

**O/061/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3480346  
IN THE NAME OF MY BODI 87 LIMITED  
FOR THE TRADE MARK:**



**IN CLASSES 27, 28 and 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600001420  
BY BEACHBODY, LLC**

## Background and pleadings

1. On 09 April 2020, My Bodi 87 Limited (“the applicant”) applied to register the trade mark



for the following goods and services:

- Class 27     *Gymnasium mats, yoga mats, wrestling mats.*
- Class 28     *Sports equipment, rehabilitation equipment resistance bands, medicine balls, exercise bike, weights, weight machines, treadmill, step machine, rowing machine, cross trainer, cardio machines.*
- Class 35     *Retail services connected with the sale of sports equipment, physical rehabilitation equipment, sports wear, health and fitness products, yoga equipment and apparatus, gymnasium sports equipment, resistance training equipment.*

2. The application was published for opposition purposes on 24 April 2020.

3. The application is opposed by Beachbody, LLC (“the opponent”). The opposition was filed on 17 June 2020 under the fast track opposition procedure and is based upon Sections 5(2)(a) and (b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods and services in the application. The opponent relies upon its UK trade mark registration number 3172549, shown below, which has a filing date of 01 July 2016 and for which the registration procedure was completed on 30 September 2016:

BODI

The opponent relies upon all of the goods and services for which the earlier mark is registered, namely:

- Class 9 *Pre-recorded DVDs featuring exercise, fitness, and dietary information instruction; downloadable, interactive multimedia computer software featuring audio, audiovisual and video training information on the subject of physical exercise, physical exercise equipment, diet and nutrition, and pictures, images, text, and photos related thereto; computer application software for mobile phones, portable media players, handheld computers, namely, software for use in database management and use in electronic storage of data, in the field of exercise, fitness, dietary information and instruction; downloadable electronic game software.*
- Class 25 *Headgear; caps; hats; visors; headbands; wristbands; bathing trunks; swimwear; sports brassieres; sports gloves; hosiery; leggings; tights; socks; clothing; tee-shirts; shirts; sweatshirts; sweatpants; tops; jackets; jerseys; vests; knitwear; singlets; pants; shorts; waterproof clothing; performance sportswear; belts; underwear; underclothing; undergarments; footwear; sports footwear; sandals; slippers.*
- Class 38 *Streaming of audio, visual and audiovisual material via a global computer network; video on demand transmissions; mobile media services in the nature of electronic transmission, broadcasting and delivery of audio, video and multimedia entertainment content including text, data, images, audio, video and audiovisual files by means of the Internet, wireless communication, electronic communications networks and computer networks; Electronic transmission and streaming of digital media content for others via global and local computer networks; providing internet chatrooms, all on the subject of exercise, fitness, and dietary information and instruction.*
- Class 41 *Providing a web site featuring fitness information and on-line instruction in the field of physical exercise and tracking progress of workouts; providing fitness information via a global computer network; providing a website featuring blogs and non-downloadable publications in the nature of articles, videos,*

*brochures in the fields of exercise, fitness and nutrition; educational services and on-line educational services, namely, providing instruction in the fields of the use of exercise equipment and physical exercise, and instructional materials distributed in connection therewith; physical fitness training services, namely, tracking progress of workouts for others; entertainment services, namely, conducting contests; education and entertainment services, namely, providing a website featuring non-downloadable audio clips, video clips, musical performances, musical videos, film clips, photographs, audio visual materials and information all in the field of exercise and fitness and dietary and nutritional instruction; educational services, namely, providing web-based and classroom training in the field of the use of exercise equipment and physical fitness for certification of and continuing education for instructors and distribution of training material in connection therewith; educational services, namely, conducting classes, seminars, conferences, workshops, and field trips in the field of the use of exercise equipment and sales techniques and distribution of training material in connection therewith; membership club services, namely, providing training to members in the field of the use of exercise equipment and sales techniques; educational services, namely, offering of assessments and surveys in the field of educator training and performance for the purpose of improving teaching procedures. physical fitness training services and consultancy; providing information in the field of exercise training services and on-line educational services, namely, providing instruction in the field of nutrition, and instructional materials distributed in connection therewith; educational services, namely, providing web-based and classroom training in the field of diet and nutritional programs for certification of and continuing education for instructors and distribution of training material in connection therewith; educational services, namely, conducting classes, seminars,*

