

**O-171-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3185811 BY FITNESS LEISURE  
LIMITED T/A BE INSPIRED GYMS TO REGISTER THE FOLLOWING TRADE  
MARK**



**IN CLASSES 25, 28 AND 41**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 408189  
BY THE ENGLISH SPORTS COUNCIL**

## BACKGROUND AND PLEADINGS

1) Fitness Leisure Limited t/a Be Inspired Gyms (hereafter “the applicant”) applied to register trade mark no. 3185811, the relevant details of which are:



Filing date: 15 September 2016

Publication date: 7 October 2016


**Class 25:** *Gymwear*

**Class 28:** *Gymnastic apparatus; fitness exercise machines*

**Class 41:** *Gymnasium services; Gymnasium facilities (provision of -); Gymnasium services relating to body building; Gymnasium services relating to weight training; Gymnasiums.*

2) The English Sports Council (hereafter “the opponent”) opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the goods and services set out above and is on the basis of the following three earlier marks:

Mark and relevant dates	Goods and services relied upon
<p>Trade mark no. 3018192</p>  <p>(series of two marks)</p> <p>Filing date: 14 August 2013  Publication date: 3 October 2014  Date completed registration procedure: 12 December 2014</p>	<p><b>Class 9:</b> <i>Databases; computer databases; electronic databases; computer software for authorising access to databases; computer software for creating searchable databases of information and data; computer software for database management; computer software and hardware; electronic publications; magnetic identity cards; cameras and parts and fittings therefor; glasses and visors; sunglasses; compasses and barometers; bicycle helmets; pre-recorded video tapes relating to sport and sporting events; pre-recorded video discs relating to sports and sporting events; pre-recorded compact discs relating to sport and sporting events; pre-recorded audio discs relating to sport and sporting events; pre-recorded audio tapes relating to sports and sporting events; pre-recorded DVDs relating to sports and sporting events; sports whistles; video game cartridges; downloadable image files; downloadable wallpapers for computers and/or mobile phones; downloadable screensavers for computers and/or mobile phones; downloadable video recordings; downloadable musical sound recordings.</i></p> <p><b>Class 16:</b> <i>Paper, cardboard and goods made from these materials, namely leaflets, booklets, books, catalogues, magazines, newspapers, journals, newsletters, brochures, pamphlets, periodicals, scrapbooks, photographs, posters, flyers, stickers, advertising and promotional printed matter, and instructional and teaching materials (other than apparatus); printed matter; printed publications; bookbinding material; newspapers; periodical publications; books; programmes; programme binders; stationery; instructional and teaching materials; postcards; notepads; pens; pencils; erasers; pencil sharpeners; rulers; book markers; posters; calendars; diaries; blackboards; height charts; carrier bags; prints; pictures; poster magazines; diaries; pads of paper; reports; stickers; score books; scorecards; autograph books; mounted and unmounted photographs; printed paper signs; paperweights; tickets; tickets relating to sporting events; personal organisers.</i></p> <p><b>Class 25:</b> <i>Clothing; footwear; headgear; articles of outer clothing; articles of sports clothing; leisurewear; shirts; boots; football boots and shoes; shorts; t-shirts; socks; pullovers; vests; skirts; dresses; overalls; bodysuits; warm-up suits; swimwear; ponchos; sweatshirts; sweaters; caps; hats; headwear; headbands; bandanas; scarves; jackets; wrist bands (sweat bands); track suits; ties; gloves; visors; waterproof clothing; belts.</i></p> <p><b>Class 35:</b> <i>Database management services; computerized database management services; management and compilation of computer databases; compilation, collection and systemisation of data and information into computer databases; overseeing and managing information issued via a computer database; advertising; marketing; promotional services; arranging of competitions for advertising purposes; business management, assistance and administration; organisation of exhibitions and trade</i></p>

