

O-853-22

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3589109
BY PERSONAL TRAINER LTD
TO REGISTER THE TRADE MARK
BOSSFIT HEALTH CLUBS ESTD 2020
IN CLASS 41**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 426921 BY
CROSSFIT LLC**

BACKGROUND

1) On 2 February 2021, Personal Trainer Ltd (hereinafter the applicant) applied to register the trade mark “Bossfit Health Clubs Estd 2020” in respect of following services:

In Class 41: Health club services; provision of gym facilities; training services relating to health and fitness.

2) The application was examined and accepted, and subsequently published for opposition purposes on 18 June 2021 in Trade Marks Journal No.2021/025.

3) On 21 September 2021 CrossFit, LLC (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
CROSSFIT	3104831	20.04.15 24.07.15	41	Education; providing of training; entertainment; sporting and cultural activities; fitness training; entertainment services, namely an on-going series featuring fitness, nutrition, sport and exercise provided through television, radio, satellite, film, internet, audio and video media; production of television programs, radio programs and cinematographic films; providing information in the field of fitness, nutrition, sports and exercise via a website; entertainment services, namely, providing information in the fields of fitness training, sports, and exercise via a podcast; educational services, namely, conducting lectures, seminars and workshops in the fields of fitness, nutrition, sports and exercise; entertainment in the nature of competitions in the field of fitness; entertainment in the nature of sports competitions.
CROSSFIT	905049192	02.05.06 02.08.07	41	Fitness training; rendering online interactive fitness services which allow users to create and/or use fitness and body building programs; providing information in the field of fitness and bodybuilding; consultation services with fitness trainers; educational, instructional and training services; arranging and conducting

				<p>educational and training conferences and seminars; production of educational sound and video recordings; lease, hire and rental of instructional and teaching materials; provision of education on-line from a computer database or via the Internet or extranets; conducting courses, seminars and workshops; design, setting, administering and marking examinations; testing of people; provision of online journals featuring information relating to fitness and nutrition; provision of blogs featuring information on fitness and special events; information, advisory and consultancy services relating to the aforesaid, including the provision of such services online from the internet or extranets.</p>
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4) The grounds of opposition are in summary:

- a) The opponent contends that the marks and services in Class 41 of the two parties are highly similar. The mark in suit therefore offends against Section 5(2)(b).
- b) The mark in suit and the services for which it is sought to be registered are similar such that the applicant will be able to free ride on the distinctive character of the opponent's mark and it's marketing, use of the mark in suit could tarnish the opponent's mark if the quality were poor, and will also dilute the distinctiveness of the opponent's mark. The mark in suit therefore offends against section 5(3).
- c) The opponent has used its mark since 2005 in the UK and has considerable reputation in its class 41 services such that use of the mark in suit on the services listed will cause misrepresentation given the similarity of the services and marks. The mark in suit offends against section 5(4)(a).

5) On 23 December 2021 the applicant filed a counterstatement, in which it denies the grounds of opposition. The applicant puts the opponent to strict proof of use.

6) Only the opponent is professionally represented. Both filed evidence and ask for an award of costs. The matter came to be heard on 7 September 2022 when the applicant was represented by Ms Sahdra who is the accounts manager of the applicant company; the opponent was represented by Mr Syed of Messrs Beck Greener LLP.

7) 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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

DECISION

8) I shall first consider the ground under section 5(2)(b) which reads:

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

(a)

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

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

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

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

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

10) Section 6A reads:

“(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), (aa) 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 relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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)-(5A) [Repealed]

(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.”

11) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. The mark in suit was applied for on 2 February 2021 at which point the opponent’s marks had both been registered for over five years. Therefore, the proof of use requirements bite.

12) Section 100 of the Act states that:

“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.”

13) In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) 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 Marken 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].”