*conferences, workshops, and field trips in the field of diet and nutritional programs; membership club services, namely, providing training to members in the field of diet and nutritional programs.*

4. In its notice of opposition, the opponent claims that the applicant's use of BODI in connection with all goods and services that are related to health, fitness and nutrition is likely to cause confusion with the health, fitness and nutrition goods and services that the opponent offers.

5. The applicant filed a counterstatement denying the claims. As these are the only comments I have from the applicant, they are reproduced in full, and as written, below:

**“Despite beachbody operating in the health, fitness, exercise and nutrition industries for a number of years. We have yet to see the mark 'BODI' be associated or represented marketing wise from beachbody. We do not wish to trade in the same classes as beachbody and we will be marketing our products in a different field to Beachbody LLC and we do not see any similarities in our LOGO. Our logo and mark combined is distinctively different. Our customers recognise our brand and have never been confused when it comes to differentiating between the two brands.”**

6. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 No. 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

7. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii)

either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

8. In an official letter dated 4 November 2020, in accordance with Tribunal Practice Notice 2/2013, the parties were allowed until 18 November 2020 to seek leave to file evidence and/or request a hearing and until 4 December 2020 to provide written submissions. Neither party requested a hearing or sought leave to file evidence, and neither party elected to file written submissions and so this decision is taken following a careful perusal of the papers.

9. In these proceedings, the opponent is represented by Cozen O'Connor and the applicant is a litigant in person.

## **DECISION**

10. The opposition is based upon sections 5(2)(a) and 5(2)(b) of the Act, which read as follows:

“5(2) A trade mark shall not be registered if because -

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

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

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

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.- (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) a European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

12. Given its filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this earlier trade mark had not been registered for more than five years at the date the application was filed, it is not subject to the proof of use provisions contained in section 6A of the Act. The opponent is, therefore, entitled to rely upon it in relation to all of the goods and services indicated without having to prove that genuine use has been made of it. Although the applicant claims that it has not seen any evidence of the earlier mark in use by the opponent. This is not relevant for these proceedings.

13. Although the UK has left the European Union, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. Therefore, this decision contains references to the trade mark case-law of the European courts.

### **Section 5(2)(a) –**

14. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where,

viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

15. The contested mark contains a device which will, in my view, not go unnoticed by the average consumer. Therefore I find that the marks are not identical and the opposition under section 5(2)(a) fails.

### **Section 5(2)(b) –**

16. 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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:

(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 greater 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 to mind the earlier mark, 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**

17. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, Case C-39/97, the CJEU 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”.

18. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) 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;

(f) 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.”

19. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) 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”.

20. In *Sanco SA v OHIM*, Case T-249/11, the General Court 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 Amalia Mary Elliot v LRC Holdings Limited* BL-O-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.”

21. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

22. The goods and services to be compared are:

Opponent's goods and services	Applicant's goods and services
<p><u>Class 9</u>  <i>Pre-recorded DVDs featuring exercise, fitness, and dietary information instruction; downloadable, interactive multimedia computer software featuring audio, audiovisual and video training information on the subject of physical exercise, physical exercise equipment, diet and nutrition, and pictures, images, text, and photos related thereto; computer application software for mobile phones, portable media players, handheld computers, namely, software for use in database management and use in electronic storage of data, in the field of exercise, fitness, dietary information and instruction; downloadable electronic game software.</i></p>	
<p><u>Class 25</u>  <i>Headgear; caps; hats; visors; headbands; wristbands; bathing trunks; swimwear; sports brassieres; sports gloves; hosiery; leggings; tights; socks; clothing; tee-shirts; shirts; sweatshirts; sweatpants; tops; jackets; jerseys; vests; knitwear; singlets; pants; shorts; waterproof clothing; performance sportswear; belts; underwear; underclothing; undergarments; footwear; sports footwear; sandals; slippers.</i></p>	
	<p><u>Class 27</u>  <i>Gymnasium mats, yoga mats, wrestling mats.</i></p>
	<p><u>Class 28</u>  <i>Sports equipment, rehabilitation equipment resistance bands, medicine balls, exercise</i></p>