	<p><i>fairs for commercial advertising; advertising and promotional services relating to cultural events, sport, exercise and health; preparation of publicity, promotional and marketing materials; business management of sport clubs; business management of sport venues; promotion of sports, fitness, sporting activities and sporting events; public relations services; information, advisory, management and consultancy services relating to all the aforesaid.</i></p> <p><b>Class 38:</b> <i>Telecommunications services for providing access to computer databases; rental of access time to a computer database; providing access to databases; information, advisory, management and consultancy services relating to all the aforesaid.</i></p> <p><b>Class 41:</b> <i>Certification services, namely operation of accreditation schemes and operation of accreditation schemes relating to sports and sporting events.</i></p> <p><b>Class 42:</b> <i>Design and development of computer databases; maintenance of databases; reconstitution of databases; updating of software databases; rental of a database server (to third parties); development, creation and maintenance of websites; hosting of websites; information, advisory and consultancy services relating to the aforesaid.</i></p>
<p>UK no. 3076248</p>  <p>Filing date: 9 October 2014  Publication date: 25 September 2015</p>	<p>Identical to the above with the exception of the following additional Class 41 services:</p> <p><i>information, advisory and consultancy services relating to all the aforesaid.</i></p>

Date completed registration procedure: 4 December 2015	
UK no. 3157809  BE INSPIRED  Filing date: 4 April 2016 Publication date: 2 December 2016 Date completed registration procedure: 17 February 2017	Identical to the list of goods and services of UK no. 3018192, with the exception of the Class 41 list which reads:  <b>Class 41:</b> <i>Providing an on-line directory of sporting activities and sporting facilities; providing information relating to sports, fitness, sporting activities, sporting and cultural events and sporting facilities on-line from a computer database or the Internet; providing newsletters in the field of sport, volunteering and culture via e-mail; providing on-line non-downloadable publications; organisation of competitions; provision of sports facilities; organisation and management of sporting activities, events, tournaments and competitions; rental of sports apparatus; management and supervision of sports and sports facilities; organisation and management of leisure services; recreation and leisure centre services; arrangement, organisation and management of sporting events and competitions; sports television programming services; publishing services including electronic publishing; certification services, namely operation of accreditation schemes and operation of accreditation schemes relating to sports and sporting events; information, advisory and consultancy services relating to all the aforesaid.</i>

3) The opponent claims that there is a strong similarity between the respective marks, that the goods and services in classes 25, 28 and 41 are identical, highly similar or complementary to the opponent's class 25 goods and class 41 services and that this will lead to a likelihood of confusion.

4) Further, and in the alternative, the opponent claims that it has established a reputation in its earlier mark since 2012 and claims that the applicant would therefore unjustly benefit from the unwarranted association with the opponent's earlier marks and reputation. It claims that use of the applicant's mark would be detrimental to this reputation because the opponent would have no control over the applicant's goods and services and would lead to dilution of the reputation. It also claims that use without due cause would take unfair advantage of, or be detrimental to the distinctive character or repute of its mark. Therefore, it claims that the application offends under section 5(3) of the Act.

5) The opponent also relies upon grounds based upon section 5(4)(a) in respect of its unregistered rights in BE INSPIRED. It claims that it has used the mark since 2012, initially in relation to the London Olympics, and subsequently in relation to sporting opportunities throughout the UK. As a result of this goodwill, its sign has come to identify the opponent's goods and services to consumers across the UK.

6) The opponent's marks all have filing dates that pre-date the filing date of the contested mark and are, therefore, earlier marks within the meaning provided in section 6 of the Act. Further, as all three earlier marks completed their registration procedures less than five years before the publication of the contested mark, they are not subject to the proof of use provisions set out in section 6A of the Act. The consequence of this is that the opponent may rely upon the full range of goods and services listed in its earlier marks.

7) The applicant filed a counterstatement denying the claims made.

8) Both sides filed evidence and written submissions. I will summarise the evidence to the extent that it is considered necessary and I will keep the submissions in mind.

9) A Hearing took place on 22 February 2018 with the opponent represented by Mr Leighton Cassidy for Field Fisher LLP. The applicant was not represented but filed further written submissions in lieu of attendance.

### **Opponent's Evidence**

10) This takes the form of a witness statement by Rona Chester, Chief Operating Officer of the opponent. Ms Chester states that the earlier marks were first used throughout the UK in 2012, initially in relation to the London Olympic Games and subsequently in relation to sporting opportunities throughout the UK. It was introduced by email communication to over four million people.

