

BL O/747/22

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK REGISTRATION No. 3552453

IN THE NAME OF  
BODY EVOLUTION LTD

FOR THE TRADE MARK:



IN CLASS 28

-AND-

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER No. 503866

BY

POCKET MEDIA (UK) LTD

## **Background and pleadings**

1. Body Evolution Ltd (“**the Proprietor**”) is the owner of the registered UK trade mark shown below (“**the Contested Mark**”).<sup>1</sup> Details of the registration are as follows:

Contested Mark:



Filing date: 5 November 2020

Registration date: 19 March 2021

Goods: Class 28

*Dumbbells; weight plates; kettlebells; barbells; gym equipment.*

2. On 13 April 2021, Pocket Media (UK) Ltd (“**the Applicant**”), applied to have the Contested Mark declared invalid under section 47 of the Trade Marks Act 1994 (“**the Act**”). The application is based on section 5(2)(b) of the Act and is directed against all of the goods for which the Contested Mark is registered.

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<sup>1</sup> See my paragraph 39 with regards to the representation of the Proprietor’s mark.

3. The Applicant relies on its earlier UK trade mark registration shown below (“**the Earlier Mark**”). Details of the registration are as follows:

Earlier Mark:



Filing date: 13 July 2018  
Registration date: 12 October 2018  
Goods: Class 25

*Sport coats; Sport shirts; Sport shoes; Sport stockings; Sports [Boots for -]; Sports bibs; Sports bras; Sports caps; Sports caps and hats; Sports clothing; Sports clothing [other than golf gloves]; Sports footwear; Sports garments; Sports headgear [other than helmets]; Sports jackets; Sports jerseys; Sports jerseys and breeches for sports; Sports over uniforms; Sports overuniforms; Sports pants; Sports shirts; Sports shirts with short sleeves; Sports shoes; Sports singlets; Sports socks; Sports vests; Sports wear; Sportswear.*

Class 28

*Fitness exercise machines; Sport balls; Sport hoops; Sportballs; Sporting articles and equipment; Sports balls; Sports bows [archery]; Sports equipment; Sports games; Sports training apparatus.*

4. The Applicant relies upon all the goods for which its mark is registered and claims that the Contested Mark is similar to the Earlier Mark and that the respective goods are identical or similar, giving rise to a likelihood of confusion.
5. The Applicant’s mark is an earlier trade mark, in accordance with section 6 of the Act. As it had not been registered for five years or more at the filing date of the application for invalidity, it is not subject to the use requirements specified within section 47 of the Act. Consequently, the Opponent may rely upon all of the goods for which the Earlier Mark is registered without having to show any use at all.

6. The Proprietor filed a counterstatement denying the claims made.
7. Only the Proprietor elected to file written submissions, which I will refer to during this decision to the extent that it is considered appropriate or necessary. No hearing was requested and I therefore make this decision following a careful perusal of the papers.
8. Neither party has professional legal representation in these proceedings.
9. Although the UK has left the EU, 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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

### **Preliminary issues**

#### **Assignment of the Contested Mark**

10. At the time the invalidation action was filed, the Contested Mark was registered in the name of Lee Brady. The ownership of the Contested Mark has since transferred to Body Evolution Ltd and the effective date of that assignment was 12 May 2021. Body Evolution Ltd, as the new proprietor, confirmed that it is aware of and accepts liability for costs for the whole proceedings, in the event that the application is successful.<sup>2</sup>

#### **Appendices accompanying Form TM26(I)**

11. The Applicant's Form TM26(I) '*Application to declare invalid a registration or a protected international trade mark (UK)*' was filed with four supporting Appendices. Whilst no formal evidence has been submitted by the Applicant, the Appendices have nonetheless entered into proceedings via Form TM26(I) which was verified by a statement of truth.

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<sup>2</sup> The Proprietor confirmed this in its email, dated 25 June 2021, in response to the Registry's official letter of 23 June 2021.