14) In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

15) In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all

depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

16) The opponent filed a witness statement, dated 4 July 2022, by Marshall Brenner its General Counsel who has held this position since 2016. He has extensive knowledge of the opponent’s activities and full access to its records. He states that there are 642 gyms in the UK licensed to use the CrossFit mark in “the provision of fitness and training facilities, coaching and related services”, with the first use occurring in 2005. He contends that the opponent also “educates the public by publishing exercise techniques, fitness, nutrition, sports and exercise advice”, and that by holding competitions and events relating to fitness and exercise it is also providing entertainment. The company also sells clothing and equipment under the mark. Income from the licensed gyms in the UK has averaged approximately US\$ 1.3million per annum in the period 2017-2021 inclusive. Revenue from individuals carrying out fitness courses in the UK in the same period has averaged approximately US\$1million per annum. The mark has been promoted by use on the websites of the opponent and the licensees and also on various social media accounts, as evidenced in the exhibits. The opponent also provides in its exhibits a number of articles from national newspapers and magazines where stories which mention CrossFit have been printed, these newspapers include The Metro, The Independent, The Daily Mai, Evening Standard and Men’s Health. I note in particular the following from exhibit MB13: “Forbes: Sportsmoney” dated: 25 February 2015:

- a) "CrossFit gives away its exercises for free in a video of the day."
- b) "The main drivers of CrossFit's revenue are the \$3,000 annual fees operators of its gyms pay and \$1,000 seminars where box [gym] owners explain the CrossFit philosophy"
- c) "There are also the Reebok CrossFit Games, televised on Walt Disney -owned by ESPN- that produces little money but a lot of brand awareness".

17) In determining a fair specification I take into account the comments in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, where 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."

18) I also note that in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

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

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

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it

was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

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

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

19) Further, in *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 (Court of Appeal), a case which concerned pharmaceutical substances and preparations, Kitchen LJ held that it was well established that (1) a category of goods/services may contain numerous subcategories capable of being viewed independently and, (2) the purpose and intended use of a pharmaceutical product are of particular importance in identifying the subcategory to which it belongs.

20) I accept that the evidence shows that the opponent has used its "CrossFit" mark in the UK during the five year period prior to the application being filed on fitness training delivered via gyms. I do not accept that the mark has been used on educational services, entertainment services or any of the other services for which the marks are registered. In the comparison test I will therefore use the following specifications:

- 3104831: Providing of training; fitness training in gyms.

- 905049192: Fitness training in gyms; providing information in the field of fitness and bodybuilding; consultation services with fitness trainers.

21) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

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

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

23) The services in question are, broadly speaking, “gyms / health clubs providing fitness training”. In my opinion, the average consumer for the services under consideration will be a member of the UK general public who wishes to get fit. Turning now to the level of attention the average consumer will display when selecting the services, the users of such services are seeking to improve their health and fitness which assumes ever more importance in society. Gym membership is relatively expensive and there are many different styles of training all claiming to achieve “better” results than others in the field. The users are, in my opinion, likely to pay an above average level of attention when choosing a service which will take up a considerable amount of their time and money.

24) Such services will be sold through a range of channels, such as advertising both on-line and in other media outlets, through signs on the physical premises and also personal recommendations. The initial selection is therefore likely to be a visual one, although I accept that the consumer may enter into a discussion with staff, for instance to ensure the type of training is suitable for their ability and needs. Considered overall, the selection process is likely to be predominantly a visual one, although I accept that aural considerations will also play their part.

Comparison of services

25) In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant

factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

26) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (GC) stated that:

“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 für 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”.

27) 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."

28) In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

29) The services of the two parties are:

Opponent’s specifications	Applicant’s specification
3104831: Providing of training; fitness training in gyms. 905049192: Fitness training in gyms; providing information in the field of fitness and bodybuilding; consultation services with fitness trainers.	In Class 41: Health club services; provision of gym facilities; training services relating to health and fitness.

30) 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.

