

O/196/12

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2552888
IN THE NAME OF VIMORA (UK) LTD

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO 101185
BY SASAKI INTERNATIONAL LIMITED

Background

1. Application No 2552888 is for the trade mark Flabelos. It has a filing date of 14 July 2010 and stands in the name of Vimora (UK) Ltd ("Vimora"). Registration was originally sought for a range of goods in classes 5, 10, 29 and 30. The application was published in the *Trade Marks Journal* on 20 August 2010. Since that time, the application has been subject of an amendment to the specification of goods for which registration is sought.

2. Following publication of the application, notice of opposition was filed by Sasaki International Ltd ("Sasaki"). The opposition is brought on grounds under section 5(1), 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Act and is directed against only some of the goods for which registration is sought.

3. I note that neither party is professionally represented.

4. Taking into account the amendment to the application which took place after the notice of opposition was filed, opposition is directed against the following goods:

Class 5

Pharmaceutical preparations; dietetic substances adapted for medical use; foods and beverages which are adapted for medical purposes.

Class 10

Sex aids; supportive bandages; furniture adapted for medical use.

5. In support of its opposition under section 5(1), 5(2)(a), 5(2)(b) and 5(3) of the Act, Sasaki relies on the following trade mark:

No	Mark	Application/ Registration date	Specification of goods
2500062	FLABéLOS	14.10.2008/ 6.2.2009	Fitness exercise machines

6. In support of its opposition under section 5(4)(a) of the Act, Sasaki relies on a mark in identical form to that shown above which it claims to have used in relation to the sale and distribution of fitness exercise equipment throughout the UK since at least January 2007.

7. Vimora filed a counterstatement in which it denies there is any similarity of the respective goods. It also denies that Sasaki has used its mark for a long enough period of time for it to have a reputation. Vimora also requests that Sasaki provide proof of use of its mark in relation to "all others in class 5 and 10 except for Fitness and Exercise Machines". As Sasaki's mark is registered only for fitness exercise machines, the request would seem to be inappropriate. In case I have misunderstood this request, then I would point out that Sasaki would not be required to provide proof of use of its registration in any event. This is because, under the provisions of section 6A (1) of the Act, proof of use would be applicable only where the registration procedure for Sasaki's earlier trade mark was completed before the

start of the period of five years ending with the date of publication of Vimora's application. It was not completed in such a timescale.

8. Sasaki filed evidence in the form of a witness statement by Christine Choong which I will refer to later in this decision as required. Vimora did not file evidence but did file written submissions. Its written submissions were brief and included a comment that the parties had entered into an agreement whereby the opposition to the application would be withdrawn on condition that the application was amended to remove various goods from the specification in class 10. A copy of a letter from Sasaki dated 21 October 2010 which sets out an offer in these terms is enclosed with the submissions. Sasaki have not commented on this submission but, in any event, despite this indication and despite the amendments having been made, Sasaki did not withdraw its opposition but continued with it and, at a later point, filed evidence in support of it. On that basis I go on to determine the proceedings. Neither party requested to be heard. I therefore give this decision after a careful review of all the papers before me.

Decision

9. The opposition is founded on grounds under section 5 of the Act. I intend to deal first with the objections founded on section 5(1) and 5(2) of the Act. This reads:

"5. (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

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

(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. 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,

(b)

(c)

(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.”

11. Sasaki relies on its trade mark registration set out in paragraph 5 above. It is an earlier trade mark within the meaning of section 6(1) of the Act.

12. In order for an opposition to be successful under section 5(1) of the Act, it is necessary for the respective goods to be identical. To succeed under the provisions of section 5(2) of the Act, the goods must be similar. I therefore proceed to consider the respective goods in detail.

