same effort. The General Court is fairly clear about identifying these because they get huge specifications in the EU IPO and you cannot just say, "They are identical" and they are not.

Our respectful submission here is that when you make a submission that these are clearly identical when they are clearly not, in essence, your case fails because you have not sub-divided that. I was rather expecting Mr. Newell to deal with this point, but he is not here. As I say, I cannot even see in Class 9 that some of the goods or services are even actually similar. Indeed, I do not think they are similar at all."

And:

"Just in summary -- and I think it rather comes to the letter which you sent -- unless it is absolutely bang on, we say forget it and that is where it is. Even where it is bang on, if you really cannot identify that readily, I am tempted to say, in those circumstances they have not properly identified how those services are. I do not really think you should do the heavy lifting and I certainly should not be doing the heavy lifting either."

26) In carrying out the comparisons I have considered whether the wording is similar and or identical and then used a simple "common sense" approach as to whether dissimilar words might have a cross over. Having considered the specifications of both parties I make the following findings:

Mark & Class	Identical	Highly similar	Similar	Not similar
3161115 Class 5	Dietary supplements; nutritional supplements; vitamins, minerals and			medical dressings, coverings and applicators; plasters.

	food supplements;			
3161115, 3161117 & 3161373 Class 9	Electronic publications; downloadable publications; podcasts; recorded DVD's and CD's; audio and video recordings; computer software; application software; downloadable audio- visual recordings; downloadable audio files; downloadable image files; personal information management software;			electronic tags and sensing and checking apparatus therefor.
3161115, 3161117 & 3161373 Class 16			Printed matter; printed publications; printed periodical publications; journals; magazines; directories; supplements; books; booklets; manuals;	event programmes; teaching and instructional materials; calendars; diaries; photographs; certificates; vouchers; stationery. calendars; diaries; photographs; certificates; vouchers; stationery.
3161115, 3161117 & 3161373 Class 25	Clothing; headgear; footwear.			
3161115 Class 32:				Mineral and aerated waters; non-alcoholic drinks; energy drinks; isotonic, hypertonic and hypotonic drinks; fruit drinks and fruit juices; syrups for making beverages.
3161115, 3161117 & 3161373 Class 35	organisation of exhibitions		the bringing together for the benefit of other of a variety of goods enabling customers to conveniently view and purchase those goods, namely nutritional and dietary supplements, clothing, headgear,	Market research; marketing; advertising and promotional services; compilation of directories; operation and supervision of incentive and loyalty schemes; event marketing; organisation of trade fairs for commercial and advertising purposes; the bringing together for the benefit of other of a variety of

			footwear, protective sporting clothing, headgear, footwear, fitness, exercise and sporting equipment and accessories.	goods enabling customers to conveniently view and purchase those goods, namely food and drink,
3161117 Class 38	Class 38: Telecommunication services; communication services; transmission of sound and/or images; photo sharing and video sharing services ; chat room services; chat room services for social networking; e-mail and instant messaging services; providing online forums; electronic bulletin boards for transmission of messages among users; communication by online blogs; broadcasting services; providing access to non-downloadable computer software programmes.			
3161115, 3161117 & 3161373 Class 41	Education; providing of training; entertainment; cultural and sporting activities; arranging and conducting of events, seminars, conferences, conventions; workshops, exhibitions, shows and events for educational, entertainment and cultural purposes; organisation and arrangement of sporting events, exhibitions, and parties; prize draws; organisation of competitions and awards; organisation of live entertainment events, live performances and participation events; publishing services; providing on-line publications (non-downloadable); provision of non-downloadable electronic journals; production and presentation of radio and television programmes; production, presentation and distribution of audio, video, still and moving images and text;			instructional services relating to diet, nutrition, and beauty;