31) To my mind the services of both the opponent's marks fully encompass the whole of the services the applicant is seeking to register. It is clear that the uses and users are identical, the physical nature of the services are identical and the services, if not identical would be highly similar and would be in competition with each other. **The services for which both the opponent's marks are registered must be regarded as identical to the applicant's specification.**

32) The above finding means that even if I were overly strict in my assessment of which services the opponent had shown use upon, the opponent would be in no stronger position than this finding.

Comparison of trade marks

33) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

34) It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall

impressions created by them. The opponent's marks are identical and I shall therefore only carry out a single comparison. The marks to be compared are, for ease of reference:

Applicant's mark	Opponent's mark
Bossfit Health Clubs Estd 2020	CROSSFIT

35) The opponent contends:

"24. With respect to the Applicant's mark, the element "health clubs estd 2020" is merely descriptive/non-distinctive for the services in the Application which, as previously mentioned, is also accepted by Mr Kiani at paragraph 11 of his statement. BOSSFIT is the dominant distinctive element of the Applicant's mark and consequently should be the Tribunal's focus of attention.

25. The Applicant's mark shares 6 identical letters with the Opponent's mark, namely 'OSSFIT' and only differs in the first letter which is a "b" rather than "cr". The identical 6 letters that are shared by the marks in particular make the marks phonetically and visually highly similar. The marks would be pronounced in almost the same way because the first syllable in each mark share the letters "oss" whereas the second syllable in each mark is identical, namely the word "fit". This is what will remain phonetically and also visually in the mind of the average consumer.

26. Conceptually, both marks are invented words and neither mark has a clear meaning in English other than the "fit" element shared by both. The word "fit" in the context of the services at issue relates to being "sound physically and mentally: healthy" (MerriamWebster Online Dictionary). The term "health clubs estd 2020" in the Applicant's mark also relates to the same concept of being "healthy" by way of club services provided by an entity which has been established since 2020. Consequently, the marks are also conceptually highly similar."

36) The opponent also referred me to *Aveda Corp v Dabur India Ltd*, [2013] E.T.M.R. 33 (2013) where at paragraph 48 Arnold J. (as he was then) said:

“48. On that basis, I consider that the hearing officer failed correctly to apply *Medion v Thomson*. He failed to ask himself whether the average consumer would perceive UVEDA to have significance independently of DABUR UVEDA as a whole and whether that would lead to a likelihood of confusion. Accordingly, it is necessary for me to consider the matter afresh. Having regard to the matters set out in [39] above, I think there can be little doubt that the average consumer who was familiar with AVEDA beauty products would be likely to be confused by the use of DABUR AVEDA in relation to identical goods. In particular, there would be a strong likelihood that the average consumer would think that it indicated some connection between DABUR and AVEDA. In my judgment it makes little difference that the second word in the composite mark is UVEDA rather than AVEDA. As the hearing officer rightly accepted, UVEDA is both visually and aurally very close to AVEDA. The human eye has a well-known tendency to see what it expects to see and the human ear to hear what it expects to hear. Thus, it is likely that some consumers would misread or mishear UVEDA as AVEDA. (Indeed, not only did the hearing officer himself write AVEDA instead of UVEDA at [43], but also the Intellectual Property Office’s database of past decisions currently records the contested mark as being “Dabur AVEDA”.)”

37) Dealing firstly with the opponent’s submissions, whilst I agree with the opponent that the words “health clubs estd 2020” are non-distinctive, they exist as part of the mark and cannot be so conveniently disregarded as the opponent contends. They form part of the mark and must be taken into account, even if the weight given to them is small. The opponent’s assertions in the remaining paragraphs are frankly absurd. Whilst the first word in the applicant’s mark and the sole word in the opponent’s mark do have six letters which are identical this ignores the somewhat inconvenient, from the opponent’s view, fact that the applicant’s mark has, as its first letter, a “B” whereas the opponent’s mark starts with the letters “CR”. The claims about similarity ignore the presence of the other words in the applicant’s mark but also ignores the fact that both the marks will be seen as consisting of two common well-known English dictionary words. In the applicant’s mark “BOSS” and “FIT” and in the opponent’s mark “CROSS and FIT”. Clearly the word “FIT” in both is descriptive of the services on offer. Equally in the case of the word CROSS this is frequently used to describe a form of training. “Cross training” is essentially adding different types of training into your routine to achieve a more rounded set of skills that your body can