Comparison of the respective goods

13. The goods to be compared are as follows:

Vimora’s application	Sasaki’s earlier mark
Class 5 Pharmaceutical preparations; dietetic substances adapted for medical use; foods and beverages which are adapted for medical purposes	Class 28 Fitness exercise machines
Class 10 Sex aids; supportive bandages; furniture adapted for medical use	

14. It is clear that the respective goods have been classified in different classes. The significance of classification and the relevance of class numbers have been considered by the courts in *Altecnic Ltd’s Trade Mark Application (CAREMIX)* [2002] RPC 639 and *Avnet Incorporated v Isoact Limited* [1998] FSR 16. In *Proctor & Gamble Company v Simon Grogan*, O-176-08, Anna Carboni, sitting as the appointed person, referred to *Altecnic* and said:

“34.....The Court of Appeal has held that, although the purpose of classifying goods and services is primarily administrative, that does not mean that the class numbers in an application have to be totally ignored in deciding, as a matter of construction, what is covered by the specification: *Altecnic Ltd’s Trade Mark Application (CAREMIX)* [2001] EWCA Civ 1928, [2002] RPC 639. But neither the Court of Appeal, nor the ECJ, nor any other court or tribunal in the United Kingdom, has gone so far as to state that class numbers are determinative of the question of similarity of goods in the case of national trade marks. On the contrary, they are frequently ignored.”

15. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 280 (“TREAT”), Jacob J said (at 289):

“When it comes to 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. After all, a trade mark specification is concerned with use in trade.”

He went on (at 295) to set out the following factors as being relevant to the question of similarity of goods without reference to the classes in which they may fall:

- (a) the respective uses of the respective goods;
- (b) the respective users of the respective goods;
- (c) the nature of the goods;
- (d) the respective trade channels through which the goods are marketed;
- (e) the extent to which the respective goods are competitive. This inquiry may take into account how those in trade classify the goods, for instance whether market research companies put them into the same or different sectors.

16. Subsequently, in *Canon Kabushiki Kaisha v MGM Inc* the ECJ stated:

“23. In assessing the similarity of the goods or services concerned.....all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

17. In Case T-420/03 – *El Corte Inglés v OHIM- Abril Sanchez and Ricote Sauger* (Boomerang TV) the CFI commented:

“96.....Goods or services which are complementary are those where 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 the production of those goods or provision of those services lies with the same undertaking (Case T14169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, and judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gomez Frias* (euroMASTER), not published in the ECR, paragraph 35).”

18. It is self-evident that the respective goods are not identical. I go on to consider whether the respective goods are similar. Sasaki’s goods are *fitness exercise machines*. They are pieces of equipment with which the user interacts in some way in order to improve or maintain his/her level of fitness. Whilst some may be bought by a member of the public for use in their own home, they may also be bought by businesses such as beauty salons or fitness centres for use by their clients. Whilst some *fitness exercise machines* are relatively small and generally available in e.g. supermarkets, others are more specialist items which are supplied only through more specialist suppliers such as sports shops or equipment suppliers.

19. As for Vimora's goods, *Pharmaceutical preparations* is a wide-ranging term but they are substances or items made from synthetic or natural chemicals and are intended to e.g. prevent, treat or diagnose various illnesses or afflictions. They are sold through specialist pharmacies, health shops or the healthcare section of a supermarket (and some may be supplied only on prescription through a licensed practitioner). *Dietetic substances adapted for medical use*; and *food and beverages which are adapted for medical use* are all items which are ingested and intended to sustain the person using them by providing some form of nutrient. Each of these goods is used by those members of the general public who has, or is perceived to have such a medical need.

20. Whilst each of these respective goods may, at the margins, have the effect of improving someone's health, the goods are not in competition nor are they complementary. This, coupled with their different uses, natures and trade channels leave me in no doubt that the respective goods are not similar.

21. *Sex aids* are items which purport to provide or increase the pleasure of sexual activity and are used by those with such desires. They are intimate items which are generally sold through specialist suppliers, suppliers which often have to be licensed. *Supportive bandages* are dressings which wrap around and support part of the body. The users are those with an ailment of some sort. They are goods which will be sold through a pharmacy or in the healthcare section of a supermarket. *Furniture adapted for medical use* are functional articles used in a residential or medical environment by or with those who have particular needs e.g. because of a disability. They are goods which will be supplied by specialist suppliers. None of these goods are in any way in competition with or complementary to the goods covered by Sasaki's earlier mark and with this in mind, coupled with their different uses, natures and trade channels, I am left in no doubt that the respective goods are not similar.

