

**O-588-15**

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3076536  
IN THE NAME OF WELLBLOCKS LTD

AND

OPPOSITION THERETO UNDER NO 403692  
BY LOUIS PAUL GUITAY

## Background

1. Application No 3076536 has a filing date of 10 October 2014, stands in the name of Wellblocks Ltd (“the applicant”) and seeks registration of the trade mark **wellblocks** for the following goods and services:

Class 10  
Manual massage instruments

Class 44  
Massage

2. Following publication of the application in *Trade Marks Journal* 2014/045 on 31 October 2014, notice of opposition was filed by Louis Paul Guitay (“the opponent”). The opposition is brought on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In respect of the opposition under sections 5(2) and (3) of the Act the opponent relies on the following Community Trade Mark (“CTM”):

CTM	Dates	Specification
4047718 WELLBOX	Filing date: 28 September 2004  Date of entry in the register: 16 November 2005	Class 10 Massage apparatus  Class 28 Apparatus for restoring physical fitness, bodybuilding apparatus, physical exercise apparatus and equipment  Class 44 Hygienic, health and beauty care for human beings

3. In respect of the objection under section 5(4)(a) of the Act the opponent relies on use of the mark WELLBOX throughout the UK since 2005.

4. The applicant filed a counterstatement denying the grounds of opposition. Both parties filed evidence with the opponent also filing written submissions. I will refer to the evidence and submissions as necessary later in this decision. Neither party requested a hearing. I therefore give this decision after careful consideration of all the papers.

### The objection under section 5(2)(b) of the Act

5. Section 5(2)(b) of the Act states:

“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”.

6. What constitutes an earlier trade mark is set out in section 6 of the Act. Under this ground, the opponent relies on its CTM 4047718 which is an earlier mark as set out in section 6. Whilst the CTM had been registered for longer than five years at the date the application was published, no request was made in the counterstatement that the opponent prove use of its earlier mark. That being so, the opponent is entitled to rely on its earlier mark under this ground for each of the goods and services for which it is registered, regardless of what use, if any, it may have made of its CTM.

7. In determining whether there is a likelihood of confusion between the respective marks, the European courts have provided guidance. 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;

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of the respective goods and services**

8. In the counterstatement the applicant has made submissions regarding the respective parties' goods (it is silent as to the respective services). In line with the comments in paragraph 6 above, the comparison I have to make is a notional one based on the specifications of goods and services as registered and applied for regardless of what use, if any, may have been made of them. The respective specifications are as follows:

<b>The earlier mark</b>	<b>The application</b>
Class 10 Massage apparatus	Class 10 Manual massage instruments
Class 28 Apparatus for restoring physical fitness, bodybuilding apparatus, physical exercise apparatus and equipment	Class 44 Massage
Class 44 Hygienic, health and beauty care for human beings	

9. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court ("GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für 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”.

10. In respect of the parties’ goods in class 10, “instruments” and “apparatus” are words used in the alternative to mean pieces of equipment. Whilst the applicant’s goods are described as “manual” these will be included within the wider category of goods comprising the opponent’s specification in this class. That being so, the respective goods are identical on the basis set out in *Merix*.

11. The applicant seeks registration of massage services in class 44. Such services may be for medical or wellbeing purposes and will be included within the terms “health and beauty care for human beings” in the opponent’s specification. Again, the respective services are identical on the basis set out in *Merix*.

### **The average consumer and the nature of the purchasing process**

12. 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 and/or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

13. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

14. Massage apparatus may be bought by the general public for use at home but may also be bought by professionals such as beauty therapists or physiotherapists. They are goods which are widely available but which are likely to be a relatively infrequent purchase. The average consumer is likely to take a reasonable degree of care over the purchase given they are intended for use on the person.

15. Massage services are also widely available and used by the general public. Being services involving contact with one’s person, they are also likely to be bought with a reasonable degree of care, particularly when utilised for medical purposes.

16. In respect of the goods, the purchase is likely to be primarily a visual one with the choice being made by self-selection from e.g. a shelf within a store or from a screen or catalogue. As for the services, the visual aspect is also likely to be part of the purchasing process with the choice being made from written material or from the location where the services are provided. Aural considerations are also likely to have

a part to play given that recommendations by word of mouth may be sought by the average consumer.

### **Comparison of the respective marks**

17. 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 them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) 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.”

It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of them and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them.

18. The earlier mark consists of the word WELLBOX presented in plain block capitals. Whilst presented as a single word, the mark naturally breaks down into its two component parts. The word WELL has a number of meanings but, in relation to the goods and services involved, will be understood to refer to good health. The word BOX also has a number of meanings but is likely to be seen as referring to a receptacle or container generally of a square or rectangular shape. As no part of the mark is highlighted in any way, the distinctiveness rests in its whole.

19. The applicant’s mark consists of the word wellblocks, presented in lower case. Again presented as a single word, it breaks down naturally into its two component parts. The word blocks again has a number of meanings but will be understood to refer to a solid piece of material often in a square or rectangular shape. Again, as no part of the mark is highlighted in any way, the distinctiveness rests in its whole.

20. Both marks begin with the letters WELLB/wellb which are visually identical, the differing presentation not being relevant to the decision I have to make. The earlier mark ends with the letters OX whereas the applicant’s mark ends with the letters locks which are visually very different. Overall, the marks share a reasonable degree of visual similarity.

21. The letters OX and ocks are aurally indistinguishable. This, coupled with the fact that both marks start with the same five letters (and therefore the only aural difference is the letter l as the sixth letter of the applicant’s mark) means that there is a very high degree of aural similarity.

