

O-183-17

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3134005
BY
JON FINN
TO REGISTER**

Tri-Plan


**AS A TRADEMARK
IN CLASS 41
AND OPPOSITION THERETO (UNDER NO. 406589)
BY
SAM WITTER HEALTH LIMITED**

BACKGROUND & PLEADINGS

1. On 30 October 2015, Jon Finn ('the applicant') applied to register the trade mark **Tri-Plan** for the following services in class 41:

Sport, business, education and personal development sector training programmes.

2. The trade mark was published on 5 February 2016 and opposed by Sam Witter Health Limited ('the opponent') under section 5(2)(b) of the Trademark Act 1994 ('the Act') on the basis of the following earlier mark:

TM details	Services relied on
<p data-bbox="204 1021 443 1055">TM no. 3095936</p>  <p data-bbox="204 1529 480 1563">Filing date: 24/2/15</p> <p data-bbox="204 1637 576 1671">Registration date: 29/5/15</p>	<p data-bbox="809 1021 1377 1995">Class 41: Physical fitness consultation; Physical fitness instruction; Provision of educational health and fitness information; Education services relating to health; Education services relating to physical fitness; Educational services relating to physical fitness; Exercise [fitness] advisory services; Health education; Instruction courses relating to health; Instruction courses relating to physical fitness; Physical fitness education services; Physical fitness instruction for adults and children; Physical fitness training services; Physical fitness tuition; Physical health education; Provision of educational services relating to fitness; Provision of educational services relating to health;</p>

	<p>Training services relating to fitness; Tuition in physical fitness; Personal trainer services [fitness training]; Physical fitness consultation; Physical fitness instruction; Provision of educational health and fitness information; Education services relating to physical fitness; Educational services relating to physical fitness; Exercise [fitness] advisory services; Exercise [fitness] training services; Instruction courses relating to physical fitness; Physical fitness education services; Physical fitness instruction for adults and children; Physical fitness training services; Physical fitness tuition; Provision of educational services relating to fitness; Training services relating to fitness; Tuition in physical fitness; Conducting fitness classes; Personal trainer services [fitness training]; Education services relating to nutrition; Instruction in nutrition [not medical]; Provision of instruction relating to nutrition; Providing instruction and equipment in the field of physical exercise; Conducting classes in exercise; Exercise [fitness] advisory services; Exercise [fitness] training services; Exercise classes; Exercise instruction; Hire of videos; Production of videos; Provision of educational services relating to exercise; Provision</p>
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	of instruction relating to exercise; Providing on-line videos, not downloadable.
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3. The applicant filed a counterstatement denying the grounds of opposition with supporting explanation.

4. The opponent's trademark is an earlier mark in accordance with Section 6 of the Act. As it is not subject to proof of use, the opponents are entitled to rely upon all of the services listed in the table above.

5. Both parties filed written submissions only. Neither party requested to be heard. I now make this decision based on the papers before me.

DECISION

6. Section 5(2)(b) of the Act is as follows:

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

(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.

7. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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.

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.

COMPARISON OF SERVICES

8. The services to be compared are:

Opponent's services	Applicant's services
Class 41: Physical fitness consultation; Physical fitness instruction; Provision of educational health and fitness information; Education services relating to health; Education services relating to physical fitness; Educational services relating to physical fitness; Exercise [fitness] advisory services; Health education; Instruction courses relating to health; Instruction courses relating to physical fitness; Physical fitness education services; Physical fitness instruction for adults and children; Physical fitness training services; Physical fitness tuition; Physical health education; Provision of educational services relating to fitness; Provision of educational services relating to health; Training services relating to fitness; Tuition in physical fitness; Personal trainer services [fitness training]; Physical fitness consultation; Physical fitness instruction; Provision of educational health and fitness	Class 41: Sport, business, education and personal development sector training programmes

information; Education services relating to physical fitness; Educational services relating to physical fitness; Exercise [fitness] advisory services; Exercise [fitness] training services; Instruction courses relating to physical fitness; Physical fitness education services; Physical fitness instruction for adults and children; Physical fitness training services; Physical fitness tuition; Provision of educational services relating to fitness; Training services relating to fitness; Tuition in physical fitness; Conducting fitness classes; Personal trainer services [fitness training]; Education services relating to nutrition; Instruction in nutrition [not medical]; Provision of instruction relating to nutrition; Providing instruction and equipment in the field of physical exercise; Conducting classes in exercise; Exercise [fitness] advisory services; Exercise [fitness] training services; Exercise classes; Exercise instruction; Hire of videos; Production of videos; Provision of educational services relating to exercise; Provision of instruction relating to exercise; Providing on-line videos, not downloadable.	
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9. With regard to the comparison of services, in the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

10. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

11. In *YouView TV Ltd v Total Ltd* ,[2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... 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."

12. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

13. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"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. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that "complementary" means:

"...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".

15. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services

are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“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.”

Whilst on the other hand:

“.....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.

16. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, (*‘Meric’*) the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

17. In the applicant’s submission, they state that:

“ ...we are a psychology consultancy; the opponent is described as a ‘celebrity health and fitness guru’. We offer distinctly different services, meaning that it seems highly unlikely that an individual would confuse one service with the other. Secondly, our mark is used to represent a discreet and distinct micro-process, guiding users through a simple process to change one small thing about their day. It could not reasonably be considered to be

prominent or high profile and refers to a small component of a much broader Tougher Minds programme.”

18. The way in which the applicant uses his mark is irrelevant. The way the opponent uses their mark is also irrelevant given that the mark is not subject to proof of use. I must compare the parties’ services on the basis of notional and fair use of the services listed in the parties’ specifications. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

19. In addition in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the Court of Justice of the European Union stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. In *Oakley v OHIM* (case T-116/06) it is made clear that consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties:

“...since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between the two marks, ...cannot be dependent on the commercial

intentions, whether carried out or not – and which are naturally subjective –of the trade mark proprietors...”

20. I will address each of the applicant’s class 41 terms in turn and, where appropriate, will group terms together.¹

Sport, education and personal development sector training programmes

21. The users of these services are the general public. These services appear to be reasonably broad and they would include a number of the opponent’s services such as ‘training services relating to fitness’, ‘education services relating to fitness’ and ‘education services relating to nutrition’. It follows then that there is identity between the services in line with the *Meric* principle

Business sector training programmes

22. It seems to me that the natural and core meaning of this term is services which are aimed at businesses in order to enable them to operate successfully and efficiently and to assist them in managing and developing their employees. It is a fairly broad term. It not only covers training programmes on business management and leadership but also on subjects such as health and safety in the workplace. It follows that the applicant’s services would include the opponent’s ‘Education services relating to health’. Even if I am wrong on that, the services would be similar to at least a medium degree given that both parties’ services share the intended purpose of training/education, the respective users may be the same, the subject matter of the training/education may sometimes overlap and there is a degree of complementarity given that the opponent’s ‘education services relating to health’ will be indispensable or at least important to certain services covered by the applicant’s term such as the already mentioned business sector training programmes relating to health and safety.

¹ *Separode Trade Mark* BL O-399-10

AVERAGE CONSUMER AND THE PURCHASING ACT

23. 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*.

24. 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

25. The average consumer for these services will be the general public and businesses. The selection of a training/education provider is likely to be a considered process. Consumers will be looking for specific criteria from training courses such as content, qualifications, duration, learning materials and such like.

26. With regard to the purchasing process, selection of training/education provision is primarily a visual act. Consumers are likely to search the internet to find a suitable provider or chose from a prospectus or other brochures. I also consider there could be an aural element if training providers are recommended by word of mouth or at trade shows or similar events.

COMPARISON OF MARKS

27. The marks to be compared are:

Opponent's mark	Applicant's mark
	Tri-Plan

28. It is clear from *Sabel BV v. Puma AG* (particularly 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 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.”

