

O-127-18

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO 3103980

BY MADELEINE SHAW

TO REGISTER

GET THE GLOW

AS A TRADE MARK IN CLASSES 09, 16, 25, 28, 29, 30, 31, 32 & 41

AND

OPPOSITION THERETO (UNDER NO. 406522)

BY

YOGAGLO, INC.

BACKGROUND

1) On 15 April 2015, Madeleine Shaw ('the applicant') applied to register GET THE GLOW as a trade mark in respect of the following goods and services:

Class 09: Electronic publications; publications in electronically, magnetically or optically recorded and readable forms; audio books; sound, video and data recordings.

Class 16: Printed matter, printed publications; books; recipe books.

Class 25: Clothing, footwear and headgear; sports clothing; clothing for yoga.

Class 28: Gymnastic and sporting goods for use in relation to yoga.

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; ready cooked meals consisting wholly or substantially wholly of meat or poultry; salads; shakes.

Class 30: Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; cereals; bread, pastry and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice; dry and liquid ready-to-serve meals, mainly consisting of rice or pasta.

Class 31: Fresh fruits and vegetables; seeds.

Class 32: Non-alcoholic beverages; fruit juices; vegetable juices; smoothies.

Class 41: Entertainment services; education services; publishing services, providing on-line electronic publications (not downloadable) from the Internet, publication of books and printed matter; book club services; yoga instruction

and education; life coaching; holiday camp services; holidays in the form of yoga retreats; information services relating to all of the aforesaid.

2) The application was published in the Trade Marks Journal on 29 January 2016 and notice of opposition was later filed by Yogaglo, Inc. ('the opponent'). The opponent claims that the trade mark application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act')¹. A number of marks were pleaded in the notice of opposition. I set out here only two of those marks given that, at the hearing, Ms Pang agreed that they offered the opponent the strongest prospect of success such that if the opposition fails on the basis of them, it would also fail on the basis of the others. The two marks are:

Trade Mark details	Goods and services
<p>UKTM Registration No: 3011250 ('250)</p> <p>GLO</p> <p>Filing date: 24 June 2013</p> <p>Priority date: 26 December 2012 (USA)</p> <p>Date of entry in register: 22 November 2013</p>	<p>Class 09: Downloadable physical fitness and exercise instructional video and audio recordings with or without pre-recorded music via the internet and wireless devices; Digital media, namely, pre-recorded video cassettes, digital video discs, digital versatile discs, downloadable audio and video recordings, DVDs, and high definition digital discs featuring fitness, exercise, music and health-related issues; Downloadable multimedia file containing artwork, text, audio, video, and Internet Web links relating to fitness, exercise, music and health-related matters;</p> <p>Downloadable electronic publications in the form of brochures, leaflets, and workbooks featuring fitness, exercise, music and health-</p>

¹ Other grounds under sections 5(3) and 5(4)(a) were deemed withdrawn for want of evidence, as per the official letter of 08 May 2017.

related issues.

Class 38: Broadcasting and streaming of audio-visual media content in the fields of fitness, exercise and health-related matters via a global computer network; webcasting services; Providing access to online forums for transmission of messages and blogs over the Internet; Providing online electronic bulletin boards for transmission of messages among users in the field of general interest; Providing on-line chat rooms for social networking; Web messaging services; Video-on demand transmission services via the internet; Providing online forums for transmission of messages featuring fitness, exercise, music and health-related matters; Electronic transmission and streaming of digital media content for others via global and local computer networks; Streaming of audio, visual and audiovisual material via a global computer network; Communications services, namely, transmitting streamed sound and audio-visual recordings via the Internet; Streaming of video and audio material on the Internet; Providing access to computer databases; Electronic transmission of instant messages and data.