	<i>bike, weights, weight machines, treadmill, step machine, rowing machine, cross trainer, cardio machines.</i>
	<p><u>Class 35</u></p> <p><i>Retail services connected with the sale of sports equipment, physical rehabilitation equipment, sports wear, health and fitness products, yoga equipment and apparatus, gymnasium sports equipment, resistance training equipment.</i></p>
<p><u>Class 38</u></p> <p><i>Streaming of audio, visual and audiovisual material via a global computer network; video on demand transmissions; mobile media services in the nature of electronic transmission, broadcasting and delivery of audio, video and multimedia entertainment content including text, data, images, audio, video and audiovisual files by means of the Internet, wireless communication, electronic communications networks and computer networks; Electronic transmission and streaming of digital media content for others via global and local computer networks; providing internet chatrooms, all on the subject of exercise, fitness, and dietary information and instruction.</i></p>	
<p><u>Class 41</u></p> <p><i>Providing a web site featuring fitness information and on-line instruction in the field of physical exercise and tracking progress of workouts; providing fitness information via a global computer network; providing a website featuring blogs and non-downloadable publications in the</i></p>	

*nature of articles, videos, brochures in the fields of exercise, fitness and nutrition; educational services and on-line educational services, namely, providing instruction in the fields of the use of exercise equipment and physical exercise, and instructional materials distributed in connection therewith; physical fitness training services, namely, tracking progress of workouts for others; entertainment services, namely, conducting contests; education and entertainment services, namely, providing a website featuring non-downloadable audio clips, video clips, musical performances, musical videos, film clips, photographs, audio visual materials and information all in the field of exercise and fitness and dietary and nutritional instruction; educational services, namely, providing web-based and classroom training in the field of the use of exercise equipment and physical fitness for certification of and continuing education for instructors and distribution of training material in connection therewith; educational services, namely, conducting classes, seminars, conferences, workshops, and field trips in the field of the use of exercise equipment and sales techniques and distribution of training material in connection therewith; membership club services, namely, providing training to members in the field of the use of exercise equipment and sales techniques; educational services, namely,*

*offering of assessments and surveys in the field of educator training and performance for the purpose of improving teaching procedures. physical fitness training services and consultancy; providing information in the field of exercise training services and on-line educational services, namely, providing instruction in the field of nutrition, and instructional materials distributed in connection therewith; educational services, namely, providing web-based and classroom training in the field of diet and nutritional programs for certification of and continuing education for instructors and distribution of training material in connection therewith; educational services, namely, conducting classes, seminars, conferences, workshops, and field trips in the field of diet and nutritional programs; membership club services, namely, providing training to members in the field of diet and nutritional programs.*

23. The opponent submits that the goods and services in the application include those that it offers, but it does not make any more detailed submissions. In making my comparisons, I have taken account of the case law on construing terms in specifications.

24. 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."

