

**O-181-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3043971  
BY  
INDIGO23 LIMITED**

**TO REGISTER THE TRADE MARK**

**INDIGO FITNESS**

**IN CLASSES 28, 35 & 41**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 402325  
BY O2 HOLDINGS LIMITED**

**BACKGROUND AND PLEADINGS**

1. On 25 February 2014, indigo23 Limited (“the applicant”) applied to register the trade mark INDIGO FITNESS (“the application”). It was accepted and published in the Trade Marks Journal on 28 March 2014 in respect of the following goods and services:

Class 28: Bar-bells; bar-bells [for weight lifting]; belts for weightlifting; belts (weight lifting -) [sports articles]; benches for gymnastic use; body training apparatus [exercise]; body-building apparatus; body-building apparatus [exercise]; body-training apparatus; boxing gloves; chest expanders; chest expanders [exercisers]; dumb-bell shafts [for weight lifting]; dumb-bells; dumb-bells [for weight lifting]; exercise bicycles (stationary -); exercise treadmills; exercisers [expanders]; fitness exercise machines; gymnastic and sporting articles not included in other classes; gymnastic apparatus; gymnastic articles; gymnastic parallel bars; gymnastics (appliances for -); indoor fitness apparatus; jump ropes; leg weights for athletic use; leg weights for exercising; physical exercises (machines for -); punchbags; punching bags; punching balls; punching balls [for boxing practice]; rehabilitation apparatus (body -); rowing machines; skipping ropes; spring bars for exercising; stationary exercise bicycles; stationary exercise bicycles and rollers therefor; stomach exercisers; treadmills for use in physical exercise; weight lifting gloves; weight lifting belts [sports articles]; weight lifting benches; stationary exercise bicycles and rollers therefor; Fitness exercise machines; machines incorporating weights for use in physical exercise; treadmills for use in physical exercise; exercise treadmills; stationary exercise bicycles; exercise bicycles (stationary -); exercise bicycles (rollers for stationary -); fitness exercise machines; indoor fitness apparatus; weight lifting benches; weight lifting gloves; weight lifting belts [sports articles]; fitness exercise machines; indoor fitness apparatus.

Class 35: Retail services connected with the sale of fitness equipment, strength equipment, sports equipment, fitness flooring, strength flooring, sports flooring; advice relating to the business management of fitness clubs; advice relating to the business management of health clubs; advice relating to the business operation of fitness clubs; advice relating to the business operation of health clubs.

Class 41: Exercise [fitness] advisory services; exercise [fitness] training services; exercise classes; exercise instruction; physical fitness consultation; physical fitness instruction; providing fitness and exercise facilities; 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; health club services [health and fitness training]; personal trainer services [fitness training]; conducting classes in exercise; exercise [fitness] advisory services; exercise [fitness] training services; exercise classes; exercise instruction.

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2. On 18 June 2014 O2 Holdings Limited (“the opponent”) opposed the application in its entirety. The opposition is based on Section 5(2)(b) and (3) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier Community Trade Mark registration number 5914437 (“earlier mark”). The opposition relies upon all of the goods and services covered by the earlier registration:

Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

Class 4: Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.

Class 6: Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores; badges of metal; signs of metal; parts and fittings for all the aforesaid goods. Class 8: Hand tools and implements (hand operated); cutlery; side arms; razors; electric and non-electric depilation appliances, shaving blades, shaving cases, razor cases, manicure sets, pedicure sets, clippers for personnel use, nail files, scissors, tongs, tweezers, curlers; hair trimmers; parts and fittings for all the aforesaid goods.

Class 8: Hand tools and implements (hand operated); cutlery; side arms; razors; electric and non-electric depilation appliances, shaving blades, shaving cases, razor cases, manicure sets, pedicure sets, clippers for personnel use, nail files, scissors, tongs, tweezers, curlers; hair trimmers; parts and fittings for all the aforesaid goods.

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines; fire-extinguishing apparatus; protective clothing; protective helmets; glasses, spectacle glasses, sunglasses, protective glasses and cases therefor; contact lenses; cameras; camera lenses; audio tapes, audio cassettes; audio-video tapes, audio-video cassettes; video tapes, video cassettes; electronic publications (downloadable), not related to agronomics and agriculture; magnets; mobile telephone covers, mobile telephone cases; parts and fittings for all the aforesaid goods.