Class 41: Education and entertainment services, namely, online instruction in the fields of exercise, fitness, music and health-related matters; Providing online information via a global computer network on the subjects of exercise, fitness and music; Electronic

	<p>publishing services, namely, publication of text, graphics, photographs, images, and audio-visual works of others online for streaming featuring exercise, fitness, music, and health-related matters; Providing blogs in the nature of an online journal over the Internet featuring exercise, fitness, music, and health-related matters; Providing a website featuring non-downloadable audio-visual content, specifically, motion pictures, videos, music videos, music, video clips, audio clips, music clips, film clips, and photographs, in the fields of exercise, fitness, and music; Consulting services in the fields of exercise and fitness; Physical fitness instruction; Physical fitness training services; Providing a web site featuring information on exercise and fitness; Providing information in the field of fitness and exercise; Electronic publishing services, namely, publishing of online works of others featuring user-created text, audio, video, and graphics; Providing on-line journals and web logs featuring user-created content.</p> <p>Class 44: Providing a website featuring informational, non-downloadable audio-visual content, specifically, photographic, audio and video presentations in the fields of health-related matters, namely, health, wellness, and nutrition; Consulting services in the fields of health-related matters, namely, health, wellness, and nutrition; Providing information in the fields of health-related matters, namely,</p>
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	health, wellness, and nutrition.
<p>EUTM Registration No: 13262217 ('217)</p> <p>YOGAGLO</p> <p>Filing date: 17 September 2014</p> <p>Date of entry in register: 09 February 2015</p>	<p>Class 09: Downloadable physical fitness and exercise instructional video and audio recordings with or without pre-recorded music via the internet and wireless devices; Digital media, namely, pre-recorded video cassettes, digital video discs, digital versatile discs, downloadable audio and video recordings, DVDs, and high definition digital discs featuring fitness, exercise, music and health-related issues; Downloadable multimedia file containing artwork, text, audio, video, and Internet Web links relating to fitness, exercise, music and health-related matters; Downloadable electronic publications in the form of brochures, leaflets, and workbooks featuring fitness, exercise, music and health-related issues.</p> <p>Class 35: Retail, on-line retail, mail order and wholesale services connected with the sale of healthcare products, exercise equipment, fitness products, clothing, footwear, headgear, sports equipment, bags, sport bags, yoga equipment, sports drinks, health foods, health food supplements, books, digital media, namely, pre-recorded video cassettes, digital video discs, digital versatile discs,</p>

	<p>downloadable audio and video recordings, DVDs, and high definition digital discs featuring fitness, exercise, music and health-related issues, downloadable multimedia file containing artwork, text, audio, video, and Internet Web links relating to fitness, exercise, music and health-related matters, downloadable electronic publications in the form of brochures, leaflets, and workbooks featuring fitness, exercise, music and health-related issues, Downloadable physical fitness and exercise instructional video and audio recordings with or without pre-recorded music via the internet and wireless devices, cosmetics, toiletries, jewellery, watches.</p> <p>Class 44: Providing a website featuring informational, non-downloadable audio-visual content, specifically, photographic, audio and video presentations in the fields of health-related matters, namely, health, wellness, and nutrition; Consulting services in the fields of health-related matters, namely, health, wellness, and nutrition; Providing information in the fields of health-related matters, namely, health, wellness, and nutrition.</p>
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3) Both of the registrations in the table above are earlier marks, in accordance with section 6 of the Act. As they did not complete their respective registration procedures more than five years prior to the publication date of the contested mark, neither is subject to the proof of use conditions, as per section 6A of the Act.

4) The applicant filed a counterstatement. I note the following points made therein:

- The respective marks are not similar.
- It is denied that GLOW is the dominant distinctive element of the applicant's mark; as part of the slogan GET THE GLOW, it has no independent distinctive character.
- The foodstuffs and beverages in the applicant's classes 29, 30, 31 and 32 are clearly dissimilar to the goods and services of the earlier marks.
- Insofar as there is any similarity between any of the applicant's other goods and services and those of the earlier marks, there cannot, in any event, be a likelihood of confusion because the marks are dissimilar.

5) The opponent filed no evidence in chief but did file evidence in reply to evidence from the applicant. A hearing took place before me on 12 January 2018. The opponent was represented by Ms Jacqueline Pang of Mewburn Ellis LLP; the applicant by Mr Jonathan Day of Carpmaels & Ransford LLP.

