

O-110-14

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 2610961
IN THE NAME OF AARON WESTON
IN RESPECT OF THE TRADE MARK:**



AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO. 84550 BY FITNESS FIRST LIMITED**

Background

1. Trade mark no. 2610961 shown on the cover page of this decision stands registered in the name of Mr Aaron Weston. It was applied for on 20 February 2012 and completed its registration procedure on 22 June 2012. It is registered for the following services in class 41:

Education; Providing of training; Entertainment; Sporting and cultural activities.

2. On 7 September 2012, Fitness First Limited (“the applicant”) filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) and sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) which state:

“47(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b)...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

And:

“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, or

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

(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 (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) 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.”

3. The application is directed against all of the services in Mr Weston’s registration. Under section 5(2)(b) of the Act, the applicant relies upon the following goods and services in the registrations shown:

(1)UK no. 2111128 for a series of three marks i.e:

FITNESS FIRST

FITNESSFIRST

The logo for Fitness First, featuring the words 'Fitness' and 'First' in a highly stylized, cursive script. The 'F' in 'Fitness' is particularly large and ornate, with a long horizontal stroke that extends to the left. The 'First' is written in a similar but slightly more compact cursive style.

applied for on 26 September 1996 and which completed its registration procedure on 11 July 1997:

Class 25 - Articles of clothing not including footwear.

Class 41 - Leisure centre, health club, fitness centre and gymnasium services; provision of swimming facilities, saunas, steam rooms and spas; provision of discotheque services; provision of recreational facilities; provision of facilities relating to gymnastics, weight training, body building, aerobics and physical exercise; instructional services relating to gymnastics, weight training, body building, aerobics, physical exercise, physical rehabilitation, diet, nutrition, health and beauty.

(2) UK no. 2370518 for the mark:

The logo for Fitness First, featuring the words 'Fitness' and 'First' in a highly stylized, cursive script. The 'F' in 'Fitness' is particularly large and ornate, with a long horizontal stroke that extends to the left. The 'First' is written in a similar but slightly more compact cursive style.

applied for on 12 August 2004 and which completed its registration procedure on 25 February 2005:

Class 41 - Leisure centre, health club, fitness centre and gymnasium services; provision of swimming facilities; provision of discotheque services; provision of recreational facilities, provision of facilities relating to gymnastics, weight training, body building, aerobics and physical exercise; instructional services relating to gymnastics, weight training, body building, aerobics, physical exercise, physical rehabilitation, diet, nutrition, health and beauty.

Class 44 - Provision of sauna, and steam room facilities; spa services; beauty salon services; massage services; hairdressing salon facilities; suntanning

salon services; advisory and information services in relation to health, hygiene, slimming and beauty; rental of towels.

(3) IR designating the EU no.854041 for the mark:

FitnessFirst

designated the EU on 14 March 2006 and for which protection in the EU was granted on 12 June 2007:

Class 25 - Clothing, footwear, headgear.

Class 41 - Leisure centre, health club, fitness centre and gymnasium services; provision of swimming facilities; provision of discotheque services; provision of recreational facilities, provision of facilities relating to gymnastics, weight training, body building, aerobics and physical exercise; instructional services relating to gymnastics, weight training, body building, aerobics, physical exercise, physical rehabilitation, diet, nutrition, health and beauty.

(4) CTM no. 8179095 for the mark:

FitnessFirst

applied for on 25 March 2009 and which completed its registration procedure on 21 January 2010:

Class 28 - Gymnastic and sporting articles, equipment, machines and apparatus; articles, equipment, machines and apparatus for physical exercise; fitness articles, machines and apparatus; bags adapted for sporting articles; toys, games and playthings; electronic games and video games; protective articles for sporting purposes; yoga and pilates equipment and apparatus.

