

O-153-14

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS IN THE MATTER OF

APPLICATION NOS 2596660, 2596661 & 2596671

BY MYTIME ACTIVE

TO REGISTER THE FOLLOWING THREE TRADE MARKS (THE FIRST IN CLASS 35 AND THE SECOND AND THIRD IN CLASS 41):



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OPPOSITION THERETO (UNDER NOS 103260, 103261 & 103262)  
BY MY TIME C.I.C.

## **BACKGROUND**

1) On 03 October 2011 Mytime Active ('the applicant') applied to register the following three trade marks:

**Application No 2596660:**



*Class 35: Advisory services (business) relating to the management of businesses; business management of sporting facilities [for others]; exhibitions (arranging) for commercial purposes; facilities management, namely administration, business management, personnel management and recruiting; business management of sporting venues [for others].*

**Application No 2596661:**



*Class 41: Arranging for students to participate in recreational activities; keep fit instruction services; keep-fit facilities (provision of); keep-fit instruction; kindergarten services [education or entertainment]; leisure centre services; organisation of recreational activities; organisation of recreational competitions; organisation of recreational tournaments; organisation of sporting activities; organisation of sporting competitions; organisation of sporting events; organising of football events; organising of sporting events, competitions and sporting tournaments; organising of sports and sports events; sports facilities (Hire of); sports facilities (provision of); teaching of swimming; water chute complex operation; arranging group recreational activities; ballet classes; bowling centres (operation of); club recreation facilities (provision of); club services [entertainment or education]; club sporting facilities (provision of); coaching services for sporting activities gym activity classes; gymnasium club services; gymnasium facilities (provision of); gymnasium services; gymnasium services relating to body building; gymnasium services relating to weight training; gymnastic instruction; gymnastics (instruction in); health club [fitness] services; health club services; health club services [exercise]; hospitality services (entertainment); instruction courses related to slimming; instruction courses relating to health; instruction courses relating to physical fitness; instruction courses relating to sporting activities; instruction in ballet; instruction in circuit training; instruction in*

*dancing; instruction in diet [not medical]; instruction in group exercise; instruction in gymnastics; instruction in martial arts; instruction in sporting activities; instruction in sports; issue of publications.*

**Application No 2596671:**



*Class 41: Entertainment services relating to the playing of golf; facilities for playing golf (provision of); golf facilities (providing); golf tournaments (organising of); golf tuition; golfing facilities (provision of); instruction in golfing skills; organising of golf tournaments; organising of golfing tournaments; provision of golfing facilities; caddying.*

2) All three applications were published on 27 January 2012 in the Trade Marks Journal and notice of opposition was subsequently filed by My Time C.I.C. ('the opponent'). The opponent claims that the applications offend under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). All three oppositions are directed against all of the applicant's services.

3) The opponent relies on the UK trade mark registration shown in the table below:

Mark details	Goods and services relied upon
<p><b>UK trade mark: 2477059</b></p> <p><b>MY TIME</b></p> <p><b>Filing date: 16 January 2008</b>  <b>Date of entry in the register: 01 August 2008</b></p>	<p><b>Class 16:</b> <i>Printed matter and publications, magazines, books, brochures, leaflets educational and training manuals, course materials, all relating to counselling and psychotherapy, personal development, confidence building, low self-esteem, depression and other emotional and mental health problems, diet and nutrition, marriage guidance.</i></p> <p><b>Class 41:</b> <i>Arranging and conducting of workshops and seminars; provision of training; life coaching; lifestyle counselling and consultancy (training); training and education relating to self esteem and confidence building; educational programmes to aid with personal development.</i></p>

	<p><b>Class 44:</b> <i>Counselling and psychotherapy services providing support to individuals suffering from low self esteem, depression and other emotional and mental health problems; counselling relating to the psychological treatment and relief of medical ailments; psychological and medical counselling; self esteem and confidence building; counselling to aid with personal development; psychological examination; psychological testing for medical purposes; preparation of psychological reports for medical purposes; lifestyle counselling and consultancy (health); counselling relating to diet and nutrition.</i></p> <p><b>Class 45:</b> <i>Marriage guidance counselling; preparation of psychological reports for legal purposes.</i></p>
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4) The trade mark relied upon by the opponent has a filing date of 16 January 2008 and completed its registration procedure on 01 August 2008. The consequences of these dates, in relation to the applicant's marks, are that i) the opponent's mark is an earlier mark in accordance with section 6 of the Act; and ii) it is not subject to the proof of use conditions contained in section 6A of the Act as it had been registered for less than five years at the date of publication of the applicant's marks.

5) The applicant filed a separate counterstatement for each opposition denying, with explanation, the grounds of opposition.

6) Further to receipt of the counterstatements the three oppositions were consolidated<sup>1</sup> in light of the identity of the parties and the similar issues to be determined. Only the opponent filed evidence. Neither party opted to be heard; only the opponent filed written submissions in lieu. I now make this decision after conducting a thorough review of the papers and giving full consideration to all evidence and submissions. I will refer to certain of the parties' submissions as, and when, I consider it appropriate.