11) Exhibit RC3 consists of a number of extracts obtained from the opponent's website [www.beinspireduk.org](http://www.beinspireduk.org). The exhibit shows both current (as of 2 June 2017) pages and pages from 31 January 2015. They both show use of the red coloured

version of the opponent's 3076248 mark. The phrase "be inspired" also appears in the current pages in the following heading: "Are you ready to Be Inspired?"

12) At Exhibit RC5 is a page from the opponent's website [www.sportengland.org](http://www.sportengland.org) showing the heading "BE INSPIRED". The text below this heading begins as follows:

"Born in 2013 to capture the spirit of the London Olympic and Paralympic Games, Be Inspired is brought to you by Sport England and UK Sport. A regular Be Inspired email newsletter will keep you in the loop with opportunities to watch, play and volunteer – from world-class sport to events in your local community and exclusive ticket offers"

13) Ms Chester states that the first of these websites received 264,432 unique visits during the period 24 May 2016 to 23 May 2017, the second website received 933,910 for the same period, and that these figures are representational of the number of unique visitors they have received since the websites has been operational.

14) Ms Chester states that the opponent has been using "Be Inspired" in relation to a database of individuals with an interest in sports and currently has 1.3 million active members, but has been as high as over 4.5 million. These members are sent a "Be Inspired" branded email newsletter. Sample copies of these newsletters (from June, July and August 2016) are provided at Exhibit RC6 showing use of the red coloured version of earlier mark 3076248. The second of these also has an introductory paragraph where the word only version the mark appears.

15) Ms Chester also provides information regarding the opponent's "Be Inspired" *Twitter* account and *YouTube* channel. Videos on the later were posted between 2014 and 2017 and have been viewed 60,000 times.

### **Applicant's Evidence**

16) This takes the form of a witness statement by Ryan Stainsby of EHL Ltd, the applicant's representative in these proceedings. Mr Stainsby provides numerous

submissions that I will keep in mind but not summarise here. He also provides a history of the applicant's business. It is not necessary for me to summarise this other than to note that the applicant operates a single location body building gym and it has not experienced any unusual spike in sales (that could be attributed to riding on the coat tails of third party marks)

### **Opponent's evidence-in-reply**

17) This consists of a further witness statement by Ms Chester who provides evidence to counter the numerous submissions and claims made by Mr Stainsby. In summary, Ms Chester provides evidence of:

- clothing retailers selling both sportswear and regular clothing;
- UK businesses providing gyms and additionally providing sport/leisure facilities;
- Several traders providing both sports clothing and sports apparatus.

## **DECISION**

### **Section 5(2)(b)**

18) Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.



## ***Comparison of goods and services***

19) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*, 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) I also keep in mind the following guidance of the General Court (“the GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*Meric*”):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

22) Mr Stainsby submits that when considering the similarity of the respective services, I should consider “the bigger picture” and that the opponent, factually, does not operate a gym or provide gym clothing and that the applicant’s specification is specific but that the opponent’s specification is broad and not specific. Further, it is submitted that because the parties use their respective marks for different purposes, namely, promotion of sport to the public on one hand and a single location body building gym on the other, then the respective goods and services are not similar. These two submissions are based on an incorrect assumption that the nature of the parties’ current marketing strategies are relevant for the purposes of assessing the similarity of goods and services under section 5(2)(b) of the Act. As I pointed out in paragraph 6, the earlier marks are not subject to proof of use and, as a consequence, the opponent is entitled to rely upon the full list of goods and services of the earlier marks. It is not restricted to reliance upon the goods and services for which its mark has actually been used. Therefore, I dismiss the approach advocated by the applicant and I will undertake a comparison of goods and services based upon the full list of the opponent’s goods and services.

### **Class 25**

23) The parties’ respective goods are:

Opponent's goods	Applicant's goods
<i>Clothing; footwear; headgear; articles of outer clothing; articles of sports clothing; leisurewear; shirts; boots; football boots and shoes; shorts; t-shirts; socks; pullovers; vests; skirts; dresses; overalls; bodysuits; warm-up suits; swimwear; ponchos; sweatshirts; sweaters; caps; hats; headwear; headbands; bandanas; scarves; jackets; wrist bands (sweat bands); track suits; ties; gloves; visors; waterproof clothing; belts.</i>	<i>Gymwear</i>

24) The applicant's goods are covered by the opponent's broad terms *clothing* and *articles of sports clothing; leisurewear*. When keeping the guidance in *Meric* in mind, these goods are identical.

