

O-419-21

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3465108

BY FIT BROADCASTING SERVICES LTD

TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASSES 38 AND 41

AND

OPPOSITION THERETO UNDER NO. 420362

BY ICON HEALTH & FITNESS INC

BACKGROUND AND PLEADINGS

1. On 7 February 2020, FIT BROADCASTING SERVICES LTD (“the applicant”) filed trade mark application number UK00003465108 for the mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 21 February 2020, in respect of the following services:

Class 38 Broadcasting services; television broadcasting services; television, cable television, satellite television and subscription television broadcasting services; interactive telecommunications services; telecommunication of information (web pages); broadcasting and transmission of television programmes; Telecommunications; advisory, consultation and information services in relation to the aforesaid; All of the above services being in the field of fitness.

Class 41 Education, teaching, instruction and training; personal training services; education, teaching, instruction and training in the fields of fitness, exercise, and body conditioning; education, teaching, instruction and training in relation to health, weight management, diet and nutrition; entertainment; sporting and cultural activities; the provision of fitness, exercise and body conditioning classes; rental of apparatus or equipment for exercise and fitness; provision of health and fitness club facilities; providing courses relating to exercise, fitness and body conditioning; publishing; the provision of on-line electronic publications (not downloadable) from the Internet; arranging, organising and conducting events, shows or competitions in the fields of fitness, exercise, entertainment, or sporting activities; advisory, consultation and information services in relation to the aforesaid; All of the above services being in the field of fitness.

2. On 21 May 2020, ICON Health & Fitness Inc (“the opponent”) filed an opposition opposing the application in full under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. Under section 5(2)(b) of the Act, the opponent relies upon the following registrations:

(i) International Registration designating the UK (“IR(UK)”) no. 1308187:

IFIT

International registration date: 21 March 2016

Date of protection in the UK: 19 January 2017

The opponent is relying on some of the services for which the IR(UK) is registered, namely:

Class 41 Personal fitness training services and consultancy; physical fitness instruction; physical fitness training services; providing exercise and fitness information through an on-line computer database; providing information in the field of exercise training; educational services, namely, conducting personal training in the field of health and fitness.

(ii) EU trade mark (“EUTM”) no. 12544425:¹

IFIT

Application date: 29 January 2014

Registration date: 23 June 2014

The opponent is relying on all the services for which the EUTM is registered:²

Class 38 Provide a forum, chat rooms, and electronic bulletin boards for registered users for transmission of messages and sharing information regarding health and fitness, sport activities, and

¹ Although the UK has left the EU and the transition period has now expired, EUTMs and International Marks which have designated the EU for protection are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SI 2019 No. 269, Schedule 5. Further information is provided in Tribunal Practice Notice 2/2020.

² At the hearing, I asked Mr Fiddes why, in the Form TM7, “Some goods and services” were ticked for the question asking which goods or services are relied upon, when the entire specification was listed in the space provided. Mr Fiddes confirmed this was an error and that all services were being relied upon.

social networking via an online website and other computer and electronic communication networks; streaming of audio and video material related to athletic activities on the internet and other computer and electronic communication networks; Providing online chat rooms and electronic bulletin boards for registered users for transmission of messages concerning food, nutrition, personal activities, general interest, classifieds, virtual community, and social networking.

4. Under section 5(2)(b), the opponent claims that the applied-for services are identical or similar to the services covered by its earlier marks and that the marks are similar, resulting in a likelihood of confusion.

5. The registration procedure for the opponent's EUTM was completed more than five years prior to the relevant date. Therefore, the opponent made the required statement of use of that mark for all the services relied upon.

6. Under section 5(4)(a), the opponent claims that it has used the sign **IFIT.LIVE** in the UK since 2016 in connection with the following services:³

Personal fitness training services and consultancy; physical fitness instruction; physical fitness training services; providing exercise and fitness information through an on-line computer database; providing information in the field of exercise training; educational services, namely, conducting personal training in the field of health and fitness.

7. The opponent asserts that it has made substantial use of the sign in the UK since that date and that, as a result, it has accrued goodwill and a reputation. Use of the contested mark for all the services in the application would, according to the opponent, cause confusion in the mind of consumers who will believe that the services of the

³ In the skeleton arguments, Mr Fiddes submitted that the evidence establishes sufficient goodwill in the marks IFIT and IFIT.LIVE, despite the opponent's pleadings in the Form TM7 only referring to the latter sign in relation to section 5(4)(a). At the hearing, I asked Mr Fiddes to clarify; he explained that it was an error and the only sign relied upon under section 5(4)(a) is IFIT.LIVE.

applicant are provided by or under the authority of the opponent. It claims that this misrepresentation is likely to lead to damage to its goodwill and reputation, the effect being a loss of sales, and so use would be contrary to the law of passing off.