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; keyrings (trinkets or fobs); cufflinks.

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Class 16: Cardboard and goods made from these materials, not included in other classes; printed matter, not related to agronomics and agriculture; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); books, calendars, cards, catalogues, programmes, writing paper, envelopes, pads, notebooks, diaries, greeting cards, magazines, pamphlets, pens, pencils, postcards, posters, stickers, tickets, beer mats; coasters of paper and cardboard; napkins of paper; tissues and towels of paper; bags of paper and/or plastic material.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 21: Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steel wool; un-worked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes; table mats, mugs, beer mugs, bottle openers, buckets, champagne buckets, ice buckets, coasters, cocktail stirrers, corkscrews, drinking glasses, shakers, tankards, toothbrushes, plastic water bottles, tableware, other than knives, forks and spoons, coin boxes of non-metallic materials, money boxes (piggy banks), not of metal.

Class 24: Textiles and textile goods, not included in other classes; bed and table covers.

Class 25: Clothing, footwear, headgear; shirts, t-shirts, sweatshirts, skirts, jogging suits, trousers, jeans, pants, shorts, rainwear, cloth bibs, blouses, sweaters, jackets, coats, jumpers, gloves, neckties, scarves, hats, caps, sunvisors, boots, slippers, sneakers, sandals, shoes.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

Class 29: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

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Class 33: Alcoholic beverages (except beers). Class 34: Tobacco; smokers articles; matches.

Class 34: Tobacco; smokers articles; matches.

Class 35: Advertising; business management; business administration; office functions; retail and wholesale services relating to bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, industrial oils and greases, lubricants, dust absorbing, wetting and binding compositions, fuels (including motor spirit) and illuminants, candles and wicks for lighting, common metals and their alloys, metal building materials, transportable buildings of metal, materials of metal for railway tracks, non-electric cables and wires of common metal, ironmongery, small items of metal hardware, pipes and tubes of metal, saves, goods of common metal, ores, badges of metal, signs of metal, hand tools and implements (hand operated), cutlery, side arms, razors, electric and non-electric depilation appliances, shaving blades, shaving cases, razor cases, manicure sets, pedicure sets, clippers for personnel use, nail files, scissors, tongs, tweezers, curlers, hair trimmers, scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, automatic vending machines and mechanisms for coin operated apparatus, cash registers, calculating machines, data processing equipment and computers, fire-extinguishing apparatus, apparatus for the transmission of sound and image, telecommunications apparatus, mobile telecommunication apparatus, mobile telecommunications handsets, computer hardware, PDA's (Personal Digital Assistants), pocket PC's, mobile telephones, laptop computers, telecommunications network apparatus, protective clothing, protective helmets, SD-Cards, glasses, spectacle glasses, sunglasses, protective glasses and cases, contact lenses, cameras, camera lenses, MP3 players, audio tapes, audio cassettes, audio discs, audio-video tapes, audio-video cassettes, audio-video discs, video tapes, video cassettes, video discs, CDs, DVDs, electronic publications (downloadable), mouse mats, magnets, mobile telephone covers, mobile telephone cases, precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes, jewellery, precious stones, horological and chronometric instruments, keyrings (trinkets or fobs), cufflinks, paper, cardboard and goods made from these materials, not included in other classes, printed matter, book binding material, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters and office requisites (except furniture), instructional and teaching material (except apparatus), plastic materials for packaging (not included in other classes), books, calendars, cards, catalogues, programmes, writing paper, envelopes, pads, notebooks, diaries, greeting cards, magazines, pamphlets, pens, pencils, postcards, posters, decalcomanias, stickers, tickets, beer mats, coasters of paper and cardboard, napkins of paper, tissues and towels of paper, bags of

