

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2149908  
BY LYDIA CAMPBELL TO REGISTER  
A MARK IN CLASSES 25 AND 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER  
No 50106 BY FIT FOR FUN VERLAG GMBH**

## TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2149908  
by Lydia Campbell to register a mark in  
Classes 25 and 41**

**and**

**IN THE MATTER OF Opposition thereto under  
No 50106 by Fit For Fun Verlag GmbH**

### DECISION

1. On 31 October 1997 Lydia Campbell applied to register the following mark

**fit 'n' fun**

for a specification of goods and services which reads:

**Class 25**

Sports clothing; T-shirts; sweat-shirts and sweat pants; vests; leotards; brassieres; jackets; hats; caps

**Class 41**

Educational services relating to physical fitness; physical education; provision and organisation of recreational services relating to physical fitness; provision of information relating to physical fitness.

2. The application is numbered 2149908. It proceeded to publication on the basis of honest concurrent use.

3. On 25 August 1999 Fit For Fun Verlag GmbH filed notice of opposition to this application based on Section 5(2)(b) of the Act. In doing so they rely on their earlier trade mark

No 2020185 which was published in Journal 6162 at page 1352 and now stands registered for the specification of goods shown in the Annex to this decision. The mark itself is as follows:



4. The applicant filed a counterstatement in which it is said that "the applicant's mark FIT 'N' FUN is not similar to the opponents' mark FIT FOR FUN; the marks FIT 'N' FUN and FIT FOR FUN are not confusable on the part of the public; and there is no likelihood of association, as an aspect of confusion, between the marks FIT FOR FUN and FIT 'N' FUN. ( I bear in mind that I must consider the actual form in which the marks are respectively registered and applied for).

5. Both sides ask for an award of costs in their favour.

6. Both sides filed evidence. In the circumstances of this case I do not propose to offer a summary of that evidence but will refer to certain parts of it during the course of the decision. The case was originally set down for a hearing but following a communication from the Registry to the effect that it would be possible to reach a decision without the need for a hearing both parties indicated that they were content to proceed in this way. Subsequently both sides filed written submissions under cover of letters from Urquhart Dykes & Lord (for the applicant) and Trade Mark Consultants Co (for the opponents).

7. Acting on behalf of the Registrar and after a careful study of the papers (including the written submissions) I give this decision.

8. Before coming to the substance of the opponents' objection I must first of all deal with the extent of the opposition. The point has arisen during the course of the proceedings but has not so far as I can see been resolved. The application in suit has a specification covering goods in Class 25 and services in Class 41. The precise terms in which the opponents framed their objections are as follows:

"2. The Applicant's mark is similar to the Opponent's earlier trade mark and is to be registered for goods that are identical with or similar to those for which the Opponent's earlier trade mark is protected and there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the Opponent's earlier

trade mark. As such, the Applicant's mark offends against the provisions of Section 5(2)(b) of the Act and should be refused registration accordingly."

9. There is no indication in that statement that the opponents object to the applicant's Class 41 services. In the light of the preceding claim the closing request that the application "should be refused registration accordingly" (my emphasis) suggests that the attack is a limited one aimed at the Class 25 goods.

10. The opponents' evidence in chief, a statutory declaration by Simon Malvin Walters, their trade mark agent, would in my view have largely reinforced the view that the objection was to the Class 25 goods. Thus references in paragraphs 3, 7, 9 and 11 of that declaration are exclusively to identity or similarity of goods. The remainder of Mr Walters' declaration (paragraphs 12 to 23) is a detailed critique of evidence filed by the applicant at the examination stage in support of an honest concurrent use claim. This does touch on services but only because the applicant's evidence was dealing with a separate examination objection based on a Community Trade Mark which itself covered Class 41 services.

11. The result of all this was to leave the applicant in some uncertainty as to the scope of the opposition. In my view the applicant might reasonably have relied on the opponents' own words in their statement of grounds but Mr Austin, their trade mark attorney, raised the matter openly in his witness statement filed on behalf of his client, the applicant. Referring to Mr Walter's declaration he says:

"..... paragraph 3 appears only to refer to Class 25 portion of the application. It is, however, unclear whether the application is opposed in its entirety or whether it is merely opposed in connection with Class 25."

12. Despite this the position was not addressed in the opponents' evidence in reply which consisted of a further statutory declaration by Mr Walters and a witness statement by the applicant, Lydia Campbell. Nor, more importantly, was any request made to amend the statement of grounds to introduce an objection to the Class 41 services if such was the opponents' intention. It is with some concern, therefore, that I find the opponents' written submissions (at paragraph 9) commenting on confusion arising from an association between sports clothing and/or games equipment and physical education services.