8. The applicant filed a defence and counterstatement denying the grounds of opposition. In relation to section 5(2)(b), the applicant denies any similarity between the marks and the respective services and denies a likelihood of confusion. The applicant requested proof of use of the opponent's EUTM. In relation to section 5(4)(a), the applicant put the opponent to proof of the reputation claimed for the earlier sign.

9. Both sides seek an award of costs.

10. Only the opponent filed evidence, which I will summarise to the extent I consider necessary. A hearing took place before me on 17 March 2021, by video conference. The opponent was represented by Alan Fiddes of Urquhart-Dykes & Lord LLP. The applicant did not attend, nor did it file submissions in lieu of attendance.

11. The opponent is represented by Urquhart-Dykes & Lord LLP. The applicant is represented by RevoMark.

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

EVIDENCE

13. The opponent filed evidence in the form of the witness statement of John McHale dated 29 October 2020. Mr McHale is the Financial Controller of the opponent, a position he has held since 2006.

14. Mr McHale states that the opponent was originally founded in 1977 and began producing a range of fitness equipment in the 1980s. Mr McHale states that the

opponent introduced the IFIT range in 1989 which includes fitness/gym machines, a range of fitness wearables (such as GPS locators and monitors which collect data relating to the wearer) and subscription services, subscribers of which have access to a library of fitness programs, an online fitness community, personalised data storage and nutritional information.

15. Mr McHale’s witness statement is accompanied by 10 exhibits. What is contained within each of those exhibits is described, briefly, in the table below.

Exhibit	Contents
JM1	Undated extracts from three different websites, one of which describes IFIT as creating custom workout schedules, personalised meal plans and providing activity and sleep tracking.
JM2	Undated extracts from various websites selling fitness equipment, one of which describes IFIT as technology which “helps you get much more out of each workout” by tracking your progress, replicating real-life runs and customising workouts to specific goals. There is evidence that exercise machines can be purchased with IFIT membership included and that some exercise machines have a stylised version of IFIT on the machine itself, though those pages are also undated.
JM3	Extracts from websites selling fitness equipment to which IFIT services need to be connected. The pages are undated but are said to be from 2016. ⁴
JM4	Brochure pages for exercise machines, some of which refer to “iFit Live” technology and its use for customising fitness programs, downloading workouts and managing an online profile. The brochure is undated but is said to be from around 2015-2016. ⁵ There are also images showing what are described as IFIT LIVE modules and media cards, in use around 2012. ⁶
JM5	Extracts from the website ifit.com referring to training materials, workouts and a live schedule of fitness classes. The only date visible on these pages

⁴ Paragraph 9 of the witness statement of John McHale.

⁵ Paragraph 10 of the witness statement of John McHale.

⁶ As above.

	<p>is 23/10/20, which I assume to be the date on which the website was accessed. Pages relating to a cycling workout, associated comments and the option to share the workout online are contained in the exhibit but are also undated. Pages referring to an online community are undated, as are the messages shown in those pages.</p>
JM6	<p>10 reviews of “iFit 2 Year Premium Membership” on the website amazon.co.uk dated between January and November 2019. The reviews are from verified purchasers in the UK, though no purchase price is evident.</p> <p>Seven online articles, three of which mention an IFIT membership or subscription service for access to online workouts, fitness-related articles and custom meal plans. One is dated November 2015, one January 2019 and one is undated (other than a print date of 30/11/2015). The remaining four articles refer to IFIT LIVE and its associated training programs. Three of the other four articles are dated November 2014, January 2014 and April 2015. The fourth article is undated, but a comment posted at the bottom of the article is dated May 2010. The article includes a 2015 update which reads as follows:</p> <p>“iFit LIVE is now called simply iFit. The SD cards have been phased out for the most part, and new machines are either iFit compatible, meaning you need to purchase a module to use it on your treadmill, or iFit enabled, which means that iFit is ready to go on your machine, no module necessary. [...]”</p>
JM7	<p>Screenshots of the opponent’s social media pages, including Twitter, Facebook and YouTube. None of the posts or videos on the accounts are dated by year, only by month and day. There is a date of 30/12/2015 at the bottom of each page, but I consider this to be the date on which the pages were accessed. There is one other social media account in the exhibit, in the name of iFit, but it is not clear which social media platform it belongs to. The group has 23.3K members and was created in August 2017, but no other date is visible.</p>