Applicant's evidence

6) This takes the form of a witness statement from Madeleine Shaw dated 07 August 2017. Ms Shaw's evidence shows examples of the use that she has made of her mark and the significant and positive attention she says her business has received. Ms Shaw also lists a number of links to third parties' websites which use the word 'Glow' in their business names. These are said to show that the word 'Glow', of itself, is descriptive and therefore non-distinctive in relation to goods and services related to health and wellbeing. Of the ten links listed, nine relate to businesses from outside the UK (specifically, Singapore, Canada, Australia and the US). One link relates to a UK based Yoga business. Ms Shaw provides a quote from the website of that business. Part of the quote states "Glow Yoga is a modern approach to yoga...."

Opponent's evidence in reply

7) This comes from Ms Jacqueline Pang, Trade Mark Attorney at Mewburn Ellis LLP. Ms Pang states that, through searches on Google for terms including 'glo' and 'glo in the dark', she notes that there are a large number of third parties using the word 'glo'

to mean 'glow'. In support of this, she provides a list of examples of various UK companies which use the word 'glo' on, or in relation to, products which are said to 'glow in the dark'/luminesce. Prints from the websites are provided. One website, for example, uses the phrase 'Glo-Pro' in relation to a range of high visibility safety clothing. Another uses the phrase 'Glo-It' to refer to a range of 'glow in the dark' paint.

8) Ms Pang states that when she searched for the term 'glo in the dark' on Google and bing.com, this generated results for 'glow in the dark' goods and companies providing such goods.

9) Ms Pang exhibits copies of decisions from the UKIPO and from EUIPO where she says it was found that consumers perceived 'glo' to mean 'glow'.

10) Ms Pang states that she conducted research on Google for businesses in the UK that offer fitness and exercise education and training services as well as related clothing and equipment. Prints from some of those websites are provided² showing, for example:

- Fitness DVDs, cookbooks and exercise equipment provided under the mark 'Davina' or 'Davina McCall'.
- Workout videos and yoga clothing provided under the mark 'Adidas'.
- Sports clothing, fitness equipment and exercise classes provided under the mark 'Pineapple'.
- Clothing and exercise classes provided under the mark 'Virgin Active'.

DECISION

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

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

(a)....

² Exhibit JP6.

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

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

12) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

13) In the judgment of the CJEU 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”.

14) 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.

15) In *YouView TV Ltd v Total Ltd* ,[2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... 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."

16) In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) 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."

17) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

18) In *Sanco SA v OHIM*, Case T-249/11, the General Court ('GC') indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

19) At the hearing, Ms Pang agreed that earlier mark ‘217 only offered the opponent a greater prospect of success than earlier mark ‘250 insofar as the former covers services in class 35 which are not covered by the latter. On that basis, the goods and services to be compared are:

Opponent’s goods and services	Applicant’s goods and services
<p>‘250:</p> <p>Class 09: Downloadable physical fitness and exercise instructional video and audio recordings with or without pre-recorded music via the internet and wireless devices; Digital media, namely, pre-recorded video cassettes, digital video discs, digital versatile discs, downloadable audio and video recordings, DVDs, and high definition digital discs featuring fitness, exercise, music and health-related issues; Downloadable multimedia file containing artwork, text, audio, video, and Internet Web links relating to fitness, exercise,</p>	<p>Class 09: Electronic publications; publications in electronically, magnetically or optically recorded and readable forms; audio books; sound, video and data recordings.</p> <p>Class 16: Printed matter, printed publications; books; recipe books.</p> <p>Class 25: Clothing, footwear and headgear; sports clothing; clothing for yoga.</p> <p>Class 28: Gymnastic and sporting goods for use in relation to yoga.</p>

music and health-related matters;
Downloadable electronic publications in the form of brochures, leaflets, and workbooks featuring fitness, exercise, music and health-related issues.