13. In the light of the opponents' pleadings and the development of the case thereafter I am not prepared to accept that an objection to the Class 41 services was ever taken. In *WILD CHILD Trade Mark* 1998 RPC 455 Geoffrey Hobbs QC., sitting as the Appointed Person commented on the need for objections to be properly and unequivocally taken. His comments were strictly in the context of Section 5(4) of the Act but are, I think, of more general application. He said:

"In the interests of justice and fairness it is plainly necessary for an objection to registration under section 5(4) to be framed in terms which: (i) .....; (ii) .....; (iii) state whether the objection is raised in relation to all or only some (and, if so, which) of the goods or services specified in the registration or application for registration of the relevant trade mark."

14. I will deal with the consequences of this later in the decision but I intend to proceed on the basis that the opponents' objection is limited to the Class 25 goods. I will simply say before leaving the point that for examination purposes the Registry does not normally cross search between the applicant's Class 41 services and the goods of the opponents' earlier trade mark. That of course cannot be determinative of the matter in opposition proceedings where evidence or argument from either side may point to a different conclusion. But the applicant was aware from the examination report on her application that the Registry objection based on the opponents' mark, No 2020189, was directed towards Class 25 (see the copy of the examination report exhibited at page 4 of Mr Walters Exhibit SMW1). The applicant would thus have had no particular reason for thinking that the opposition extended to Class 41 in the absence of a clear statement to that effect.

15. Section 5(2)(b) reads:

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

(a) .....

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

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

16. My attention has been drawn in the written submissions to the guidance provided in the following ECJ cases *Sabel BV v Puma AG* [1998] ETMR 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] ETMR 1 and *Lloyd Schuhfabrik Mayer & Co GmbH v Klijsen Handel BV* [2000] FSR 77.

17. The opponents have filed no evidence claiming use of their own mark. As I have said above the applicant's mark was accepted for publication on the basis of evidence filed to show honest concurrent use with the opponents' earlier trade mark and another (Community) mark. The position of honest concurrent use in opposition proceedings was considered in *CODAS Trade Mark*, 2001 RPC 240. The Hearing Officer concluded that "the mere fact that there has been honest concurrent use is not a defence, which in itself will save an application, but it is one of the relevant factors which should be taken into account in determining whether there is a likelihood of confusion."

18. Unusually in this case the applicant has not adopted her 'examination stage' evidence into these proceedings but the opponents have. It is exhibited as SMW1 to Mr Walters' declaration and much of that declaration is devoted to a detailed analysis of the evidence, the purpose of which is to undermine the basis for any honest concurrent use claim. However for reasons which I will briefly explain I do not understand the applicant to place any reliance on this evidence in the opposition proceedings. My reasons are:

- the applicant makes it clear in her counterstatement that the view is taken that the respective marks are not confusable. No claim to honest concurrent is made
- there is no express reliance on any such use in the applicant's evidence
- Mr Austin, her attorney, distances the applicant from the assumption made by the opponents that honest concurrent use will be relied on (see for instance paragraphs 6 and 9 of Mr Austin's declaration).
- in dealing with those paragraphs of Mr Walters' declaration commenting in detail on the applicant's evidence of use (filed at the examination stage) Mr Austin says:

"With regard to paragraphs 12 to 22, none of these paragraphs contain any information relevant to the stated ground of opposition (Section 5(2)(b)) of the Trade Marks Act 1994 as set out in the Statement of Grounds filed on behalf of the opponent on 25 August 1999."

19. Even if I have misinterpreted the applicant's intentions regarding her use, on the basis of the material at SMW1 I do not think it would improve her position in the opposition proceedings. Ms Campbell's declaration (pages 30-32 of SMW1) suggests that her main business is in the area of physical education and fitness services; the moderate turnover figures (ranging from £35,000 to £95,000 per annum) do not distinguish between the services and clothing sales; clothing advertisements are largely restricted to two pages of the exhibit; not all the clothing appears to carry the Fit 'n' Fun mark and those that do do not have the appearance of trade mark use as distinct from promoting the services. I, therefore, approach the matter on the basis that the applicant takes the view that the respective marks are not similar and places no reliance on concurrent use (or that if any such claim were to be considered it is extremely weak). For convenience I reproduce below the marks and goods (taking the opponents' Class 25 specification as being the high point of their case).