22. The word WELL/well is likely to bring to mind the image of being fit and healthy to both marks. Whilst there is a degree of conceptual similarity between a box and blocks, in that both could be squared or rectangular in shape, a block is generally a solid object whereas a box is not. Overall, there is a reasonable degree of conceptual similarity between the respective marks.

### **The distinctive character of the earlier mark**

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

24. The opponent has filed evidence. It takes the form of a witness statement of Louis Paul Guitay. Mr Guitay states that he is a Swiss citizen, sufficiently fluent in the English language to make his statement. The witness statement is very brief. Mr Guitay states:

“Goods and services bearing the trade mark WELLBOX have been provided throughout the UK since at least 2007. In that time the turnover has risen from approximately €6,000 to almost €400,000 per year.”

25. Whilst I have quoted Mr Guitay as saying the turnover has risen “from approximately €6,000”, the print of the document is not clear and the figure may, in fact, say €8,000. I have not sought to clarify the figure as nothing hangs on the difference.

26. Attached to Mr Guitay’s witness statement is exhibit LPG1 which, he states, are examples of marketing and promotional articles that have appeared in the UK in relation to the opponent’s goods. It includes the following:

Page 5: Downloaded on 19 May 2015, this page is taken from the plastic-cosmetic-surgery.co.uk website. Headed “Wellbox Cellulite Treatment” it describes the “Wellbox Lipo Massage Anti Cellulite device” retailing at £975. The page bears a copyright date of 2007.

Page 6: Downloaded on 26 May 2015 but bearing the date 1 February 2012, this is a page taken from the wellbox.com website. It shows a “Deluxe version of Wellbox ® Swarovski [-] exclusively available in the legendary apothecary room at Harrod’s”. The article goes on to say that “this fabulous (extraordinary) edition is available to order and its price is communicated only on demand”.

Page 7: A copy of an article said to have been published in *The Sunday World Magazine* on November 29<sup>th</sup> 2009. I am not familiar with this magazine and no indication of its circulation is given. The article refers to the Wellbox device available from an Irish website for £995.

Page 8: An article published on the Telegraph.co.uk website on 10 February 2009. It includes details of the “Wellbox Rejuvenator” available from Harrods at a cost of £1000.

27. Also included are similar extracts from the *luxurylaunches*, *bornrich*, *Luxe-stuff* and *avrilconnorsanti-agingdiary.blogspot.fr* websites.

28. The opponent has given no evidence to show any use of its mark in relation to any goods for which its mark is registered in class 28 or the services as registered in class 44. In relation to its registration for goods in class 10, the evidence shows the “standard” device retails at approximately £1000. The turnover figures provided by Mr Guitay suggest that relatively few devices have been sold. The only store where such goods are said to have been available is Harrods in London. Whilst it is not disputed that sales of goods in class 10 have been made, taking the evidence as a whole, I do not consider that the use made will have enhanced, to any material extent, the mark’s inherent distinctiveness. Made up of two ordinary dictionary words, the mark has an average degree of inherent distinctive character.

### **Likelihood of confusion**

29. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.



30. The evidence filed on behalf of the applicant consists of a witness statement by Dr Caroline Keddie, its founder. Dr Keddie's evidence consists of submission which makes a comparison of the goods her company has developed with those of the opponent and so, for reasons already explained, is not of relevance to the issues I have to decide. Other parts of her evidence compare various logos used by the respective businesses. Again this is not of relevance to the issues I have to decide as those logos are not the marks applied for by the applicant or relied on by the opponent in these proceedings.

31. Earlier in this decision I determined:

- The applicant's goods and services are identical to the opponent's goods and services in the corresponding classes;
- The goods and services will be bought by the general public or professionals in business. The goods are such as will be a relatively infrequent purchase likely to be bought with a reasonable degree of care. The services will be bought more regularly and also likely to be with a reasonable degree of care;
- The purchase of the goods will be primarily visual whereas the purchase of the services will involve both visual and aural considerations;
- The respective marks have a reasonable degree of visual similarity, a very high degree of aural similarity and a reasonable degree of conceptual similarity;
- The earlier mark has an average degree of inherent distinctive character which has not been shown to have been materially enhanced through use.

32. Taking all matters into account, the similarities between the respective marks, goods and services lead me to find there is a likelihood of direct confusion where one mark will be taken for the other. That being the case, the opposition under section 5(2)(b) succeeds.

### **The objections under section 5(3) and 5(4)(a) of the Act.**

33. Given my findings under section 5(2) of the Act, I decline to deal with the remaining objections. I will say, however, that I set out above a summary of the evidence filed by the opponent. On the basis of that evidence, I do not consider the opponent has shown it has the necessary reputation to succeed in its objection under section 5(3) of the Act. As for the objection under section 5(4)(a), the opponent can be in no better position than it is under section 5(2)(b).

### **Summary**

34. The opposition has succeeded in full under section 5(2)(b) of the Act. Subject to any successful appeal, the application will be refused.

### **Costs**

35. The opponent having succeeded, he is entitled to an award of costs in his favour. In making the award, I note that his evidence was brief in the extreme and that the decision was reached from the papers. Whilst the applicant also filed a witness statement, it consisted largely of submissions and went only to matters which are not

relevant to the decision I had to make for reasons given in paragraph 8 above.  
Taking all matters into account, I make the award on the following basis:

For filing the notice of opposition and reviewing the counterstatement:	£300
Fee:	£200
For filing and reviewing evidence:	£300
For preparation of and filing submissions:	£200
<b>Total:</b>	<b>£1000</b>

36. I order Wellblocks Ltd to pay Louis Paul Guitay the sum of £1000. This sum is to 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 14th day of December 2015**

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