

O-232-15

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3032664

BY

GI TECHNOLOGIES LTD

TO REGISTER THE TRADE MARK

SOUL SPIN

IN CLASSES 25 AND 41

AND

THE OPPOSITION THERETO

UNDER NO 401952

BY

MAD DOGG ATHLETICS INC

BACKGROUND

1. On 28 November 2013, GI Technologies Ltd (the applicant) applied to register the above trade mark in classes 25 and 41 of the Nice Classification system¹ as follows:

Class 25

Articles of clothing.

Class 41

Leisure centre, health club, fitness centre and gymnasium services; provision of training and education relating to gym use, weight training, body building, aerobics, physical exercise, physical rehabilitation, diet, nutrition, health and beauty; instructional services relating to gymnastics, weight training, body building, aerobics, physical exercise, physical rehabilitation, diet, nutrition, health and beauty; personal training services.

2. The application was published on 7 February 2014, following which Mad Dogg Athletics Inc (the opponent) filed notice of opposition against the application.

3. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent initially sought to rely upon two Community Trade Marks (CTMs), the earlier of which was subject to the requirement to prove use. In the absence of such evidence the single mark relied upon in respect of these proceedings is as follows:

Mark details and relevant dates	Goods relied upon
CTM: 6208508 SPIN FITNESS Filed: 17 August 2007 Entered in the register: 23 June 2009	Class 9 Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; carriers including records, discs, tapes, cassettes, cartridges and cards bearing or for use in bearing sound recordings, data, images, games, graphics, text, programs or information; memory carriers; inter-active compact discs; CD-Roms; electrically, magnetically and optically recorded data for computers; computer software; computer software, including software downloadable from the internet; downloadable electronic publications; computer software for use in downloading audio, video, still and moving images and data in compressed and uncompressed form from a computer or communication network and the organisation of data; audio, video, still and moving images and data recordings in compressed or uncompressed form; sound, video and data recordings; downloadable electronic publications; pre-recorded audio and video recordings, namely, CDs, DVDs and audio and video cassettes featuring instruction in the field of health and exercise.

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

	<p>Class 25 Clothing, footwear, headgear; apparel, namely, T-shirts, tank tops, polo shirts, sports bras, jackets, coats, rain suits, sweatshirts, hooded sweatshirts, sweatpants, warm-up suits, sweaters, jerseys, pullovers, tights, shorts, socks, caps.</p> <p>Class 28 Games and playthings; gymnastic and sporting articles not included in other classes; exercise equipment; exercise equipment, namely, resistance training machines, elastic tubing, exercise mats, exercise blocks, exercise straps, exercise balls, stability balls, weighted resistance products.</p> <p>Class 41 Education; providing of training; entertainment; sporting and cultural activities; production, presentation and rental of audio and video shows, performances, programmes and recordings, still and moving images and data relating to entertainment, education, recreation, instruction, tuition and training whether in compressed or uncompressed form and whether downloadable or non downloadable; providing on-line publications (non-downloadable); electronic publications (not downloadable); providing physical fitness instruction and consultation in the fields of health and exercise; health club services; health club services, namely providing instruction and equipment in the fields of health and exercise.</p>
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4. The applicant filed a counterstatement on 14 May 2014. It denies the grounds on which the opposition is based.

5. Included in the applicant's counter-statement is reference to 16 other marks on the register which contain the word SPIN and have been registered since 1997 in respect of goods and services in classes 25 and 41. It has long been established that state of the register evidence of this type does not assist the applicant. It does not indicate whether the marks are being used, or give any indication of the goods on which there is use, or what agreements may be in place between the parties. It is not, therefore, an indicator of whether or not there will be confusion in the market place in relation to the respective trade marks.² I shall give it no further consideration.

6. The applicant did not file evidence. The opponent filed written submissions in the period allowed for the filing of evidence. Neither side filed written submissions in lieu of attendance at a hearing nor did they request a hearing.

² see *Jacob J in British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 and the General Court in *Zero Industry Srl v Office of Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM)*, Case T-400/06 and *GfK AG v Office of Harmonisation in the Internal Market (trade Marks and Designs)(OHIM)*, Case T-135/04

7. I give this decision following a review of all of the material before me.

DECISION

8. Section 5(2)(b) reads as follows:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

9. An earlier trade mark is defined in section 6 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.”

10. The opponent’s mark is an earlier mark which had not been registered for five years at the date of publication of the application. Consequently, the proof of use requirements, set out in s.6A of the Act, do not apply.³ Accordingly, the opponent is entitled to rely on its full specification as registered for its earlier mark in these proceedings.