Class 35 - Advertising; business management; business administration; office functions; advertising services, namely dissemination of advertising for others via an on-line electronic communications network; retail advertising services, namely, dissemination of advertising for others via an on-line electronic communications network; presentation of goods on communication media for retail purposes, electronic shopping retail services, all relating to computerized on-line ordering featuring general merchandise and general consumer goods namely foodstuffs and drinks, articles of clothing and haberdashery, including apparel and gloves, socks, headbands, shoelaces, towels, shoes, bags, luggage, travel goods, cases, parasols and umbrellas, textile piece goods, clocks and watches and other measuring instruments,

scales, weighing machines, pedometers , fat analysers, fat monitors, home diagnostic and test kits, blood pressure monitors, DVDs, videos, audio and video apparatus, video games, cameras, computer software, stationery, books, magazines and newspapers, calendars, skincare and cosmetic products, toiletries, toilet articles and apparatus, beauty, health and personal care devices and equipment, gymnastic, sporting and exercise articles, equipment, machines and apparatus, sports bags, bags adapted for sporting articles, toys, games, protective articles for sporting purposes, goggles, swim hats, snorkels, fins, swimming accessories, yoga mats, pharmaceutical products, machines and appliances for preparing food or drink; providing an online commercial information directory; online services relating to membership loyalty schemes and incentive and awards programme services to members; management of incentive and loyalty programmes and other promotional schemes including those that reward healthy lifestyle.

Class 41 - Entertainment services; education services; television, radio, stage or audio entertainment services; organising and managing of sporting events; competitions; provision of computer games for entertainment purposes; services for the arranging and conducting of exhibitions; organisation of ceremonial events; awarding of prizes; organisation of events and competitions relating to sports, fitness, health, weight loss and physical exercise; conducting receptions to recognise achievement in the field of health and fitness; health club, gym and fitness centre services; provision of swimming facilities; provision of discothèque services; provision of recreational facilities; leisure centre, health club, fitness centre and gymnasium services; provision of swimming facilities, provision of facilities relating to gymnastics, weight training, body building, aerobics, swimming and physical exercise; instructional services relating to gymnastics, weight training, body building, aerobics, physical exercise, physical rehabilitation, diet, nutrition, health and beauty; provision of entertainment, sporting and cultural activities; providing a searchable database in the field of fitness.

(5) CTM no. 898734 for the mark:

The logo for 'Fitnessfirst' is written in a highly stylized, cursive script. The letters are interconnected, with long, sweeping flourishes, particularly on the 'i' and 't'. The overall appearance is elegant and dynamic, typical of a brand logo.

applied for on 30 July 1998 and which completed its registration procedure on 15 December 1999:

Class 25 - Articles of clothing not including footwear.

Class 41 - Leisure centre, health club, fitness centre and gymnasium services; provision of swimming facilities, saunas, steam rooms and spas; provision of discotheque services; provision of recreational facilities; provision of facilities relating to gymnastics, weight training, body building, aerobics and physical exercise; instructional services relating to gymnastics, weight

training, body building, aerobics, physical exercise, physical rehabilitation, diet, nutrition, health and beauty.

4. In relation to its objection based upon section 5(2)(b) of the Act, the applicant states:

“The registered mark is similar to the earlier sign taking into account the visual, aural and conceptual similarities between them. The registration covers services which are identical to those covered by the earlier registration. The marks FITNESSFIRM and FITNESS FIRST are so similar their use on identical services is likely to lead to confusion which includes the likelihood of association...”

5. In relation to its objection based upon section 5(3) of the Act, the applicant relies upon the registrations as above, save that in relation to CTM no. 8179095, the applicant indicates that it has a reputation in relation to:

Class 41 - Organisation of events and competitions relating to sports, fitness, health, weight loss and physical exercise; health club, gym and fitness centre services; provision of swimming facilities; provision of recreational facilities; leisure centre, health club, fitness centre and gymnasium services; provision of swimming facilities, provision of facilities relating to gymnastics, weight training, body building, aerobics, swimming and physical exercise; instructional services relating to gymnastics, weight training, body building, aerobics, physical exercise, physical rehabilitation, diet, nutrition, health and beauty.

6. In relation to its objection based upon section 5(3) of the Act, the applicant states:

“As a result of the extensive use made by the applicant of the earlier signs, the earlier signs have acquired a reputation in the UK...The registration is closely similar to the earlier mark and the relevant public is likely to believe that services identified by the registration have been provided by the owner of the earlier mark. Having regard to the reputation in the earlier mark, the proprietor’s proposed use would take unfair advantage of that reputation by inferring a connection with the earlier mark, resulting in the relevant public purchasing the proprietor’s services believing them to originate from, or be connected with, those of the applicant.