## **EVIDENCE**

### **The opponent's evidence**

7) The opponent's evidence consists of three witness statements (one having been filed in respect of each trade mark application), dated 07 May 2013, in the name of Michael Lilley, Chief Executive of MY TIME C.I.C. All of the witness statements are, for the most part, identical.

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<sup>1</sup> Under the provision of rule 62(1)(g) of The Trade Marks Rules 2008.

8) Mr Lilley's states, in summary, the following:

- The trade mark 'MY TIME' has been used in the UK by the opponent since 2002.
- The opponent has worked within the public sector and, since 2002, has secured contracts to provide health services with local authorities including the NHS, the Police, Ministry of Justice and a range of other publicly funded agencies. In that time, the opponent has built a significant reputation with these organisations and an association between the words 'MY TIME' and the provision of quality mental and physical health services within Birmingham and the surrounding community.
- The opponent has won many awards, such as, Innovation in Counselling and Psychotherapy (2007), Outstanding Contribution to Research in Counselling and Psychotherapy (2010), West Midlands Social Enterprise of the Year (2012) etc.
- The opponent is a well-known influential leader and host of public discussions on health and social care issues. Mr Lilley refers to Exhibit 1 which shows a copy of an agenda for an event which was hosted by the opponent in May 2013.
- The opponent has two categories of consumers: its end customers (the public) who experience mental health problems, and the commissioners whose funding the opponent relies upon.
- The applicant, like the opponent, is also a charitable organisation providing services for local authorities and primary care trusts.
- The opponent has been alerted to instances of confusion on the part of the public by the applicant's use of the words 'MY TIME'. By way of example, Mr Lilley states: 'earlier this year, Birmingham City Council tendered a contract for Looked After Children. I went to the tender meeting and had a one to one session with one of Birmingham City Council's contract lawyers who said that he had just completed a contract for "MYTIME GOLF" to manage a Birmingham City Council golf course and was intrigued that we dealt with children as well as health and leisure services. He explained his concern that we were spreading ourselves over too many areas.'
- All of the applicant's and opponent's brands cross health and well-being commissioning. In addition, under the Health and Social Care Act 2012, patients will be given personal health budgets which will allow them, with the help of professional health advisors, to manage their own care by being able to potentially use, for example, both leisure facilities (as provided by the applicant) and counselling (as provided by the opponent) as a method of recovery.
- Both the applicant and the opponent have to make their respective services available to the public through leaflets and posters in GP surgeries, libraries and publicly funded leisure centres.
- Mr Lilley refers to a further instance of 'confusion' as he states: 'In 2012, MY TIME CIC was commissioned by Sandwell Metropolitan Borough Council Children and Families Commissioner to undertake a Borough-wide study on the emotional well-being of Sandwell children and young people. MY TIME CIC uses a community participatory method of research which involves

employing and training the services of local people (in this case young people) to interview their peers. This involved engaging 5 young Sandwell women students.....who subsequently engaged with 121 children and young people through libraries, GP surgeries, schools and youth facilities. MYTIME ACTIVE has contracts with NHS Sandwell to deliver a range of health and well-being services which they started in 2011. The Commissioner and Contract Manager at Sandwell reported that they thought MY TIME CIC and MYTIME ACTIVE were connected as they knew of MY TIME CIC'S reputation and brand, they thought we had expanded our services. This was also reported by 2 of the employed students and over 20 incidences (reported by the community researchers) of young people, parents and professionals, indicating that they made this connection. On 4 occasions, Sandwell residents complained about MYTIME ACTIVE services to the community researchers and it had to be explained to them that there were 2 different service providers.'

- Mr Lilley refers to Exhibit 2 which he states shows that the applicant identifies itself as a social enterprise 'within the wider meaning of the word' and that this is 'inevitably likely to lead to both sets of consumers being confused between them' as the opponent is the holder of a Social Enterprise mark. Exhibit 2 shows a screen shot from the applicant's website. In the middle of the page it states 'The Social enterprise that's changing lives for the better!'

## **DECISION**

### **Section 5(2)(b)**

9) This section of the Act provides:

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

(a) .....

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

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

10) The leading authorities which guide me are from the Court of Justice of the European Union (CJEU): *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, *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 for 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) 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*,

(f) 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*,

(g) 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.*,

(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; *Sabel BV v Puma AG*,

(i) 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.*,

(j) 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*,

(k) 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*,

(l) 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.*

**Comparison of goods and services**

11) The goods and services to be compared are shown in the table below:

<b>Opponent's goods and services</b>	<b>Application 2596660</b>
<p><b>Class 16:</b> Printed matter and publications, magazines, books, brochures, leaflets educational and training manuals, course materials, all relating to counselling and psychotherapy, personal development, confidence building, low self-esteem, depression and other emotional and mental health problems, diet and nutrition, marriage guidance.</p>	<p><b>Class 35:</b> Advisory services (business) relating to the management of businesses; business management of sporting facilities [for others]; exhibitions (arranging) for commercial purposes; facilities management, namely administration, business management, personnel management and recruiting; business management of sporting venues [for others].</p>
<p><b>Class 41:</b> Arranging and conducting of workshops and seminars; provision of training; life coaching; lifestyle counselling and consultancy (training); training and education relating to self esteem and confidence building; educational programmes to aid with personal development.</p> <p><b>Class 44:</b> Counselling and psychotherapy services providing support to individuals suffering from low self esteem, depression and other emotional and mental health problems; counselling relating to the psychological treatment and relief of medical ailments; psychological and medical counselling; self esteem and confidence building; counselling to aid with personal development; psychological examination; psychological testing for medical purposes; preparation of psychological reports for medical purposes; lifestyle counselling and consultancy (health); counselling relating to diet and nutrition.</p> <p><b>Class 45:</b> Marriage guidance counselling; preparation of</p>	<p><b>Application 2596661</b></p>
	<p><b>Class 41:</b> Arranging for students to participate in recreational activities; keep fit instruction services; keep-fit facilities (provision of); keep-fit instruction; kindergarten services [education or entertainment]; leisure centre services; organisation of recreational activities; organisation of recreational competitions; organisation of recreational tournaments; organisation of sporting activities; organisation of sporting competitions; organisation of sporting events; organising of football events; organising of sporting events, competitions and sporting tournaments; organising of sports and sports events; sports facilities (Hire of); sports facilities (provision of); teaching of swimming; water chute complex operation; arranging group recreational activities; ballet classes; bowling centres (operation of); club recreation facilities (provision of); club services [entertainment or education]; club sporting facilities (provision of); coaching services for sporting activities gym activity classes; gymnasium club services; gymnasium facilities (provision of); gymnasium services; gymnasium</p>



<p><i>psychological reports for legal purposes.</i></p>	<p><i>services relating to body building; gymnasium services relating to weight training; gymnastic instruction; gymnastics (instruction in); health club [fitness] services; health club services; health club services [exercise]; hospitality services (entertainment); instruction courses related to slimming; instruction courses relating to health; instruction courses relating to physical fitness; instruction courses relating to sporting activities; instruction in ballet; instruction in circuit training; instruction in dancing; instruction in diet [not medical]; instruction in group exercise; instruction in gymnastics; instruction in martial arts; instruction in sporting activities; instruction in sports; issue of publications.</i></p>
	<p><b>Application 2596671</b></p>
	<p><b>Class 41:</b> <i>Entertainment services relating to the playing of golf; facilities for playing golf (provision of); golf facilities (providing); golf tournaments (organising of); golf tuition; golfing facilities (provision of); instruction in golfing skills; organising of golf tournaments; organising of golfing tournaments; provision of golfing facilities; caddying.</i></p>

12) The leading authorities as regards determining similarity between goods and services are considered to be *British Sugar Plc v James Robertson & Sons Ltd* ('*Treat*') [1996] R.P.C. 281 and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 ('*Canon*'). In the latter case, the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive.

13) In *Beautimatic International Ltd v. Mitchell International Pharmaceuticals Ltd and Another* ('*Beautimatic*') [2000] FSR 267 Neuberger J held that the words must be given their natural meaning, subject to their being construed within their context; they must not be given 'an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor'. However, I must also bear in mind the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* ('*Avnet*') [1998] FSR 16:

'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.'

14) Further, in *YouView TV Ltd v Total Ltd* ('*YouView*') [2012] EWHC 3158 (Ch) at [12] Floyd J said:

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

15) Whether goods/services are complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), will depend on whether there exists a close connection or relationship such that one is important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* it was stated:

'It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *Ei Corte*

Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).'

On the matter of complementarity, I also bear in mind the comments of Mr Daniel Alexander QC, sitting as the appointed person, in *Sandra Amalia Mary Elliott v LRC Products Limited* BL O/214/13.

16) When comparing the respective services, if a term clearly falls within the ambit of a term in the competing specification then identical services must be considered to be in play (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) ('Meric')* Case T-133/05).

17) Finally, I also bear in mind that, where it is not obvious to me that there is similarity between respective goods and services, the onus is on the opponent to present evidence (or at least focused submissions) in support of its contentions that there is similarity (see, for example, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97, paragraph 22).

18) I will make the comparison by addressing the services covered by each application in turn, and, where appropriate and for the sake of expediency, grouping certain terms together (*Separode Trade Mark* BL O-399-10).

#### **Application 2596660**

19) In relation to this specific application, the opponent states:

'The services are similar as business services found in class 35 could be for businesses that provide workshops, seminars, training, and life coaching. Sporting facilities such as sports halls can also be used as facilities to give workshops and other forms of training, including in the areas of personal development, mental health etc. The services are therefore similar.'

20) The opponent also states, inter alia, the following:

'There is similarity between the services offered by both parties as for example, the Opponent is registered for counselling related to diet and nutrition under class 44.....The Opponent focuses on emotional wellbeing but encourages the public to engage in physical activities as part of the Department of Health's strategy. The Applicant focuses on physical activities (such as sport) in order to aid emotional wellbeing under the strategy. These are reflected in the parties' respective specifications as for example, the Applicant is attempting to register under class 35 for business management of sporting facilities [for others] and the Opponent is registered under class 44 for counselling related to diet and nutrition. The services offered by the Applicant and Opponent, and covered by their respective specifications, are therefore clearly complementary and similar.' and '...patients would be able to choose counselling services alongside, for example, engaging in physical activities such as swimming.'