call on when needed. For example, runners often use cycling as an alternative exercise to build and maintain endurance, whereas swimmers practicing rowing to keep up their exercise capacity and work similar muscle groups. This provides variety for the athlete and also sometimes helps in winter when outdoor exercise can be difficult, whereas cycling indoors on rollers or on a static bike avoids adverse weather conditions.

38) The whole of the opponent's mark is thus somewhat descriptive of the services on offer. To my mind, the average consumer will view CROSSFIT as simply another way of stating that the services offered by the opponent will get you fit using cross training, and their advertising serves to confirm the use of a variety of training methods. In contrast the applicant's mark has "BOSS" as its first word. This, to the best of my knowledge, has no meaning whatever in relation to the services in question.

39) Turning to the case of Aveda to my mind this is not on all fours with the instant case. In that case an invented word which would have been unfamiliar to the average consumer had been slightly misspelt (Aveda / Uveda) and had a house mark put in front of it. In the instant case both marks are formed by the conjoining of two well known English words (BOSS FIT and CROSS FIT). The conjoining does not disguise the fact that they are both made up of two well known words, the latter one in each instance being descriptive of the services. There are very obvious visual, aural and conceptual differences between the two marks and only superficial similarities. The only point of similarity is the letters "ossfit" and the opponent does not have a reputation in these letters. Further, the average consumer will not view the letters as forming a word. There is such a difference between the meanings of CROSS and BOSS, not least as CROSS has a meaning in respect of fitness training, that the average consumer will not confuse them. At best the marks could be said to be similar to a low degree visually and aurally, whilst conceptually they are significantly different.

Distinctive character of the earlier trade mark

40) 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).”

41) The opponent’s mark has an obvious meaning for the services involved in this action despite the opponent conjoining two words and claiming it to be invented. In my opinion it has a low degree of inherent distinctiveness. The opponent has provided evidence of use which shows that it has a reputation in the UK for the services in question and as such can benefit from enhanced distinctiveness through use.

Likelihood of confusion

42) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the

average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

Earlier in this decision, I concluded that:

- At best the marks could be said to be similar to a low degree visually and aurally, whilst conceptually they are different.
- the average consumer for the services is a member of the UK general public who wishes to get fit, who will select the services by predominantly visual means, although I do not discount aural considerations and that they are likely to pay an above average degree of attention to the selection of the services.
- the opponent's mark has a low degree of inherent distinctiveness but can benefit from an enhanced distinctiveness through use in relation to the services for which I found that there has been use.
- The services for which both the opponent's marks are registered must be regarded as identical to the applicant's specification.

43) I take into account the views in *The Picasso Estate v OHIM*, Case C-361/04 P, the Court of Justice of the European Union found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

44) I also take into account the views expressed in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).
 - (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).
 - (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

45) In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be

a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

46) In view of all of the above, even allowing for the concept of imperfect recollection, despite the identity of the services the differences between the trade marks of the two parties are such that there is no likelihood of consumers being indirectly or directly confused into believing that the services provided by the applicant are those of the opponent or provided by an undertaking linked to it. **The opposition under Section 5(2) (b) therefore fails.**

47) I next turn to the ground of opposition under section 5(3) which reads:

“5. (3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

48) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark

have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L’Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L’Oreal v Bellure*).