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paper and/or plastic material, leather and imitations of leather, and goods made of these materials, animal skins, hides, trunks and travelling bags, umbrellas, parasols and walking sticks, whips, harness and saddlery, household or kitchen utensils and containers (not of precious metal or coated therewith), combs and sponges, brushes (except paint brushes), brush-making materials, articles for cleaning purposes, steel wool, un-worked or semi-worked glass (except glass used in building), glassware, porcelain and earthenware, table mats, mugs, beer mugs, bottle openers, buckets, champagne buckets, ice buckets, coasters, cocktail stirrers, corkscrews, drinking glasses, shakers, tankards, toothbrushes, plastic water bottles, tableware, other than knives, forks and spoons, coin boxes of non-metallic materials, money boxes [piggy banks], not of metal, textiles and textile goods, bed and table covers, clothing, footwear, headgear, shirts, t-shirts, sweatshirts, skirts, jogging suits, trousers, jeans, pants, shorts, rainwear, cloth bibs, blouses, sweaters, jackets, coats, jumpers, gloves, neckties, scarves, hats, caps, sunvisors, boots, slippers, sneakers, sandals, shoes, games and playthings, gymnastic and sporting articles, decorations for Christmas trees, meat, fish, poultry and game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages, alcoholic beverages (except beers), tobacco, smokers articles, matches; business management relating to broadcasting stations, telecommunications installations; provision of information relating to the aforesaid.

Class 36: Insurance; financial affairs; monetary affairs; real estate affairs; payment processing; online payment processing; information services relating to finance, monetary affairs and real estate affairs; information and advisory services relating to the aforesaid.

Class 39: Transport; packaging and storage of goods; travel arrangement; information and advisory services relating to the aforesaid.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; interactive entertainment services; electronic games services provided by means of any communications network; entertainment and information services relating to education, training, entertainment, sporting and cultural activities provided by means of telecommunications network provided by means of telecommunication networks; provision of news information; television production services, television programming services; television production and television programming services provided by means of internet protocol technology; provision of entertainment by means of television and internet protocol television; provision of musical events; entertainment club services; discotheque services; presentation of live performances; night clubs; rental of music venues and stadiums; casino services; information and advisory services relating to the aforesaid.

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Class 42: Scientific and technological services and research and design relating thereto, not in the field of agriculture and agronomics; industrial analysis and research services, not in the field of agriculture and agronomics; services of engineers, none of the aforesaid in the field of agriculture and agronomics; technical consulting and technical expert advice and opinions relating to telecommunications; technical services relating to projection and planning of equipment for telecommunication; services of information brokers and providers, namely product research services for others, none of these services being in the field of agriculture and agronomics; weather forecasting; research of field telecommunication technology; monitoring services relating to telecommunications networks and apparatus; information and advisory services relating to the aforesaid.

Class 43: Services for providing food and drink; restaurant, bar, café and snack bar services; information and advisory services relating to the aforesaid.

Class 44: Medical services; veterinary services; hygienic and beauty care for human beings or animals; horticulture and forestry services; information and advisory services relating to the aforesaid; all the aforementioned services being not related to agronomics or for use in relation to agriculture.

Class 45: Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals; management and use of copyright; arbitration services; information and advisory services relating to the aforesaid; information services relating to fashion and astrology.

3. The opponent argues that the respective goods and services covered by the application are identical or similar to their earlier mark, and that the marks are similar.

4. The applicant filed a counterstatement, denying a likelihood of confusion between the marks. The applicant states that many of the goods are distinguishable. Further, they argue that whilst the opponent may have a reputation for the mark as registered it is not for the word *solus*.

5. Neither side filed evidence. Both ask for an award of costs. The matter came to be heard on 8 April 2015. The applicant was represented by Mr Austen of Counsel, instructed by the applicant. The opponent was represented by Ms Claire Jenkins, a trade mark attorney, of Stobbs IP.

6. Since the opponent did not file evidence in support of their section 5(3) claim it was dismissed by the Registrar. Therefore, this opposition proceeds under the section 5(2)(b) claim only.

### **DECISION**

#### **Legislation and leading case law**

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

8. 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.

### **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;



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(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.

### Average consumer and the purchasing act

9. 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*.

10. 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 (paragraph 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.”

11. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services and then to determine the manner in which these will be selected by the average consumer in the course of trade. The conflict relates to exercise equipment, retailing of the exercise equipment, advisory services relating to the running of a fitness/health club plus exercise and training services.