12. I have carefully reviewed the Appendices, which relate to the parties' selling their goods on the online marketplace *www.amazon.co.uk*, and legal correspondence between the parties. I do not consider this material relevant to the decision task before me and I make no further reference to it.

### Acquiescence

13. The Proprietor has intimated that the Applicant has acquiesced to its use of the Contested Mark by not having opposed its trade mark application to register it. This suggestion is misconceived since the Act expressly provides that a registered trade mark may be declared invalid; this does not require the initial application to have been opposed. Section 48 of the Act does deal with the possibility of acquiescence, but that provision cannot assist the Proprietor since the provision requires use of a registered trade mark for a continuous period of five years, whereas the Contested Mark was registered only in 2021.

## **DECISION**

### **Legislation and Case Law**

14. Section 5(2)(b) of the Act reads as follows:

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

[...]

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

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

15. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG &*

*Adidas Benelux BV, Case C-425/98, Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.*

- (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 the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

**Comparison of goods**

16. My comparison between the respective parties' goods, for the purposes of this application, must be based on what the specifications cover (i.e. what the marks are registered for), rather than what the parties are actually selling. Therefore I am required to interpret the respective specifications in order to determine whether they are identical and/or similar to each other.

17. The goods to be compared are:

<b>Applicant's goods</b>	<b>Proprietor's goods</b>
<p><u>Class 25</u></p> <p><i>Sport coats; Sport shirts; Sport shoes; Sport stockings; Sports [Boots for -]; Sports bibs; Sports bras; Sports caps; Sports caps and hats; Sports clothing; Sports clothing [other than golf gloves]; Sports footwear; Sports garments; Sports headgear [other than helmets]; Sports jackets; Sports</i></p>	

<i>jerseys; Sports jerseys and breeches for sports; Sports over uniforms; Sports overuniforms; Sports pants; Sports shirts; Sports shirts with short sleeves; Sports shoes; Sports singlets; Sports socks; Sports vests; Sports wear; Sportswear.</i>	
<u>Class 28</u>  <i>Fitness exercise machines; Sport balls; Sport hoops; Sportballs; Sporting articles and equipment; Sports balls; Sports bows [archery]; Sports equipment; Sports games; Sports training apparatus.</i>	<u>Class 28</u>  <i>Dumbbells; weight plates; kettlebells; barbells; gym equipment.</i>

18. “*Fitness exercise machines*” in the Applicant’s Class 28 specification falls within the general category of “*gym equipment*” in the Proprietor’s Class 28 specification. These goods are identical on the principle outlined in the case of *Gérard Meric*,<sup>3</sup> in which the General Court held to the effect that, goods can be considered as identical when the goods designated by the earlier mark are included in a more general category designated by the later mark, and vice versa.
19. The remaining Class 28 terms in the contested registration, “*Dumbbells; weight plates; kettlebells; barbells*”, are all essentially the same species of goods and can collectively be categorised as ‘exercise weights’.<sup>4</sup>
20. When considering whether goods are similar, all the relevant factors relating to

<sup>3</sup> *Gérard Meric v OHIM*, Case T- 133/05

<sup>4</sup> Goods may be grouped together and addressed collectively for the purpose of comparison if the same reasoning applies – see *Separode Trade Mark* BL O/399/10, paragraph 5



the goods should be taken into account. Those factors include, inter alia:<sup>5</sup>

- (a) the physical nature of the goods;
- (b) their intended purpose;
- (c) their method of use / uses;
- (d) who the users of the goods are;
- (e) the trade channels through which the goods reach the market;
- (f) where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
- (g) whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put the goods in the same or different sectors)

or

- (h) whether they are complementary to each other. 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”*.<sup>6</sup> I note that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between the goods.<sup>7</sup>

21. My interpretation of *“sports training apparatus”* in Class 28 of the Applicant’s specification, is that it encompasses articles and equipment needed for the purpose of physical exercise. Training for a particular sport involves playing/practising a sport such that the *“sports training apparatus”* could include