JM8	24 invoices dated between June 2015 and February 2020. 21 of those invoices mention IFIT in the item name and are billed to various locations across England, Scotland and Ireland.
JM9	Examples of circumstances in which consumers can purchase exercise machines with an IFIT subscription included. The pages are undated, other than what I assume to be the date the pages were accessed (27 October 2020).
JM10	Printouts of webpages from a store in Italy. The webpages are undated but appear to have been accessed on 30 November 2015. The majority of the products available to purchase are exercise machines, whereby IFIT is mentioned as an optional extra. There are two items named iFIT Wellness Card and one named Modulo iFit Live, the descriptions of which are in Italian.

16. Mr McHale's witness statement provides the following figures, said to be in relation to the marketing of exercise equipment and IFIT and IFIT LIVE services:

	2016	2017	2018	2019
UK	£268,570	£522,746	£820,765	£732,267
EU	£1,095,584	£1,599,274	£1,710,483	£1,882,253
TOTAL	£1,364,154	£2,122,021	£2,531,247	£2,614,520

17. Also included is a table showing approximate turnover figures for exercise machines bearing IFIT or IFIT LIVE names in the years 2014-2019:

Country	2014	2015	2016	2017	2018	2019
United Kingdom	\$10.2m	\$13.4m	\$12.2m	\$9.8m	\$11.7m	\$11.7m
Ireland	\$1.1m	\$1.3m	\$1.3m	\$1.3m	\$1.5m	\$1.8m
France	\$38.4m	\$36.8m	\$34.0m	\$24.5m	\$23.0m	\$19.3m
Italy	\$5.6m	\$4.3m	\$2.1m	\$1.3m	\$1.5m	\$0.7m
Spain	\$2.1m	\$0.7m	\$2.8m	\$4.4m	\$5.6m	\$4.7m
Hungary	\$0.4m	\$0.3m	\$0.3m	\$0.3m		\$0.1m

Finland	\$0.3m	\$0.1m	\$0.2m	\$0.1m		
Holland	\$0.9m	\$1.1m	\$1.6m	\$1.7m	\$1.7m	\$0.4m
Germany					\$0.1m	\$0.6m

18. The witness statement also shows the following table (the first line is said to represent approximate memberships and wearables; the second to IFIT LIVE compatible products):

2015		2016		2017		2018	
Sales GBP	Qty	Sales GBP	Qty	Sales GBP	Qty	Sales GBP	Qty
71,532	2881	244,364	8979	180,306	5491	153,982	4424
756,375	1528	109,393	181	69,707	101	0	0

19. Approximate subscriber numbers for IFIT services in the EU (excluding the UK) are as follows:

2015	2016	2017	2018
4,078	7,500	11,732	4,695

DECISION

Proof of use

20. The relevant statutory provisions are as follows:

“6A. – (1) This section applies where -

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

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if -

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

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

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

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

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

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the

purposes of this section as if it were registered only in respect of those goods or services.”

21. Section 100 of the Act is also relevant, which reads:

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

22. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is **8 February 2015 to 7 February 2020**.

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

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

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

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

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

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

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

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

24. As the earlier mark is an EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, are relevant. The court noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at

the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And:

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And:

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

At paragraphs 57 and 57, the court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial

borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community' within the meaning of that provision.

A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity."

25. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the services at issue in the EU during the relevant five-year period. In making the assessment, I am required to consider all relevant factors, including:

- a. The scale and frequency of the use shown;
- b. The nature of the use shown;
- c. The services for which use has been shown;
- d. The nature of those services and the market(s) for them; and
- e. The geographical extent of the use shown.

Form of the mark

26. Some of the opponent's evidence contains stylised versions of the EUTM relied upon. However, those exhibits have not assisted the opponent in proving use of its mark and so I do not intend to discuss them further.

Genuine use

27. I bear in mind that an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁷

28. Despite the majority of the evidence being undated, there are 21 invoices dated within the relevant period which show that IFIT membership cards were sold and delivered to consumers across the UK. There are also 10 reviews of the IFIT membership by verified purchasers in the UK within the relevant period. Some of the remaining exhibits help me to understand what services are offered via the IFIT membership. Sales figures have also been provided in the witness statement, although I bear in mind that it is not clear what proportion of those relate to the services relied upon.

