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TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 055 705 IN
THE NAME OF YOGASPHERE LIMITED TO REGISTER THE
FOLLOWING TRADE MARKS (AS A SERIES OF TWO) IN CLASSES
25, 28 AND 41:

YOGASPHERE

YOGASPHERE

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO 402 869
IN THE NAME OF SFERA JOVEN, S.A.

Background and pleadings

1. Yogasphere Ltd (the applicant) applied to register the trade marks

YOGASPHERE

YOGASPHERE

(series of two) in the UK on 15th May 2014. The application was accepted and published in the Trade Marks Journal on 13th June 2014 in respect of the following goods:

Class 25

Clothes for sports.

Class 28

Yoga straps.

Class 41

Yoga instruction.

2. Sfera Joven, S.A (the opponent) oppose the trade mark on the basis of Section 5(2) (b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier Community Trade Marks (CTM):

CTM 4 563 541:

(Sfera)

Goods relied upon:

Class 25:

Clothing, footwear, headgear.

Class 28:

Games and playthings; gymnastic and sporting articles not included in other classes.

CTM 2 296 416:



Goods relied upon:

Class 25:

Clothing, footwear, headgear.

Class 28:

Games and playthings; gymnastic and sporting articles not included in other classes.

Class 41:

Education; providing of training; entertainment; sporting and cultural activities.

CTM 2 296 440:



Goods relied upon:

Class 25:

Clothing, footwear, headgear.

Class 28:

Games and playthings; gymnastic and sporting articles not included in other classes.

Class 41:

Sporting activities.

CTM 9 806 481:

(Sfera  KIDS)

Goods relied upon:

Class 25:

Clothing, footwear and headgear

3. The opponent argues that the respective goods are identical or similar and that the marks are similar.
4. The applicant filed a counterstatement denying the claims made.
5. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.
6. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. A hearing was requested but was cancelled for reasons that will become clear during this decision. This decision is taken following a careful perusal of the papers.

Evidence filed

Opponent

7. This is a witness statement from Michael Barrett, a Trade Mark Attorney representing the opponent. Attached to his witness statement is a number of exhibits: website hits; photographs of shop fronts displaying SFERA (all in Spain); screenshots of the opponent's Twitter page etc. Very limited use of SFERA KIDS and SFERAMODA is also shown.

Applicant

8. These are witness statements from Mandip Kaur Jharmat and Leonard Lourdes, both Directors of the applicant company. The witness statements are accompanied by exhibits showing use of YOGASPHERE.
9. It is clear from the evidence filed that SFERA has been used in Spain in respect of various items of clothing and related accessories. No other

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information is provided in terms of market share, advertising, turnover etc. As such, it is considered that the evidence is only sufficient to prove use of the earlier SFERA trade mark. It does not demonstrate that the mark is entitled to any enhanced degree of protection as a result of enhanced distinctiveness. Further, it is noted that there is a claim from the opponent that its marks act as a series or a “family”. There is scant evidence provided to support this assertion and so the claim is set aside.

DECISION

10. For reasons of procedural economy, the opposition will initially be considered in respect of earlier trade mark CTM 4 563 541.

Section 5(2)(b)

11. Sections 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”.

Comparison of goods and services

12. Some of the contested goods i.e. clothes for sports, are identical to the goods on which the opposition is based, i.e. clothing. For reasons of procedural economy, the Tribunal will not undertake a full comparison of the good listed above. The examination of the opposition will proceed on the basis that the contested goods are identical to those covered by the earlier trade marks. If the opposition fails, even where the goods are identical, it follows that the opposition will also fail where the goods are only similar.

Comparison of marks

13. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the



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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.”

14. 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.

15. The respective trade marks are shown below:

	
Earlier trade mark	Contested trade mark

16. Before carrying out a comparison of the marks shown above, the following guidance is noted: In *J.W. Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290:

48. “*Similarity as a threshold question*

49. Nobody disputes that there are cases where the mark and sign do not share any visual, aural or conceptual elements. In such a case, even if there were some actual confusion, it could not have occurred by reason of the similarity between the marks. Beyond that extreme case (which it is hard to imagine in the context of contested litigation) is there a threshold of similarity that mark and sign must reach before one needs to assess the consequent issue of likelihood of confusion? Mattel's skeleton argument cited the decision of Lewison J (as he then was) in *L'Oreal v Bellure NV* [2006] EWHC 2355 (Ch); [2007] RPC 14 at [110]:

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"A minimum threshold of similarity?"