**Class 28**

25) The parties' respective goods are:

Opponent's goods	Applicant's goods
<b>Class 41:</b> ... <i>rental of sporting apparatus...</i>	<i>Gymnastic apparatus; fitness exercise machines</i>

26) In his skeleton argument, Mr Cassidy relied upon all of the opponent's Class 25 and Class 41 services, submitting that they are similar. He further referred to Mr Chester's evidence that, he claimed, demonstrates that it is common in the UK for producers of clothing to also produce fitness/gym apparatus and equipment. These submissions were supplemented at the hearing by reference to the tribunal decision *FITNESS DIRECT trade mark*, BL O-037-17 where the hearing officer commented as follows:

"24) Turning to the similarity between the applicant's goods [*that included indoor fitness apparatus as well as many other types of exercise apparatus*]

and the opponent's services in class 41, the opponent argues that these are directly related, complementary and thus highly similar. I agree that there is a complementary relationship between the applicant's goods and certain of the opponent's services such as 'rental of sporting apparatus/equipment' given that the former is indispensable to the latter. The nature of the respective goods and services differs as does their purpose and method of use. However, the users and trade channels may overlap and there is a degree of competition in play given that a consumer may choose between purchasing a weight lifting bench (for example) and renting one or visiting a leisure/fitness centre to use one there. I find there to be a medium degree of similarity between the applicant's goods and the opponent's services in class 41."

27) As Mr Cassidy pointed out, the opponent's Class 41 specification includes *rental of sports apparatus* and submitted, therefore, that the hearing officer's comments apply equally to the current case. I agree with the hearing officer's findings that there is a complementary relationship between *rental of sporting apparatus* (that can include the rental *gymnastic apparatus* and *fitness exercise machines*) and the goods themselves, that they may be in competition, where a consumer may make a choice between purchasing such goods or renting them. I also agree with the hearing officer when concluding that the respective goods and services share a medium degree of similarity.

28) Whilst Mr Cassidy did not withdraw reliance upon the opponent's other goods and services, none of them place the opponent in a stronger position than its reliance upon rental of *sporting apparatus*. This finding includes the opponent's reliance upon clothing. It filed evidence to support its contention that it is common for producers of clothing to also produce fitness/gym apparatus. I do not accept this contention. The evidence illustrates two brands who do so, but it would be wrong for me to extrapolate from this that it is common for producers of clothing to also produce sporting apparatus. These respective groups of goods are not particularly close or complementary and it strikes me as unlikely that clothing manufacturers also produce sporting apparatus even if there are a few notable exceptions. The consumer will not ordinarily assume or expect that there is a common trade channel for clothing and sporting apparatus.

## **Class 41**

29) The table below shows the opponent's services relied upon at the hearing, even though the other goods and services are also still relied upon. Based on Mr Cassidy's submissions at the hearing, the parties' respective goods are:

<b>Opponent's services</b>	<b>Applicant's services</b>
<i>Management and supervision of sports and sports facilities; organisation and management of leisure services; recreation and leisure centre services</i>	<i>Gymnasium services; Gymnasium facilities (provision of -); Gymnasium services relating to body building; Gymnasium services relating to weight training; Gymnasiums.</i>

30) Once again, keeping the guidance of *Meric* in mind, it is clear to me that all of the applicant's services are covered by, at least, the opponent's broad term *recreation and leisure centre services* that, under their normal meaning would be understood to include gymnasium services. As an ordinary consumer of such services, it is my experience that whilst not being exclusively provided, it is certainly common for leisure centres and the like to provide, as part of their offering, a fitness gym. At her Exhibits RC07 to RC10, Ms Chester provided evidence of four different traders providing gym services that, whilst not providing conclusive evidence, lends support to my finding. I conclude that the respective services are identical.

### ***Comparison of marks***

31) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23), Case C-251/95, that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated 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.”