Section 5(2)(b) case law

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

³ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

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 be dominated by one or more of its components;

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

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

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

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

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

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

The average consumer and the nature of the purchasing act

12. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

13. I note that the opponent’s specification for classes 25 and 28 includes the word “namely”. The word “namely” must be approached, as indicated in the Trade Mark Registry’s classification guidance, on the basis shown below:

“Note that specifications including ‘namely’ should be interpreted as only covering the named goods, that is, the specification is limited to those goods. Thus, in the above ‘dairy products namely cheese and butter’ would only be interpreted as meaning ‘cheese and butter’ and not ‘dairy products’ at large. This is consistent with the definitions provided in Collins English Dictionary which states ‘namely’ to mean ‘that is to say’ and the Cambridge International Dictionary of English which states ‘which is or are’.”

14. The average consumer of the wide range of goods and services at issue may be a member of the general public or, in the case of services such as the opponent’s “production of audio and video shows” may be a professional or business.

15. The majority will be selected visually from websites, brochures or from a shelf, though I do not rule out an aural element where word of mouth recommendations play a part. With regard to the class 25 specifications, I am mindful of the General Court’s (GC) decision in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03 in which it commented:

“43. It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it

comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.

...

53. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

16. The level of attention paid will vary according to the nature of the goods, in this case, ranging from a pair of socks in class 25 to the commissioning of production services in class 41, but will be at least reasonable. In considering the parties’ leisure, gym and health club services in class 41, in my experience the level of attention paid is likely to be slightly higher than average bearing in mind the need to consider, inter alia, cost, length of membership contract and the particular facilities on offer.

Comparison of goods/services

17. In the absence of any evidence from either party regarding the nature of the goods and services to be compared, the following assessment is made from my own understanding.

18. The goods and services I initially compare are:

Opponent’s goods and services	Applicant’s goods and services
<p>Class 9 Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; carriers including records, discs, tapes, cassettes, cartridges and cards bearing or for use in bearing sound recordings, data, images, games, graphics, text, programs or information; memory carriers; inter-active compact discs; CD-Roms; electrically, magnetically and optically recorded data for computers; computer software; computer software, including software downloadable from the internet; downloadable electronic publications; computer software for use in downloading audio, video, still and moving images and data in compressed and uncompressed form from a computer or communication network and the organisation</p>	

<p>of data; audio, video, still and moving images and data recordings in compressed or uncompressed form; sound, video and data recordings; downloadable electronic publications; pre-recorded audio and video recordings, namely, CDs, DVDs and audio and video cassettes featuring instruction in the field of health and exercise.</p> <p>Class 25 Clothing, footwear, headgear; apparel, namely, T-shirts, tank tops, polo shirts, sports bras, jackets, coats, rain suits, sweatshirts, hooded sweatshirts, sweatpants, warm-up suits, sweaters, jerseys, pullovers, tights, shorts, socks, caps.</p> <p>Class 28 Games and playthings; gymnastic and sporting articles not included in other classes; exercise equipment; exercise equipment, namely, resistance training machines, elastic tubing, exercise mats, exercise blocks, exercise straps, exercise balls, stability balls, weighted resistance products.</p> <p>Class 41 Education; providing of training; entertainment; sporting and cultural activities; production, presentation and rental of audio and video shows, performances, programmes and recordings, still and moving images and data relating to entertainment, education, recreation, instruction, tuition and training whether in compressed or uncompressed form and whether downloadable or non downloadable; providing on-line publications (non-downloadable); electronic publications (not downloadable); providing physical fitness instruction and consultation in the fields of health and exercise; health club services; health club services, namely providing instruction and equipment in the fields of health and exercise.</p>	<p>Class 25 Articles of clothing.</p> <p>Class 41 Leisure centre, health club, fitness centre and gymnasium services; provision of training and education relating to gym use, weight training, body building, aerobics, physical exercise, physical rehabilitation, diet, nutrition, health and beauty; instructional services relating to gymnastics, weight training, body building, aerobics, physical exercise, physical rehabilitation, diet, nutrition, health and beauty; personal training services.</p>
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19. In comparing the goods and services, I bear in mind the following guidance provided by the GC in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

20. Factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)*⁴ (hereafter *Treat*) for assessing similarity between goods and services:

- (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 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, taking into account how goods/services are classified in trade.