### Class 28

12. Mr Austen submits that the average consumer of the class 28 goods<sup>1</sup> and retailing of various, *inter alia*, fitness goods<sup>2</sup> are likely to be specialist purchasers

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<sup>1</sup> Bar-bells; bar-bells [for weight lifting]; belts for weightlifting; belts (weight lifting -) [sports articles]; benches for gymnastic use; body training apparatus [exercise]; body-building apparatus; body-building apparatus [exercise]; body-training apparatus; boxing gloves; chest expanders; chest expanders [exercisers]; dumb-bell shafts [for weight lifting]; dumb-bells; dumb-bells [for weight lifting];

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who will pay a high degree of care and attention. I consider that the goods will be bought by the general public who wish to exercise at home, and businesses such as gymnasiums and health clubs.

13. The general public and businesses will purchase these goods following a visual perusal of websites, catalogues or brochures. The degree of care taken during the selection process will vary depending on the cost of the goods. Items which are of ordinary cost (e.g. dumb-bells, skipping ropes, etc.) will cause an average degree of care taken when purchasing. The more expensive the goods (e.g. treadmills, fitness exercise machines, etc.) will be purchased following a higher degree of attention. Generally, businesses are likely to purchase the goods in greater quantity and in order to ensure quality, they will be more willing to pay a higher price. Therefore, they will pay a greater degree of attention.

### *Class 35*

14. With regard to the class 35 business advisory services,<sup>3</sup> Mr Austen submitted that these are business to business services. I agree. Providing a business advisory service would only be sought by business owners looking to develop and/or expand their existing business. The purchasing act is likely to come from word of mouth recommendations and perusal of websites (possibly brochures and prospectuses). This is likely to be followed by a meeting to finalise details. Therefore the purchasing of such services can be via aural considerations and, on an equal level, visual perusal. As to the degree of care taken during the selection process, given that businesses are the end consumer I believe that the level of care and attention will be higher than average.

### *Class 41*

15. Average consumers of the class 41 services are most likely to be the general public, i.e. a person attending a gym class, seeking personal training services, etc. Whilst I do not discount the possible use of these services by businesses, I believe that they will be in the minority.

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exercise bicycles (stationary -); exercise treadmills; exercisers [expanders]; fitness exercise machines; gymnastic and sporting articles not included in other classes; gymnastic apparatus; gymnastic articles; gymnastic parallel bars; gymnastics (appliances for -); indoor fitness apparatus; jump ropes; leg weights for athletic use; leg weights for exercising; physical exercises (machines for -); punchbags; punching bags; punching balls; punching balls [for boxing practice]; rehabilitation apparatus (body -); rowing machines; skipping ropes; spring bars for exercising; stationary exercise bicycles; stationary exercise bicycles and rollers therefor; stomach exercisers; treadmills for use in physical exercise; weight lifting gloves; weight lifting belts [sports articles]; weight lifting benches; stationary exercise bicycles and rollers therefor; Fitness exercise machines; machines incorporating weights for use in physical exercise; treadmills for use in physical exercise; exercise treadmills; stationary exercise bicycles; exercise bicycles (stationary -); exercise bicycles (rollers for stationary -); fitness exercise machines; indoor fitness apparatus; weight lifting benches; weight lifting gloves; weight lifting belts [sports articles]; fitness exercise machines; indoor fitness apparatus

<sup>2</sup> Retail services connected with the sale of fitness equipment, strength equipment, sports equipment, fitness flooring, strength flooring, sports flooring

<sup>3</sup> Advice relating to the business management of fitness clubs; advice relating to the business management of health clubs; advice relating to the business operation of fitness clubs; advice relating to the business operation of health clubs

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16. The selection process is likely to consist of a mixture of both visual and aural considerations. The average consumer is most likely to select the services following a visual perusal of websites, prospectus and/or brochures, visiting a local gym or following a word of mouth recommendation from a friend, relative or colleague.

17. The degree of care and attention paid will depend on the service selected. From my own experience, those who are selecting a gymnasium or health club will consider a number of factors, including, cost of membership, length of membership, termination periods, opening times, facilities, classes, equipment available, etc. Therefore, the level of attention paid will be above the norm.

18. I will bear each of the considerations above in mind when reaching my conclusions on the likelihood of confusion.

### **Comparison of goods/services – general case law**

19. 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”.

20. 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.