32) It would be wrong, therefore, to artificially dissect the marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

33) At the hearing, Mr Cassidy identified the opponent’s word mark BE INSPIRED as representing its best case. I agree because the additional material present in its other earlier marks create points of difference between the respective marks and, therefore, reduce the likelihood of confusion compared to its word mark. I, therefore, only consider the similarity between the opponent’s word mark and the applicant’s mark. The respective marks are:

Earlier mark	Contested mark
BE INSPIRED	

34) The opponent’s mark consists of two words that form the phrase BE INSPIRED. The distinctiveness resides in its totality. There are no other elements contributing to the distinctive character of the mark. The most prominent element of the applicant’s mark is the three words BE INSPIRED GYMS. The first letter of each of these words is presented in red with the rest of the words presented in white letters. All of this is on a black background. In addition, appearing centrally above these words is a device of a laurel wreath within which is, what appears to be, a vertically positioned

barbell. The letters “B” and “G” are positioned either side of the bar of the barbell. This device is distinctive in its own right and contributes to the distinctive character of the mark, but because of its size relative to the words, it is the words that are the dominant, distinctive element of the mark.

35) Visually, the marks share some similarity because the words BE INSPIRED appear in both. In all other aspects, the marks are different with the applicant’s mark having a device element, the first letter of each of the three words being presented in a different colour and all being presented on a black background. All these elements are absent from the applicant’s mark. Taking all of this into account, I conclude that respective marks share a medium level of visual similarity.

36) Aurally, the device element and other embellishments present in the applicant’s mark will not be a factor. The applicant submits that the letter’s BG present in the device element of its mark are presented either side of the bar of the barbell device to create the impression of the acronym B.I.G. Whilst I accept that the average consumer will notice this, in my view it is not likely to be referred to. Rather, the mark will be referred to as BE INSPIRED GYMS. The opponent’s mark will be referred to as BE INSPIRED. Taking all of this into account, I conclude that the respective marks share a high level of aural similarity.

37) Conceptually, the opponent’s mark is likely to be perceived as an exhortation to be inspired. The applicant’s mark, whilst containing the same words BE INSPIRED also has the word GYMS that creates the impression of gyms where a person would go to be inspired. There is nothing in the device element to contradict this impression. Therefore, whilst the respective concepts are not identical (the opponent’s mark is absent a concept of “gyms”), there is nevertheless a good deal of conceptual similarity resulting from the common occurrence and meaning of the words BE INSPIRED.

### ***Average consumer and the purchasing act***

38) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood

of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

39) 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.”

40) Mr Cassidy submitted that the average consumer is the general public. I partially agree, but I also recognise that in respect of the applicant's Class 28 goods and the relevant Class 41 services (see para. 28, above) that they may be provided in a business to business environment. In respect of the Class 25 goods, where the average consumer is the general public, I agree with Mr Cassidy who submitted that the level of care and attention during the purchasing process is average.

41) In respect of the other goods and services, the level of care and attention paid during the purchasing process is likely to be greater. For example, in respect of the Class 41 services, they are often accessed via membership for a given time, for example, 12 months, and such a commitment from the consumer will raise the level of care and attention paid during the purchasing process. Where the goods and services are provided through a business to business transaction, the level of care and attention is likely to be enhanced through the normal due-diligence that would be expected from a business customer in purchasing such goods and services.

42) The purchasing act is likely to be predominantly visual in nature, but I do not ignore that aural considerations may play a part.



### ***Distinctive character of the earlier trade mark***

43) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-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).”

44) As I have already mentioned, at the hearing Mr Cassidy identified the opponent’s word mark BE INSPIRED as representing its best case. I agreed. Therefore, I consider the level of distinctive character of the words BE INSPIRED and in limiting myself to this consideration, I do not consider that this places the opponent at any disadvantage. It is a natural word combination that will be readily understood by the average consumer as an exhortation to be inspired. This is a message that traders in all fields may wish to use and, further, is particularly relevant in the fields of exercise and sports. This has the impact of endowing the mark with only a low level of inherent distinctive character.

