**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2047739**
**BY RUN/WALK FOR LIFE INTERNATIONAL (PTY) LTD**
**TO REGISTER A MARK IN CLASS 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER OPPOSITION NO. 45083 BY BLADERUNNER CORPORATION UK LIMITED**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF application no. 2047739 by Run/Walk For Life International (Pty) Ltd to register a mark in Class 41**

**AND**

**IN THE MATTER OF Opposition thereto under opposition no. 45083 by Bladerunner Corporation UK Limited**

**DECISION**

On 6 December 1995 Run/Walk for Life International (Pty) Limited applied under the Trade Marks Act 1994 to register the mark exhibited below, in Class 41for a specification of services covering "Providing recreation and fitness facilities and services; recreation and fitness services and information; health club services; physical education; publication of printed materials, books magazines and newsletters; organisation of competitions; arranging and conducting conferences and seminars; physical training and instruction; production of video and CD programmes; radio and television programmes."

RUN WALK FOR LIFE

The application is numbered 2047739.

On 8 August 1996 Bladerunner Corporation UK Ltd filed an opposition to this application. The grounds of opposition are in summary:-

i) the opponents are registered proprietors of the trade mark WORKING FOR LIFE and have used the trade mark in relation to health and fitness services from at least the date registration, that is February 1993. The mark applied for is similar to the trade mark owned by the opponents and is to be registered for services which are identical or similar to those for which the opponents trade mark is registered. Registration would, therefore, be contrary to the provisions of Section 5(2);

ii) the opponents say they are the proprietors of an earlier right within the meaning of Section 5(4) of the Act;

iii) the application was made in bad faith and therefore registration would be contrary to the provisions of Section 3(6) of the Act.

Details of the registrations of the earlier trade mark referred to above are as follows:-

| NO. | MARK | FILING DATE | JOURNAL | SPECIFICATION |
|---|---|---|---|---|
| 1527781 | WORKING FOR LIFE | 23 February 1993 | 5997/6696 | Health club services; provision of gymnasium, leisure and recreation facilities; keep fit instruction services; provision of training courses, seminars, conferences and other educational services, all relating to health, fitness and physical and mental development and well-being; provision of information relating to sport and leisure activities, and to leisure, recreational and sports facilities, events and venues; advisory and consultancy services, all relating to the aforesaid services; all included in Class 41. |
| 1527782 | WORKING FOR LIFE | 23 February 1993 | 5995/6375 | Medical, health and fitness services; medical and health counselling and advisory services; provision of solarium and sauna facilities; advisory and consultancy services, all relating to the aforesaid in Class 42. |

The applicants filed a counterstatement denying the grounds of opposition.

Both sides seek an award of costs in their favour.

The opponents filed evidence in these proceedings and have asked for the Registrar's decision to be made on the basis of the papers filed and without recourse to a hearing. The applicants did not file evidence but they too have asked for a decision off the papers. Acting on the Registrar's behalf and after a careful study of the papers filed in these proceedings, I now give this decision.

The opponents evidence consists of a Statutory Declaration by Steven Burt and is dated 9 July 1997. Mr Burt explains that he formed Bladerunner Corporation UK Limited in 1989 and since then has occupied the position of Managing Director. He goes on to say that he is authorised to complete the declaration on his company's behalf which he does from his own knowledge and company records.

By way of background Mr Burt explains that he created the trade mark WORKING FOR LIFE in 1991 - the services offered under the trade mark taking the form of an educational fitness programme. Mr Burt states that the trade mark WORKING FOR LIFE seemed to be ideal for the services offered in that his Company were seeking to improve health and fitness through the organisation of educational and fitness programmes in the workplace. The words FOR LIFE seemed apt for services to improve the health of workers and thus their quality of life. He goes on to say that the combination of words WORKING FOR LIFE seemed to him to be a strong trade mark which conveyed his Company's aims and objectives whilst being distinctive and unusual and, in Mr Burt's view, being different from any trade mark used for these services.

