

O-164-10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2498393  
BY US PREVENTIVE MEDICINE, INC TO REGISTER THE TRADE MARK**

**THE PREVENTION PLAN BY UK PREVENTIVE MEDICINE**

**IN CLASSES 16, 41 AND 44**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 98951  
BY RODALE, INC**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2498393  
By US Preventive Medicine, Inc to register the trade mark**

**THE PREVENTION PLAN BY UK PREVENTIVE MEDICINE**

**and**

**IN THE MATTER OF Opposition thereto under No. 98951  
by Rodale, Inc**

**BACKGROUND**

1. On 23<sup>rd</sup> September 2008, US Preventive Medicine, Inc of 1004 Woodcliff Drive, McKinney, Texas 75070, United States of America (hereafter "US") applied to the register (in standard characters without claim to font, style, size or colour) the following mark:

THE PREVENTION PLAN BY UK PREVENTIVE MEDICINE

in Classes 16, 41 and 44 for the following goods and services:

**Class 16**

Printed matter, publications; brochures; newsletters; magazines; books, professional journals; manuals and stationery.

**Class 41:**

Personal coaching services in the fields of health, nutrition, wellness, weight loss, diet, exercise, disease prevention and lifestyle.

**Class 44:**

Medical services, including medical and health risk testing, analysis and reporting; counselling and analytical services in the fields of health, disease prevention, nutrition and lifestyle wellness; providing information on health, wellness, disease prevention and nutrition via a website; providing information on health, wellness, disease prevention and nutrition via an on-line computer database; providing advice on fitness evaluation and consultation to individuals to help them make health, wellness and nutritional changes in their daily living to improve health; providing advice on fitness evaluation and consultation to corporate clients to help their employees make health, wellness and nutritional changes in their

daily living to improve health; providing health care information by telephone and the internet; monitoring of data indicative of the health or condition of an individual or group of individuals.

2. The application was published on 9<sup>th</sup> January 2009 and on 9<sup>th</sup> April 2009 Rodale, Inc of 33 East Minor Street, Emmaus, Pennsylvania 18098-0099, United States of America (hereafter “Rodale”) lodged an opposition against all goods and services specified.
3. Rodale based its opposition on section 5(2)(b) of The Trade Marks Act 1994 (hereafter the “Act”), citing an earlier Community Trade Mark, 4438248, the details of which are as follows:

Mark	Filing and registration dates	Goods and services relied upon in the opposition
PREVENTION	13 <sup>th</sup> May 2005 and 21 <sup>st</sup> June 2006	<p><b>Class 9</b></p> <p>Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic and optical data carriers; data-processing equipment and computers; breathalyser testing equipment; gas and air analysers (not for medical purposes); compact disc players; magnetic audio and video tapes; magnetic cards; magnetic cards being credit cards, smart cards; mouse pads; mobile telephones; electronic games adapted for use exclusively with a television receiver; computer game programs.</p> <p><b>Class 16:</b></p> <p>Printed matter, bookbinding material; stationery; greeting cards; non-electric credit card imprint apparatus; lithographic</p>