21) The applicant denies that there are any similarities between the respective goods and services.

22) Advisory services (business) relating to the management of businesses; business management of sporting facilities [for others]; facilities management, namely administration, business management, personnel management and recruiting; business management of sporting venues [for others].

I disagree with the opponent that I should find similarity on the basis it proposes. I must consider the similarity between the actual goods and services which are listed before me. It is to be noted that the terms listed above in the applicant's specification do *not* describe or cover services for the provision of training or the like; they describe services which are offered to businesses to assist them in co-ordinating and controlling their resources or to provide assistance with day-to-day administrative tasks in order to facilitate efficient operations. 'business management of sporting venues [for others]', for instance, is likely to primarily involve the provision of assistance to sporting venues in using resources efficiently and effectively and helping them to achieve short and long-term objectives and goals to ensure that the sporting venue is a commercial success. The applicant's services are specialised business to business services concerned essentially with management and/or administration. Such services may, of course, be provided to a wide range of businesses and the latter may provide all varieties of different goods and services to their own customers (including provision of sports training, for example). It does not follow that business management services provided to a business are similar to the goods/services provided by that business to its customers. The opponent's argument in that regard is flawed.

The opponent's goods are, in essence, printed matter in various forms and its services are all, essentially, training and educational services, counselling and psychotherapy services. Bearing in mind the factors set out in the relevant case law, and having regard, in particular, for the respective nature, intended purpose and users of the goods and services at issue, I fail to see any similarity (including a lack of any complementarity) between the applicant's services listed above and the opponent's goods and services. Accordingly, I must conclude that there is no similarity between them.

23) exhibitions (arranging) for commercial purposes.

The applicant's services above are essentially for the purpose of publicising/displaying information and, bearing in mind that they are specified to be for 'commercial purposes', they are, in my view, likely to be provided to businesses to display and/or demonstrate the goods/services those businesses have to offer to potential customers. Again, it is not obvious to me that there is any similarity within the parameters of the case law with any of the opponent's goods and services and, in the absence of any specific evidence directed to this point, or any focused submissions from the opponent explaining why I should find to the contrary, I must conclude that there is no similarity.

## Application 2596661

24) The applicant again denies that there are any similarities between the respective goods and services.

25) In relation to this specific application, the opponent states:

‘The recreational, sport and leisure activities and other services listed in the application are either identical to the services in class 41 of the earlier right, or are similar to services in class 41 or as listed in other classes. It is well known that mental health, personal development and lifestyle training is related to and includes sports, leisure and associated activities.’

26) *keep fit instruction services; keep-fit instruction; teaching of swimming; ballet classes; club services [education or entertainment]; coaching services for sporting activities gym activity classes; gymnastic instruction; gymnastics (instruction in); instruction courses related to slimming; instruction courses relating to health; instruction courses relating to physical fitness; instruction courses relating to sporting activities; instruction in ballet; instruction in circuit training; instruction in dancing; kindergarten services [education or entertainment]; instruction in diet [not medical]; instruction in group exercise; instruction in gymnastics; instruction in martial arts; instruction in sporting activities; instruction in sports.*

I do not find the opponent’s submission particularly helpful. Nevertheless, I note that the opponent’s specification contains the term ‘provision of training’ in class 41. The term ‘training’ is a broad one, defined as ‘the process of bringing a person, etc., to an agreed standard of proficiency, etc., by practice and instruction’.<sup>2</sup> The opponent’s term would therefore cover a wide variety of educational/instruction services in various disciplines, including sports and fitness training and education of children. In light of this, it appears self-evident and obvious to me that all of the applicant’s terms listed above would fall within the opponent’s ‘provision of training’ in accordance with the *Meric* principle. The respective services are identical.

27) *issue of publications.*

The opponent’s strongest case in relation to the above term lies with its ‘printed matter and publications ...’ There is clearly a complementary relationship between these goods and the applicant’s ‘issue of publications’; the goods are indispensable to the service of issuing publications and the trade channels will be the same. Bearing these factors in mind, it is self-evident that the respective goods and services are similar to a good degree.

28) *keep-fit facilities (provision of); leisure centre services; sports facilities (Hire of); sports facilities (provision of); bowling centres (operation of); club recreation facilities (provision of); club sporting facilities (provision of); gymnasium club services; gymnasium facilities (provision of); gymnasium services; gymnasium services*

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<sup>2</sup> 2000 ‘[Training](#)’ in *Collins english dictionary*, Collins, London, United Kingdom. Accessed: 31 March 2014, from Credo Reference.

relating to body building; gymnasium services relating to weight training; health club [fitness] services; health club services; health club services [exercise].

The above listed services of the applicant are all, in essence, concerned with providing facilities to engage in sport and fitness. Bearing in mind my earlier comments regarding the opponent's 'provision of training', it seems obvious to me that an undertaking providing sporting/training facilities may also provide instruction in sports and/or fitness. For instance, a leisure centre is likely to provide a swimming pool and may also provide swimming lessons. The respective services may therefore share the same trade channels, have the same users and may be considered complementary in some instances since training in certain sports will likely require the provision of the facilities necessary to engage in that sport. I consider the applicant's services listed above and the opponent's 'provision of training' to be reasonably similar.