Both infringement under section 10(2) and infringement under section 10(3) require similarity between the sign and the mark. Mr Wyand submitted that there was a threshold degree of similarity which had to be crossed before the court would consider whether the extent of similarity could have either of the effects required by section 10(2) and section 10(3) respectively. I do not agree. In my judgment similarity is a relative concept. A sign can be more or less similar to a mark. For example, Trésor is packaged in a cardboard box. So is La Valeur. These forms of packaging are similar to each other when compared to the whole range of possible packaging (e.g. Perspex cases, tins etc.). Whether something is relevantly similar to another thing seems to me to depend on why you are asking the question. In the case of trade mark infringement the question is asked in order to determine whether the degree of similarity has had (or would have) a particular effect. In my judgment this is borne out by the ruling of the ECJ that a lower degree of similarity between the mark and the sign may be counterbalanced by a greater similarity between the goods to which the mark and the sign are respectively applied. Accordingly, in my judgment, there is no minimum threshold of the kind for which Mr Wyand contended. It is a question of degree in every case."

50. However Mr Mellor drew attention to a series of cases in the CJEU which he submitted cast doubt on the proposition in *L'Oreal*. He refers first to Case C-558/12 *OHIM v Riha Weser-Gold Getränke GmbH & Co KG* (unreported 23 January 2014) where the General Court had held that the signs at issue had "average" visual and phonetic similarity to the mark but that, conceptually, the signs were different. This led the General Court to hold that, despite the visual and phonetic similarities, the marks were "dissimilar overall". It was argued on appeal that the court had wrongly considered it relevant to take account of enhanced distinctiveness through use. At [44] the court said, uncontroversially, that:

"Similarity of the marks in question is thus a necessary condition for it to be found that there is a likelihood of confusion for the purposes of Article 8(1)(b) of Regulation No 207/2009. Accordingly, the lack of similarity between the marks at issue renders Article 8 of Regulation No 207/2009 inapplicable."

51. However, at [48] the court went on to say:

"In that way, by holding that the Board of Appeal's failure to examine the enhanced distinctiveness of the earlier marks, acquired through use, meant that the contested decision was invalid, the General Court called for the Board of Appeal to examine a factor that was of no relevance to the assessment as to whether there was a likelihood of confusion, for the purposes of Article 8(1)(b) of Regulation No 207/2009, between the marks at issue. Since the General Court had

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already found that the marks at issue were dissimilar overall, any likelihood of confusion had to be ruled out and the possible enhanced distinctiveness of the earlier marks, acquired through use, could not offset the lack of similarity between the marks at issue."

52. It does not appear from this judgment that the CJEU was asked to rule on the correctness of the General Court's finding that the marks were not similar overall, merely on whether enhanced distinctiveness could displace such a finding. As such, it does not to my mind directly cast doubt on the proposition derived from *L'Oreal*.

53. The next case was Case C-552/09 *Ferrero v OHIM* [2011] ETMR 565, in which the General Court found that "*there were a number of visual and phonetic features which precluded the signs from being perceived as similar*". At [65] to [66] the Court said:

"65 Although that global assessment implies some interdependence between the relevant factors, and a low degree of similarity between the marks may therefore be offset by the strong distinctive character of the earlier mark (see, to that effect, judgment of 7 May 2009 in Case C-398/07 P *Waterford Wedgwood v Assembled Investments (Proprietary) and OHIM*, not published in the ECR, paragraph 33), the fact remains that where there is no similarity between the earlier mark and the challenged mark, the reputation or recognition enjoyed by the earlier mark and the fact that the goods or services respectively covered are identical or similar are not sufficient for it to be found that there is a likelihood of confusion between the marks at issue or that the relevant public makes a link between them (see, to that effect, Case C-254/09 P *Calvin Klein Trademark Trust v OHIM* [2010] ECR I-0000, paragraph 53 and the case-law cited).

66 As is apparent from paragraph 51 above, in order for Article 8(1)(b) or (5) of Regulation No 40/94 to be applicable, the marks at issue must be identical or similar. Consequently, those provisions are manifestly inapplicable where the General Court has ruled out any similarity between the marks at issue (see, to that effect, *Calvin Klein Trademark Trust v OHIM*, paragraph 68). It is only if there is some similarity, even faint, between the marks at issue that the General Court must carry out a global assessment in order to ascertain whether, notwithstanding the low degree of similarity between them, there is, on account of the presence of other relevant factors such as the reputation or recognition enjoyed by the earlier mark, a likelihood of confusion or a link made between those marks by the relevant public."

54. Again, it seems to me that it was not the General Court's conclusion that there was no similarity that was under attack in *Ferrero*. What was under attack was whether, given such a finding, it was necessary to go on and undertake the global assessment to determine whether there existed a likelihood of confusion or a link. It is only if there is at least

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some "faint" similarity that the global assessment needs to be carried out.