	<p>educational demonstrations; demonstrations for entertainment purposes; instructional services relating to fitness, physical exercise, physical rehabilitation and health; fitness training; conducting fitness classes; fitness club services; running club services; sports club services; providing contest and incentive award programs designed to recognize, reward and encourage individuals and groups which engage in health and fitness.</p>			
<p>3161117 and 3161373 Class 42</p>			<p>design and development of computer software; computer programming; installation, maintenance and repair of computer software; computer consultancy services;</p>	<p>Class 42: Scientific and technological services and research and design relating thereto; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services.</p>
<p>3161115, 3161117 & 3161373 Class 43</p>				<p>Class 43: Providing food and drink; restaurant, bar and catering services; café services; snack bar and canteen services; organisation and conducting supper clubs; advisory and information services relating to restaurants and holiday accommodation; providing information relating to cooking; cookery demonstrations.</p>
<p>3161115, 3161117 & 3161373</p>				<p>Class 44: Information, advisory and consultancy services relating to health and</p>

Class 44				fitness; health assessment; dietary management and nutrition advisory and consultation services; slimming advisory and consultancy services; beauty services; beauty treatments; health and beauty salon and spa services; massage services; hair styling services.
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Comparison of trade marks

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

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

28) It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account 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 them. The trade marks to be compared are:

Applicant's Marks	Opponent's mark
BE:FIT	
BE:FIT LONDON	



29) The opponent contends:

“2.3 The Opponent’s LIONSGATE BEFIT sign contains the entire term BEFIT which is identical to how the Applicant’s BE:FIT sign will be understood by consumers.

2.4 In *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, the CJEU stated (emphasis added):

29 In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34 This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely known mark or commercial name included in the composite sign.

35 Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36 It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.

37 Accordingly, the reply to the question posed must be that Article 5(1)(b) of the directive is to be interpreted as meaning that where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein.

2.5 In *Medion* the earlier right the trade mark LIFE and later, composite mark THOMSON LIFE. It was in this context that the CJEU stated as above.

2.6 In the present case, the composite trade mark is the earlier right and the later-filed opposed marks consist of a sign that is near-identical visually and identical aurally and conceptually to an element of the composite mark. That is, BE:FIT is near identical to the BEFIT aspect of LIONSGATE BEFIT.

2.7 The reasoning in *Medion* must apply equally to this situation. In other words, the reasoning in *Medion* must be a two-way street: if the later-filed mark in this case was LIONSGATE BEFIT and the earlier right BE:FIT, the marks would clearly be considered similar pursuant to *Medion*.

2.8 The applicant's evidence, insofar as it posits that the marks are distinguished by the inclusion of LIONSGATE in the Opponent's sign, appears to emphasise the similarity. If consumers will identify LIONSGATE as a separate brand, then BEFIT is seen as a thing apart from this brand and, accordingly, it retains more of an identity as a standout and stand-alone part of the composite sign LIONSGATE BEFIT. This further enhances, rather than diminishes, the risk of confusion and economic association.

2.9 This interpretation is supported by Arnold J. in *Aveda Corporation v. Dabur India Limited* [2013] EWHC 589 (Ch), at paragraph 45:

As the Court of Justice recognised in *Medion v Thomson*, however, there are situations in which the average consumer, while perceiving a composite sign as a whole, will recognise that it consists of two signs one or both of which has a significance which is independent of the significance of the composite whole. Thus when the well-known pharmaceutical company Glaxo plc acquired the well-known pharmaceutical company Wellcome plc, the average consumer of pharmaceutical goods confronted with the composite sign GLAXO WELLCOME or GLAXOWELLCOME would perceive the significance of both the whole and its constituent parts and conclude that this was an undertaking which combined the two previously separate undertakings (see *Glaxo Group Ltd v Glaxowellcome Ltd* [1996] FSR 388). The essence of the Court of Justice's reasoning in *Medion v Thomson* is that an average consumer of leisure electronic products confronted with the composite sign THOMSON LIFE could perceive both the whole and its constituent parts to have significance and thus could be misled into believing that there was a similar kind of connection between the respective undertakings.

2.10 Further, in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271

(Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, and on the court's earlier judgment in *Medion v Thomson*.

2.11 The Judge said:

18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.