Registration of the mark in relation to the services it covers is an attempt by the registered proprietor, through the use of a sign similar to the applicant’s mark to ride on the coat tails of that mark in order to benefit from its power of attraction, its reputation and its prestige and to exploit the marketing effort expended by the applicant to create and maintain the image of that mark.

Also, because the consumers are likely to believe that the services identified by the registration are provided by the applicant, the originality and distinctiveness of the earlier mark and the advertising effectiveness derived from its uniqueness will be impaired.

Furthermore, consumers are likely to associate the registration with the allure and reputation of the earlier mark which would take unfair advantage of the distinctive character and repute of the applicant's brand.

The services provided by the applicant are of a consistently high quality. The registration would cause detriment to the distinctive character of the earlier mark because it covers identical services, and if a member of the relevant public purchased such services believing them to have been provided by the applicant and is dissatisfied with their quality, this would have an adverse effect on the applicant's reputation."

7. 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) or 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

8. All of the applicant's marks qualify as earlier trade marks under the above provisions. Given the interplay between the date of the application for invalidation and the dates on which the earlier marks completed their registration procedure, only mark (4) above is not subject to the proof of use provisions set out in section 47(2)(A)(a) of the Act. In relation to marks 1, 2, 3 and 5 above, the applicant indicates that it has used the mark on all the goods and services shown.

9. Mr Weston filed a counterstatement in which the basis of the invalidation is denied. Where appropriate, he asks the applicant to provide proof of use of its earlier marks. In his counterstatement, Mr Weston states:

"2.. On that point it is noted that the only common element between the marks relied upon and [his mark] is the element "FITNESS". That element is not even present in the registered mark as a word in its own right. That element forms but a very minor part of the overall mark...Furthermore, that common element is descriptive and/or devoid of distinctive character in relation to the services under consideration. It is submitted that other elements of [his mark] constitute the dominant and distinctive parts of the mark for the purposes of comparison with other marks."

10. Both parties filed evidence. Whilst neither party asked to be heard, Mr Weston filed written submissions in lieu of attendance at a hearing. I will bear these submissions in mind and refer to them as necessary below.

The applicant's evidence

11. This consists of a witness statement from the applicant's company secretary, Susan Cadd, dated 8 March 2013. The main facts arising from Ms Cadd's statement are, in my view, as follows:

- the Fitness First group of companies (headed by the ultimate holding company Fitness First Limited) comprises the largest privately owned gym and health club group in the world. At 30 October 2010, the applicant had over 435 clubs in 15 countries and 1.1 million members;
- Ms Cadd states: "In the UK alone there are 80 Fitness First clubs with over 233,000 members". This information has been taken from exhibit SC1 which consists of an extract obtained "From Wikipedia, the free encyclopedia" on 7 March 2013;
- the applicant offers a range of products and services including gyms, health clubs, personal training, team work-outs, martial arts and classes in yoga, Pilates, aerobics etc. It also offers competitions and sponsors sporting events;
- exhibit SC2 consists of a copy of the group's CFO's report for 2009 which indicates that the group's revenue in the UK for the years 2008 and 2009 was: £164.3m and £156.5m respectively;
- turnover/revenue for Fitness First Limited appears to be as follows: 2008 - £27,545m (of which £15,197m relates to Europe), 2009 -£34,423m (of which £15,711m relates to Europe), 2010 - £40,503m (of which £7,093m relates to the UK) and 2011 - £34,786m (of which £6,280m relates to the UK) - exhibit SC3 refers;
- as of December 2006, the applicant had more than 1 million members in 400 clubs worldwide and 170 clubs in the UK;
- as of December 2007, the applicant had more than 1.4 million members in 500 clubs worldwide and 180 clubs in the UK;
- in 2008 the applicant had more than 1.7 million members in 550 clubs worldwide and 171 clubs in the UK (with 480,000 members);
- in 2010 the applicant had more than 1.4 million members in 540 clubs worldwide and 160 clubs in the UK with over 405,000 members;
- in 2011 the applicant had more than 1.2 million members in 430 clubs worldwide and 140 clubs in the UK – exhibits SC4 and SC5 refer;
- Ms Cadd states: "The annual worldwide expenditure on advertising of the name and trade mark FITNESS FIRST (and other sub brands incorporating the words FITNESS FIRST) for all its goods and services over the past seven

years is as follows: 2006 - £35m, 2007 - £40m, 2008 - £44m, 2009 - £42m, 2010, 2011 and 2012 - £40m per year;