55. Thirdly, there is Case C-216/10 *Lufthansa Airplus Servicekarten GmbH v OHIM* (unreported 25 November 2010) where the court again said that where there is no similarity between mark and sign a court or tribunal is justified in declining to go on to consider whether there is a likelihood of confusion. In that case the General Court had taken the view that there was no visual or phonetic similarity and a low degree of conceptual similarity between mark and sign. The complaint was that the court had failed to take account of the high degree of similarity between the goods. That of course does not overcome the absence of any overall similarity between mark and sign.

56. Finally, in Case C-193/09 *Kaul v OHIM* (unreported 4 March 2010) the marks in issue were ARCOL and KAPOL. The Board of Appeal at OHIM had found that the marks were "not in any way similar". The only feature apart from the common use of the letter "A" was that both marks ended in –OL. Mr Mellor relied on [44] of the CJEU's reasoned order which he says is to similar effect as the other cases he relies on:

"The General Court was also right to observe, in this connection, at paragraph 29 of the judgment under appeal, that when it is found that two opposing marks, considered individually, do not display the minimum degree of similarity required for it to be possible to establish a likelihood of confusion solely on the basis of the highly distinctive character of the earlier mark or solely because the goods covered by the earlier mark and those covered by the trade mark applied for are identical, the opposition must be rejected, and this is not precluded by the principle of interdependence (see, to that effect, *Il Ponte Finanziaria v OHIM*, paragraph 50)."

57. Mr Mellor emphasises the words "*the minimum degree of similarity*". With respect, I do not find this paragraph, which tracks *verbatim* an equivalent passage in the General Court's judgment, very easy to follow. I do not regard it as establishing that there is a minimum threshold of similarity required. There was certainly no need for the court to go that far, given that there was no similarity at all on the facts of that case. If it does suggest such a minimum threshold, it seems to me to be inconsistent with *Ferrero*.

58. Thus I do not consider that any of these cases provides direct authority which suggests that there is a minimum threshold of similarity. The cases suggest instead that overall similarity is a binary question. Where there is some overall similarity, even faint, then it is necessary to carry out the global assessment, taking account of all relevant circumstances. Moreover, in such cases, the enhanced distinctive character of the mark may play a role in increasing the likelihood of confusion.

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59. On the other hand the cases do show that the General Court has said that where there is (a) average visual and phonetic similarity, but no conceptual similarity (*Wesergold*), or (b) a number of visual and phonetic features which precluded the signs from being perceived as similar (*Ferrero*), or (c) no visual or phonetic similarity but a low degree of conceptual similarity (*Lufthansa*), or (d) a common suffix (*Kaul*), there may yet be no similarity overall between mark and sign. I have no difficulty with these conclusions: it is only overall similarity which counts.

60. Thus I would summarise the position in the following way:

i) The court should assess the phonetic, visual and conceptual similarity of mark and sign and decide whether, overall, mark and sign would be perceived as having any similarity by the average consumer.

ii) If no overall similarity at all would be perceived, the court would be justified in declining to go on and consider the likelihood of confusion applying the global appreciation test, as Article 9(1)(b) is conditional on the existence of some similarity. Such situations are not likely to occur often in contested litigation, but where they do occur, it is not legitimate to take account of any enhanced reputation or recognition of the mark.

iii) Where the average consumer would perceive some overall similarity, however faint, the court must go on to conduct the global appreciation test for the likelihood of confusion, taking account where appropriate of any enhanced reputation or recognition of the mark.

iv) In conducting the global appreciation test the court must take forward its assessment of the degree of similarity perceived by the average consumer between mark and sign”.

17. As regards distinctive and dominant components, each of the signs contains verbal elements and minor graphics. In each of the signs, it is considered that the verbal elements SFERA and YOGASPHERE are the dominant and distinctive components. It is noted that each of the marks contain the letters S, E and R, which appear in the same order. However, this does not in any way render them visually similar. The letter F would produce the same sound as the letters PH in the later mark when spoken aloud. However, the earlier trade mark is most likely three syllables S-FE-RA and the later trade mark YO-GA-SPH-ERE. They are clearly different. Conceptually, the earlier mark has no meaning and so there is no similarity in this regard. Bearing in mind all of the aforesaid, it is considered that there is no overall similarity between these signs.

18. Even if there was any possibility of a finding of the tiniest degree of overall similarity between these signs and even if all the other elements of the global

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comparison worked in the opponent's favour to the maximum amount possible, it is considered that there is clearly no likelihood of confusion here. The opposition fails in its entirety.

Final Remarks

19. The opposition is based upon three other earlier trade marks. However, these marks are even further away from the contested trade mark than the one compared above as they contain additional stylisation and/or other not similar elements. They therefore do not place the opponent in any better position. As such, they will not be considered.

COSTS

20. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £1100 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement: -
£500

Considering other side's evidence - £300

Preparing written submissions - £300

TOTAL - £1100

21. I therefore order Sfera Joven, S.A. to pay Yogasphere Ltd the sum of £800. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of October 2015

Louise White

For the Registrar

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