29) Arranging for students to participate in recreational activities; organisation of recreational activities; organisation of recreational competitions; organisation of recreational tournaments; organisation of sporting activities; organisation of sporting competitions; organisation of sporting events; organising of football events; organising of sporting events, competitions and sporting tournaments; hospitality services (entertainment); organising of sports and sports events; arranging group recreational activities.

The applicant's services listed above can be collectively described as those for the organisation of recreational/sporting competitions, activities and entertainment. Whilst I am conscious that I must not give terms an overly broad interpretation (*Avnet, YouView*), it appears to me that there is a certain degree of similarity between these services and the opponent's 'provision of training' which, as stated earlier, would include the provision of sports training. I think it reasonable to conclude, for instance, that an undertaking providing training in golf may also arrange golf competitions and entertainment relating to golf (i.e. golf events). I conclude that there is a moderate degree of similarity between the applicant's services listed above and the opponent's 'provision of training'.

30) water chute complex operation.

The applicant's services are concerned with the operation of water slides such as those in an amusement water park, for example. I can see no obvious coincidence between these services and the goods and services of the opponent. There is no similarity.

### **Application 2596671**

31) The applicant again denies that there is any similarity between the respective goods and services.

32) In relation to this specific application, the opponent states:

'The golf related services in the application are either identical, coming under the more generic terms of arranging and conducting workshops and seminars

(as these can be golf related), or are similar to the other protected services of the earlier right. Confidence building and personal development training, for example, can also use playing golf as a means to achieve these ends and as part of a broader training programme.'

33) *golf tuition; instruction in golfing skills.*

Bearing in mind my comments at paragraph 26, the applicant's services listed above are identical to the opponent's 'provision of training' in accordance with *Meric*.

34) *facilities for playing golf (provision of); golf facilities (providing); golfing facilities (provision of); provision of golfing facilities.*

Bearing in mind my comments at paragraph 28, I consider that the opponent's 'provision of training' (which would include instruction in playing golf) and the applicant's services listed above are reasonably similar.

35) *golf tournaments (organising of); organising of golf tournaments; organising of golfing tournaments; Entertainment services relating to the playing of golf.*

Bearing in mind my comments at paragraph 29, I find there to be a moderate degree of similarity between the applicant's services listed above and the opponent's 'provision of training'.

36) *caddying.*

The intended purpose and nature of 'caddying' would also appear to share similarities with 'provision of training'. A golf trainer will provide advice and instruction on various aspects of playing golf. Similarly, a caddy may provide advice and support to a golfer during play as regards, for example, the best club to use for a particular shot. I find there to be a moderate degree of similarity between the applicant's 'caddying' and the opponent's 'provision of training'.

**Average consumer and the purchasing process**




37) It is necessary to consider these matters from the perspective of the average consumer of the goods and services at issue (*Sabel BV v.Puma AG*). The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods and services.

38) The respective specifications cover a range of services including those relating to health, sports, fitness and training. The opponent's specification also includes a range of publications in class 16. I would expect the average consumer to consist mainly of members of the general public (with the exception of those covered by application 2596660 which will be purchased primarily by businesses). The level of attention paid by the general public is likely to vary from fairly low in relation to 'magazines' up to at least reasonable in relation to services such as 'instruction in sporting activities'.

39) The opponent states that the average consumer will also include commissioners in the public sector. I accept that this may be the case. The level of attention paid by commissioners is likely to be higher than the general public and therefore, I bear in mind that in relation to goods and services which may be purchased by both the general public and commissioners, the assessment should be made from the perspective of the former rather than the latter (see *Adelphoi Limited v DC Comics (a general partnership)* BL O/440/13, paragraph 21). Turning to the manner in which the goods and services at issue will be selected, this is likely to be predominantly visual in every instance; all of the goods and services are likely to be selected primarily by the eye after, for example, perusal of the internet, brochures or from a shelf. That said, aural considerations will certainly not be ignored from my assessment.

**THE RESPECTIVE MARKS**

40) The average consumer normally perceives a mark as a whole and does not proceed to analyse its details. The visual, aural and conceptual similarities 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*). Accordingly, there cannot be an artificial dissection of the marks, although it is necessary to take into account any distinctive and dominant components.

Opponent's mark	Applicant's marks
<p><b>MY TIME</b></p>	<p><b>Application 2596660:</b></p>  <p><b>Application 2596661:</b></p>  <p><b>Application 2596671:</b></p> 



### **Dominant and distinctive elements**

41) The opponent's mark consists of the two words 'MY' and 'TIME' presented in plain block capitals. The two words appear to hang together and neither is more dominant than the other. The distinctiveness of the mark lies in its totality.

#### **Application 2596660**

42) The distinctive verbal element in the applicant's mark is presented as a single word. However, it naturally breaks down into three immediately recognisable words, 'my', 'time' and 'active'. The two words 'my' and 'time' have a degree of dominance over the word 'active' owing to the former preceding the latter; they strike the eye first. Above those words is a further distinctive element of an abstract device of two wavy lines. The device, although far from negligible, is less dominant than the words when viewing the mark as a whole.