29. It would be wrong, therefore, to artificially 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.

30. The opponent's mark is a composite one comprising a device, the stylised words TRI-PLAN separated by a hyphen and the words EXERCISE NUTRITION MIND in block capitals, each separated by a circle similar to a bullet point. The words EXERCISE NUTRITION MIND will be seen as descriptive matter given the services covered in the specification and therefore carry little weight in the overall impression of the mark. In terms of the remaining two elements, TRI-PLAN and the device, it is a general rule of thumb that words speak louder than devices. I consider that rule to be applicable here. Although both of those elements are distinctive and have substantial visual impact, it is the TRI-PLAN element by which the mark is likely to be referred to and which carries the greater weight in the overall impression of the mark

31. The applicant's mark consists of the two words TRI-PLAN separated by a hyphen. The overall impression rests solely on those words.

32. In a visual comparison of the marks, the only point of similarity are the words TRI-PLAN. The applicant's mark has no other visual elements whereas the opponent's mark has a device placed above the words TRI-PLAN and the descriptive words EXERCISE NUTRITION MIND placed below, separated by the bullet point-like circles. The applicant refers to the blue colour in the opponent's mark as being a point of difference. However, that is not a distinguishing factor because the applicant's mark could be used in the same colour. I find there is a medium degree of visual similarity.

33. In an aural comparison of the marks, the words TRI-PLAN in both marks are pronounced in the same way. It is unlikely that a consumer would vocalise the device element. Furthermore I also consider it unlikely that the consumer will vocalise the EXERCISE NUTRITION MIND part of the opponent's mark. It is more likely that only TRI-PLAN will be pronounced. On that basis, the marks would be aurally identical. However, even allowing for vocalisation of all of the words, TRI-PLAN EXERCISE NUTRITION MIND, I still consider there would be a medium degree of aural similarity.

34. In a conceptual comparison of the marks, to the extent that TRI-PLAN has any immediately graspable concept², which at its most literal could be seen as a plan with three elements, then it would be same for both marks. The device element is unlikely to form part of a conceptual hook and the words EXERCISE NUTRITION MIND are descriptive of the nature of the services. I find there is high degree of conceptual similarity.

DISTINCTIVE CHARACTER OF THE EARLIER MARK

35. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from

² It has been highlighted in numerous judgments such as *The Picasso Estate v OHIM*, Case C-361/04 that it is only concepts capable of immediate grasp by the consumer that are relevant.

chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

36. The opponent did not file any evidence showing use for the services relied on so I can only consider the inherent distinctiveness of the earlier mark.

37. As previously stated the earlier mark contains three elements, that is the device, the words TRI-PLAN and the words EXERCISE NUTRITION MIND separated by bullet point type circles. Of these elements, the device consists of three geometric shapes which have at least an average level of inherent distinctiveness. The words EXERCISE NUTRITION MIND are descriptive or at least non-distinctive for the services provided. The words TRI-PLAN appear to form a neologism. Although allusive of a plan with three elements, it is not the most natural way of saying so. I find the TRI-PLAN element has at least an average level of inherent distinctiveness and the mark, as a whole, has the same level of distinctiveness. However, as it is only the TRI-PLAN element which is present in the later mark, it is the distinctiveness of that element which is of particular importance. This is borne out in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, when Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

LIKELIHOOD OF CONFUSION

38. I must now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors:

- a) The interdependency principle, whereby a lesser degree of similarity between the services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) 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 BV*).

39. I have found that the marks are visually similar to a medium degree, aurally identical or at least similar to a medium degree, and conceptually highly similar. Taking these factors into account together with the identical services, or if not identical then similar to at least a medium degree, and at least average level of distinctiveness of the earlier mark as a whole, and the TRI-PLAN element of itself, I find that there is a likelihood of confusion, notwithstanding that the purchase is likely to be considered one. Even if the consumer does not mistake one mark for the other, they are at the very least, likely to believe that the respective services come from the same or economically linked undertakings.

CONCLUSION

40. The opposition succeeds under section 5(2)(b) of the Act for all the services claimed.

COSTS

41. As the opponent has been successful, they are entitled to a contribution towards their costs incurred in the proceedings. Using the guidance in Tribunal Practice

Notice 4/2007 (which was in force when the opposition was filed) I make the following award:

£100 Official fee for filing the Notice of Opposition

£200 Preparing the Notice of Opposition

£300 Preparing written submissions

42. I order Jon Finn to pay Sam Witter Health Limited the sum of £600. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12TH day of April 2017

June Ralph

For the Registrar,

The Comptroller General