		<p>works of art.</p> <p><b>Class 35:</b> Advertising and publicity services; rental of advertising time on all means of communication; online advertising via a computer network; direct mail advertising; samples; advertising mail; publication of publicity texts; compilation and systematisation of data for advertising purposes in a central data file; data searches in computerised files; opinion polling for others.</p> <p><b>Class 38:</b> Telecommunications, transmission of programs, data, sound, images; providing access to a global network connecting several terminals with each other; online provision of access to information for subscribers; transmission of messages and images; transmission of data from databases; electronic transmission of data recorded in a database accessible via telecommunications networks; transmission of data, software, videos and films from the Internet, for others; providing access to sales pages via computer networks.</p> <p><b>Class 41:</b> Electronic online publication of books and articles; arranging of competitions for education or entertainment.</p> <p><b>Class 42:</b> Providing technical services in</p>
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		<p>connection with Internet subscriptions; Hosting of sites on a worldwide or local computer network; designing, development and maintenance of software and websites; software design; development, programming and design for the construction of databases, for others; programming of advertising pop-ups on web pages and websites, for others.</p>
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4. Rodale says the distinctive and dominant elements of US's mark are the words 'PREVENTION/PREVENTIVE'. The remaining elements: 'THE PLAN', 'BY', 'UK' and 'MEDICINE' are simple descriptive terms or words. Given that the distinctive elements are the same or similar, the respective marks are similar, based upon a visual, aural and conceptual comparison. The goods in class 16 are identical and the respective services in classes 41 and 44 are similar to those covered by Rodale's specification given their nature and other factors. Taking all factors into account, there is a likelihood of confusion under section 5(2)(b).
5. US filed a counterstatement denying the ground of opposition. They say the respective marks are not similar in sight, sound or meaning. The mere fact that the respective marks share a common term is not dispositive of the issue of there being a conflict and/or consumer confusion would be likely. Their mark contains seven words and Rodale's only one. Rodale's mark comprises the noun, 'PREVENTION', whereas they use the word PREVENTION as an adjective, modifying the noun 'PLAN'. US also use the further source identifier, 'BY UK PREVENTIVE MEDICINE', which makes the respective marks less similar.
6. They also say that Rodale's mark is inherently weak and/or generic as applied to health, wellness, fitness or related subject areas. Many third parties have registered marks in the UK or at Community level which include the word 'PREVENTION' in the same classes 16, 41 or 44.
7. As regards the goods and services, they concede that the goods in class 16 are the same but there are no services in Rodale's specification which are remotely similar to their own specification. Rodale's specification covers computer, technical or advertising services which are not the same or similar to coaching, medical, and/or wellness services covered by US's specification.

8. Neither side filed evidence. US's attorneys filed final submissions and these will be taken into account. Both sides request costs. In the absence of any request for a hearing, the matter falls to be decided on the basis of the papers on file.

## DECISION

9. The opposition is founded solely upon Section 5(2) (b) of the Act. This reads:

“(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.”

10. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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,

11. With a filing date of 13<sup>th</sup> May 2005 and a registration date of 21<sup>st</sup> June 2006, it is clear that under Section 6(1) of the Act, Rodale's mark is an earlier trade mark. Further, as it completed its registration procedure less than five years before the publication of the contested mark (9<sup>th</sup> January 2009), it is not subject to the proof of use requirement set out in section 6A of the Act.

12. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (“ECJ”) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in*

*the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

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

13. In assessing the similarity of goods and services, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23 of the Judgment:

‘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 end users and their method of use and whether they are in competition with each other or are complementary.’

14. Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.

15. Three further cases on the way that specifications ought to be interpreted (particularly in respect of services) should be borne in mind. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd (“Thomson”)* [2003] RPC 32, at para 31, Aldous LJ, says



“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use.”

Although this was in the context of arriving at a fair specification consequent to an attack of revocation on the grounds of non-use, the principle that it is the public and circumstances of the relevant trade that should underpin consideration as to the terms used in a specification nonetheless holds good. Secondly, there is the case of *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd* (“*Beautimatic*”) [2000] FSR 267, in which the principle of giving words their ordinary (rather than an unnaturally narrow) meaning was enshrined. In summary, the *Beautimatic* case urges an approach that is not unnaturally narrow, whilst the *Thomson* case stresses that the exercise is not one of lexical analysis in a vacuum, but by reference to how the average consumer may perceive matters in the relevant trade.

16. It is important to recognise that even though there is no evidence on similarity, I nevertheless have the statements of case and am able to draw upon commonly known facts. Mr Geoffrey Hobbs QC sitting as the Appointed Person said in *Raleigh International trade mark* [2001] R.P.C. 11 at paragraph 20, that such evidence will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary. He also stated that the tribunal may, in an appropriate case, consider the question of similarity from the viewpoint of the notional member of the relevant purchasing public.
17. I should also mention a further case in terms of the application of legal principles, and that is the European Court of First Instance (“CFI”) in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) (“*Meric*”) Case T-133/05, where, at para 29, it is stated:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

16. Finally, there is the case of *Avnet Incorporated v Isoact Ltd* (“Avnet”) [1998] FSR 16 where Jacob J (as he then was) says:

“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.”