#### **Application 2596661**

43) The words in the applicant's mark hang together; that said, given the descriptive connotations of the word 'leisure' in relation to the applicant's services and despite it being presented in larger font, more attention will be placed on 'mytime' (which is immediately recognisable as the two words 'my' and 'time'). Further, it is a general rule of thumb that words speak louder than devices. In my view, the rule of thumb is applicable here; the device, although a distinctive element, is less dominant than the words.

#### **Application 2596671**

44) Similar conclusions apply to this mark as for application 2596661. Again, the words hang together, but given the descriptive nature of 'golf', and despite its larger font, more attention will be placed on 'mytime' (again this will be recognised as 'my' and 'time'). The device of the stylised figure swinging a golf club is a distinctive element but it is less dominant than the words.

45) Despite my findings as to the dominance of certain aspects of the applicant's marks, none of their elements are negligible and therefore it is still the marks as a whole which must be compared with the opponent's mark.

### **Comparison of the marks**

46) In approaching the comparison of the respective marks, I bear in mind that the colour in the applicant's marks is not a distinguishing feature. In *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch) Mann J stated:

'119. It is not clear to me that this is a debate which advances the case very much, but the position seems to me to be as follows. As a matter of principle the exercise involves comparing the offending sign with the registered mark

and assessing the likelihood of confusion or association. The two things have to be compared. Since we live in a visual world, and signs are visual, some form of appearance has to be considered. If the registered mark is limited to a colour, then the mark that is used has to be compared, as used, to the mark that is registered, as registered (and therefore in colour). If the registered mark is unlimited as to colour then it is registered for all colours. This means that the colour of the offending sign becomes irrelevant. It will not be possible to say that its colour prevents there being an infringement. At this point one can take one of two courses, each of which ought to have the same result. The first is to imagine the registered mark in the same colour as the offending sign. The second is to drain the colour from the offending sign. Either way one then has the material for comparison. One could even imagine them both in a third colour. It does not matter. So in a sense both Mr Purvis and Mr Bloch are right. As a matter of visual convenience it seems to me to be easier to imagine the registered mark in a colour than to imagine the offending sign drained of colour, and I propose to adopt that course.'

47) The following comparisons are therefore made on the basis of the applicant's marks being drained of colour.

#### **Application 2596660**

48) The applicant states, inter alia, the following:

'It is denied that the marks are identical in the first two components of the Applicant's mark. The Opponent's mark is a word only mark consisting of two separate elements, the word "My" and the word "Time". The words are generic words in common usage and are not invented. In contrast the Applicant's mark is highly stylised and consists of two components elements: a single word "mytimeactive" capped by two distinctive swooshes.

From a visual perspective the marks are very different. The use of two ordinary, generic words and the visual simplicity of the Opponent's word only, non-stylised, mark contrasts significantly with the Applicants highly stylised mark which has a considerable degree of visual distinctiveness accentuated by distinctive component parts represented in different tones.

...

As to the argument that the device element adds little differentiation, it is denied that this is the case. The device element, consisting of two interlinking 'swooshes' is very distinctive due to its sharpness at one end which gradually fades out and softens towards the other. ...'

49) The opponent states, inter alia, the following:

'It is denied that the use of the space between 'MY' and 'TIME' renders the most distinctive element of the Marks visually different. The words 'MY TIME' and 'MYTIME' are identical to each other for trade mark purposes and in line with established case law, it would be overly analytical to distinguish the

Marks on the basis of one being a word and the other being a two word phrase (see *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch)).

50) There is clearly a point of similarity between the marks owing to the presence of the 'MY TIME'/'mytime' aspects. I agree with the opponent that the lack of a space between the two words 'my' and 'time' in the applicant's mark is of little significance in differentiating these aspects. It is also of little consequence that the words are presented in lower case and upper case in the applicant's and opponent's marks respectively. The addition of the word 'active' in the applicant's mark and the presence of the device element which is alien to the opponent's mark are points of difference. On the whole, there is a moderate degree of visual similarity.

51) On aural similarity, the applicant states:

'The only aural similarity between the two marks is in relation to the first element of the Applicant's mark, the "my" and "time" element. This is diminished by the fact that the words are in common usage. The applicant's mark includes the addition of the word "active" and is therefore significantly different aurally and will therefore not be confusing.

Additionally, although 'mytime' and 'MY TIME' may be pronounced similarly, there is likely to be a difference in emphasis put on the words. When 'MY TIME' is pronounced there is likely to be a lot of emphasis on the word 'MY'. Whereas when 'mytimeactive' is read all together, the three constituent words are likely to have an equal emphasis.'

52) The opponent states, inter alia:

'There is aural similarity between the marks. The words 'MY TIME' and 'MYTIME' are aurally identical. It is denied that their aural similarities are diminished by the common usage of the words.'