- Ms Cadd states: The “Fitness First” logo was first used by my company in 1996. The original “Fitness First” logo was first registered and used in commerce by my company in the United Kingdom in 1996”. The original Fitness First logo Ms Cadd refers to, is, I assume, a reference to the following:



- Ms Cadd states: “[The applicant] has since modernised its logo (to the form shown in CTM no. 8179095) i.e.



- Exhibit SC6 consists of a range of screen shots relating to: a Fitness First competition from 2007 (www.affiliates4u.com), a Fitness First Facebook contest from 2011 (www.youtube.com), a gym review from 2011 (www.cosmopolitan.co.uk), a competition from 2010 (www.lbc.co.uk), a competition from 2012 (www.boxnumber8.com), a case study from 2011 (www.marketingweek.co.uk) and a partnership with Sports Aid from 2008 and 2010 (www.sportsaid.org.uk).

Mr Weston’s evidence

12. This consists of a witness statement from Mr Weston in which he states:

“1...[His mark] is intended mainly for use in relation to fitness services, particularly fitness training services provided online, together with related goods and services, under a business proposition which I have been developing.

6. For services and products in the field of fitness training there are many names in use which start with the word “Fitness” and I do not believe that any one company can claim to have broad protection for marks which start with the word “Fitness”. Customers are used to seeing many different names which start with the word “Fitness” in this area of business and are perfectly able to distinguish between them.”

13. Attached to his statement are three exhibits. Exhibit AW1 consists of the results of a review of the IPO's on-line trade mark database conducted on 10 June 2013, for trade marks in class 41 which start with the word FITNESS. Of the 114 results obtained, Mr Weston states:

"7...It is clear there are a lot of marks which start with the word FITNESS especially in the class for fitness training services."

14. Exhibit AW2 consists of the results of a review of the Companies House database, conducted on 10 June 2013, for UK company names which start with the word FITNESS or with the words THE FITNESS. Mr Weston explains that this shows that there are a total of 309 live companies whose names start with the word FITNESS and 54 live companies whose names start with the words THE FITNESS. Of these results, Mr Weston concludes:

"8...I suggest that the majority of these companies are active in relation to products or services associated with keeping fit or fitness generally."

15. Exhibit AW3 consists of the results of a review of the Internet, conducted between 6 and 10 June 2013, for names which are currently in use in the UK in relation to fitness services or closely related services and which start with the word FITNESS. Mr Weston states that this shows:

"9...that not only are there a large number of trade marks and companies registered with names starting FITNESS but there are also many such names which are actually in use in the fitness sector. I believe this demonstrates that no one company has broad rights in a name starting with the word FITNESS in the field of fitness training and also shows that consumers are accustomed to distinguishing between these types of names on the basis of other elements contained in the name and on the basis of their particular styling."

16. Mr Weston submits that, in his view, the evidence provided by the proprietor only shows use of the words FITNESS FIRST in the form shown in CTM no. 8179095 and that the use shown is in relation to health clubs and gyms. He states:

"12(b) The various reports included in exhibit SC3 identify Fitness First Limited as a management company in the Director's Report section. There is no indication of Fitness First Limited trading in relation to any of the services or goods covered by the marks relied upon."

The applicant's evidence in reply

17. In her evidence in reply, Ms Cadd, in her second witness statement dated 8 November 2013, responds in the following terms:

"3. It is correct to say that Fitness First Limited...is a management company. It is the entity which holds the majority of intellectual property within the Fitness First Group of companies.

4. I confirm that the FITNESS FIRST mark and all the stylised versions thereof are used with the consent of my company by the operating companies within the Fitness First Group which provide the goods and services to the consumer.”