17. I will deal with each of US’s classes in turn.

18. *Class 16*.

I do not understand US to be disputing that their goods in class 16 are identical to the goods in class 16 of Rodale’s specification. This must be the case as Rodale’s specification contains the broad term “printed matter” which would encompass US’s “printed matter” and the other less broad terms, all of which could constitute, or come within the term “printed matter”.

19. *Class 41*.

The respective goods and services are as follows:

US Specification	Rodale specification
<p><b>Class 41</b></p> <p><i>Personal coaching services in the fields of health, nutrition, wellness, weight loss, diet, exercise, disease prevention and lifestyle.</i></p>	<p><b>Class 9</b></p> <p><i>Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic and optical data carriers; data-processing equipment and computers; breathalyser testing equipment; gas and air analysers (not for medical purposes); compact disc players; magnetic audio and video tapes; magnetic cards; magnetic cards being credit cards, smart cards; mouse pads; mobile telephones; electronic games adapted for use exclusively with a television receiver; computer game programs.</i></p>

	<p><b>Class 16:</b>  <i>Printed matter, bookbinding material; stationery; greeting cards; non-electric credit card imprint apparatus; lithographic works of art.</i></p> <p><b>Class 35:</b>  <i>Advertising and publicity services; rental of advertising time on all means of communication; online advertising via a computer network; direct mail advertising; samples; advertising mail; publication of publicity texts; compilation and systematisation of data for advertising purposes in a central data file; data searches in computerised files; opinion polling for others.</i></p> <p><b>Class 38:</b>  <i>Telecommunications, transmission of programs, data, sound, images; providing access to a global network connecting several terminals with each other; online provision of access to information for subscribers; transmission of messages and images; transmission of data from databases; electronic transmission of data recorded in a database accessible via telecommunications networks; transmission of data, software, videos and films from the Internet, for others; providing access to sales pages via computer networks.</i></p> <p><b>Class 41:</b>  <i>Electronic online publication of books and articles; arranging of competitions for education or entertainment.</i></p> <p><b>Class 42:</b>  <i>Providing technical services in connection with Internet subscriptions; Hosting of sites on a worldwide or local computer network; designing,</i></p>
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	<p><i>development and maintenance of software and websites; software design; development, programming and design for the construction of databases, for others; programming of advertising pop-ups on web pages and websites, for others.</i></p>
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20. The highest point of Rodale’s case is likely to be found in their Class 41 services against those of US in the same class. It is to that comparison that I turn first. In terms of their nature and intended purpose, these services would not appear to be similar. US’s services are of a personal nature. The end users will be people who have been identified or who have put themselves forward as beneficiaries of such coaching, or who have particular concerns or conditions which may need lifestyle changes or medicative treatment to address their specific health issues. It is not clear that the people accessing such services would necessarily do so through the normal health channels, such as their GP, and I cannot assume that such services are therefore offered only on that basis. The method of providing such services would normally be personal consultation on a one-to-one basis or via a group.

21. Rodale’s specification in class 41 includes, firstly, *electronic online publication of books and articles* and it is conceivable that, although I have concluded that US’s services are most likely to be delivered by personal consultation, I cannot rule out the possibility that the advice, coaching and support that US offer may not under any circumstances be offered via electronic online publication of books and articles. However, the fact that the electronic publication may act to supplement face-to face consultation, or even as a substitute, this does not render the respective services ‘similar’ for these purposes. The provider of coaching services such as US would not be known by the average consumer, first and foremost, as an electronic ‘publisher’, simply because they happen to publish coaching material on, eg the internet. Their primary purpose would still be in the field of personal coaching to address the specific conditions listed in the specification. The precise means of delivering that coaching would be entirely ancillary. In terms of their specification, Rodale’s services on the other hand are those of ‘publishing’, namely to disseminate through electronic media in this case, the work of a variety of authors, including eg writers and journalists. Thus, in terms of their purpose and nature the respective services are not similar. Nor would they be similar in terms of the channels of trade. Personal coaching services are offered selectively to those who may benefit, whether referred through normal medical channels or not. They can be offered to beneficiaries through, eg clubs,