2.12 The Applicant has not provided any evidence that demonstrates that in respect of the term LIONSGATE BEFIT the *average consumer would perceive the composite mark as a unit having*

a different meaning to the meanings of the separate components. Indeed, the two terms LIONSGATE and BEFIT are quite jarring and do not naturally “mesh” into a unified whole, as demonstrated by the Applicant’s evidence. This is not a situation where the terms BEFIT and BE:FIT play strikingly different roles or take on different conceptual meanings or connotations in the respective compared signs, or where the “whole” term LIONSGATE BEFIT is overwhelmingly more than, or distinguishable from, the mere sum of its respective independent parts.

2.13 The compared signs must therefore be considered highly similar. Mark 2 and Mark 3 must also therefore be considered highly similar with the Opponent’s earlier mark.”

30) For its part the applicant, whilst quoting many of the same authorities, takes a different approach. It contends:

“The law regarding the approach under s.5(2) and s.5(3) is well known to the Registry. In *Comic Enterprises v Twentieth Century Fox Film* [2016] EWCA Civ 41, there is a clear statement by the Court of Appeal on the approach to likelihood of confusion. At paragraphs 31-32, Kitchin LJ held that:

“31. Turning to Condition (vi), this court explained the general approach to be adopted to the assessment of the likelihood of confusion in *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24; [2012] F.S.R. 19 at [51]–[52]. We endorsed at [52] the following summary of the key principles developed by the Trade Marks Registry as being sufficient for the determination of many of the disputes coming before it:

52. (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 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 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.

31. In *Maier* we explained (at [76]) that to this summary should be added the further guidance provided by the Court of Justice in *Canon* (at [29]) that the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion for the purposes of the provision.

Earlier Composite Marks v Later Marks incorporating an element of the Composite Mark

17. There is a line of authorities concerning likelihood of confusion between composite marks starting from C-120/04 *Medion* through to *Bimbo* (C-591/12P) and its consideration in the United Kingdom by Arnold J in *Whyte & Mackay*. In all cases, this involves comparison of an earlier mark with a later mark that is incorporated in a composite mark (i.e. A vs A+B). Thus, in *Medion*, it was LIFE vs THOMPSON LIFE; in *Bimbo*, it was DOGHNUTS vs DOUGHNUTS BIMBO and in *Whyte & Mackay*, it was ORIGINS vs JURA ORIGIN.”

And:

“19. This principle has no role to play where the *earlier* mark is a composite mark. If one assumes normal and fair use of the earlier mark, one cannot say that the public has become accustomed to the use of an element of the earlier composite mark as an indication of trade origin in its own right. In contrast, where the earlier mark consists of an element of the later mark, *ex hypothesi*, the public may be accustomed to seeing that element as an indication of trade origin and thus the only question is whether it sees that element in the later composite mark as having a distinctive significance independent of the whole and by reason of that, there is a likelihood of confusion.

20. Thus, as said in *Comic Enterprises*, at ¶31 citing ¶52(f) *Specsavers*, the application of the “independent distinctive role” doctrine applies 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.

21. Where the *earlier* mark is a composite mark, then the approach is much more orthodox. In particular, an important factor is whether the earlier mark has a dominant distinctive element. As said in *Comic Enterprises*, 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 (¶52(e) *Specsavers*).”

31) The opponent prefers to compare the applicant’s first mark to its mark and believes that the same outcome will apply to the applicant’s other two marks. I shall therefore compare the mark BE:FIT to the opponent’s mark LIONSGATE BEFIT.

32) I do not accept the applicant’s contention regarding *Medion*, to my mind the question of similarity must be approached globally taking the whole of the marks into consideration. In my view, the term “BEFIT” will be seen, in the context of the goods and services in the instant case, as being an exhortation to get fit. In my opinion, it has a very low level of distinctiveness being barely registerable. Clearly, in my view, the distinctive and dominant element of the opponent’s mark is the word LIONSGATE which appears at the start of the mark and so is the element, which points to the origin of the goods and services. Whilst the marks of the two parties share an element the differences both visually and aurally far outweigh any similarity. Conceptually they share a concept of an instruction to get fit. **Overall there is a low degree of similarity.** The applicant’s other marks contain the word LONDON (3161117) and the word LONDON and DEVICE (3161373). I accept that the word LONDON is not particularly distinctive and is clearly a geographical reference but it does take the marks further away from the opponent’s mark.