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<sup>5</sup> See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v. James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the *“Treat”* case

<sup>6</sup> *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82

<sup>7</sup> *Kurt Hesse v OHIM*, Case C-50/15 P

any apparatus necessary to play that sport (e.g. balls, rackets, clubs etc). However, in my view it also involves supportive training to aid strength and improve fitness and performance, which would require ‘workouts’ (the word ‘training’ and ‘workout’ can be used synonymously and ‘workout’ is defined as ‘a period of physical exercise or training’<sup>8</sup>). Therefore, the “*sports training apparatus*” could also include apparatus that would typically be used for such ‘workouts’/ ‘training’. ‘Exercise weights’ would be a type of such apparatus.

22. With the above in mind, the ‘exercise weights’ in the Proprietor’s specification fall within the general category of “*sports training apparatus*” in the Applicant’s specification, and can therefore be deemed identical on the principle outlined in the case of *Gérard Meric*. In the alternative, they can at least be deemed highly similar; this is because they overlap in nature and purpose as they are both apparatus used for physical exercise. There is overlap in method of use and user; there would also be overlap in trade channels as the same undertakings would sell the respective goods. There may also be a degree of competition between them as a consumer may select a specific training aid that is adapted for a particular sport, above generic ‘exercise weights’ and vice versa. The goods are also complementary, as ‘exercise weights’ will complement other apparatus used for sports training.
23. I have found that the Proprietor’s Class 28 goods are identical to the Applicant’s Class 28 goods (or in the alternative, partly identical and partly highly similar). For reasons of procedural economy, I will not undertake a detailed comparison between the Applicant’s goods in Class 25 and the Proprietor’s goods in Class 28, but note that the Class 25 sporting clothing may be considered to have a degree of similarity based on elements such as user and trade channels, but the goods are different in nature and purpose and the similarity overall is low.

#### **Average consumer and the nature of the purchasing act**

24. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods in question. It is the

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<sup>8</sup> See the entry for ‘workout’ contained in the Collins English Dictionary ([www.collinsdictionary.com](http://www.collinsdictionary.com))

perception of the marks in the mind of the average consumer that plays a decisive role in the appreciation of the likelihood of confusion.

25. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word “average” merely denotes that the person is typical,<sup>9</sup> which in substance means that they are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics.<sup>10</sup>
26. It is therefore necessary to determine who the average consumer of the respective goods is, and how the consumer is likely to select those goods. It must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods in question.<sup>11</sup>
27. The average consumer of the goods at issue will be a member of the general public at large as well as businesses, organisations and/or associations (such as gyms and sports clubs i.e. ‘commercial consumers’).
28. In some instances the goods would be sold through a range of retail outlets (and their online equivalents) such as specialist sports and fitness retailers, catalogues and online marketplaces – in which case they are available to all consumers; in other instances the goods may be directed primarily at commercial consumers for example, large pieces of gym equipment made/designed especially for commercial usage rather than at-home use.
29. Depending on the size of the goods, they are likely to be displayed on shelves or in dedicated display areas where they can be viewed and self-selected by the consumer. A similar process will apply online and with catalogues where the consumer will select the goods having viewed an image of the goods displayed on a webpage/page. The selection of the goods is therefore primarily visual, although I do not discount that aural considerations may play a part by way of word-of-mouth recommendations and advice from sales assistants. However,

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<sup>9</sup> *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), paragraph 60

<sup>10</sup> *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

<sup>11</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

even where the goods are selected by making requests to staff, the selection process prior to purchase would be visual in nature. Accordingly, visual considerations dominate.