Mr Burt explains that as the trade mark element LIFE became more closely associated with his Company they launched the trade marks LIFECHECK and LIFESWITCH for fitness related goods and services. They have also created the trade mark WALKING FOR LIFE for similar services in October 1995, some three months before the applicants mark was filed. Mr Burt states that these trade marks together with their flagship mark WORKING FOR LIFE have played an important part in his Company's success to date. In his opinion the word LIFE is generally associated with his Company in the minds of consumers.

Mr Burt provides details of the opponents registered trade mark WORKING FOR LIFE in classes 41 and 42 (see above). The annual monetary turnover in respect of services provided under the trade mark WORKING FOR LIFE in the United Kingdom since 1993 are as follows:-

| Year | £ |
|---|---|
| **1996** | 44,000 |
| **1995** | 30,000 |
| **1994** | 50,000 |
| **1993** | 45,000 |

Mr Burt explains that the opponents services are often publicised and advertised within customer organisations and he provides at Exhibit SB1 a 1993 leaflet advertising WORKING FOR LIFE services, a copy of a 1994 application form for British Telecommunications employees to join the WORKING FOR LIFE programme and a follow-up questionnaire for participants. At Exhibit SB2 Mr Burt provides a letter from Mr Michael Hepter, the then Group Managing Director of British Telecommunications PLC, regarding the participation by BT workers in the WORKING FOR LIFE programme. He goes on to say that the provision of this kind of service in a work environment, particularly to large corporations, is in itself unusual for employees. The programme is run in such a way that participants are aware that these services are offered by an outside agency rather than directly by their employers.

At Exhibit SB3 Mr Burt provides a review of the services the opponents offered under the trade mark WORKING FOR LIFE in British Petroleum PLC, Grangeworth, between 1995 and 1996. Also, at Exhibit SB4 he provides the most recent stylisation of the trade mark WORKING FOR LIFE which they use in a number of their current advertising and promotional leaflets and literature.

Mr Burt states that the geographical spread of the services offered within the UK has been extensive. His Company have operated fitness programmes under the WORKING FOR LIFE trade mark extensively in London and the South East, the Midlands, Wales and Scotland. Mr Burt says that his Company have spent £15,000 and £20,000 per annum on advertising the services for the years 1993 to 1996 inclusive. These amounts have been spent on the production of brochures, leaflets and other promotional material, the organisation and operation of seminars, and presentations, and attendance at trade shows and exhibitions. At SB5 is a copy of a photograph of a stand used as part of a presentation to British Petroleum PLC in 1996. Also, at Exhibit SB6 are a selection of local and trade press articles.

Mr Burt states that it was a natural progression from WORKING FOR LIFE to the creation in October 1995 of a new trade mark WALKING FOR LIFE. He expresses the view that the elements WORKING and WALKING are phonetically virtually identical and that the opponents have been successful in establishing a link between the two marks. Mr Burt states that the WALKING FOR LIFE trade mark was created three months before the applicants mark was filed and he is concerned that consumers would assume that services offered under the applicants mark emanate from the opponents. He goes on to say that the words FOR LIFE following a word or words describing an exercise activity have a strong association with the opponents. Also, he expresses the view that the device in the applicants mark has a negligible effect on the mark as a whole.

Whilst being aware of all the opponents major competitors, Mr Burt says that he has not heard of Run/Walk for Life International (Pty) Ltd and investigations have revealed no significant use of the applicants trade mark in the United Kingdom. Consequently, he has not been made aware of any specific instances of confusion. However, Mr Burt expresses the view that, in the event of the applicants mark being used more extensively in the United Kingdom, there is a significant risk that such confusion would occur.

As the applicants have filed no evidence that concludes my summary of the evidence. I go on to consider the grounds of opposition, starting with Sections 5(2) and 5(4) of the Act.