25. In *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), Arnold LJ set out the following summary of the correct approach to interpreting broad and/or vague terms:

"...the applicable principles of interpretation are as follows:

- (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.
- (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.
- (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.
- (4) A term which cannot be interpreted is to be disregarded."<sup>1</sup>

## Class 27

26. The applicant's goods under Class 27, being "*Gymnasium mats, yoga mats, wrestling mats*" are likely to be used for the purposes of maintaining and improving

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<sup>1</sup> Paragraph 56



health and fitness, as would the opponent's goods such as "*performance sportswear*". The respective users of the goods will be the same, being those with an interest in health and fitness. However, the physical natures of the goods are dissimilar, as is the method of use. The respective goods are not considered to be in direct competition with each other. In my view, there is an overlap in trade channels with the respective goods being sold through a sport and fitness retailers or through a department store or a 'catalogue' retailer where they are likely to be found in relatively close proximity to each other. Balancing the similarities and the differences, I consider the applicant's Class 27 goods to be similar to a low degree to the opponent's "*performance sportswear*".

### Class 28

27. The applicant's goods in Class 28 will again be used for the purposes of maintaining and improving health and fitness. As before, there is an overlap in the intended purpose of the opponent's goods and services such as "*downloadable, interactive multimedia computer software featuring audio, audiovisual and video training information on the subject of physical exercise, physical exercise equipment, diet and nutrition, and pictures, images, text, and photos related thereto*". I consider the physical nature of the goods different and they are not in direct competition with each other. However there is a degree of complementarity between them as the opponent's goods include software featuring information on physical exercise equipment and, in my view, the average consumer may assume that the goods are provided by the same undertaking or ones that are economically linked. There may be an overlap in the respective trade channels, but this is unlikely to be large. In light of the above considerations, I find that the goods are similar to a low degree.

### Class 35

28. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

29. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*, and *Assembled Investments (Proprietary) Ltd v. OHIM*, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;
- iii) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

30. It is clear from this case law that in all instances where the applicant's retail services are to be compared with the opponent's goods, the retail services will be different in nature, purpose and method of use to those goods. However, where there is some complementarity and shared trade channels, retail services may be similar to goods. It is equally clear that a finding of complementarity does not necessarily mean that they goods and retail services are similar, if the consumer would find it unlikely for them to be offered by the same undertaking. I also note that I must not treat the retail services as goods, although consideration of the retail services normally associated with the opponent's goods should be made.

31. The term "sports wear" in the applicant's specification of "*retail services connected with the sale of sports wear*" encompasses goods which may be considered identical to the "*sports brassieres; sports gloves; performance sportswear; sports footwear*" of the earlier mark. The users are for the most part identical, although it is possible to consume retail services while purchasing goods for someone else to use. The applicant's services cannot be supplied without the goods, and so they will share trade channels. As the goods are indispensable to the services, I find them to be complementary to the extent that the average consumer will assume that they are offered by the same undertaking. Taking all factors into account, I find that there is a medium degree of similarity between the applicant's "*retail services connected with the sale of sports wear*" and the opponent's "*sports brassieres, sports gloves, performance sportswear and sports footwear*".

32. In the same way, the term "health and fitness products" in the applicant's "*retail services connected with the sale of health and fitness products*" covers several goods in the opponent's specification, such as "*Pre-recorded DVDs featuring exercise, fitness, and dietary information instruction*". For the reasons set out above, I consider them to be similar to a medium degree.

33. The applicant's "*Retail services connected with the sale of sports equipment, gymnasium sports equipment, resistance training equipment*" relate to more specific categories of goods than the ones I have considered in the previous paragraph. The opponent's specification includes goods providing information on exercise and fitness, such as "*Pre-recorded DVDs featuring exercise, fitness, and dietary information instruction*". The intended users are the same and there will be shared trade channels. In my view, there is a degree of complementarity as the retail of sports, gymnasium and resistance training equipment is important for the use of the opponent's goods. While I find that "*Retail services connected with the sale of sports equipment, gymnasium sports equipment, resistance training equipment*" is slightly further removed from the opponent's goods than the retail services I have considered in the previous two paragraphs, I find them to be similar to "*Pre-recorded DVDs featuring exercise, fitness, and dietary information instruction and computer software in the field of exercise, fitness, dietary information*" and instruction to a low degree.