Class 38: Broadcasting and streaming of audio-visual media content in the fields of fitness, exercise and health-related matters via a global computer network; webcasting services; Providing access to online forums for transmission of messages and blogs over the Internet; Providing online electronic bulletin boards for transmission of messages among users in the field of general interest; Providing on-line chat rooms for social networking; Web messaging services; Video-on demand transmission services via the internet; Providing online forums for transmission of messages featuring fitness, exercise, music and health-related matters; Electronic transmission and streaming of digital media content for others via global and local computer networks; Streaming of audio, visual and audiovisual material via a global computer network; Communications services, namely, transmitting streamed sound and audio-visual recordings via the Internet; Streaming of video and audio material on the Internet; Providing access to

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; ready cooked meals consisting wholly or substantially wholly of meat or poultry; salads; shakes.

Class 30: Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; cereals; bread, pastry and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice; dry and liquid ready-to-serve meals, mainly consisting of rice or pasta.

Class 31: Fresh fruits and vegetables; seeds.

Class 32: Non-alcoholic beverages; fruit juices; vegetable juices; smoothies.

Class 41: Entertainment services; education services; publishing services, providing on-line electronic publications (not downloadable) from the Internet, publication of books and printed matter; book club services; yoga instruction and

<p>computer databases; Electronic transmission of instant messages and data.</p> <p>Class 41: Education and entertainment services, namely, online instruction in the fields of exercise, fitness, music and health-related matters; Providing online information via a global computer network on the subjects of exercise, fitness and music; Electronic publishing services, namely, publication of text, graphics, photographs, images, and audio-visual works of others online for streaming featuring exercise, fitness, music, and health-related matters; Providing blogs in the nature of an online journal over the Internet featuring exercise, fitness, music, and health-related matters; Providing a website featuring non-downloadable audio-visual content, specifically, motion pictures, videos, music videos, music, video clips, audio clips, music clips, film clips, and photographs, in the fields of exercise, fitness, and music; Consulting services in the fields of exercise and fitness; Physical fitness instruction; Physical fitness training services; Providing a web site featuring information on exercise and fitness; Providing information in the field of fitness and exercise; Electronic publishing services, namely, publishing</p>	<p>education; life coaching; holiday camp services; holidays in the form of yoga retreats; information services relating to all of the aforesaid.</p>
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of online works of others featuring user-created text, audio, video, and graphics; Providing on-line journals and web logs featuring user-created content.

Class 44: Providing a website featuring informational, non-downloadable audio-visual content, specifically, photographic, audio and video presentations in the fields of health-related matters, namely, health, wellness, and nutrition; Consulting services in the fields of health-related matters, namely, health, wellness, and nutrition; Providing information in the fields of health-related matters, namely, health, wellness, and nutrition.

'217:

Class 35: Retail, on-line retail, mail order and wholesale services connected with the sale of healthcare products, exercise equipment, fitness products, clothing, footwear, headgear, sports equipment, bags, sport bags, yoga equipment, sports drinks, health foods, health food supplements, books, digital media, namely, pre-recorded video cassettes, digital video discs, digital versatile discs, downloadable audio and video recordings, DVDs, and high definition

<p>digital discs featuring fitness, exercise, music and health-related issues, downloadable multimedia file containing artwork, text, audio, video, and Internet Web links relating to fitness, exercise, music and health-related matters, downloadable electronic publications in the form of brochures, leaflets, and workbooks featuring fitness, exercise, music and health-related issues, Downloadable physical fitness and exercise instructional video and audio recordings with or without pre-recorded music via the internet and wireless devices, cosmetics, toiletries, jewellery, watches.</p>	
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20) Mr Day conceded that the applicant's goods in classes 09 and 16 are identical or highly similar to the opponent's goods and services. He also conceded that the applicant's services in class 41 are identical to the opponent's class 41 services, with the exception of 'book club services', 'life coaching', 'holiday camp services', and 'holidays in the form of yoga retreats'. Mr Day submitted that those services in class 41 and all of the applicant's goods in classes 25, 28, 29, 30, 31 and 32 are not similar to any of the opponent's goods or services.