29. During the relevant period in which the opponent must prove use of its EUTM, the UK was still a member of the EU. Consequently, this decision will be decided upon that basis. There is very little evidence provided which relates to the EU market outside of the UK. However, the above case law makes it clear that use corresponding to the territory of one member state can be sufficient to establish genuine use in the EU as a whole. Clearly, there have been sales made in the UK. Therefore, taking the evidence as a whole into account, I am satisfied that the opponent has done enough to demonstrate genuine use of the EUTM.

Fair specification

30. I must now consider whether, or to what extent, the opponent has shown use of the EUTM in relation to the services for which it is registered, as per the opponent's statement of use.

⁷ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09.

31. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*,⁸ Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

32. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*,⁹ Mr Justice Carr summed up the law relating to partial revocation as follows.

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

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

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

⁸ BL O/345/10.

⁹ [2016] EWHC 3103 (Ch).

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

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

33. Mr Fiddes, at the hearing, submitted that the evidence "demonstrates use of the mark on or in relation to all of the services covered by the earlier trade mark registrations" on which the opponent relies. Whilst they are largely undated (other than the date on which they were accessed), the pages taken from various websites show me that the IFIT membership gives members access to a range of online fitness classes, either live or pre-recorded. It is my understanding, having reviewed all the evidence, that such videos can be viewed online or linked to a compatible exercise machine. I therefore consider that the opponent has shown use of its EUTM in relation to 'streaming of audio and video material related to athletic activities on the internet and other computer and electronic communication networks' in its class 38 specification.

34. In relation to the remaining services relied upon, I do not consider the evidence to have shown genuine use. The only exhibits which appear to refer to a forum, chat room or electronic bulletin board are JM5 and JM7. As described earlier in this decision, the only pages in JM5 which refer to an online community are undated, as

are the messages. Exhibit JM7 contains screenshots of the opponent's social media pages, which are also undated. There is one other social media account in the exhibit, in the name of IFIT, but it is not clear which social media platform it belongs to. It was created in August 2017 but no other date is visible. The exhibit shows the group as having 23.3K members, but I cannot tell when that was the case. With no evidence of any actual conversations or the transmission of messages between members, I am not satisfied that the opponent has made genuine use of its EUTM throughout the relevant period in relation to the following services:

Provide a forum, chat rooms, and electronic bulletin boards for registered users for transmission of messages and sharing information regarding health and fitness, sport activities, and social networking via an online website and other computer and electronic communication networks.

Providing online chat rooms and electronic bulletin boards for registered users for transmission of messages concerning food, nutrition, personal activities, general interest, classifieds, virtual community, and social networking.

35. For the purposes of this opposition, the opponent may rely on its IFIT mark for 'streaming of audio and video material related to athletic activities on the internet and other computer and electronic communication networks'.

Section 5(2)(b)

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

"A trade mark shall not be registered if because –

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

Relevant law

37. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(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.

Comparison of services

38. The competing services are shown in the table below:

Earlier marks (following proof of use)	Contested mark
<u>EUTM</u> Class 38: Streaming of audio and video material related to athletic activities on the internet and other computer and electronic communication networks.	Class 38: Broadcasting services; television broadcasting services; television, cable television, satellite television and subscription television broadcasting services; interactive

IR(UK)

Class 41: Personal fitness training services and consultancy; physical fitness instruction; physical fitness training services; providing exercise and fitness information through an on-line computer database; providing information in the field of exercise training; educational services, namely, conducting personal training in the field of health and fitness.

telecommunications services; telecommunication of information (web pages); broadcasting and transmission of television programmes; Telecommunications; advisory, consultation and information services in relation to the aforesaid; All of the above services being in the field of fitness.

Class 41: Education, teaching, instruction and training; personal training services; education, teaching, instruction and training in the fields of fitness, exercise, and body conditioning; education, teaching, instruction and training in relation to health, weight management, diet and nutrition; entertainment; sporting and cultural activities; the provision of fitness, exercise and body conditioning classes; rental of apparatus or equipment for exercise and fitness; provision of health and fitness club facilities; providing courses relating to exercise, fitness and body conditioning; publishing; the provision of on-line electronic publications (not downloadable) from the Internet; arranging, organising and conducting events, shows or competitions in the fields of fitness, exercise, entertainment, or sporting activities; advisory, consultation and

	information services in relation to the aforesaid; All of the above services being in the field of fitness.
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39. Mr Fiddes' submission at the hearing was that the services at issue are identical or similar. No submissions have been made by the applicant, other than the pleadings in its defence and counterstatement.