22. For an opposition brought on grounds under section 5(1) of the Act to succeed, there must be a finding that the respective goods are identical. For an opposition brought on grounds under sections 5(2)(a) or (b) to succeed, there must be a finding that the respective goods are similar. The outcome of my comparison of goods is that none of Vimora's goods are identical or similar to Sasaki's goods. That being the case, Sasaki's objections must fail under each of these grounds.

The objection under section 5(3) of the Act

23. Section 5(3) of the Act states:

“ A trade mark which-

- (a) is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

24. A positive finding under section 5(3) of the Act does not rely on the similarity of the respective goods. In order, however, to be successful in an objection based on section 5(3) of the Act, Sasaki must prove its earlier mark has a reputation. Reputation in this context means that the earlier trade mark is known by a significant part of the public concerned with the goods covered by that mark (see paragraph 26 of the CJEU's judgment in *General Motors Corp. V Yplon SA (CHEVY)* [1999] ETMR 122). The Court stated:

“27 In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking promoting it.”

25. Sasaki's evidence consists of a single witness statement by Christine Choong which is dated 26 October 2011. It is accompanied by 5 exhibits. Exhibits CC1 and CC2 were subject of an order for confidentiality from the public as they contain various bank account details. Whilst the order does not affect my consideration of this material, I take the order into account when referring to this material.

26. Ms Choong states that she has been Company Secretary of Sasaki since 1998. She states “The Trade Mark Flabelos was first used in the United Kingdom in 2007” in relation to fitness and exercise machines. She gives the following details of sales and promotional spend:

Year	£ Sales	£ Marketing	£ Advertising
2007	692,894	129,182	119,458
2008-2009	720,683	175,465	99,255
2009-2010	890,858	139,556	88,706
2010-2011	915,979	49,060	60,795

27. These figures have not been broken down further and consequently I am unable to say how much, if any, of the figures for 2009-2010 and 2010-2011 refer to a period before the relevant date (14 July 2010). Nor am I able to determine whether any of these figures relate solely to the UK.

28. Ms Choong states that promotion has taken place:

“by means of annual attendance at the Ideal Home Show and other trade/public related shows as Professional Beauty North, Olympia Beauty, advertisements in Guild News, Salon Today and a national newspaper, television advertisements on the Chinese Channel and production of a marketing DVD for salons. A Public Relations company was also hired on a one year contract.”

29. Ms Choong exhibits the following:

CC1: This exhibit consists of a number of invoices and statements addressed to Sasaki. They appear to relate to costs incurred for attendance at shows and exhibitions such as Beauty UK, Ideal Home Show, Manchester Furniture

Show and International Leisure Industry (all 2008) and Professional Beauty North (2008 and 2009). None make any reference to the earlier mark.

CC2: This exhibit consists of further invoices each dated 2007. Several relate to monthly fees for public relations work (though no details of what work was actually carried out are provided). Others relate to charges for placing advertisements in Salon Today Summer Edition, The Epoch Times (UK), UK East Week and UK Leisure. Although no indication is given in the evidence, I presume these are the titles of some sort of periodical publication. No evidence is given of where any such publications were distributed or the numbers involved, though I note that the Epoch Times (UK) Ltd invoice refers to an advert appearing for one week in 308 issues. There are also invoices from The Chinese Channel (France) SAS for 'on-air commercials (Feb 07 to Jan 08)'. No further information is provided as to where these commercials might have aired (e.g. whether they were radio or television commercials or when and where they were broadcast or how many people were likely to have heard or viewed them). There is an invoice from Phoenix Chinese News & Entertainment Ltd for associated sponsorship Miss China 07 (Language Chinese June 07 to November 07). Again, I presume this is some sort of beauty or other contest but I have been given no evidence of where it took place or what form such sponsorship may have taken. Lastly, there is an invoice for the supply of two models for three hours each. No explanation is given of what role these models may have had or where.