21) I agree with Mr Day that there is no similarity between the applicant's goods in classes 29, 30, 31 and 32 with any of the opponent's goods or services covered by earlier mark '250. The respective nature, uses, trade channels and intended purpose of the goods and services is very different and there is nothing in the evidence before me to persuade me otherwise.

22) Class 35 of earlier mark '217 includes 'retail, on-line retail, mail order and wholesale services connected with the sale of healthcare products, sports drinks,

health foods, health food supplements...'. Ms Pang argued that such services are similar to all of the applicant's goods in classes 29, 30, 31 and 32 because the latter fall within the goods covered by the opponent's retail specification.

23) I find that the opponent's 'retail services connected with the sale of sports drinks' share a low degree of similarity with the applicant's 'non-alcoholic beverages' (a term which includes 'sports drinks') in class 32. Although they differ in nature, uses and intended purpose there is clearly a complementary relationship in play and shared channels of trade. As for the remainder of the opponent's retail specification (the retail services connected with the sale of the goods I have underlined in the preceding paragraph), I do not find any similarity between those services with any of the applicant's foodstuffs or beverages. This is because none of the applicant's foodstuffs are in the nature of 'health food supplements' (which are proper to class 5). Further, the terms 'healthcare products' and 'health foods' are, to my mind too vague (which, in turn means that the term 'retail services connected with the sale of healthcare products, health foods' is also vague) such that it is not possible to compare those retail services of the opponent with the food and beverages covered by the application.

24) I now turn to consider the applicant's goods in classes 25 and 28. I agree with Ms Pang that the opponent's class 35 services of 'Retail...services connected with the sale of...clothing, footwear, headgear, sports equipment...' covered by earlier mark '217 are similar to the applicant's goods. Although the nature, intended purpose and method of use are different, the applicant's goods are indispensable to the opponent's services and the trade channels are the same. I find a low degree of similarity overall between the applicant's class 25 and 28 goods with those retail services.

25) Ms Pang also argued that the applicant's goods in classes 25 and 28 are similar to the opponent's class 41 services of earlier mark '250. In this regard, she directed me to the opponent's evidence³ which she submitted shows that it is common for providers of instruction services in the field of exercise and fitness to also provide

³ Exhibit JP6.

sports clothing and sports equipment. I am not persuaded that the very few examples before me are sufficient to show that the respective goods and services are commonly or normally marketed in that way. To my mind, they share no real similarity when their respective nature, intended purpose, methods of use are borne in mind. If I am wrong about that, any similarity which does exist on the basis that there may be some complementarity and/or sharing of trade channels must be low.

26) Finally, I turn to consider the services in class 41 which Mr Day disputed were similar to any of the opponent's goods or services. For ease of reference, those services are 'book club services', 'life coaching', 'holiday camp services' and 'holidays in the form of yoga retreats' (and 'information services [relating thereto]'). There is no evidence before me going to the issue of similarity between those services and the opponent's goods and services. Accordingly, I remind myself that I can only make the assessment on the basis of factors which are obvious.

27) Ms Pang argued that 'book club services' are similar to the opponent's goods in class 09 and services in class 41. I disagree. In the absence of evidence, it is not obvious to me that there is any similarity between those goods and services (or the applicant's 'information services relating to book club services').

28) I agree with Ms Pang that the applicant's 'life coaching' services (and 'information services' relating thereto) are highly similar to the opponent's class 41 services such as 'education services, namely, online instruction in the fields of exercise, fitness... and health-related matter; consulting services in the fields of exercise and fitness; physical fitness instruction; providing information in the field of fitness and exercise'. It seems obvious to me that life coaching may involve the provision of information/education and advice about how to live a healthy lifestyle which may necessarily involve assisting a person to become more fit and active by providing them with information about fitness/exercise activities.