53) The device element in the applicant's mark will not be pronounced and so does not come into play in the aural comparison. Both marks consist of known dictionary words with quite obvious pronunciations; the opponent's mark being pronounced MY-TIME and the applicant's mark MY-TIME-AC-TIV. I am not persuaded by the applicant's submission regarding the likely difference in emphasis of the 'MY TIME'/'mytime' aspects. In my view, those aspects will be pronounced identically. That said, even if the applicant's view is correct, this is of little consequence since such differing emphasis would still lead to extremely high similarity between the relevant aspects. I agree with the opponent that whether the words 'my' and 'time' are in common usage does not disturb this finding. Whilst there is a point of difference created by the 'AC-TIV' sound at the end of the applicant's mark which is absent from the opponent's mark, on the whole, the aural similarity is, nevertheless, reasonably good.

54) On conceptual similarity, the applicant states:

'The word 'mytimeactive' immediately suggests concepts of physical activity including sport and personal fitness in addition to the idea of leading a

physically healthy lifestyle. This contrasts with the Opponent's mark which has little or no physical or active dimension. Therefore the two marks are conceptually very different.'

55) The opponent states:

'The words 'MY TIME' and MYTIME' are conceptually identical.

The word 'ACTIVE' is a dictionary word which means engaging or ready to engage in physically energetic pursuits. The applicant's use of this word therefore adds little in the way of conceptual differences to the Trade Mark as it is descriptive of the Applicant's services.'

56) The concept portrayed by the opponent's mark is the time a person has to one's self. The applicant's mark contains the same concept together with the concept of activity created by the word 'active'. It is not altogether clear to me, contrary to what the opponent asserts, that the word 'active' is descriptive of the applicant's services. In any event, the presence of the words 'my' and 'time' in both marks results in a reasonably good degree of conceptual similarity.

57) Overall the respective marks are similar to a reasonably good degree.

#### **Applications 2596661 & 2596671**

58) The opponent states that these marks are visually, aurally and conceptually similar to its mark and that the 'principle and most distinguishing element of the [respective] Marks ("MYTIME" and "MY TIME") is identical'.

59) The applicant submits similar arguments as those set out at paragraph 48 above. It also states, inter alia, the following:

'The word 'leisure' / ['golf'] is a prominent part of the Applicant's mark due to its much larger font size than the word 'mytime'. Therefore the consumer is automatically drawn to it first as it is the focal point of the mark. The word 'leisure' / ['golf'] is also accompanied by a very distinct device element comprising three figures in 'active' stance / [an abstract-design golfer device]. The abstract design and colour scheme of the figures is also striking. The device element in combination with the word 'leisure' / ['golf'] provide significant additional distinctive material that, taken together in combination with all elements comprising the Applicant's mark, are such that there is no visual similarity between the parties' respective marks.'

...

Although 'mytime' and 'MY TIME' may be pronounced similarly, there is likely to be a large difference in the emphasis which is put on the words when spoken. When 'mytime' is read in conjunction with the word 'leisure', the word 'leisure' is likely to be given equal emphasis, having the same number of syllables as the first word 'mytime'. [Further], when 'mytime' is read in

conjunction with the word 'golf', the word 'golf' is likely to be given equal emphasis.

...

The word 'leisure' is conceptually unambiguous as it brings to mind activities which are normally carried out in one's spare time. In particular it evokes images of recreational pursuits. Consumers tend to perceive trade marks as a whole, and so read together with the device element (consisting of three 'active' figures), the concept of sport and physical activity is strengthened. This contrasts with the Opponent's mark which has no recreational dimension. Therefore the two marks are conceptually very different.

...

The word golf is conceptually specific and brings that one sporting activity to mind. This word is conceptually reinforced in the Applicant's mark by the use of the golfer device. This contrasts with the Opponent's mark which has no reference to golf whatsoever. Therefore the two marks are conceptually very different.'

60) I do not agree with the applicant that there is no visual similarity between the opponent's mark and applications 2596661 and 2596671. Although the words 'leisure'/'golf' and the corresponding device elements are points of contrast, there is also a clear point of commonality owing to the 'MY TIME'/'mytime' aspects. Viewing the marks as wholes, there is a moderate degree of visual similarity.

61) The words 'leisure'/'golf' in the applicant's marks create some aural contrast. However, as the applicant's marks and the opponent's mark contain the words 'my' and 'time' this inevitably results in a reasonably good degree of aural similarity, regardless of possible differences in emphasis.

62) Turning to the conceptual aspect, I have already identified the concept portrayed by the words 'MY TIME' i.e. the time a person has to one's self; this is the sole concept of the opponent's mark. The applicant's marks conjure the idea of leisure activities/golfing activities to be undertaken during the time a person has to one's self, with the corresponding device elements appearing to re-enforce these concepts. Bearing in mind that the leisure/golf aspects are clearly indicative of the nature of the applicant's services, it is the 'mytime' aspect of the applicant's marks which is likely to have the greater impact on the consumer's perception. Bearing all of this in mind, I disagree with the applicant's view that the marks are 'very different'; in my view the respective marks share a good degree of conceptual similarity.

63) Overall the respective marks are similar to a reasonably good degree.

#### **Distinctive character of the earlier mark**

64) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of

confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark must be assessed by reference to the goods or services for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* Case T-79/00 [2002] ETMR 91).