30. The goods vary in terms of functionality and as a result of this, they can range from affordable, inexpensive small items to large, relatively expensive apparatus. The purchase of the goods will be infrequent as the goods will tend to have a long life-span/ durability and will only need to be replaced occasionally. The purchase is therefore likely to be somewhat considered rather than casual.
31. When purchasing the goods, the average consumer is likely to take into account such things as functionality, purpose, quality, durability, weight and size. Whether the goods are expensive or relatively inexpensive, the average consumer is likely to pay more attention in the purchasing process to ensure that the goods meet their specific needs and requirements. I think these considerations will apply whether the consumer is buying the goods for their own personal use or whether they are for commercial use. Where the goods are more expensive, the degree of attention paid in the selection and purchasing of them is only likely to increase, but for the most part, the average consumer will pay a medium degree of attention.

### **Comparison of marks**

32. It is clear from established case law that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.<sup>12</sup> The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks in the mind of the average consumer, bearing in mind the distinctive and dominant components of the marks.<sup>13</sup> Then, in light of the overall impression, and all factors relevant to the circumstances of the case, it is necessary to assess the likelihood of confusion.<sup>14</sup>



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<sup>12</sup> *Sabel BV v. Puma AG*, Case C-251/95, paragraph 23

<sup>13</sup> *Ibid.*

<sup>14</sup> *Bimbo SA v OHIM*, Case C-591/12P, paragraph 34

33. It would be wrong, therefore, to dissect the trade marks artificially, 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.
34. The respective trade marks are shown below:

Earlier Mark	Contested Mark
	

Overall impression

35. The Earlier Mark is a figurative mark which is composed of the words 'BODY' in black and 'REVOLUTION' in red, presented in lowercase letters in a stylised font. The word 'BODY' is encircled with a red device consisting of four contorted triangular shapes.

36. The word 'BODY' is the only element of the Earlier Mark that is black which places it in contrast to the rest of the mark. The device creates separation between the two word elements of the mark and also places a degree of emphasis on the word 'BODY'. Whilst the device and the word 'BODY' in combination are a prominent feature within the Earlier Mark, I do not consider they dominate the overall impression created by the mark. Being a longer word, 'REVOLUTION' also has prominence within the mark and the fact that it is also in red makes it stand out.
37. Whilst all the elements making up the mark (i.e. the word elements, the stylised get-up and the figurative device) contribute to its overall impression, it is the word elements, 'BODY REVOLUTION', that dominate that overall impression, since the word elements make up the majority of the components of the mark and since, generally speaking, the mind of the average consumer 'latches on' to them, and it is the word elements that the average consumer will use to identify the mark.
38. In that regard, it should be noted that, *"according to well-established case-law, in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements"*.<sup>15</sup>
39. I now turn to the overall impression of the Contested Mark, which is a figurative mark. It appears that when the Proprietor submitted its image of the mark for registration, it supplied an image of a screen-shot taken from an electronic device (such as a mobile phone) – which is apparent from the large portrait-orientated grey box, with a dark line at the bottom, surrounding the mark text. It is reasonable to assume that the Proprietor's intention was for the mark to only comprise of the text that runs through the middle of the mark, and that the grey box represents unintentional matter. Either way, for all intents and purposes, the

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<sup>15</sup> *Migros-Genossenschafts-Bund v EUIPO – Luigi Lavazza (CReMESPRESSO)*, Case T-189/16, paragraph 52

grey box surrounding the text and the dark underline at the bottom of the box are negligible and they do not contribute to the overall impression of the mark.

40. The remainder of the mark consists of the text 'BODYEVOLUTION' which is made up of the conjoined words 'BODY' and 'EVOLUTION', presented in a stylised black font on a white background, although this stylisation is quite subtle. Reading left to right, the font lines start off thin and become progressively thicker towards the end with 'LUTION' being the most notably emboldened letters. It is the word element 'BODYEVOLUTION' that dominates the overall impression created by the mark.