29) Finally, I turn to 'holidays in the form of yoga retreats' and 'holiday camp services' and the information services relating thereto. I find there to be a low degree of similarity between these and certain of the opponent's class 41 services. This is because, although the precise nature, intended purpose and methods of use are not

the same, I agree with Ms Pang that there is a complementary relationship between the opponent's 'physical fitness instruction' and the applicant's 'holidays in the form of yoga retreats'. The former is indispensable for the latter in such a way that the consumer may believe that the responsibility for the provision of the respective services lies with the same undertaking. I find the same applies to 'holiday camp services' insofar as they may also be in the nature of camps providing yoga instruction or some other kind of fitness instruction and to 'information services' relating thereto.

30) As I have found that some of the applicant's goods and services are not similar to any of the opponent's goods and services, the opponent has no prospect of success in relation to those. To this end, see, for example, *Waterford Wedgwood plc v OHIM* – C-398/07 P, where the CJEU stated:

“35....Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

Average consumer and the purchasing process

31) It is necessary to determine who the average consumer is for the respective goods and services that I have found to be identical/similar and the manner in which they are likely to be selected. 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.”

32) Ms Pang submitted that the average consumer will be the general public given that the goods and services are everyday consumer items and that, generally speaking, an average degree of attention is likely to be paid during the purchase. I agree.

33) Ms Pang also argued that aural considerations are likely to play an important role in the purchasing process for the goods and services at issue. For example, in relation to physical fitness training services, where, she submitted, word of mouth recommendations are likely to be common. I agree that aural considerations must play a part in my assessment. However, to my mind, the visual aspect is of greater significance given that I would expect the goods and services to be sought out mainly by the eye on websites, at brick and mortar establishments and by way of signage on the high street (for example).

Comparison of marks

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

35) The marks to be compared are:

Opponent's marks	Applicant's mark
<p style="text-align: center;">GLO & YOGAGLO</p>	<p style="text-align: center;">GET THE GLOW</p>

36) The overall impression of the GLO mark lies solely in that invented word. Turning to YOGAGLO, this too has the appearance of a single invented word in which the overall impression lies. Ms Pang argued that the average consumer is likely to break the mark down into the two elements YOGA and GLO. That may be true, at least in relation to yoga-related goods and services. However, even in such circumstances, I find that neither of those elements materially dominates the mark.

37) Turning to the applicant's mark, I disagree with Ms Pang that the word 'GLOW' is the dominant and distinctive element. I find that the three words GET THE GLOW naturally combine to form a unit in which none of the words materially dominate the others in the overall impression conveyed.

38) I now turn to consider the visual, aural and conceptual similarities between the marks. I will begin with the GLO mark. Visually, Ms Pang argued there is at least a medium degree of similarity. I disagree. The applicant's mark is much longer than the opponent's mark GLO and the single point of visual coincidence between the marks lies towards the end of the applicant's mark. I find no more than a low degree of visual similarity. Aurally, the opponent's mark consists of one syllable which will

likely be pronounced 'gl-oh'. The applicant's mark consists of three syllables, 'get-thur-gl-oh'. Overall, the aural similarity is low. Conceptually, both parties agreed that the opponent's GLO mark is likely to be perceived as an invented word but one which is evocative of the dictionary word 'glow'. The applicant's mark will be perceived as an instruction to obtain a glow. I find there to be a fairly high degree of conceptual similarity overall.

39) Turning to YOGAGLO, both visually and aurally, I find a very low degree of similarity with GET THE GLOW. Conceptually, for some average consumers, YOGAGLO will likely be seen as a single invented word with no meaning. In those circumstances, the respective marks are conceptually different. Other average consumers may, as Ms Pang contended, perceive the mark as two elements, YOGA and GLO (where GLO is evocative of the word 'glow'). In those circumstances, there is some conceptual similarity.

Distinctive character of the earlier marks

40) The distinctive character of the earlier marks must be considered. The more distinctive they are, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“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).”

41) There is no evidence before me to show that the opponent’s earlier marks have been used, so I have only the inherent position to consider.