21. The comments of Daniel Alexander Q.C., sitting as the Appointed Person, in *LOVE*⁵, which dealt with similarity of goods but by analogy is relevant to similarity of services, are also to be borne in mind:

“18. ...the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

22. And at paragraph 20 where he warned against applying too rigid a test:

“20. In my judgment, the reference to ‘legal definition’ suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

23. Where appropriate I will, for the purposes of comparison, group related goods and services together in accordance with the decision in *Separode Trade Mark*⁶:

“5. The determination must be made with reference to each of the different species of goods listed in the opposed application for registration;

⁴[1996] R.P.C. 281

⁵BL O/255/13

⁶BL O-399-10

if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

24. When considering the parties’ services I am mindful of the decision in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16, in which Jacob J stated:

“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 meaning attributable to the rather general phrase.”

25. With regard to interpreting terms in specifications, I will bear in mind the guidance provided in *Treat*:

“In construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning.”

26. I will also bear in mind Floyd, J’s statement in *YouView TV Ltd v Total Ltd*:⁷

“...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.”

27. And *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 in which the GC explained when goods are complementary:

“82. 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

⁷ [2012] EWHC 3158 (Ch) at [12]

Class 25

28. The applicant’s specification in class 25 is for a number of named articles of clothing. The opponent’s specification in the same class stands registered for clothing. Clearly these are identical goods.

Class 41

29. The applicant’s health club services are identical to the same term in the opponent’s specification. With regard to leisure centre, fitness centre and gymnasium services in the application these are the same, or at least highly similar to, the opponent’s health club services. In the absence of evidence from either party, in my experience a health club is a private club which provides a range of fitness, health and beauty services of the type provided at leisure centres, gymnasiums and fitness centres. The users of these premises will be the same and the purpose is the same, namely, maintenance or improvement of fitness through available facilities and advice/information.

30. The applicant’s specification in this class includes “provision of training and education relating to gym use, weight training, body building, aerobics, physical exercise, physical rehabilitation, diet, nutrition, health and beauty” AND “instructional services relating to gymnastics, weight training, body building, aerobics, physical exercise, physical rehabilitation, diet, nutrition, health and beauty; personal training services”. These are services which provide training/instruction and are identical to the opponent’s “health club services, namely providing instruction in the fields of health and exercise”.

31. In reaching these conclusions I have not neglected consideration of the term “beauty” in the application which includes information and training in respect of health and beauty. In my experience it is not uncommon to find a health club offering a wide range of health and beauty services.

32. The opponent’s registration also includes classes 9 and 28, which I will not go on to consider as neither class puts the opponent in any better position than the assessment I have already made in respect of classes 25 and 41.

Comparison of marks

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

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is

sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

35. The marks to be compared are as follows:

Opponent's mark	Applicant's mark
SPIN FITNESS	SOUL SPIN

36. The opponent's mark consists of the two words 'SPIN' and 'FITNESS' in block capitals with no form of stylisation. The two words hang together, with one qualifying the other. The word SPIN plays a slightly more significant role in the mark due to the fact that it is at the beginning and the word FITNESS is descriptive in respect of clothing for fitness and the majority of the services at issue. That said, in this context, the word SPIN does not play a strongly distinctive role due to the fact that it can be seen to indicate that the fitness includes a turning/spinning motion.

37. The applicant's mark consists of the two words 'SOUL' and 'SPIN' which hang together. With regard to these words the opponent submits:

“In the challenged sign ‘SOUL SPIN’, the element ‘SPIN’ forms the dominant part of the mark. This is because the word ‘SOUL’ within the compound mark ‘SOUL SPIN’ has a descriptive nature in relation to the goods and services for which protection is sought”.

38. I disagree that the word 'SOUL' is descriptive in respect of the goods and services in play. Whilst it may allude to a type of music which could be used in connection with the services, this falls a long way short of being descriptive of the services themselves. I find that both words play an equal role in the overall impression of the mark.

Visual and aural similarities

39. Both marks consist of two common English words which will be known to the average consumer. Any similarity between the marks rests in the fact that each contains the word 'SPIN', it being the first word of the opponent's mark and the second word of the mark applied for. There is clear difference in the fact that the opponent's mark has the second word 'FITNESS' and the applicant's has the first word 'SOUL'. These are clearly visually different, being different lengths with different beginnings and will evidently be pronounced differently.