40. In the judgment of the CJEU in *Canon*,¹⁰ 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.”

41. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case¹¹ 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;

¹⁰ Case C-39/97.

¹¹ [1996] R.P.C. 281.

(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.

42. In *Kurt Hesse v OHIM*,¹² the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods/services. In *Boston Scientific Ltd v OHIM*,¹³ the General Court stated that “complementary” means:

“...there is 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”.

43. The General Court confirmed in *Gérard Meric v OHIM*¹⁴ that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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”.

¹² Case C-50/15 P

¹³ Case T-325/06

¹⁴ Case T-133/05

44. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

45. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“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.”

46. Where there is a lack of evidence or submissions from the parties relating to the definitions of some of the terms in their respective specifications, I rely on my own knowledge of those terms, where necessary.¹⁵

47. I will make the comparison between the services at issue by grouping together the applicant’s services if they are susceptible to common reasoning.¹⁶

¹⁵ *esure Insurance Ltd v Direct Line Insurance Plc*, [2008] EWCA Civ 842 [56]-[57]

¹⁶ As per the decision of Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, in *Separode Trade Mark* BL O/399/10.

The applicant's class 38

48. Today, streaming, broadcasting and telecommunications are services that are increasingly converging. All three relate to communicating, in one way or another, with the public. There is no evidence before me on the point, but it is my understanding that providers of such services now bundle them together (i.e. internet, phone and television packages) so that there are shared channels of trade. The convergence of such technology, in my view, means that the consumers' perception of where the differences between the services lie is likely to be blurred. In the case of the parties' services, they are all related to athletic activities or are in the field of fitness, resulting in an overlap in purpose and in user. That the nature of streaming, broadcasting and telecommunications differs by way of the type of digital network (internet, satellite, cable, for example) creates a difference between the services. However, overall, I find a high degree of similarity between the opponent's 'streaming of audio and video material related to athletic activities on the internet and other computer and electronic communication networks' and the following terms in the applicant's specification:

Broadcasting services; television broadcasting services; television, cable television, satellite television and subscription television broadcasting services; interactive telecommunications services; telecommunication of information (web pages); broadcasting and transmission of television programmes; Telecommunications; All of the above services being in the field of fitness.

49. That leaves the applicant's 'advisory, consultation and information services in relation to the aforesaid [...] in the field of fitness'. The same reasoning applied in my previous paragraph does not apply here: the nature, purpose, user and channels of trade of these services differs to that of the opponent's class 38 services. However, there is some similarity between this term and the opponent's 'personal fitness training services and consultancy; providing exercise and fitness information through an on-line computer database; providing information in the field of exercise training' in class 41. There is a difference in nature in that the applicant's services offer advice, consultancy and information in relation to telecommunications and the opponent's offer consultancy and information in relation to exercise and fitness. However, given

the overlap in subject (i.e. fitness), it is likely the users will overlap, as well as there being a shared purpose. I find a medium degree of similarity between these services.

The applicant's class 41

50. In my view, it is self-evident that the following services in the applicant's specification are identical, either due to their wording or in accordance with *Merix*, with one or more of the terms in the opponent's class 41 specification:

Education, teaching, instruction and training; personal training services; education, teaching, instruction and training in the fields of fitness, exercise, and body conditioning; education, teaching, instruction and training in relation to health, weight management, diet and nutrition; the provision of fitness, exercise and body conditioning classes; providing courses relating to exercise, fitness and body conditioning; the provision of on-line electronic publications (not downloadable) from the Internet; All of the above services being in the field of fitness.

51. Publishing means to make information available to the public either through issuing printed copies of documents or via websites, e-publications and applications, for example.¹⁷ Therefore, I find the applicant's 'publishing [...] in the field of fitness' identical, in accordance with *Merix*, to the opponent's 'providing information in the field of exercise training'.

52. I turn now to the applicant's 'entertainment; sporting and cultural activities; arranging, organising and conducting events, shows or competitions in the fields of fitness, exercise, entertainment, or sporting activities; All of the above services being in the field of fitness'. Entertainment, activities, events and competitions in the field of fitness are all likely to be hosted by a fitness instructor or at least involve physical fitness instruction, a term included in the opponent's specification. These services differ in their nature but are likely to overlap in purpose and in user. Whilst they are not complimentary in the sense described in *Kurt Hesse*, it is possible that consumers will

¹⁷ Definition from www.nationalarchives.gov.uk.

think they are provided by the same undertaking. I find a high degree of similarity between these services.