42) GLO has the appearance of an invented word but one which may evoke the well-known dictionary word ‘glow’. Mr Day submitted that ‘glow’ is descriptive in relation to the opponent’s goods and services which relate to health and wellbeing as shown in the applicant’s evidence and, as the opponent’s mark is an obvious misspelling of that word, its distinctiveness is also very low. I do not accept that the word ‘glow’ is descriptive in relation to any of the opponent’s goods or services. The applicant’s evidence on the point emanates primarily from outside the UK and also appears, in any event, to be use of the word ‘glow’ as a trade mark in relation to various yoga/nutrition based businesses. In my view, the evocation of ‘glow’ does nothing more (at most) than mildly allude to the goods and services being related to health/wellbeing. I also remind myself that the mark I am considering is not, in any event, simply the word ‘glow’ (which, in my view would have, at most, an average degree distinctiveness) but GLO. I find that the invented nature of GLO is such that it has a high degree of distinctiveness despite its allusion to ‘glow’.

43) As to YOGAGLO, this too has the appearance of an invented word, albeit one which, in the context of yoga-related goods and services (at least) may be recognised as consisting of YOGA and GLO conjoined. Owing to its overall appearance of being an invented word and that, to the extent that any allusive message is perceived, it is again, likely to be mild, I find that this mark also has a high degree of distinctive character.

Likelihood of confusion

44) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

45) I will first consider the likelihood of confusion in respect of the opponent's GLO mark. Some of the respective goods and services are identical. Others are similar to varying degrees (from low to high). The respective marks are conceptually similar to a fairly high degree but visually and aurally similar only to a low degree. In terms of the distinctiveness of GLO, I concluded that it has a high degree of inherent distinctiveness. However, I remind myself that in attributing the mark with that level of distinctiveness, I bore in mind that GLO, although evocative of the known word 'glow', has the appearance of being an invented word. It is that invented nature which attributes the mark with high distinctiveness. The applicant's mark shares no such attribute of being invented. Taking all of these factors together, I find that, an average consumer paying an average degree of attention during a mainly visual purchase is unlikely to mistake one mark for the other; there is no likelihood of direct confusion. There is even less likelihood of direct confusion in respect of the YOGAGLO mark when all factors are considered (including the high degree of distinctiveness of that mark and notwithstanding that some average consumers are likely to perceive some conceptual similarity between the marks) given, in particular, the very low degree of visual and aural similarity between the marks and the low degree of similarity between the relevant goods and services.

46) As to whether there is a likelihood of indirect confusion with either of the earlier marks, I find that the average consumer is not likely to believe that the respective

goods and services emanate from the same or linked undertaking(s). The common element is not “so strikingly distinctive”⁴, the applicant’s mark does not “simply add a non-distinctive element to [either of the earlier marks]”⁵, the applicant’s mark does not appear to me to be “entirely logical and consistent with a brand extension”⁶ of either of the opponent’s marks and I cannot see any other reason why the marks may be indirectly confused. To my mind, the most that can be said is that the applicant’s mark may call to mind the opponent’s marks (or vice versa). However, that is mere association rather than confusion which is insufficient to satisfy the requirements of section 5(2)(b).⁷ **The opposition fails.**

Costs

47) As the applicant has been successful, she is entitled to a contribution towards her costs. Mr Day confirmed that the applicant seeks costs on the usual scale. Accordingly, using the guidance in Tribunal Practice Notice 2/2016, I award the applicant costs on the following basis:

Preparing a statement and considering the opponent’s statement	£300
Preparing evidence and considering the other side’s evidence	£500
Preparing for and attending the hearing	£500
Total:	£1300

48) I order Yogaglo, Inc. to pay Madeleine Shaw the sum of **£1300**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of

⁴ *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, [16].

⁵ *ibid*

⁶ *ibid*

⁷ See, for example, the comments of Mr James Mellor QC in *Duebros Limited v Heirler Cenovis GmbH* (BL O/547/17).

the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th day of February 2018

Beverley Hedley

For the Registrar, the Comptroller-General