34. The same reasoning applies in the case of the applicant's "*Retail services connected with yoga equipment and apparatus*", and I find them to be similar to a low degree to the opponent's "*DVDs featuring exercise, fitness, and dietary information instruction and computer software in the field of exercise, fitness, dietary information and instruction*".

35. In my view, the natural and ordinary meaning of "*Retail services connected with the sale of physical rehabilitation equipment,*" includes the retail of equipment that will be used by the consumer to aid recovery from a physical injury. The opponent's Class 9 goods may include those that provide information on the physical exercise that can be done in these circumstances. To my mind, the bringing together of physical rehabilitation equipment may be done by the retailer with consideration of the information available to the consumer on their use. I find there to be a low degree of similarity between these services and the opponent's Class 9 goods.

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

36. 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. I must then

decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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”.

37. 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*.

38. The average consumer of the goods and services at issue is a member of the general public with an interest in health and fitness. They may also be a professional such as a trainer, owner of gymnasiums or physical therapist.

39. The goods are sold through a range of channels, including retail premises such as specialist sports retailers, department stores, and online. In retail stores, goods such as exercise mats will be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a web page. In these circumstances, visual considerations will dominate the process. For larger equipment, while the goods such as treadmills and rowing machines may be available to view on display, giving rise to visual deliberations, they will often be stored behind the counter and the consumer will need to make a request to purchase them.

40. Considered overall, the selection process will, in my view, be a predominantly visual one, although aural considerations will play their part and may include verbal recommendations from a sports equipment specialist. The goods at issue are relatively inexpensive for sports mats and moderately expensive for treadmills and exercise bikes and the like, both types of goods being purchased fairly infrequently by the general public, if not as a one-time purchase. However, the average consumer will wish to ensure they are selecting, for example, the correct type of equipment for their needs and budget, and they will, in my view, pay a medium degree of attention to their selection.

41. When using the retail services at issue, the average consumer will make their choice based on the range of goods available and prices charged, customer services offered, and other factors, for example in the case of bricks and mortar retailers the location of a shop. The visual element will be important, as they see the mark used on signage and advertising, both in print and online. However, I do not discount the aural element, as word-of-mouth recommendations may play a part in the choice. These are services that the consumer will be using because they wish to purchase the goods stocked and are unlikely to be used on an everyday basis. Overall, it is my view that the average consumer who is a member of the general public will be paying a medium degree of attention when choosing the retail services.

42. The professional consumer will purchase the goods and use the services more frequently and will wish to ensure that the goods are fit for purpose and that they are of a standard commensurate with the reputation of their business as well as their budget. They are therefore likely to pay a medium to high degree of attention to their selection.


### **Comparison of marks**

43. 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.”

44. 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. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
<b>BODI</b>	

45. The opponent's trade mark consists of the word "BODI" presented in a standard font and capital letters without any other elements to contribute to the overall impression. The overall impression conveyed by the mark therefore rests in the word itself.

46. The applicant's mark consists of a number of components. The mark is presented in monochrome with the letters B D and I in large black capitals in a fairly standard font. However the letter "O" is replaced by a device element that is likely to be seen as a person with outstretched arms, holding on to a circle which could be

perceived as a hoop. The mark would still, in my view, be read as “BODI”, and I consider that this word would make the greater contribution to the overall impression of the mark, although the device is not negligible and would also play a part. The word and device are contained within black stripes at the top and bottom of the mark. In my view, these elements are banal and do not contribute to the overall impression of the mark.

### **Visual comparison**

47. Both parties’ trade marks consist of the same four letters B O D I, while the applicant’s mark contains the additional figurative elements as previously described, resulting in what I find to be at least a medium degree of visual similarity between the two marks.

### **Aural comparison**

48. In whichever way the average consumer would pronounce “BODI”, they are likely to do so identically for each of the marks. As the figurative elements within the applicant’s mark would not be articulated, I find the competing marks to be aurally identical.