49) I must first determine, if at the relevant date for the opposition (2 February 2021) the opponent had a reputation in relation to its mark CROSFIT and if so in what services. The test for 'reputation' was set out by the CJEU in *General Motors*. The earlier mark must be known by 'a significant part' of the relevant public. The evidence provided by the opponent was summarised earlier in this decision at paragraph 16. It was far from overwhelming as the figures for turnover were not put into perspective in relation to market share. Despite this I am willing to accept that the opponent clears the first hurdle of reputation in respect of "Providing of training; fitness training in gyms" and "Fitness training in gyms; providing information in the field of fitness and bodybuilding; consultation services with fitness trainers".

50) I must now turn to consider whether the consumer would make a link between the activities of the two parties. In deciding this issue, I take into account the comments of Mr Geoffrey Hobbs Q.C. (sitting as a Deputy Judge) in *Electrocoin Automatics Limited and Coinworld Limited and Others* [2005] FSR 7:

"102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, 'the link' established in the minds of people in the market place needs

to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.”

51) I also look to the case of *Intel Corporation Inc v CPM United Kingdom Ltd* [2006] EWCH 1878 where Patten J said at para 28:

“But the first step to the exploitation of the distinctive character of the earlier mark is necessarily the making of the association or link between the two marks and all that Neuberger J is, I think, saying in this passage [Premier Brands at p. 789] is that the existence of a later mark which calls to mind the earlier established mark is not sufficient to ground an objection under s.5(3) or s.10(3) unless it has one or other of the consequences specified by those provisions. It must be right that the making of the association is not necessarily to be treated as a detriment or the taking of an unfair advantage in itself and in cases of unfair advantage it is likely to be necessary to show that the making of the link between the marks had economic consequences beneficial to the user of the later mark. But in relation to detriment the position is more complicated. The association between two marks and therefore potentially between the products or services to which they relate may be detrimental to the strength and reputation of the earlier mark if it tarnishes it by association or makes it less distinctive. This is likely to take place as a consequence of the same mental process which links the two marks in the minds of consumers and is essentially a negative reaction and effect.”

52) Under this ground of opposition it is not necessary that the reputation of the opponent is in goods or services which are similar to those sought to be registered by the applicant. However, in the instant case the services opposed were found earlier in this decision to be identical to the services for which the opponent has a reputation. This identity is merely one of the factors to be taken into account. Earlier in this decision I determined that the marks of the two parties are visually and aurally similar to a low degree, but they are significantly different conceptually. To my mind the mark in suit will not form a link even when used on services which are identical to those for which the opponent has reputation.

This provides an outcome identical to that under section 5(2)(b). The ground under section 5(3) therefore fails.

53) Lastly, I turn to the ground of opposition under section 5(4)(a). In respect of section 5(4)(a) Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

54) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

55) Earlier in this decision I found that the opponent has goodwill and reputation in its marks. I also found earlier in this decision that use of the mark in suit, actual or on a fair and notional basis would not result in confusion with the opponent’s mark. Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will not occur. **The opposition under Section 5(4)(a) of the Act must fail.**

CONCLUSION

56) The grounds of opposition under sections 5(2)(b), 5(3) & 5(4) all failed. Trade mark 03594111 can proceed to registration.

COSTS

57) As the applicant has been successful it is entitled to a contribution towards its costs. The applicant has represented itself during the course of this action. In *Adrenalin Trade Mark*, BL O/040/02, Simon Thorley Q.C. sitting as the Appointed Person on appeal, observed that:

“It is correct to point out that the Registrar’s practice on costs does not specifically relate to litigants in person but in my judgement it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR [Civil Procedure Rules]. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6.”

58) Part 48.6 of the Civil Procedure Rules referred to in the above passage provides as follows:

“48.6 – (1) This rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative.”

59) The applicant provided a proforma of the time spent on this case which totalled 59 hours. This seems reasonable to me and so I award the applicant £1121.

60) I order Crossfit LLC to pay Personal Trainer Ltd the sum of £1,121. This sum to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd day of October 2022

G W Salthouse

For the Registrar

the Comptroller-General