- groups, personal trainers, counsellors, health practitioners or a variety of other channels. The services of electronic publishing are not likely to be offered through the same channels or even types of channels. Depending on the nature of the material being published, they may well be targeted at certain groups but these are unlikely to be the same groups as I have identified above.
22. In terms of Rodale's '*arranging of competitions for education or entertainment*' these too, are not on the face of it similar to personal coaching services. Competitions are generally for temporary 'entertainment', entered into with the hope of winning a prize. Whilst these competitions may also be for educational purposes this does not make them remotely similar to 'personal coaching' which has a systematic and concentrated improvement objective in mind. I likewise find these services not similar to US's personal coaching services.
23. For these reasons I consider that the respective services in class 41 are not similar.
24. As regards whether there is any similarity between Rodale's class 9 specification and US's class 41 specification, plainly Rodale's specification in class 9 is primarily for scientific instrumentation of various descriptions as well as media. Whilst US's 'personal coaching services' may conceivably utilise such instrumentation in their provision, that is as close as any 'connection' is likely to be. So for example, it is likely that if the personal coaching being offered is in the realm of weight and diabetic management then electronic weighing scales and blood sugar level monitors may well be provided as part and parcel of the 'service'. But the consumer will not therefore make any linkage in terms of implying any economic connection between the respective provider and manufacturer. In terms of the overall nature, intended purpose and channels of trade of the respective goods and services these are going to be very different. Scientific instruments will be offered through specialist or general outlets depending on their nature. Personal coaching services will be offered to beneficiaries through a variety of channels, as I have already said, but these channels will not coincide with those through which the instrumentation is offered. On that basis I conclude that US's services in class 41 are not similar to Rodale's class 9 specification.
25. As regards any similarity between Rodale's class 16 specification for 'printed matter' and US's class 41 specification, it could be argued, as with electronic publishing in class 41, that personal coaching services are apt to provide supporting material in printed form. It is noted also that Rodale's class 16 specification does not comprise the 'service' of *publishing* as such (unlike their class 41 specification), ie on behalf of others, but simply 'printed matter'. In Case T-388/00, *Institut für*

*Lernsysteme GmbH v OHIM* before the CFI (now the General Court), the Court observed that printed materials and the service of 'development and running correspondence courses' were 'linked' on the basis that printed materials were used to support such courses, the end users were therefore the same and they also found that printed matter 'complemented' such services (see paras 54-56). In the same way, though not necessarily as obviously as in correspondence courses where printed materials are an inevitable medium, I nevertheless believe that personal coaching services are apt to be supported and complemented by printed matter. On the same basis, I find that US's services in class 41 are similar to printed matter in class 16. As far as the other goods in Rodale's class 16 specification are concerned these are plainly narrower in scope than 'printed matter' and I do not believe such materials, given their nature and intended purpose, complement or are even likely to be used in conjunction with personal coaching services.

26. As regard the services in Rodale's class 35, 38 and 42 specifications against US's class 41 specification, I do not believe any of these services have the same nature or intended purpose as personal coaching services. Nor would they be provided to the same end users or be complementary to those services. Whilst it is possible that personal coaching services would advertise that does not mean they provide an advertising *service* to others. Nor would they provide a telecommunications *service* to others or provide technical internet *services*.

#### *Class 44*

27. US's class 44 specification is similar in scope to their class 41 specification (the former being 'medical services' at large, in particular in relation to lifestyle matters, and the latter, 'personal coaching' services). Of course, it may be that medical services are more 'regulated' than less formal personal coaching services but they may well overlap and the intended purpose is the same. On that basis, my finding in relation to class 41 can be adopted in relation also to class 44. That is to say that there is similarity as regards 'printed matter' in Rodale's class 16 specification but the remainder of the goods and services in Rodale's specification are not similar.