45) The opponent claims that its mark benefits from an enhanced level of distinctive character and filed evidence in support of this. The mark has been used in respect of a promotional campaign to encourage the general public to get involved in sport either via participation or volunteering. Whilst the opponent submits that the use of its mark goes beyond this, if this is correct, such use is not to the extent that it has an enhanced level of distinctive character. However, in respect of services that form part of the operation of its promotional campaign, such as *providing information relating to sports, fitness, sporting activities [...] on-line from a computer database or the Internet*. I conclude that the mark benefits from a certain level of enhanced distinctive character, but that such enhancement is not particularly high.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion**

46) The following principles are gleaned from the decisions of the CJEU 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

47) Mr Stainsby relies upon the guidance provided in the case *Polarad Elecs. Corp* from 1961. This set out the guidance as it then was under the Trade Marks Act 1938.

The guidance in respect of interpreting the current legislation, namely the Trade Marks Act 1994, is cited above and it is this guidance I must now take into account.

48) Mr Stainsby contends that the opponent's mark is of weak distinctive character. I have already concluded that it does indeed have a low level of inherent distinctive character. Nevertheless, the weak distinctive character of an earlier trade mark does not necessarily preclude a likelihood of confusion (see *L'Oréal SA v OHIM*, Case C-235/05 P, para. 45).

49) In his witness statement, Mr Stainsby highlighted the differences between the parties' activities with his client operating a body building gym and the opponent using its marks in relation to an online service to encourage people to participate in sport. I note this but marketing considerations are not relevant when considering the likelihood of confusion as set out in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, where the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

50) In light of this guidance, I dismiss the submission.

51) In his witness statement, Mr Stainsby placed reliance upon *The Whyte and Mackay Limited v Origin Wine UK Limited & Anor* [2015] EWHC 1271 where the court found that the word ORIGIN did not play an independent distinctive role in the mark JURA ORIGIN and that, because the word JURA had no counterpart in the opponent's mark there was no likelihood of confusion. The considerations in that case and the current case are different. In the mark JURA ORIGIN, the court found that the word ORIGIN functioned to indicate that the goods sold under the mark originated from JURA and therefore it was not distinctive. In the current case, the phrase BE INSPIRED serves to identify the name of the GYMS because the phrase

appears directly before the word. Consequently, the phrase has a distinctive (i.e. trade mark) role in the mark as the name of the group of gyms alluded to by the word GYMS. Therefore, I dismiss this submission.

52) Mr Stainsby also submitted that because there are numerous other EU marks registered that feature “Be Inspired” then the term is generic. Again, I dismiss this submission. It has been held that state of the register evidence is irrelevant. In particular, in *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01, the CJEU found that:

“65... The fact that an identical trade mark has been registered in one Member State as a mark for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark for goods or services similar to those for which the first trade mark was registered.”

53) Further, it is not open to me to make a finding that the sign BE INSPIRED is generic. The earlier mark is registered and by virtue of section 72 of the Act this is *prima facie* evidence of its validity. As it is valid, it must have at least the minimum level of distinctive character for registration. This approach has been endorsed by the CJEU in *Formula One Licensing BV v OHIM*, Case C-196/11P, paras 42 – 45). One possible exception to this is where the earlier mark is inherently lacking distinctive character but has been found to have acquired a secondary meaning as a trade mark, but this is not the case here because, as Mr Cassidy pointed out at the hearing, it was not registered on the basis of acquired distinctive character.

54) Mr Stainsby also submitted that the opponent has failed to provide any evidence of actual confusion. Once again, it has been held that such an absence of confusion in the marketplace is not relevant. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“80. ....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

55) Also, in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

56) In his written submissions, Mr Stainsby claimed that because the elements “GYMS”, “BG” and the device don’t have a counterpart in the opponent’s mark that there will be no confusion between the marks. I keep this in mind as being one of the factors to take into account.

57) I rule out any likelihood of direct visual confusion where one mark is confused for the other. The visual differences are sufficient to remove this likelihood. Whilst I have acknowledged that visual considerations are the most important, I recognise that

aural considerations may play a part, particularly when the respective goods and services are recommended by word of mouth or advertised via radio broadcasts. Here, with the respective marks being highly similar to the ear and with the only difference (the word GYMS) being totally descriptive, I find that direct aural confusion is likely.