#### Visual comparison

41. The marks coincide in their word elements. Both marks share the exact same sequence of letters, 'BODY\_EVOLUTION'. The Earlier Mark consists of 14 letters and the Contested Mark of 13 letters, there being only one letter difference between them, which is the letter 'R', the Earlier Mark also contains a space after the letter 'Y' which the Contested Mark does not. However, these differences occur towards the middle of the marks and given that generally speaking, a consumer's attention tends to focus on the first part of a word/words,<sup>16</sup> the presence of the same beginning, 'BODY', gives rise to a strong visual similarity between the marks, which is then reinforced by the subsequent presence of the identical sequence of letters 'EVOLUTION'.
42. The device in the Earlier Mark represents a point of visual difference between the marks. The Earlier Mark is presented in black and red whereas the later mark is presented in black and white, and the word elements of the marks are presented in different stylised fonts, which are further visual points of difference between the marks. However, the difference in font (which is a decorative element in both marks) does not detract from the similarity of the word elements. Further, notwithstanding that the words are conjoined in the Contested Mark, and distinctly separated in the Earlier Mark, this difference is insufficient to remove

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<sup>16</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paragraph 81

the identity with regards to the word 'BODY' and a high visual similarity between the words 'REVOLUTION' and 'EVOLUTION'.

43. The word elements are visually highly similar, but because the marks differ visually in their get-ups, I consider them to be visually similar overall to a medium degree.

#### Aural comparison

44. Both marks share the common element 'BODY' and the letter sequence 'EVOLUTION'. 'BODY' is pronounced identically in both marks. In that respect, it should again be emphasised that generally speaking, the attention of the consumer is usually directed to the beginning of the word/words,<sup>17</sup> though this is no more than a rough rule of thumb. I do not think that the conjoining of the word 'BODY' with the word 'EVOLUTION' in the Contested Mark will alter the way it is pronounced overall; the average consumer will see the natural break and pronounce the words as though they are separate.
45. 'REVOLUTION' is pronounced as 'REH-VUH-LOO-SHUN'. However, 'EVOLUTION', can be pronounced in two different ways, being either 'EH-VUH-LOO-SHUN' – where the 'E' is pronounced as 'EH' (the same as in 'REVOLUTION'), and the other is 'EE-VUH-LOO-SHUN' – as though there is a double 'EE'. The 'VOLUTION' in both marks is pronounced identically.
46. Whichever way 'EVOLUTION' is pronounced, I consider the marks to be aurally highly similar, even more so if it is pronounced as 'EH-VUH-LOO-SHUN'.

#### Conceptual comparison

47. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>18</sup> The parties have made no submissions as to the concept of their respective marks. The words 'BODY', 'REVOLUTION' and 'EVOLUTION' are all ordinary common words with dictionary definable meanings

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<sup>17</sup> *El Corte Inglés*, paragraph 83

<sup>18</sup> This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R. I-643; [2006] E.T.M.R. 29.



and I think the average consumer will understand the word (i) 'BODY' as referring to a person's physique, (ii) 'REVOLUTION' as meaning a radical, relatively sudden, extreme change; or to mean a full circular motion; and (iii) 'EVOLUTION' as meaning a process of gradual change or development that is achieved over time.

48. The device in the Earlier Mark, which is formed of triangular shapes arranged in a circular pattern, appears to be a graphical representation of movement swooshes and it gives the impression of circular movement i.e. of 'revolution', although this may not be immediately grasped by the average consumer.
49. The stylisation of the letters in the Contested Mark, where the letters go from thin-lined to gradually thicker and emboldened, appear to emulate the ordinary meaning of the word 'EVOLUTION', where change is gradual, although this is subtle and may not be immediately grasped by the average consumer or indeed may even be overlooked.
50. Both marks share the common concept attached to the word 'BODY'. Notwithstanding 'REVOLUTION' essentially means a 'radical' change and 'EVOLUTION' means a 'gradual' change, when used in conjunction with the word 'BODY', it is my opinion that the overriding concept conveyed by both marks is that of 'change' to a person's body or physique, and it is this concept that the average consumer will immediately grasp and is likely to keep in mind. For this reason, I consider the marks to share a similar concept.