18. That concludes my summary of the evidence filed to the extent that I consider it necessary.

DECISION

Section 5(2)(b)

Section 5(2)(b) – case law

19. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

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; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

The principles

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when

all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The applicant's best case

20. In these proceedings, the applicant is relying upon the five registrations shown in paragraph 3 above. All but one of these registrations is subject to proof of use and Mr Weston has asked for proof of use to be provided. It appears from Ms Cadd's statement, that the mark the subject of CTM no. 898734 and the stylised variant shown in the series of marks in UK no. 2111128, is the old version of the applicant's mark which is not, Mr Weston submits, and as far as I can tell, to be found in any of the applicant's exhibits.

21. However, the evidence provided by the applicant indicates that it has used its mark in, inter alia, the form shown in registrations nos. UK 2370518, IR 85404I and CTM no. 8179095. As CTM no. 8179095 is the principal version of the applicant's mark included in its evidence, is not subject to proof of use, and contains services identical to those in Mr Weston's registration, it is this mark upon which I shall base the comparison. If the applicant does not succeed on the basis of this registration, it will, in my view, be in no better position in relation to any of the other marks upon which it relies.

The average consumer and the nature of the purchasing process

22. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services in class 41 and then to determine the manner in which these services will be selected by the average consumer in the course of trade.

23. The average consumer of the very broad range of services at issue in these proceedings i.e. education, entertainment and sporting and cultural activities, will be either a member of the general public or those selecting on behalf of a commercial undertaking. Whilst, as in most areas of trade, the selection process is likely to consist of a mixture of both visual and aural considerations, as the average consumer is, in my view and experience most likely to select the vast majority of the services at issue from the pages of a brochure, prospectus or website, visual considerations are likely to dominate the selection process. Whilst aural considerations will also play their part (recommendations by word of mouth for example), they are likely, in my view, to feature to a lesser extent. As to the degree of care taken during the selection process, this will be dependent on the service being selected. For example, given the need to ensure that an educational service (be it academic or sporting) meets the particular needs of the individual or organisation concerned, one would expect the average consumer to display quite a high degree of attention when selecting such services. Similarly, my own experience tells me that when selecting a gymnasium or health club, the need to satisfy oneself of factors such as cost of membership, length of membership, termination periods, opening times, facilities offered, classes and equipment available etc. once again points to a level of attention above the norm. I will return to the degree of care taken during the selection process when I consider the likelihood of confusion later in this decision.

Comparison of services

The applicant's services in class 41 of CTM registration no. 8170905	Mr Weston's services
<p>Class 41 - Entertainment services; education services; television, radio, stage or audio entertainment services; organising and managing of sporting events; competitions; provision of computer games for entertainment purposes; services for the arranging and conducting of exhibitions; organisation of ceremonial events; awarding of prizes; organisation of events and competitions relating to sports, fitness, health, weight loss and physical exercise; conducting receptions to recognise achievement in the field of health and fitness; health club, gym and fitness centre services; provision of swimming facilities; provision of discothèque services; provision of</p>	<p>Class 41 - Education; Providing of training; Entertainment; Sporting and cultural activities.</p>

recreational facilities; leisure centre, health club, fitness centre and gymnasium services; provision of swimming facilities, provision of facilities relating to gymnastics, weight training, body building, aerobics, swimming and physical exercise; instructional services relating to gymnastics, weight training, body building, aerobics, physical exercise, physical rehabilitation, diet, nutrition, health and beauty; provision of entertainment, sporting and cultural activities ; providing a searchable database in the field of fitness.	
--	--

24. The terms “education”, “entertainment”, “sporting and cultural activities” in Mr Weston’s registration find exact counterparts in the applicant’s specification and are identical. As the phrase “provision of training” in Mr Weston’s specification is simply an alternative way of describing the educational/instructional services in the applicant’s specification, they too are identical.

Comparison of trade marks

25. The marks to be compared are:

Applicant’s mark (best case)	Mr Weston’s mark
	

26. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

27. In her first statement, Ms Cadd states:

“17. I note that the registration in suit...includes the words FITNESSFIRM prominently. I am of the opinion that the words FITNESSFIRM and FITNESSFIRST are very similar. Both marks have in common the first ten letters FITNESSFIR and differ only in the final letters M and ST respectively...”