### **Conceptual comparison**

49. A proportion of consumers may see the word “BODI” in the earlier mark as an invented word, and to those consumers the word would hold no conceptual identity. However, other consumers may perceive the word as a mis-spelling of the word “BODY”. The concept of “body” may be reinforced by the image in the applicant’s mark, and for those consumers who see the word “BODI” in the earlier mark as a mis-spelling, the marks will be conceptually identical.

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

50. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by



reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

51. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

52. As the opponent has filed no evidence regarding the distinctiveness of the earlier trade mark, I have only the inherent characteristics of its trade mark to consider. The opponent's trade mark has no dictionary defined meaning, and may be perceived by some consumers as an invented word. However, in the context of the goods and services for which it is registered, I consider it to be more likely that the mark will be seen as a mis-spelling of the word 'body'. This being so, while not directly describing a characteristic of the goods and services, it suggests that those goods and services are to be used in connection with the body. Because of the unusual spelling, I find the earlier mark to be inherently distinctive to a medium degree.

### **Likelihood of confusion**

53. There is no simple formula for determining whether there is a likelihood of confusion. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind.

54. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them 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 vice versa (*Canon* at [17]). In making my assessment, I must consider the various factors from the perspective of the average consumer, bearing in mind 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 (*Lloyd Schuhfabrik* at [26]).

55. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related. The distinction between these was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

56. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

57. Earlier in this decision, I found that:

- The average consumer is a member of the general public with an interest in health and fitness or a sport and exercise specialist or rehabilitation practitioner who, whilst not ignoring aural considerations, will select the goods and services at issue by predominantly visual means whilst paying at least a medium degree of attention during that process;
- The competing trade marks are visually similar to a medium degree and are aurally identical;
- Some consumers would see “BODI” as a mis-spelling of the word “BODY”, and so would find the competing marks to be conceptually identical, while for other consumers the earlier mark would be considered an invented word with no conceptual identity;
- For those consumers who see the earlier mark as an invented word it will have a high degree of distinctive character, whereas for other consumers who see a mis-spelling, the opponent’s trade mark is possessed of a medium degree of distinctive character.
- Whilst not identical, the goods and services of the marks are similar to at either a medium or low degree.

58. In its counterstatement, the applicant claimed that the parties’ goods and services would be marketed in different fields. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

59. Neither party has filed any evidence to show how the goods and services would be marketed, but, even if they had, I must make my assessment based on how they might fairly be used now or in the future.

60. In its counterstatement, the applicant states that “Our customers recognise our brand and have never been confused when it comes to differentiating between the two brands.” However absence of evidence of confusion does not necessarily mean an absence of actual confusion.

61. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“80. ....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

62. It is settled case-law that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind. While it is not always the case, a word is likely to be more memorable for the average consumer. In my view, they would be likely to recall the word BODI but be less certain about whether there was a figurative element or not. In my view, this would be the case even where the goods and/or services are similar only to a low degree. I find that there is a likelihood of direct confusion.

63. In case I am wrong in this, I will consider whether there might be a likelihood of indirect confusion. Here the average consumer recognises that the marks are different but assumes that the goods and/or services are the responsibility of the same or connected undertakings. In my view, given that both marks share the same unusual spelling, it is likely that the average consumer would assume that the applied-for mark is a refresh of the opponent's mark. I find that there is a likelihood of indirect confusion.

## **Outcome**

64. The opposition has succeeded and, subject to any successful appeal, the application will be refused.

## **Costs**

65. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in fast track opposition proceedings are governed by Tribunal Practice Notice ("TPN") 2 of 2015. Applying the guidance in that TPN, I award the opponent the sum of £300, which is calculated as follows:

Official fee:	£100
Filing a notice of opposition:	£200
<b>Total:</b>	<b>£300</b>

66. I therefore order My Bodi 87 Limited to pay to Beachbody, LLC the sum of £300. This sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 25th day of January 2021**

**Suzanne Hitchings  
For the Registrar,  
the Comptroller-General**