21. During the hearing Mr Austen stated that the wording of specifications should not be unduly broad and should be given their ordinary and natural meaning. He referred to paragraph 12 of *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), whereby Floyd J. (as he then was) stated that:

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"... 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."

22. Reference was also made to *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was). The relevant paragraph 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."

### Class 28

Opponent's Class 28 goods	Applicant's Class 28 goods
Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.	Bar-bells; bar-bells [for weight lifting]; belts for weightlifting; belts (weight lifting -) [sports articles]; benches for gymnastic use; body training apparatus [exercise]; body-building apparatus; body-building apparatus [exercise]; body-training apparatus; boxing gloves; chest expanders; chest expanders [exercisers]; dumb-bell shafts [for weight lifting]; dumb-bells; dumb-bells [for weight lifting]; exercise bicycles (stationary -); exercise treadmills; exercisers [expanders]; fitness exercise machines; gymnastic and sporting articles not included in other classes; gymnastic apparatus; gymnastic articles; gymnastic parallel bars; gymnastics (appliances for -); indoor fitness apparatus; jump ropes; leg weights for athletic use; leg weights for exercising; physical exercises (machines for -); punchbags; punching bags; punching balls; punching balls [for boxing practice]; rehabilitation apparatus (body -); rowing machines; skipping ropes; spring bars for exercising; stationary exercise bicycles; stationary exercise bicycles and rollers therefor; stomach exercisers; treadmills for use in physical exercise; weight lif[t]ing gloves; weight lifting belts [sports articles]; weight lifting benches; stationary exercise bicycles and rollers therefor; Fitness exercise machines; machines incorporating weights for use in physical exercise; treadmills for use in physical exercise; exercise treadmills; stationary exercise bicycles; exercise bicycles (stationary -);

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	exercise bicycles (rollers for stationary -); fitness exercise machines; indoor fitness apparatus; weight lifting benches; weight lif[t]ing gloves; weight lifting belts [sports articles]; fitness exercise machines; indoor fitness apparatus.
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23. During the hearing, Mr Austen accepted that there is a high degree of similarity between the opponent’s “gymnastic and sporting articles” and the applicant’s goods in class 28. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court in paragraph 29 stated that:

“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”.

24. In this instance the contested goods are identical to the goods on which the opposition is based. Accordingly, the respective class 28 goods are identical.

### **Class 35**

25. The opponent’s class 35 services are lengthy. Therefore, rather than duplicate all of the services, I shall make specific comparisons based on where I believe the opponent’s best case lies.

#### *Retail*

<b>Applicant’s class 35 services</b>	<b>Opponent’s class 35 services</b>
Retail services connected with the sale of fitness equipment, strength equipment, sports equipment, fitness flooring, strength flooring, sports flooring	Retail and wholesale services relating to...games and playthings, gymnastic and sporting articles...

26. Prior to the hearing Mr Austen conceded that the above services share a “high degree of similarity”. In my view, this was a realistic and sensible concession on the applicant’s part. However, I am of the view that the respective services are identical rather than highly similar.

#### *Business management*

<b>Applicant’s class 35 services</b>	<b>Opponent’s class 35 services</b>
Advice relating to the business management of fitness clubs; advice relating to the business management of health clubs; advice relating to the business operation of fitness clubs; advice relating to the business operation of health clubs	Business management; business administration; office functions

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27. Mr Austen made a general submission that whilst trade mark specifications can be broad, they should nevertheless not be construed too broadly. In this particular instance he went on to submit that the specification of the earlier registration effectively provides the owner with protection for any type of business administration which includes the word indigo. He submits that this penumbra of protection is too broad and should not be construed in this manner.

28. The opponent's "business administration" and "business management" are broad terms. During the hearing Mr Austen submitted that there was, at best, a low level of similarity between the broad terms "business administration" and "business management" and those of the application. Ms Jenkins argued that the services offered under the application are merely a sub-set of the opponent's broad terms. I agree. The broad nature of the opponent's services encompasses the application services. Therefore, they are identical.