58) I also consider whether there is a likelihood of indirect visual confusion where the average consumer is likely to believe that the goods and services provided under one of the marks originate from the same or linked undertaking as the goods and services provided under the other mark. In considering this, I keep in mind the following guidance of Mr Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10:

“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).”

59) I must take account of the common element in the context of the later mark as a whole (as highlighted by Mr James Mellor Q.C. sitting as the Appointed Person in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17). Whilst the current contested mark does not appear to fall squarely into any of Mr Purvis’ categories, I do not understand him to be setting out an exhaustive list. The contested mark falls partially into Mr Purvis’ category a) in that the common element appears in both marks, however, this common element is not “strikingly distinctive”. It also falls partially into category b) in that the non-distinctive element GYMS is added, but of course, it is not the only additional matter. I do not find either of these points fatal to a finding of indirect confusion.

60) It is clear to me that when encountering the mark, the average consumer will be immediately struck by the words BE INSPIRED as indicating the name of the GYMS. This is despite the presentation with the first letters of each of these words (i.e. the letters “B”, “I” and “G”) appearing in a contrasting colour. The presence of the device element and the overall stylisation of the mark does not detract from this. If the device element is noticed, the appearance of the letters “B” and “G” appearing either side of the bar of a barbell to create the impression of the letters “B I G” and serve to reinforce the name BE INSPIRED GYMS.

61) I acknowledge that the figurative element of the applicant’s mark contributes to its distinctive character as does the stylisation of the mark as a whole, however, it remains the case that:



- The applicant's mark includes the opponent's mark;
- I am required to consider the earlier mark BE INSPIRED as having at least a minimum degree of distinctiveness;
- A distinctive element of the applicant's mark is the figurative element and, also, the marks stylisation and these contribute to its distinctive character and that these have no counterparts in the earlier mark;
- The element BE INSPIRED GYMS is the dominant and distinctive element of the applicant's mark, but the word GYMS, on its own, is non-distinctive;
- The words BE INSPIRED must therefore also have a minimum degree of distinctive character in the applicant's mark;
- On this basis, I have found there is medium level of visual similarity between the marks;
- The respective goods and services in Class 25 and Class 41 are identical and the opponent's services are similar to a medium degree to the applicant's Class 28 goods;
- Although aural similarity is less important than the degree of overall visual similarity between the marks, if the marks are verbalised I have found they would share a high level of similarity.

62) Taking all relevant factors into account, and keeping in mind the principle of interdependence, namely, that the overall degree of similarity between the marks may offset the lesser degree of similarity between the goods and *vice versa*, I find that there is a likelihood of indirect visual confusion in respect of all of the applicant's goods and services because consumers are likely to believe that the applicant's mark is a variant of the opponent's mark and used by the same undertaking, or by an economically related undertaking.

63) In reaching this conclusion I have given particularly careful consideration to the competing submissions of the parties. Ultimately, I have decided that the logic of the applicant's case effectively depends upon me attributing no distinctive character to the opponent's earlier mark. For the reasons given above, it is not open to me to do so.

64) In summary, the opposition, insofar as it is based upon section 5(2)(b) of the Act, succeeds in its entirety.

### **Section 5(3) and section 5(4)(a)**

65) In light of my findings under section 5(2)(b) of the Act, it is not necessary for me to consider the opponent's fall-back positions based upon section 5(3) and section 5(4)(a) of the Act.

### **Summary**

66) The opposition succeeds against all of the applicant's goods and services and the application is refused.

### **Costs**

67) The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2 of 2016. I take account that both sides filed evidence and written submissions and that a hearing was held. I award costs as follows:

Official fee for filing the notice of opposition	£200
Preparing notice and considering the counterstatement	£300
Filing evidence and submissions & considering applicant's evidence and submissions	£800
Preparing for, and attendance at hearing	£700
<b>TOTAL</b>	<b>£2000</b>

68) I order Fitness Leisure Limited t/a Be Inspired Gyms to pay to The English Sports Council the sum of **£2000**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 15<sup>th</sup> day of March 2018**

**Mark Bryant  
For the Registrar  
The Comptroller-General**