CC3: There are four pages showing a montage of different magazine covers. Some are so small that I cannot make out what they are intended to show. Text has been placed next to some of the others which I presume is intended to show what is included within that magazine though without the extract itself being shown, I have no idea of the context of its appearance. Two pages refer to magazines from 2007. The other two pages refer to magazines in the latter months of 2010, after the relevant date. There is also a copy of a page headed 'competition' though there is no indication of where or when this may have appeared. Finally, there are extracts from the March 2008 edition of Health & Beauty Salon, the June 2008 edition of Work Out and The Sunday Telegraph of 18 November 2008 each of which contains references to a Flabelos exercise machine. I note that in the latter extract there is an advertisement for a machine under the name Flabelos and which is shown to retail at £3525. Whilst I am prepared to accept that the Sunday Telegraph is a national (Sunday) newspaper with a relatively large circulation, the same cannot be said, absent evidence on the point, about these other two publications.

CC4: This exhibit is said to be copies of photographs from exhibitions. None of them are dated or give any indication as to where and when the exhibitions took place, who attended them or the numbers involved.

30. Ms Choong states that there has been a substantial advertising campaign which has enhanced the "reputation of the Flabelos as a weight loss product". She states it is a "well known brand in the Health & Beauty Industry" and that over one thousand salons, gyms and beauty clinics in the UK are using it as a slimming and toning

treatment. She states it is widely used by slimming clinics in conjunction with food supplements and diet pills. She exhibits the following:

CC5: This consists of three printouts taken from the Internet. The first is taken from the flabelos.org website and shows a FLABÉLOS vibration plate along with a bottle of Look Fabulous advanced Dietary Formula. The second, shows “joblot flabelos slimming pills” for sale on the ebay Internet site. The third is taken from the shadesofbronze website which indicates that it is a tanning beauty and hair salon. The text on this latter printout is small and hard to make out but it appears to offer a course of some sort of treatment under the heading Flabelos. None of these printouts are dated.

31. The mark was first used sometime in 2007. Given the relevant date in these proceedings, that means there is a period of use of around three years. The sales figures given are not broken down in such a way that enables me to determine how much of the total relates to the UK or to a period before the relevant date. Taking the figures for 2007-2009 into account, this amounts to around £1.4m. Given the advertised price of a machine shown in exhibit CC3 of £3525 this equates to around 400 machines. (Even if I were to take the whole of the sales figures into account it would equate only to some 920 machines). The evidence does not provide me with any information that shows the size of the market in fitness exercise machines, however, it is likely to be considerable given that fitness suites are part and parcel of private and public gyms in towns and cities across the country. That market increases substantially when the health and beauty and domestic markets are taken into account. I have no evidence of Sasaki’s position within any or all of these markets. Whilst there is evidence of advertising and promotion of the mark, my comments above as to the deficiencies in that evidence, mean that I have been given nothing that will allow me to judge the coverage and extent of that promotion, and certainly do not enable me to establish what the position might have been at the relevant date.

32. In summary, Sasaki has not proved that its earlier mark has a reputation such that it is known by a significant part of the public concerned. That being the case, the opposition based on grounds under section 5(3) of the Act fails at the first hurdle.

The objection under section 5(4)(a) of the Act

33. Given my comments regarding the deficiencies in the evidence, I do not see that Sasaki can be in any stronger position in relation to this ground of opposition and I decline to deal with it further.

Summary

34. Sasaki’s opposition against Vimora’s application has failed in its entirety.

Costs

35. The opposition has failed and Vimora is entitled to an award of costs in its favour. As I indicated above, neither party has been professionally represented. Consequently, and in line with the registrar’s practice, any award of costs will be

calculated at half the rate of the amount on the published scale. As I indicated above, Vimora amended its specification apparently in line with an agreement between the parties, however, Sasaki did not withdraw its opposition as agreed but instead continued with it. I do not know the reason why it did so, however, Vimora did not file evidence but would have had to review Sasaki's evidence and did file written submissions. Taking all matters into account, I award costs to Vimora on the following basis:

For preparing a counterstatement (and reviewing Sasaki's statement)	£100
For considering and commenting on Sasaki's evidence:	£250
For preparing written submissions:	£150
Total:	£500

36. I order Sasaki International Limited to pay Vimora (UK) Limited the sum of £500. 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 11th day of May 2012

**Ann Corbett
For the Registrar
The Comptroller-General**