As mentioned above, in his counterstatement, Mr Weston stated:

“2...That element forms but a very minor part of the overall mark...Furthermore, that common element is descriptive and/or devoid of distinctive character in relation to the services under consideration. It is submitted that other elements of [his mark] constitute the dominant and distinctive parts of the mark for the purposes of comparison with other marks.”

Distinctive and dominant elements

28. The applicant’s mark consists of the words fitness and first presented in a cursive script in lower case and in which the initial letter f of each word is enlarged. Although there is a background element to the mark and an underlining, these will go largely unnoticed. In my view the phrase “fitness first” “hangs together” and will be understood as meaning an encouragement to make one’s fitness a priority; as a consequence, there are no dominant elements, the distinctiveness of the mark lies in the totality.

29. Mr Weston’s mark consists of three elements. The first element is the two upper case letters F presented in mirror image. This is both a dominant and distinctive element of Mr Weston’s mark. The second element consists of the conjoined words FITNESS and FIRM presented in upper case. While this element of Mr Weston’s mark is presented as a unified whole, as the average consumer will be very familiar with both the word FITNESS and FIRM, I have no doubt that this is how they will interpret this element of his mark. Although this is a smaller element of the mark than the mirrored letters F, it is an important element as it is likely to be this element that the average consumer will rely upon when referring to Mr Weston’s mark. As, in my view, the words FITNESS and FIRM also hang together and will be understood as meaning either an undertaking specialising in fitness or the effect fitness has on the body, there are, once again, no dominant elements in this part of Mr Weston’s mark. Given the ambiguous nature of the message this element of Mr Weston’s mark is likely to convey to the average consumer, it too is a distinctive element of the mark. The third element is the word LONDON presented in upper case. Given its size and positioning, and as the average consumer is likely to construe it as a reference to where the undertaking responsible for the mark is located or the area in which the services are provided, it is neither a dominant nor a distinctive element of Mr Weston’s mark. I will bear these conclusions in mind when comparing the marks from the visual, aural and conceptual standpoints.

Visual similarity

30. Both marks contain the word fitness/FITNESS and share the letters F-I-T-N-E-S-S-F-I-R- in the same order. There is also some similarity arising from the use of the enlarged letters f in the applicant's mark and the presence in Mr Weston's mark of the letter F in mirror image. However, the presence in the applicant's mark of the letters f (as the first letter in the words fitness and first) are in a completely different context to their use in Mr Weston's mark where they form a distinctive and dominant figurative element of the mark in their own right. Considered overall, the competing marks are, in my view, visually similar to (at best) a moderate degree.

Aural similarity

31. The applicant's mark consists of three syllables i.e. fit-ness first. Although Mr Weston's mark consists of a number of elements, it is, as I mentioned above, by the words FITNESSFIRM that the average consumer will refer to his mark. Mr Weston's mark also consists of three syllables. As the first two syllables of the competing marks is identical and as the third syllable in each mark begins with an F sound, the competing marks are, in my view, aurally similar to quite a high degree.

Conceptual similarity

32. I have already expressed a view on the conceptual message the competing marks are likely to convey to the average consumer i.e. an encouragement to make one's fitness a priority (the applicant's mark) and an undertaking specialising in fitness or the effect fitness has on the body (Mr Weston's mark). Although there is a degree of conceptual similarity resulting from the use of the word FITNESS, the relevant conceptual message the competing marks will convey are, in my view, quite different.

Distinctive character of the earlier trade mark

33. I must now assess the distinctive character of the earlier mark. The distinctive character of a trade mark can be appraised only, first, by reference to the services for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

34. Earlier in this decision, I concluded that the message the applicant's mark is likely to convey to the average consumer is as an encouragement to make one's fitness a priority i.e. to put fitness first. Considered in that context, in relation to the services in class 41, and keeping in mind the minimal degree of stylisation present in the mark, the applicant's mark is, absent use, possessed of a relatively low degree of inherent distinctive character. In his statement, Mr Weston commented:

“12(a) The documents which have been filed only seem to show use of one version of the FITNESS FIRST name [i.e. CTM no. 8179095). The documents also only seem to show that there has been use of the FITNESS FIRST name in relation to health clubs and gyms.”