65) The opponent states that its mark was first used in the UK in 2002 and that it has secured a number of contracts with local authorities and the NHS etc. has won many awards and is well-known. However there is no further evidence beyond these statements to illustrate the exact nature or extent of such purported use prior to the relevant date. I am not able to conclude, on the basis of the evidence before me, that the opponent's mark has acquired an enhanced distinctive character through use. As such, I have only the inherent level of distinctiveness to consider.

66) The applicant contends that the opponent's mark is possessed of a 'relatively low level of distinctive character'. Throughout its submissions it states that the earlier mark consists of 'common, everyday words' and that 'the words are generic..., in common usage and are not invented'. The mark does indeed contain everyday immediately recognisable English words. I have already indicated that, to my mind, the words 'MY TIME' conjure the idea of the time a person has to one's self i.e. *personal* time. In light of the terms in the opponent's specification, many of which relate to *personal* development, the words 'MY TIME' are, to a certain degree, somewhat suggestive of the nature of such services. That said, they are not directly descriptive. Bearing these factors in mind, I consider the mark to be possessed of no more than a moderate degree of distinctive character.

### **Likelihood of confusion**

67) In its evidence (and submissions), the opponent has made reference to what it states are instances of actual confusion through 'MYTIME ACTIVE's use of the words "MY TIME"'. I do not find this information to be helpful, not least because there is no clear evidence to suggest that the marks at issue involved in these 'instances' were the exact marks before me in this opposition. Furthermore, the exact nature of the respective services on offer in these 'instances' is also not clear to me. For example, the opponent refers to one instance of purported actual confusion when it 'tendered a contract for Looked After Children' - this does not inform me as to the nature of the service which was tendered. The evidence from the opponent purporting to demonstrate instances of actual confusion will have no bearing on my considerations of the likelihood of confusion.

68) In deciding whether there is a likelihood of confusion I must take account of all of my earlier findings. I must also keep in mind the following:

- i) the interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*);
- ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and;
- iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the

imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

### **Application 2596660**

69) Notwithstanding my finding that the relevant respective marks are similar to a reasonably good degree, in light of my conclusions that none of the services covered by this application share any similarity with the goods and services of the opponent's earlier mark, there cannot be a likelihood of confusion (see, for example, *Waterford Wedgwood plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-398/07* ('Waterford')). The opposition fails in respect of application 2596660.

### **Applications 2596661 & 2596671**

70) I have found that 'water chute complex operation' services covered by application 2596661 share no similarity with any of the opponent's goods and services. Accordingly, there can be no likelihood of confusion in respect of those services (*Waterford*). The opposition fails in respect of 'water chute complex operation' services in application 2596661.

71) As for the remaining services covered by the two applications, I have found these to be either identical or similar (to varying degrees) to the opponent's goods and services. The relevant average consumer will be the general public<sup>3</sup> whose level of attention will vary from fairly low to at least reasonable during the mainly visual purchasing act. I have also found that the earlier mark is possessed of no more than a moderate degree of inherent distinctive character. As regards the similarities between the opponent's mark and the applicant's two marks, I have found, in respect of both, that there is a moderate degree of visual similarity, a reasonably good degree of aural similarity and a good degree of conceptual similarity with the earlier mark, resulting in a reasonably good level of similarity overall.

72) Drawing all of my findings together, I find that, in light of the nature of the purchasing act, which will be primarily visual, the consumer is unlikely to directly confuse the marks given the only moderate degree of visual similarity. Nevertheless, even allowing for the no more than moderate degree of distinctive character of the earlier mark, I consider that the similarities that do exist between the marks, bearing in mind the identity and similarities between the respective goods and services, are sufficient to result in a likelihood of indirect confusion i.e. that the consumer is likely to believe that the respective goods and services emanate from the same or linked undertaking(s). The opposition succeeds in respect of the services of the two applications which I have found to be similar to the opponent's goods and services.

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<sup>3</sup> See my earlier comments at paragraph 39 regarding the relevant average consumer (*Adelphoi Limited v DC Comics (a general partnership)* BL O/440/13).

## SUMMARY

73) Both parties have achieved a degree of success. This is reflected as follows:

- Application 2596660 will proceed to registration for all services in its specification.
- Application 2596661 will proceed to registration for the following services only:

*Class 41: water chute complex operation.*

- Application 2596671 is refused in its entirety.

## COSTS

74) The opponent has achieved a greater measure of success than the applicant and, as such, I consider it is entitled to an award of costs. In approaching the award I take into account that the proceedings were consolidated further to receipt of the three counterstatements. I will also allow for the degree of success enjoyed by the applicant. I award costs to the opponent on the following basis:

Preparing notice of opposition x 2 (for applications 2596661 & 2596671)	£400
Opposition fee x 2 (for applications 2596661 & 2596671)	£400
Preparing and filing evidence	£500
Written submissions:	£300
(Preparation of counterstatement for application 2596660)	- £300)
<b>Total:</b>	<b>£1300</b>

75) I order Mytime Active to pay My Time C.I.C. the sum of **£1300**. 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 8<sup>th</sup> day of April 2014**

**Beverley Hedley  
For the Registrar,  
the Comptroller-General**