Since the mark cited by the opponents is registered and therefore is an earlier trade mark as defined by Section 6 of the Act, it would seem that I need only consider the matter under Section 5(2) since the opponents cite no other basis for their opposition under Section 5(4). Section 5(2) reads as follows:-

> 5(2) A trade mark shall not be registered if because -
>
> *(a) ..... , or

(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 trademark is protected,

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

( *since the marks at issue are obviously not identical I see no need to consider the matter under Section 5(2)(a)).

The term "earlier trade mark" is defined as follows in Section 6(1) of the Act:

"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,".

The first matter I must consider is whether the applicants services are identical with or similar to those of the opponents' registrations. The applicants specification includes "providing recreation and fitness facilities and services; recreation and fitness services and information; health club services". The opponents registration in Class 41 includes "health club services; keep fit instruction services; provision of training courses, seminars, conferences and other education services, all relating to health, fitness and physical and mental development and well being", and in their Class 42 registration "Medical, health and fitness services; medical and health counselling and advisory services". From this it seems clear to me that both identical and similar services are involved within the respective specifications. Having established that identical and similar services are at issue I go on to compare the marks themselves.

In comparing the respective marks I take into account the guidance given by Parker J in Pianotist Co Ltd's application (1906) 23 RPC 774 at page 777 lines 26 et seq which reads as follows:-

"You must take the two words. You must judge of them both by their look and their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy these goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods by the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be confusion - that is to say, not necessarily that one man will be injured and the other gain illicit benefit, but there will be confusion in the minds of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse registration in that case".

I also bear in mind the guidance set down by Luxmore L J which was approved by the House of Lords in the Aristoc Ltd V Rysta Ltd case [1945] 62 RPC at page 72 line 46 to page 73 line 4 which reads:

> "The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of Section 12 of the Trade Marks Act 1938 must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word and has perhaps an imperfect recollection of it who is likely to be deceived or confused. Little Assistance therefore is to be obtained from meticulous comparison of the two words, letter by letter and syllable by syllable pronounced with the clarity to be expected from a teacher of elocution. The court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants."

The opponents mark consist of the words WORKING FOR LIFE. The applicants mark is the words RUN/WALK FOR LIFE incorporating a device of a runner in place of the letter "i" in LIFE, with the words FOR LIFE in bold print. It appears to me that the essential feature of both marks is the words FOR LIFE. In de Cordova v Vick Chemical Co (1951) 68 RPC 163 Lord Radcliffe in delivering the opinion of the Privy Council said "a mark is infringed by another trader if, even without using the whole of it upon or in connection with his goods, he has one or more of its essential features ..... It has long been accepted that, if a word forming part of a mark has come in trade to be used to identify the goods of the owners of the mark, it is an infringement of the mark itself to use the word as the mark or part of the mark of another trader for confusion is likely to result." Whilst this is not an infringement action, it would seem logical that a mark which could infringe a prior right of a registered mark would fall within the ban expressed by Section 5.

I believe that the presence of the words FOR LIFE in the applicants mark would be noted by potential consumers and indeed I note that the opponents claim some notoriety in these words because of use of their mark and through advertising. Taking imperfect recollection into account, I could well imagine that a significant number of the public would be confused as to origin if they encountered the applicant's mark used in relation to identical and similar services, particularly when the two words FOR LIFE follow a word describing some form of fitness/health activity.

There are differences in the marks of course and I take account of the fact that the applicants mark does incorporate a device (as shown on page 1 of this decision). However, I take the view that the words are the dominant element in the applicants mark and the device has little impact in the context of any comparison with the opponent's mark. When comparing the marks as wholes, as I must do in the light of the ERECTICO v ERECTOR case 52 RPC 136, I find the marks to be confusingly similar. Consequently, the opposition succeeds under Section 5(2)(b) of the Act.

The remaining ground of opposition is under the provisions of Section 3(6) of the Trade Marks Act 1994. However, as the opponents have filed no evidence in support of this ground I find formally that they fail in this ground of their opposition.

The opposition having succeeded I order the applicants to pay to the opponents the sum of £535 as a contribution toward their costs.

Dated this 13 day of January 1998.

D C MORGAN
For the Registrar
the Comptroller General