35. I have summarised the applicant's evidence above. It indicates that the original fitness first logo was first used by the applicant in 1996 and that this logo has been modernised to the form shown in CTM no. 8179095 (although no date for the modernisation is given). However, the evidence shows that the mark the subject of the CTM was in use in the UK as early as 2006 and was still in use in 2012. Although the number of health clubs operated by the applicant in the UK has varied (as has the number of members), the evidence indicates that as at 2006 the applicant had 170 clubs in the UK, 180 in 2007, 171 in 2008, 160 in 2010 and 140 in 2011. Membership levels have varied but in 2008 and 2010 membership figures in the UK were 480,000 and 405,000 respectively. It appears that by the time of Ms Cadd's statement in March 2013, the applicant had 80 clubs in the UK with over 233,000 members. The Group's turnover in the UK in 2008 and 2009 amounted to £164.3m and £156.5m respectively. Although turnover/revenue figures are provided for the applicant for 2008 to 2011, these are on occasion not limited by reference to the UK and do not, it appears, include figures for the wider group. Advertising figures are not provided for the UK alone, but given the total worldwide spend between 2006 and 2012 i.e. £280m and bearing in mind that in October 2010 the number of clubs in the UK accounted for 24% of all the applicant's clubs worldwide (exhibit SC4 refers), it is, I think, reasonable for me to infer that the advertising spend in relation to the UK would have been considerable. As to the services upon which the mark has been used, I agree with Mr Weston that the vast majority of use is in relation to health club and gym services. That said, there is also evidence to the effect that the applicant arranges competitions and is involved in partnerships with, for example, SportAid. Although the applicant's evidence has shortcomings, when considered as a totality, I am satisfied that it demonstrates that the mark the subject of CTM no. 8179095 has had its inherent distinctive character enhanced to a significant extent. Whilst this enhancement, in my view, has been primarily in respect of health club and gym services, given the nature of the applicant's core business together with the nature of the competitions it runs and the events it sponsors, it is inevitable that its reputation has "spilt over" to these non core activities.

Likelihood of confusion

36. 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 services and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of the earlier mark as the more distinctive this mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and 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.

37. Earlier in this decision I concluded that: (i) the average consumer is a member of the public or business user who is, for the most part, likely to pay an above average degree of attention when selecting the services at issue (but see below), (ii) whilst visual considerations are likely to dominate the selection process, aural considerations cannot be ignored, (iii) the services at issue are identical, (iv) the competing marks are visually similar to (at best) a moderate degree, are aurally similar to quite a high degree, and, when the relevant conceptual position is considered, conceptually dissimilar and (v), although not highly distinctive per se, the use the applicant has made of its mark principally in relation to health club and gym services has enhanced its mark's inherent distinctive character to a significant extent.

38. In reaching a conclusion on the likelihood of confusion, I note that in *The Picasso Estate v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* – Case C-361/04, the CJEU said:

“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.”

39. However, I also note that in *Nokia Oyj, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* – Case T-460/07 the GC said:

“66. Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

40. I begin by reminding myself that both marks contain the word FITNESS, that both marks also contain the letters F-I-T-N-E-S-S-F-I-R in the same order and that the distinctive character of the applicant's mark has been enhanced by the use that has been made of it. Although both marks contain the word FITNESS as an identifiable element, as Mr Weston argues and as his evidence demonstrates, this element is descriptive and lacks distinctive character for fitness related services. This is an unremarkable conclusion and one which I would have been prepared to accept on the basis of judicial notice. In addition, when one considers the conceptual message the competing marks are likely to convey to the average consumer, they are (save for the reference to fitness which, given the area of trade of interest to the competing parties, is inevitable), in my view, quite different. This clear conceptual difference between the applicant's mark and the FITNESSFIRM element of Mr Weston's mark is, in my view, sufficient alone to counteract the visual and phonetic similarities between the competing marks. However, should that conclusion be considered arguable, in my view, the inclusion of the mirror image letters F as a distinctive and dominant element of Mr Weston's mark puts the matter beyond any doubt. Although I have characterised the degree of attention the average consumer will pay to the selection of the services identified earlier as above the norm, the differences

between the competing marks I have identified are, in my view, sufficient to point to the same conclusion even if the average consumer paid only a relatively low degree of attention to the selection of all the services at issue. **As a consequence, the applicant's request to invalidate Mr Weston's mark on the basis of section 5(2)(b) of the Act fails and is dismissed.**