### **Comparison of marks**

28. The respective marks are as below:

US's mark	Rodale's mark
THE PREVENTION PLAN BY UK PREVENTIVE MEDICINE	PREVENTION

29. The case law makes it clear that I must undertake a full comparison of both marks in their totalities, taking account of all differences and similarities. The comparison needs to take account of the visual, aural and conceptual similarities and differences between the marks.

30. In terms of visual appearance, Rodale's mark presents as a 10 letter single word mark. US's mark presents as a seven word mark which, whilst it has the word 'prevention' in common with Rodale's mark, in pure visual terms, US's mark is of much greater length and linguistic complexity. The word 'prevention' nonetheless appears as the second word in the mark after the short word 'the'. It thus has some prominence in the overall mark, and this is to some extent reinforced by the similar word 'preventive' appearing later in the mark. Taking these similarities and dissimilarities into account I find that the respective marks share a reasonable level of visual similarity.

31. Aurally, Rodale's mark will be pronounced PRE-VENN-SHUN. US's will be pronounced THE PRE-VENN-SHUN PLAN BY UK PRE-VEN-TIVE MED-I-SUN. Again, the only common element is the word, 'prevention', pronounced as PRE-VENN-SHUN and so, taking the similarities and dissimilarities into account I find that aurally the respective marks are similar only to a low degree.

32. The question of conceptual similarity or dissimilarity hinges around the word 'prevention' as this is the only element in Rodale's mark. The dictionary meaning of this word is as follows:

**prevention<sup>1</sup>**

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<sup>1</sup> "prevention *noun*" *The Oxford Dictionary of English* (revised edition). Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2005. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 13 April 2010 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t140.e61450>>

→ **noun**

[mass noun] the action of stopping something from happening or arising: *crime prevention* | *the treatment and prevention of Aids*.

33. Thus, the word 'prevention' on its own and in no context is, as US's attorneys submit, a noun. It is unclear what particular 'thing' may be being 'prevented', as there is no context at all. If there is a 'concept' behind Rodale's mark it must derive from the dictionary meaning of the word 'prevention' as above. In contrast, in US's mark the word 'prevention' has a context which renders its usage adjectival, that is to say that it is naming the attribute of the 'plan' which is the subject of the broader term, 'The Prevention Plan'. At this point I would note that US's mark, in linguistic terms, breaks down into two separate elements: 'The Prevention Plan', and 'by UK Preventive Medicine' (my emphasis). Given the link word, 'by', the overall concept behind US's mark is that, what must be assumed to be a 'group' or trader called 'UK Preventive Medicine', has produced a plan called 'The Prevention Plan'. Given the name of the group, it would be assumed that the plan relates to preventive medicine or treatments aimed at prevention of disease or other conditions. The term, 'The Prevention Plan', is an entirely descriptive one within the context of the whole mark. Whilst the word 'prevention' is shared by both respective marks, the usage in US's mark is plainly adjectival and the usage in Rodale's is as a noun having no context whatsoever. On that basis I conclude that the respective marks share only a very low level of conceptual similarity, and this arises by virtue of the shared word, 'prevention'.

34. Overall, I conclude that the respective marks share only a low level of similarity.

### ***The average consumer and nature of purchase***

35. As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), it is important that I assess who the average consumer is for the goods at issue, and whether there is anything about the nature of transactions under the respective marks that may lead me to conclude that the average consumer is other than someone "deemed to be reasonably well informed and reasonably circumspect and observant" (see authority (b) in para 11 above).

36. The average consumer for the goods covered by US's specification will a broad spectrum of people comprising in the main the general public seeking in particular, advice on and help with lifestyle and health issues. The average consumer for Rodale's goods and services will likewise comprise the general public plus in some cases specialised businesses involved with, for example, technical instruments, those looking for advertising, telecommunications and internet related services. There may be overlap in terms of the identity of the respective average consumers



insofar as the respective products or services may be available to the general public.