### Class 41

<b>Applicant's class 41 services</b>	<b>Opponent's class 41 services</b>
Exercise [fitness] advisory services; exercise [fitness] training services; exercise classes; exercise instruction; physical fitness consultation; physical fitness instruction; providing fitness and exercise facilities; 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; health club services [health and fitness training]; personal trainer services [fitness training]; conducting classes in exercise; exercise [fitness] advisory services; exercise [fitness] training services; exercise classes; exercise instruction.	Providing of training Sporting and cultural activities

29. The earlier mark consists of broad terms. I find that these services sufficiently cover all of the applicant's class 41 services. Mr Austen argued that the services are not clear and should not be given a broad interpretation. Ms Jenkins stated "Sporting activity may be broad but it is clear". I agree with Ms Jenkins. The opponent's services are identical to those of the application.

### Comparison of the marks

30. 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


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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.”

31. 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.

32. The respective trade marks are shown below:

Applicant's mark	Opponent's mark
INDIGO FITNESS	

33. The earlier mark comprises of the word “indigo” with a small subscript 2 connected to the O at the end of the word to denote the chemical formula for oxygen. Indigo is a colour of the rainbow which will be understood and recognised by consumers. Mr Austen submitted that given the reputation of O<sub>2</sub>, albeit in the telecommunications field, the dominant and distinctive element of the mark is O<sub>2</sub> rather than indigo. I shall consider this further when I decide whether there is a likelihood of confusion. However, the overall impression of the mark is the word indigo, albeit with a reference to the chemical formula O<sub>2</sub>.

34. The application consists of two words: INDIGO and FITNESS. The word FITNESS describes a characteristic of the goods and services offered. It is not distinctive or dominant in the mark as a whole. Therefore, the overall impression of the application is the word indigo.

35. The differences between the marks are twofold, 1) the inclusion of the word FITNESS in the application, and 2) reference to the chemical formula for oxygen in the application. Other than these two differences, both share the word indigo. Accordingly, based on the marks as a whole, I consider there to be a higher than average degree of visual similarity.

36. With regard to the aural considerations, the application will be pronounced as INDIGO FITNESS and the opponent's mark as indigo-two, or possibly (but unlikely) as indigo-oh-two. Therefore, the only aural differences are the inclusion of the word

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FITNESS in the application, and two at the end of the opponent's mark. The indigo element of each mark will be pronounced identically. Accordingly, I find that there is a higher than average degree of aural similarity between the respective marks.

37. Conceptually, the application is a well known colour that would be recalled as a deep reddish blue colour, together with the descriptive/non-distinctive word Fitness. The earlier mark will be remembered in the same manner. The fact that the O<sub>2</sub> symbol overlaps with the O at the end of INDIGO in the contested mark leads to a degree of word play where the O<sub>2</sub> serves as the last letter of INDIGO but also as the chemical symbol mentioned above. Since all of the word INDIGO is preserved in the contested mark, it will be recalled as such, but also to the chemical symbol for the element Oxygen. In view of the aforementioned, I am of the opinion that the marks are conceptually similar to an average degree.

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

38. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23:

“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).

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

39. The distinctive character of the earlier mark is another important factor to consider because the more distinctive it is (based either on inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24).

40. The opponent has not filed turnover or advertising figures, or any examples of how the mark is used. Therefore, I only have the mark's inherent nature to consider.

41. The earlier mark is a combination of the word indigo and O<sub>2</sub>. It is not descriptive of the goods and services provided, nor does it allude to any characteristic thereof.



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42. The word indigo is not an invented word so it cannot be at the top end of the distinctiveness scale. However, given the combination of the word indigo, which is distinctive for the goods and services, together with O<sub>2</sub>, I am of the view that the earlier mark has a higher than average level of distinctive character.

### **Global assessment – likelihood of confusion**

43. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I must also keep in mind the distinctive character of the opponent's mark as the more distinctive these marks are, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture retained in their mind.

44. To summarise, I have found that:

- The average consumer of the respective goods and services are the general public and businesses. The general public will pay a reasonable degree of care and attention whilst businesses will pay a slightly higher degree of care and attention. The business advisory services will be business to business rather than to the general public. Therefore, I find that a higher than average degree of care and attention will be paid.
- Given the broad terms covered by the opponent's earlier mark, all of the applied for goods and services are identical thereto.
- The overall impression of each mark is the word indigo, together with the opponent's reference to O<sub>2</sub>.
- The respective marks share a higher than average degree of visual and aural similarity, and an average degree of conceptual similarity.
- The earlier mark has a higher than average level of inherent distinctive character.