**Applicant's mark and goods**

**fit 'n' fun**

**Opponents' mark and goods**

**fit  
FOR FUN**

## Class 25

Sports clothing; T-shirts; sweat-shirts and sweat pants; vests; leotards; brassieres; jackets; hats; caps.

## Class 25

Articles of clothing made of leather and imitation leather, sports wear, sports shoes.

20. I must consider notional and fair use of the respective marks (see REACT Trade Mark 2000 RPC 285).

21. I do not understand the applicant to dispute that either identical or closely similar goods are involved. Certainly the counterstatement makes no explicit claim to the contrary and concentrates the applicant's defence on the marks not being similar. For present purposes the main considerations to be borne in mind from the ECJ cases are as follows:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, paragraph 23, 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 Mayer & Co GmbH v Klijsen Handel BV* paragraph 27;
- (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*, paragraph 23;
- (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*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 17.

22. I have had the benefit of written submissions on behalf of the parties. The main points made on behalf of the applicant are:

- visually the earlier trade mark is in a stylised form whereas the applied for mark is in a plain typeface;
- phonetically there are common elements but "for" and "n" have different, unconfusable sounds which cause the marks to be pronounced differently;

- conceptually it is noted that 'fit' has different meanings in the sense of 'suitable for' or 'healthy'. It is also suggested that the earlier mark will convey the meaning 'healthy enough to have fun' whereas the applicants mark would suggest 'healthy and fun' or 'healthy whilst having fun'.

23. It is, therefore, contended that the marks are different visually, phonetically and conceptually. I will say straightaway that I cannot accept those submissions. As the *Sabel v Puma* case acknowledges marks are remembered by their distinctive and dominant components. Marks are rarely seen side by side and detail is not always remembered. In this case it is the conjunction of the words FIT and FUN that is likely to imprint itself in the mind of the customer. The stylistic differences in the marks are not so visually arresting or remarkable that that factor alone will differentiate. Moreover fair use of the applied for mark would include presenting the elements on separate lines in a manner similar to the opponents' presentation. Aurally there is little between them. The only difference is the preposition 'FOR' and conjunction 'N' which I take to stand for 'and'. Such elements are weak distinguishing features. The applicant's strongest case is probably that the marks are capable of yielding different ideas. However that presupposes that the public would pause to analyse the marks or search for meanings behind the words. *Sabel v Puma* (paragraph 23) counsels against such an approach. Consumers do not generally approach trade marks in an analytical frame of mind. I bear in mind also that both marks have specifications covering sports clothing. In that context the strongest impression left by the marks is the association of fit (in the sense of fitness) with fun. I conclude that there is a strong likelihood of confusion within the context of the global nature of the test. The opposition, therefore, succeeds under Section 5(2)(b).

24. In the circumstances the application will be allowed to proceed to registration if, within 28 days of the end of the appeal period the applicant files a Form TM21 restricting her specification to the Class 41 services details of which are given at the start of this decision. If the applicant does not file a Form TM21 restricting her specification in this way the application will be refused in its entirety.

25. In the circumstances of this case the opponents have been successful in their attack on the Class 25 goods and are entitled to a contribution towards their costs. I order the applicant to pay them the sum of £635. This sum is to be paid within seven days of the expiry of the appeal period allowed for filing the Form TM21 or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 23<sup>RD</sup> day of May 2001**

**M REYNOLDS  
For the Registrar  
the Comptroller-General**



Details of the goods covered by the specification of the opponents' earlier trade mark (No 2020185).

**Class 03**

Soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices; body lotions and creams.

**Class 08**

Hand tools and implements, apparatus and instruments for body care and cosmetic purposes, razors and shavers.

**Class 09**

Apparatus and instruments for weighing, measuring and checking, magnetic data carriers, recording discs, calculating machines and computers

**Class 14**

Jewellery, precious metals and alloys of precious metals, horological and chronometric instruments.

**Class 16**

Printed matter, photographs, stationery, office requisites.

**Class 18**

Leather and imitations of leather and goods made of these materials, trunks and travelling bags, suitcases, umbrellas, parasols, walking sticks.

**Class 21**

Household and kitchen utensils and containers, electric combs, electric toothbrushes, shaving brushes.

**Class 25**

Articles of clothing made of leather and imitation leather, sports wear, sports shoes.

**Class 28**

Games, gymnastic and sporting articles for all kinds of sports.

**Class 32**

Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

**Class 34**

Tobacco, smoker's articles; matches.