37. The goods and services concerned may be specialised purchases in terms of their subject matter. Personal coaching and medical services will be selected with care and perhaps only on recommendation or referral. The same may not be altogether true for all Rodale's goods and services but certainly for some, in particular business related services such as advertising, telecommunications and internet related services, there will be careful selection involved.

### ***Use and distinctive character of the earlier trade mark***

38. Before I bring my findings together in an overall assessment, I have to consider whether Rodale's mark has a particularly distinctive character, either arising from the inherent characteristics of the trade mark or because of the use made of it. In terms of its inherent distinctiveness I consider Rodale's mark to have only a low level of distinctiveness. The mark comprises a single, known, dictionary word 'prevention', which is in everyday use. Such a mark, whilst it must be presumed to be validly registered and to have a minimum level of distinctiveness, would not be regarded as having anything but an inherently low level of distinctiveness in connection with the goods and services for which it is registered. Rodale has provided no evidence of use on the UK market, such that the inherent characteristics of their mark could be said to be 'enhanced' through use, and consequently it is only the inherent characteristics that I can consider. I would just add for the sake of completeness that my assessment of level of distinctiveness is unaffected by evidence of the presence of the word 'prevention' in other marks filed in the UK or elsewhere.

### ***Likelihood of confusion***

39. The various findings I have arrived at above need now to be factored into an overall assessment of likelihood of confusion. I need to adopt a global approach, which takes into account 'imperfect recollection' on the part of the consumer, as advocated by the ECJ in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* It is also the case that the authorities, to which I have referred above in para 12 above, recognise two forms of confusion, direct and indirect. By direct confusion, it is meant that the average consumer is likely to mistake one mark for another, assuming imperfect recollection of course. By indirect, it is meant that although the average consumer will not necessarily mistake the respective marks directly, he or she may well nevertheless assume an association, in that goods sold under the mark the subject of the application derive from the same economic undertaking as the goods sold under the earlier mark.

40. I should just mention, for the sake of completeness, that US's attorneys have noted that both parties have their respective marks registered in the United States of America without instances of confusion. US's version of the mark registered is, unsurprisingly, slightly different, being 'THE PREVENTION PLAN BY US PREVENTIVE MEDICINE' (my emphasis). This submission is however not a factor in my overall analysis as, firstly, it relates to the situation in the US rather than the UK. Secondly, although it is well established that evidence of what is often referred to as "parallel trading" may be a factor which could potentially assist in deciding whether there exists a likelihood of confusion, such evidence needs to establish that the respective marks have actually been put to use in the same market (as opposed to the notional use which is normally considered), without the consumer being confused regarding economic origin. If such evidence is forthcoming then this can inform the tribunal's decision. Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18 gave weight to an absence of confusion in the marketplace, however, this should be tempered by a number of decisions which express caution about the circumstances in which it is appropriate to give these factors weight (see the Court of Appeal in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at page 291, Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at 809 and the Court of Appeal in *Phones 4U Ltd v Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paras 42 to 45.) In the first of the above cases Millet LJ stated:

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

41. In this case there simply is no evidence on the nature of the co-existence. I cannot therefore accord it any weight.

42. I have decided the respective marks share only a low level of similarity. US's goods are identical in class 16 and similar in classes 41 and 44 to 'printed matter' in Rodale's class 16. The identities of the respective average consumers' may overlap but the earlier mark has only a low inherent distinctiveness. I have come to the conclusion that in this case there is a no likelihood of confusion (either direct or indirect) in relation to all US's goods and services.

43. In all the circumstances case, I find that the opposition fails in its entirety.

### **Costs**

44. The applicant, US, has succeeded in defending the opposition under section 5(2). Accordingly, it is entitled to a contribution towards its costs. I

take account of the fact that that the decision has been reached without any evidence having been filed and without a hearing taking place. In the circumstances I award US the sum of £500 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

1. Preparing a statement and considering counterstatement - £200
2. Preparing submissions- £300

Total £500

45. I order Rodale Inc to pay US Preventive Medicine Inc the sum of £500. The sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 24 day of May 2010**

**Edward Smith  
For the Registrar,  
the Comptroller-General**