### **Distinctive character of the Earlier Mark**

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 used as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings.<sup>19</sup>

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<sup>19</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22; see also to that effect *Windsurfing Chiemsee v Huber and Attenberger* [1999] ETMR 585 (joined Cases C-108/97 and C-109/97) paragraph 49

52. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
53. The level of distinctive character is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. Simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask, 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.<sup>20</sup>
54. The Applicant makes no claim to enhanced distinctiveness through the use made of the Earlier Mark, therefore I only have the inherent distinctiveness of the mark to consider.
55. The words 'BODY REVOLUTION' do not describe the goods, however they could be seen to allude to the intended purpose of the goods, for example, to revolutionise or drastically change a person's physique. Accordingly, the inherent distinctiveness of the word elements of the mark would be on the lower side as a result of this allusive nature.
56. The font used is quite plain, although there is some stylisation, including colour use, that creates visual interest. The device is suggestive of circular motion (i.e. revolution) and is quite banal even though it does have some prominence within the mark.
57. That said, the whole is greater than the sum of its parts – the device, the font, and configuration of the mark in combination, elevate the distinctiveness of the mark beyond the words only.
58. Irrespective of the allusive nature of the words, it is the pairing of these words, chosen by the Applicant for its Earlier Mark, which is somewhat distinctive in and of itself. Whilst the device, the font, and configuration of the mark in combination elevate the distinctiveness of the mark overall, it is the words 'BODY

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<sup>20</sup> *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, paragraphs 38-39

REVOLUTION' in which the distinctiveness of the mark lies, and which are also the dominant element of the mark, on which consumers will primarily rely to identify trade origin.

59. I note that even a low level of distinctiveness does not preclude a finding of a likelihood of confusion per se. In any event, the distinctive character of the Earlier Mark is not a factor which influences the perception which the consumer has of the similarity of the signs.<sup>21</sup>

### **Likelihood of Confusion**

60. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.<sup>22</sup> I must also keep in mind the average consumer of the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.<sup>23</sup>
61. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the Contested Mark with an imperfect recollection of the Earlier Mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.<sup>24</sup>
62. The question is whether there is a likelihood of confusion amongst a significant proportion of the relevant public;<sup>25</sup> occasional confusion by a small minority is not sufficient to find a likelihood of confusion. The relative weight of the factors is

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<sup>21</sup> *L'Oréal SA v OHIM*, Case C-235/05 P, paragraph 42

<sup>22</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

<sup>23</sup> *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

<sup>24</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

<sup>25</sup> *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, paragraph 34(v)

not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case.<sup>26</sup>

63. There are three sets of circumstances where a consumer may associate a later mark with an earlier mark because of the identity and/or similarity between them, the one leads to direct confusion, the second leads to indirect confusion, and in the third circumstance, there is no confusion, merely association.<sup>27</sup> Direct confusion is a simple matter of the consumer mistaking one mark for the other. Indirect confusion arises where the consumer does not simply mistake the later mark for the earlier mark, but they instead believe that the goods bearing the later mark come from the same undertaking or from an economically linked undertaking.<sup>28</sup> For example, they conclude that the later mark is another brand of the owner of the earlier mark because they share a common element.<sup>29</sup> Whilst this is a helpful explanation of the concept of indirect confusion, it is not intended to be an exhaustive definition.<sup>30</sup>
64. If on the other hand, the later mark merely brings the earlier mark to mind, there is no confusion, this is because, notwithstanding the consumer's perception of the similarities between the marks, they do not believe that the marks are from the same or economically linked undertaking and therefore are not confused.
65. I find that the factors of primacy in this case are:
- (i) the respective goods are identical (or in the alternative, partly identical and partly highly similar);
  - (ii) the word elements dominate the overall impression of both marks and there is only one letter difference between the two;
  - (iii) the marks share visual, aural and conceptual similarities;

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<sup>26</sup> See paragraph 33 of the decision of Iain Purvis QC sitting as the Appointed Person in Case No. O/049/17, (*Rochester Trade Mark*).