41. In reaching that conclusion, I have not overlooked the fact that the applicant also has registrations of the marks FITNESS FIRST and FITNESSFIRST in UK series mark no. 2111128. Those marks are, of course, subject to proof of use and Mr Weston has asked for use to be proven. Whilst there is use of the words FITNESS FIRST in the evidence, there is, as far as I can tell, no use of the words FITNESSFIRST (i.e. as one word). However, even if the applicant's evidence were also considered sufficient for it to establish both proof of use and an enhanced reputation in relation to both marks in the series, it would, given the presentation of these marks and the minimal degree of stylisation present in CTM no. 8179095, place it in no better position.

Conclusion under section 5(2)(b)

42. The request to invalidate Mr Weston's mark fails.

The invalidation based upon section 5(3) of the Act

43. The principles to be applied when determining an objection under this ground were summarised by the Hearing Officer, Allan James, in BL O-179-11 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 Corp v Yplon SA* [2000] RPC 572 (CJEU), 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; but the reputation of the earlier mark may extend beyond the consumers for the goods and services for which it is registered; *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 (CJEU), paragraph 51.

(c) It is necessary, but not sufficient, 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 Salomon AG v Fitnessworld Trading Ltd*. [2004] ETMR 10 (CJEU), paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account all relevant factors, including the degree of similarity between the respective marks and between the respective 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) Although it is not a necessary factor, a link between the trade marks is necessarily established where the similarity between the marks causes the relevant public to believe that the goods/services marketed under the later mark come from the owner of the earlier mark, or from an economically connected undertaking; Intel, paragraph 57.

(f) Where a link is established, the owner of the earlier mark must also establish that it has resulted in 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 the relevant factors; Intel, paragraph 79.

(g) 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 likelihood that this will happen in future; Intel, paragraphs 76 and 77.

(h) 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.

(i) Detriment to the repute of the earlier mark is caused when the goods or services for which the later mark is used by the third party may be perceived by the public in such a way that the earlier trade mark's power of attraction is reduced; *L'Oreal SA and others v Bellure NV and others* - C-487/07 (CJEU), paragraph 40.

(j) Unfair advantage covers, in particular, cases where a third party seeks to ride on the coat-tails of the senior mark in order to benefit from a transfer of the image of the earlier mark, or of the characteristics it projects to the goods/services identified by the later mark; L'Oreal, paragraph 41."

44. I have no doubt that on the basis of the use provided the mark the subject of (at least) CTM no. 8179097 has the necessary reputation in the UK to get the applicant's objection under section 5(3) of the Act off the ground. However, in line with my conclusions on the ground based upon section 5(2)(b) of the Act, the competing marks are, in my view, sufficiently different that the average consumer will not make the necessary "link" between the competing marks. Without a link, the objection based upon section 5(3) of the Act cannot succeed and is dismissed accordingly.

Conclusion under section 5(3) of the Act

45. The request to invalidate Mr Weston's mark fails.

Overall conclusion

46. **The request to invalidate Mr Weston's mark on the basis of sections 5(2)(b) and 5(3) of the Act has failed.**

Costs

47. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. In awarding costs to Mr Weston, I note that a significant part of his witness statement and all of his exhibits were filed to demonstrate that the word FITNESS was descriptive and non-distinctive for fitness related services. As this is a notorious fact of which I would have been entitled to take judicial notice, the filing of evidence in these circumstances was, in my view, unnecessary and I make no award in respect of it. In addition, as Mr Weston's submissions in lieu of attendance at a hearing amounted to two operative paragraphs of a two page letter, none of which added anything of substance to what he had already said in his counterstatement and witness statement, I make no award in respect of these submissions either. Bearing the above in mind, and using the TPN mentioned as a guide, I award costs to Mr Weston on the following basis:

Preparing a statement and considering the applicant's statement:	£400
Considering and commenting on the applicant's evidence:	£600
Total:	£1000

48. I order Fitness First Limited to pay to Aaron Smith the sum of **£1000**. This sum is to 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 10th day of March 2014

**C J BOWEN
For the Registrar
The Comptroller-General**