53. The applicant's 'rental of apparatus or equipment for exercise and fitness; provision of health and fitness club facilities' are complimentary to the opponent's class 41 services. These services are likely to overlap in purpose and in user. I find a medium degree of similarity between these services.

54. Finally, the applicant's 'advisory, consultation and information services in relation to the aforesaid' warrants the same reasoning as applied in paragraph 49 of this decision and I find a medium degree of similarity with the opponent's class 41 services.

The average consumer and the nature of the purchasing act

55. It is necessary for me to determine who the average consumer is for the services in question; I must then determine the manner in which the services are likely to be selected by the average consumer in the course of trade.

56. 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.

57. 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.”

58. In my view, the average consumer of the services at issue will be a member of the general public with an interest in fitness. Purchases are likely to vary in frequency, but consumers accessing fitness-related services are likely to do so on a fairly regular basis. The cost will also vary – for example, a person may be able to access fitness content online for a small monthly membership. Conversely, having one-to-one personal fitness training may attract a higher cost. In the case of all the services, the consumer is likely to exercise some care in its selection to ensure the services are suited to its requirements. I therefore consider that the level of attention paid by the average consumer during the purchasing process will be medium.

59. The services are most likely to be chosen online or in printed advertisements. Consequently, I consider that visual considerations are likely to dominate the selection process. However, there is an aural element to the purchase with word of mouth recommendations playing a part in the selection, and with conversations taking place with professionals, such as fitness trainers.

Comparison of marks

60. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relevant 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.”

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

62. The trade marks to be compared are as follows:

Earlier marks	Contested mark
IFIT	

63. The opponent's EUTM and IR(UK) are identical and so I will refer to them collectively as "the earlier marks" in my comparison.

Overall impression

64. The contested mark consists of the word FIT (with the F and T in upper case and the I in lower case) in a stylised font, in black, followed by a red full stop. Below and aligned right is the word LIVE in upper case, in black and in a standard font. These elements are contained within the outline of a black circular device. The word FIT, whilst being the visually dominant element, is descriptive of the services for which the mark is applied for, as is the word LIVE. The stylisation, full stop and device are simply

decorative within the mark. All the elements of the mark are pretty weak, so they will play a roughly equal role in the overall impression.

65. The earlier marks consist of the invented word IFIT. Although conjoined, the consumer is likely to separate the word into the letter I and the ordinary dictionary word FIT. As FIT is descriptive of the services for which the marks are registered, it will play a lesser role in the overall impression, which lies in the joining of the two elements.

Visual comparison

66. Visually, three of the letters of both marks are the same – FIT. The marks differ because the earlier marks are preceded by the letter I and the contested mark is followed by a full stop and the word LIVE. The stylisation and device in the contested mark also create a visual difference. Overall, I consider the marks to share a low to medium degree of visual similarity.

Aural comparison

67. I consider that the earlier marks will be broken down into the letter I and the ordinary dictionary word FIT, which will both be given their ordinary English pronunciations. The full stop in the contested mark is unlikely to be articulated and so the mark will be pronounced as the two ordinary dictionary words FIT LIVE. As the word FIT is descriptive of the services for which the marks are applied for/registered, the difference between the other verbal elements will be given greater significance by the consumer. In my view, the marks share a medium degree of aural similarity.

Conceptual comparison

68. Conceptually, the applicant's mark is likely to create the impression of a fitness service that can be accessed in real time. In my view, the letter I in the earlier marks could be perceived as referring to either the user or a service which is intended to be used via the internet. For those consumers who recognise the latter meaning, there will be at least a medium degree of conceptual similarity given the overlap between

“live” and “internet”. For those consumers who recognise the former meaning, there will be a low degree of conceptual similarity.

Distinctive character of the earlier mark

69. The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier marks, the greater the likelihood of confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer* 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).”

70. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

71. Mr Fiddes, at the hearing, made the following submission:

“This is a mark which is quite well known, as the evidence supports. [...] there are also examples of where use of the marks are referred to by third parties in the evidence. It is quite clearly well known. So, therefore, as a result of that acquired distinctiveness, I think it has quite a high degree of inherent acquired distinctive character.”

72. The evidence I believe Mr Fiddes was referring to consists of three online articles relating to IFIT memberships.¹⁸ One article is undated, and one is an article relating to NordicTrack’s VR Bike (which I understand to be another brand of the opponent), which briefly mentions IFIT half way through. The third article relates to an IFIT watch and is dated November 2015. I am not satisfied that these articles show use of the mark at a sufficient level to have enhanced its distinctive character.