45. During the hearing Mr Austen submitted that the dominant and distinctive element of the mark is O<sub>2</sub> since O<sub>2</sub> has a significant reputation in the telecommunications market. He went to say that in view of O<sub>2</sub>'s strong reputation, the average consumer would only see O<sub>2</sub> and indigo would effectively go unnoticed. It is established case law<sup>4</sup> that if all the other components of the mark are negligible the assessment of the similarity can be carried out solely on the basis of the dominant element. In this instance, it is clear that the word indigo is not negligible. It

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<sup>4</sup> *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P

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is a dominant element of the mark and will not be ignored. This is particularly the case since O<sub>2</sub> may have a reputation in the telecommunications sector, but there has been no evidence that they have a reputation in the fitness industry. Accordingly, the average consumer would not ignore indigo due to the existence of O<sub>2</sub>

46. It was also submitted that since the application does not contain O<sub>2</sub>, the average consumer would not believe that the application would belong to or be economically linked to the opponent. However, I must consider the notional and fair use of the mark. Whilst the levels of attention paid to the goods and services vary this does not detract from the fact that the overall impression created by the application is INDIGO, and in the case of the earlier mark it is indigo plus O<sub>2</sub>. Therefore, a likelihood of confusion exists.

47. Even if I were to accept that the only dominant and distinctive element of the earlier mark is O<sub>2</sub>, the word indigo retains an independent distinctive role within the application. Therefore, this line of argument cannot succeed. In *Aveda Corp v Dabur India Ltd* [2013] EWHC 589 (Ch), Arnold J. stated in paragraphs 47 and 48 that:

“In my view the principle which I have attempted to articulate in [45] above is capable of applying where the consumer perceives one of the constituent parts to have significance independently of the whole, but is mistaken as to that significance. Thus in *Bulova Accutron* the earlier trade mark was ACCURIST and the composite sign was BULOVA ACCUTRON. Stamp J. held that consumers familiar with the trade mark would be likely to be confused by the composite sign because they would perceive ACCUTRON to have significance independently of the whole and would confuse it with ACCURIST.

On that basis, I consider that the hearing officer failed correctly to apply *Medion v Thomson*. He failed to ask himself whether the average consumer would perceive UVEDA to have significance independently of DABUR UVEDA as a whole and whether that would lead to a likelihood of confusion.”

48. In this instance, even if the average consumer did not consider indigo to be dominant or distinctive (in light of the O<sub>2</sub> reputation in the telecommunications sector), given the independent distinctive role that indigo plays in the applicant's mark as a whole this would still result in a finding of a likelihood of confusion.<sup>5</sup>

49. In view of the above, I find that there is a likelihood of confusion between the respective marks.

### Outcome

**50. The opposition succeeds. The application is refused in its entirety.**

### COSTS

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<sup>5</sup> *Medion AG v Thomson multimedia Sales Germany & Austria GmbH* ('Thomson Life') [2005] ECR I-8551

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51. The opponent has been successful and is entitled to a contribution towards its costs. During the hearing Ms Jenkins highlighted that the applicant's skeleton argument was submitted the day before the hearing. Mr Austen stated that the section 5(3) ground was withdrawn shortly before the hearing, however it was struck out by the Registry in November since no supporting evidence was submitted, so would not have put the applicant to much expense. It is also noted that the opponent relied upon an unrealistically broad list of goods and services rather than particularise their case. This would have caused the applicant additional and unnecessary time at the pleadings and hearings stage.

52. In view of the above, I award the opponent the sum of £1000 as a contribution towards the cost of the proceedings. This award is at the lower end of the scale since the opponent relied upon a wide range of goods and services rather than particularise their claim. This would result in the applicant having to consider which were similar at the pleadings and hearing stage. The sum is calculated as follows:

Preparing a statement and considering the other side's statement £400

Official fee £100

Preparing for and attending a hearing £500

53. The official fee has been limited to £100 from £200 since the section 5(3) was a spurious and unsupported claim which was struck out prior to the final determination of these proceedings.

54. I therefore order indigo23 Limited to pay O2 Holdings Limited the sum of £1000. The above sum should 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 16th day of April 2015**

**MARK KING**  
**For the Registrar,**  
**the Comptroller-General**