Distinctive character of the earlier trade mark

33) 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 *WindsurfingChiemsee 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).”

34) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. 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.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

35) The opponent’s mark consists of an exhortation to get fit which will be seen as allusive if not descriptive for the majority of the goods and services for which the mark is registered and the word LIONSGATE which is easily the distinguishing and dominant element. **Overall the opponent’s mark is inherently distinctive to a medium degree. The opponent has not shown use of its mark and so it cannot benefit from enhanced distinctiveness.**

Likelihood of confusion

36) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade marks as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the services is a member of the general public including businesses who will select the goods and services by predominantly visual means, although I do not discount aural considerations and that they are likely to pay a varying degree (ranging from low to medium) of attention to the selection of such goods and services.
- the opponent's mark is similar to the applicant's 3161115 to a low degree. The applicant's other marks 3161117 and 3161373 are further away from the opponent's mark.
- the opponent's mark has a medium level of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.
- the goods and services are as set out earlier in the decision.

37) In view of all of the above, and allowing for the concept of imperfect recollection, in respect of any of the applicant's marks, there is no likelihood of consumers being confused into believing that the goods and services applied for under the marks in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it.

38) I must also consider the comments of Mr Iain Purvis Q.C. as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, where he noted 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).”

39) I do not believe that the instant case falls into the category described above and find that there will be no indirect confusion, as the only point of similarity in the marks of the two parties exists in an element which is more descriptive than distinctive and the average consumer will not make a link between the two parties’ marks. **The opposition under Section 5(2) (b) therefore fails.**

40) Given the above finding, I do not need to consider the fall-back limitation on the applicant's specification as set out in paragraph 32 of its skeleton where it suggested the addition of the words "The aforesaid goods/services all being related to fitness."

41) I next turn to the other grounds of opposition based upon section 5(3) and 5(4)(a). A pre-requisite of these grounds is that the opponent can show, respectively, reputation and goodwill in its earlier mark. As can be seen from my evidence summary earlier in this decision the opponent falls hopelessly short in both categories. It has shown no use of its registered mark (LIONSGATE BEFIT) and no relevant use in the UK of the word BEFIT. As such both these grounds of opposition fail.

CONCLUSION

42) The ground of opposition under section 56 was withdrawn as was the opposition to the services applied for under class 36. The ground of opposition under section 5(3) was not pursued but would have failed even if it had been. The opposition also failed in respect of the grounds of opposition under section 5(2)(b) and 5(4)(a).

43) The opposition in relation to all the opposed goods and services has failed. The mark will be registered for all of the goods and services applied for by the applicant.

COSTS

44) The opponent in its initial statement of grounds did not specify precisely which goods and services it thought were identical/similar to the goods and services applied for by the applicant and the reasons why it believed this such as trade channels etc. Prior to the hearing I wrote to the opponent, on 25 December 2017, instructing them to provide this information by Friday 5 January 2018. The opponent completely ignored this instruction and in its skeleton argument provided scant information and failed to identify in the precise terms required which goods and services it relied upon to oppose the goods and services applied for by the applicant. The opponent withdrew its ground of opposition under section 56 and its opposition to the goods in class 36 but did not withdraw the grounds of opposition under section 5(3) or 5(4)(a) despite it being clear that the evidence did not support either ground, and indeed the opponent did not even comment in its skeleton about the ground under section 5(3). As the opponent was not represented at the hearing it was not possible to put any of these issues to the opponent and possibly obtain the necessary information. Instead it was left to the applicant to

have to provide a defence to all the grounds in its skeleton and also to plough through the lengthy specifications in an attempt to provide a defence against all of the opponent's goods and services and second guess what reasons the opponent might contend, instead of having to respond to a targeted list of goods and services with clear reasons why the opponent believed they were identical/similar. At the hearing the applicant requested that I consider an award of costs off the scale due to the manner in which the opponent have conducted the opposition. I therefore invite the applicant to provide, within two weeks of the date of this decision, their bill of costs for the instant case. The opponent with then have a week from receipt of the applicant's response to provide its submissions on the matter.

Dated this 5th day of February 2018

George W Salthouse
For the Registrar,
the Comptroller-General