<sup>27</sup> See to that effect *Sabel BV v Puma AG*, Case C-251/95, paragraph 16

<sup>28</sup> *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 10

<sup>29</sup> *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16-17

<sup>30</sup> *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 12

- (iv) the purchasing process is dominated by visual considerations (and it is in the respective word elements where the visual similarities lie);
- (v) the marks have different get-ups and are therefore visually different overall however, the respective goods are identical which offsets a lesser degree of similarity between the respective trade marks; and
- (vi) when selecting the goods, the average consumer will be making a somewhat considered purchase and will therefore be displaying a medium level of attention when selecting the goods.

66. In my view, the question of likelihood of confusion must be approached on the basis that the distinctive character of the Earlier Mark lies in the combination of the two words 'BODY REVOLUTION',<sup>31</sup> and the order in which they have been paired. Having weighed all the relevant factors, I conclude that there would be a likelihood of confusion.

67. In reaching this conclusion I have kept in mind that due to imperfect recollection, it is likely that the differences between the word elements 'BODY REVOLUTION' and 'BODYEVOLUTION' may go unnoticed by the average consumer, (even where the average consumer is paying a medium degree of attention in the selection process) given that the marks would be seen on identical goods.

68. This conclusion takes into account that (i) there is only one letter difference between the two marks; (ii) both share identical beginnings and identical endings and the differences lie toward the middle; (iii) the difference in font does not detract from the similarity of the word elements; (iv) the stylisation of the Contested Mark and the conjoining of the words is such that, the difference between the words may even be completely overlooked. In this regard I note that there is a degree of visual prominence given to the letters 'LUTION' in the Contested Mark because they are emboldened, so much so that it draws the eye from the point at which the words conjoin. What's more, the conjoining of the words means that there is no visual divide between the two. These two stylistic configurations in combination mean that the eye would not focus on (and

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<sup>31</sup> See to that effect *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraph 14

therefore may overlook) that part of the Contested Mark where the visual differences between the word elements lie i.e. the spacing and the letter 'R'; (v) the words are aurally highly similar and share conceptual similarities; and (vi) generally speaking, the average consumer will keep in mind the word elements to identify the marks.

69. Aside from the single letter difference as between the 13 and 14 letters involved in the marks, the differences between the two marks can be viewed as essentially differences in 'get-up'. The chosen stylisation in the Contested Mark is subtle and conjoins the words, such that I find it insufficient to overcome the shared similarities between the marks.
70. Having concluded that there is a strong degree of visual similarity between 'BODY REVOLUTION' and 'BODYEVOLUTION' (and the difference between them may go unnoticed or may be imperfectly recalled), it is my opinion that, while the average consumer may notice the differences in get-up, those differences would be attributed to marketing considerations or a brand revamp for example,<sup>32</sup> and not be taken to denote (identical) goods from different undertakings. There is therefore a likelihood that the average consumer will mistake one mark for the other leading to a likelihood of confusion.

## **OUTCOME**

71. The declaration for invalidity succeeds in its entirety.

## **COSTS**

72. The Applicant has been successful and would ordinarily be entitled to an award of costs. However, as the Applicant had not instructed professional representatives, they were invited by the Tribunal to indicate whether they intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to bringing

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<sup>32</sup> It is not uncommon for undertakings to undergo a brand 're-fresh' or 'brand-revamp' from time to time to accommodate changes in marketing considerations such as appealing to wider audiences. Such changes are not changes in the brand name, rather a change in font or a change in colour palette, even a change to the design or the logo.

the proceedings. It was made clear by letter dated 18 May 2022 that, if the pro-forma was not completed, no costs would be awarded. The Applicant did not return a completed pro-forma to the Tribunal and, on this basis, no costs are awarded other than the official fee of £200 for the filing of the Form TM26(I).

73. I therefore order Body Evolution Ltd to pay Pocket Media (UK) Ltd the sum of £200. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an unsuccessful appeal, within twenty-one days of the appeal proceedings.

**Dated this 31<sup>st</sup> day of August 2022**

**Daniela Ferrari**  
**For the Registrar**