40. Taking all of these factors into account the marks are visually and aurally similar to a medium degree.

Conceptual similarities

41. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁸ The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.⁹

42. In respect of this comparison the opponent submits:

“2. There are two possible ways in which the public will perceive the word SOUL in the mark ‘SOUL SPIN’. In both cases the public’s perception is descriptive.

a. Firstly, the public may understand the word ‘SOUL’ as referring to ‘soul music’. Given that the applicant seeks protection for fitness related services in which ‘music’ is often used as a motivational tool and to render the training more enjoyable, the public is likely to perceive ‘SOUL’ in ‘SOUL SPIN’ as referring to the type of music used for and during the services offered under the sign and for which the goods, namely ‘articles of clothing’ are intended. Accordingly, the word ‘SOUL’ in ‘SOUL SPIN’ will be seen as a descriptive reference. Therefore ‘SPIN’ will be perceived as the dominant word element in the compound sign and the element to which the public will turn first for distinction between different signs and different sources of origin.

b. Secondly, the public may find the word ‘SOUL’ in ‘SOUL SPIN’ to be alluding to fitness services in which the emphasis is not so much on the “sportive element” but rather on emotional well-being relaxation stress relieve [sic] and motivation thus good for the “soul”. This perception of SOUL” within the compound sign SOUL SPIN goes along with an on-going-trend in the fitness industry to offer training in traditional relaxation and meditation techniques such as yoga or tai chi or to incorporate these into existing training concepts. Thus, if “SOUL” perceived this way, is it [sic] likewise descriptive of the goods and services applied for, thereby rendering the remaining mark part ‘SPIN’ the dominant word within the challenged mark to which the public will turn for orientation (as to commercial source).”

43. The applicant's goods are clothing at large which will include but are not limited to clothing for fitness and exercise. The services covered by the application are varied and include some which are specifically fitness/exercise related, such as physical exercise services; and some which are not, such as diet and nutrition services.

⁸ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

⁹ See the comments of Anna Carboni, sitting as the Appointed Person in *Cherokee*, BL O-048-08, paragraphs 36 and 37.

44. For the most part the applicant's mark will be seen by the average consumer as referring to music. Since music is often used as part of exercise, it is more likely that 'SOUL' will be taken as referring to music of that genre.

45. In the context of fitness clothing and fitness/exercise services, the 'SPIN' element of the mark could be considered a physical movement and may be taken to infer a type of exercise to soul music or exercise for the soul of an individual.

46. In any event, the 'SOUL' part of the mark plays a significant role in the mark as a whole and, in my view, will not be dismissed by the average consumer in the manner suggested by the opponent.

47. The 'FITNESS' element of the opponent's mark is descriptive in respect of exercise and fitness related goods and services. The mark in its totality provides an impression of a fitness class or programme which includes an element of spinning or turning.

48. While I accept that both parties' marks are susceptible to different conceptual meanings, in my view, the meanings that will immediately occur to the average consumer of the goods and services at issue will be those mentioned above, namely, a musical impression in respect of the applicant's mark and clearly a fitness/exercise message in respect of the opponent's mark. Consequently, I find the competing marks are conceptually distinct.

Distinctive character of the earlier mark

49. In determining the distinctive character of a trade mark it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify its goods as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

50. As I have concluded above, the opponent's mark will be seen as alluding to a fitness class or programme which contains an element of spinning or turning. Consequently, it is allusive of the majority of goods and services at issue and enjoys a medium level of inherent distinctive character.

Likelihood of confusion

51. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind¹⁰. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

52. I have found the parties' marks to be visually and aurally similar to a medium degree and to be conceptually distinct. I have found the earlier mark to have a

¹⁰ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

medium degree of inherent distinctive character in relation to the goods and services relied on by the opponent. I have identified the average consumer, namely a member of the general public and have concluded that the degree of attention paid is likely to be at least reasonable. I have found the parties' goods and services to be identical.

53. In my view, even where the goods and services are identical and are frequent, low priced purchases demanding an average level of attention, the marks in their totality are such that the differences far outweigh the similarities. Consequently, I find there is no likelihood of confusion, whether direct (where one mark is mistaken for the other) or indirect (where the average consumer believes the respective goods and services originate from the same or a linked undertaking).

CONCLUSION

54. The opposition fails under section 5(2)(b) of the act.

COSTS

55. The opposition having failed, the applicant is entitled to a contribution towards its costs. I make the award on the following basis:

Preparing a statement and considering the other side's statement	£300
Total:	£300

56. I order Mad Dogg Athletics Inc to pay GI Technologies Ltd the sum of £300. 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 21st day of May 2015

**Ms Al Skilton
For the Registrar,
The Comptroller-General**