73. There have clearly been sales in the UK. However, I have not been provided with the market share held by the mark. Further, the amount spent on advertising relates to exercise equipment, IFIT services and IFIT live services and is not broken down. Similarly, the turnover figures are said to relate to exercise machines and the sales figures relate to both memberships and wearables. Therefore, I cannot discern the proportion of the aforesaid figures which solely relate to the mark IFIT used for the services on which the opponent relies. The opponent’s evidence falls short of demonstrating that the distinctiveness of its marks has been enhanced through use.

74. I can, therefore, only consider the inherent distinctiveness of the earlier marks. Whilst registered trade marks must be assumed to have “at least some distinctive character”,¹⁹ I have found that the word FIT is descriptive of services relating to fitness. The distinctive character of the mark lies in the conjoining of the word FIT with the letter I. I consider the inherent distinctive character of the earlier marks to be very low.

¹⁸ Exhibit JM6.

¹⁹ *Formula One Licensing BV v OHIM*, Case C-196/11P

75. For the avoidance of doubt, even if I had taken the figures in Mr McHale's witness statement into account, the distinctiveness of the opponent's marks would only have been enhanced from a very low degree to a low degree.

Likelihood of confusion

76. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

77. I have found the marks to be visually similar to a low to medium degree, aurally similar to a medium degree and conceptually similar to either a low or at least medium degree depending on the consumer's perception of IFIT. I have found the earlier mark to have a very low degree of inherent distinctive character (or a low degree if I am wrong in my finding of enhanced distinctiveness). I have identified the average consumer to be a member of the general public interested in fitness who will purchase the services predominantly by visual means, though I do not discount an aural element to the purchase. I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the services to vary in similarity from medium to identical.

78. I will carry out my assessment on the basis of those services which are identical, as if there is no likelihood of confusion in respect of those, it follows that there will be no likelihood of confusion in respect of those services which share a lesser degree of similarity.

79. I bear in mind the decision of the CJEU in *L’Oreal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion. However, it is clear from the judgment of the CJEU in *Lloyd* (cited above), that descriptive matter should be given less weight when comparing trade marks. Further, I bear in mind the comments of Mr Iain Purvis Q.C., sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O/075/13. 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.”

80. In my view, the distinctiveness of the earlier mark does not lie in the use of the word FIT but in the conjoining of FIT with the letter I.

81. Because the common element of the marks is descriptive of the services for which they are applied for/registered, greater weight will be attributed to the remaining elements of the mark. The contested mark combines different elements with the word FIT and in a different form (with the letter I at the beginning of the earlier marks to create one word and the word LIVE at the end of the contested mark which is presented as two separate words). Whilst the marks may have similar conceptual

meanings, the visual and aural differences are sufficient to differentiate between them. Notwithstanding the principle of imperfect recollection, I consider that the different additional elements in the marks will be sufficient to enable the consumer to differentiate between them. I do not, therefore, consider that there is a likelihood of direct confusion.

82. I will now consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:²⁰

“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 recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.”

83. If the consumer recognises the difference between the marks, I see no reason why the average consumer would assume that the marks come from the same or economically linked undertakings. The common element – the word FIT – is descriptive of the services at issue. The consumer would have no reason to believe that only one undertaking would use this word in relation to fitness-based services. I do not, therefore, consider there to be a likelihood of indirect confusion.

84. The opposition under section 5(2)(b) has been unsuccessful.

²⁰ BL O/375/10.

Section 5(4)(a)

85. Section 5(4)(a) states as follows:

“5(4) A trade mark shall not be registered it, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection 4(A) is met or

(b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

Subsection 4(A) is as follows:

“The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

86. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "*a substantial number*" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

87. For the purposes of its opposition based upon section 5(4)(a), the opponent claims to have used the sign IFIT.LIVE throughout the UK since 2016 for 'Personal fitness training services and consultancy; physical fitness instruction; physical fitness training services; providing exercise and fitness information through an on-line computer database; providing information in the field of exercise training; educational services, namely, conducting personal training in the field of health and fitness'.

88. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander Q.C., as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TMO-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.' "

89. There are no submissions or evidence to suggest that the applicant has used its contested mark prior to the date of application (7 February 2020), so this is the relevant date.

Goodwill

90. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

91. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing

officer that it is not shown on the balance of probabilities that passing off will occur.”

92. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

93. Mr McHale, at paragraph 6 of his witness statement, made the following submissions:

“(iii) The IFIT subscription service and apps. Originally, we provided media cards which were inserted into the fitness equipment and played recorded classes from instructors: these used the brand IFIT. The next stage was module branded IFIT LIVE which connected exercise machines to wifi, and allowed workouts to be accessed on the machine. We then moved on to our current system, which uses LCD consoles attached to the equipment. Most of these are provided on a pivot, so that they can either be used on the equipment itself, or can be used for other workouts such as yoga, or other mat work classes. In particular, subscribers to our services have access to:

a. [...]

The subscription service has included the name IFIT for at least the last 14 years, since I have been with the company. There was use of IFIT LIVE when the module was introduced, and this continued as the main name for the workouts and the like until around 2015-2016. After that point there was

some use of IFIT COACH also, but we moved primarily use only IFIT. However, in the last year or so the importance of live classes has increased and we have a weekly schedule of live classes, so once again LIVE is associated with the IFIT name, as we reference the live classes as IFIT LIVE. [...]"

94. This appears to suggest that neither IFIT.LIVE (as per the statement of grounds) or IFIT LIVE (as per the witness statement) were in use in 2016. I take these submissions to mean the opponent ceased use of IFIT.LIVE by 2016 and has recently started using it again. This is reinforced by one of the articles in exhibit JM6. The article on www.runreviews.com headed "iFIT Workouts and Review" reviews IFIT LIVE module workouts and the SD cards. It is undated, but was updated in 2015 with the following message at the top of the article:

"2015 UPDATE: iFit LIVE is now called simply iFit. The SD cards have been phased out for the most part, and new machines are either iFit compatible, meaning you need to purchase a module to use it on your treadmill, or iFit enabled, which means that iFit is ready to go on your machine, no module necessary....]"

95. This supports the submission in Mr McHale's witness statement that the opponent stopped using IFIT LIVE in 2015. In any case, I have reviewed the evidence and will make a finding in relation to goodwill accordingly. That way, I can determine whether there is any residual goodwill from the earlier period of use.

96. There is a brief mention of IFIT LIVE in relation to workouts in an undated brochure (although Mr McHale submits it is from around 2015-2016) at exhibit JM4. IFIT LIVE is visible on a device in an image within the same exhibit. Mr McHale submits the image is from 2012. There are four articles in exhibit JM6 that mention IFIT LIVE and its associated training programs. One article is undated (referenced at paragraph 94 to this decision), however, as a comment is visible at the bottom of the article dated May 2010, I presume the article was posted in or before 2010. The remaining three articles are dated November 2014, January 2014 and April 2015.

97. The amount spent on advertising in Mr McHale's witness statement includes the marketing of exercise equipment, IFIT services and "to some degree IFIT LIVE services". There is no breakdown for me to know how much was spent on marketing IFIT LIVE in relation to the services the opponent claims the mark has been used on, and with what result in terms of sales. In fact, there is no evidence of any sales in connection with the services listed in paragraph 87. The turnover figures at paragraph 20 of the witness statement relate to exercise machines and the sales figures at paragraph 21 relate to IFIT LIVE compatible products, neither of which are the services mentioned at paragraph 87. Mr McHale, in his witness statement, said that the opponent had started using IFIT LIVE again. There is no dated evidence to corroborate this statement and to show the extent to which the sign was used after 2015.

98. In *Starbucks (HK) Limited & Anor v British Sky Broadcasting Group Plc & Ors* [2015] UKSC 31, Lord Neuberger (with whom the rest of the Supreme Court agreed) stated that:

"I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involved the presence of clients or customers in the jurisdiction for the products or services in question."²¹

99. The opponent has not shown that it has customers in the UK for the services listed in paragraph 87 under the mark IFIT LIVE. Consequently, I am unable to find that the opponent has protectable goodwill in relation to those services, neither at the relevant date nor residual goodwill from a previous period.

100. The opposition under section 5(4)(a) has been unsuccessful.

CONCLUSION

101. The opposition has failed and the application can proceed to registration.

²¹ Paragraph 47.

COSTS

102. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016. I have borne in mind the fact that the applicant filed no evidence or submissions. In the circumstances I award the applicant the sum of £300 as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Preparing a statement and considering the other side's statement	£300
Total	£300

103. I therefore order ICON Health & Fitness Inc to pay FIT BROADCASTING SERVICES LTD the sum of £300. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 3rd day of June 2021

E VENABLES

For the Registrar