

O-009-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2357206
BY EXTEN FITNESS SYSTEMS LIMITED
TO REGISTER THE TRADE MARK:**

EXERGENICS

IN CLASS 28

AND

**THE OPPOSITION THERETO
UNDER NO 92665
BY IIC – INTERSPORT INTERNATIONAL CORPORATION GMBH**

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**In the matter of application no 2357206
by Exten Fitness Systems Limited
to register the trade mark:
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in class 28
and the opposition thereto
under no 92665
by IIC – Intersport International Corporation GmbH**

BACKGROUND

1) On 1 March 2004 Exten Fitness Systems Limited, which I will refer to as Exten, applied to register the trade mark **EXERGENICS** (the trade mark). The application was published for opposition purposes in the “Trade Marks Journal” on 23 April 2004 with the following specification:

gymnastic and sporting articles; apparatus for achieving physical fitness; indoor and outdoor fitness apparatus; parts and fittings for all the aforesaid goods.

The above goods are in class 28 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 19 July 2004 IIC – Intersport International Corporation GmbH, which I will refer to as Intersport, filed a notice of opposition to the registration of the application.

3) Intersport is the owner of Community trade mark registration no 2679264 of the trade mark **ENERGETICS**. The trade mark is registered, inter alia, for the following goods:

gymnastic and sporting articles included in Class 28, appliances for gymnastic, body-building apparatus, machines for physical exercises, chest expanders (exercisers), as well as weights, parts and fittings of the aforesaid goods included in Class 28, dumbbells, exercise benches, balls, rings and stretch bands for physical exercises, stationary exercise bicycles and rollers therefor, stationary rowing exercisers.

The above goods are in class 28 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

4) Intersport states that the class 28 goods of its registration are identical or similar to the goods of the application. It claims that the respective trade marks are similar. Consequently, there is a likelihood of confusion and registration of Exten’s trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

5) Exten filed a counterstatement. It denies that the respective trade marks are similar. It states that Intersport’s trade mark is a dictionary word for the properties or behaviour of something in terms of energy. It is also a plural form of the common

adjective energetic. Exten states that as a result Intersport's trade mark has a low level of distinctiveness in relation to goods for physical exercise. Exten states that its trade mark is a distinctive, invented word. It states that there is no conceptual similarity between the respective trade marks and that they are sufficiently distinctive visually and phonetically to obviate any likelihood of confusion. Exten seeks the dismissal of the opposition and an award of costs.

6) Both sides furnished evidence.

7) Both sides were advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Neither side requested a hearing. Intersport furnished written submissions.

EVIDENCE

Evidence of Intersport

8) This consists of a witness statement by Victoria Jane Martin. Ms Martin is the representative of Intersport in this case. Ms Martin's statement consists of submissions rather than evidence of fact. I would not normally give a précis of such evidence. However, as this case is being decided without oral submissions I will do so.

9) Ms Martin states that both trade marks consist of ten letters. She submits that they will be broken up into syllables in the following manner: EX-ER-GEN-ICS and EN-ER-GET-ICS. Ms Martin states that the respective trade marks only differ by two letters: EXERGENICS and ENERGETICS. She submits that whilst there are some conceptual differences between the trade marks, these are not great. Ms Martin states that whilst ENERGETIC is a dictionary word, ENERGETICS is not. She states that EXERGENICS is also an invented word, suggesting things with which to exercise. Ms Martin submits that "energy and exercise go hand in hand"; in order to exercise one has to expend energy, in other words be energetic. She submits that, consequently, the conceptual elements of the respective trade marks "although different are confusingly similar". Ms Martin submits that the conceptual elements of the trade marks are intertwining and confusing for a customer with imperfect recollection.

10) Ms Martin rehearses the specification of Intersport's trade mark and states that the goods encompassed by the trade marks are identical. Ms Martin submits that under the criteria established by the European Court of Justice (ECJ) the respective trade marks are "confusingly" similar. She submits that if a customer were to purchase a physical exercise machine under the trade mark ENERGETICS, then a few months later return to the shop to purchase some additional parts for the equipment, for example heavier weights, he might not immediately recall the name of the machine he had purchased but on seeing weights in the shop bearing the trade mark EXERGENICS could well have an imperfect recollection that his apparatus at home was an EXERGENICS machine, rather than an ENERGETICS machine. He would then purchase the incorrect weights for his apparatus, only to find when he returned home that he had bought the wrong goods. Ms Martin goes on to submit that there are

safety issues to consider when spare parts are involved and the wrong brand of spare part is purchased and fitted. She submits that if a piece of exercise equipment requires a replacement part and the customer, who need not necessarily be the user of the machine, if the purchase was a delegated task, being unsure of the exact brand of equipment, might purchase the wrong brand. The spare part may appear to fit but be lacking in some essential element to allow it to function properly, or to stay in place, or it may not be the correct strength. The spare part could fail and cause damage to the user and/or the machine.

11) Ms Martin submits that while the above are fictional examples of confusion, actual confusion between the trade marks is inevitable; bearing in mind the visual, aural and conceptual similarities between the trade marks and the identity of the goods. She submits that whilst there are visual, aural and conceptual differences between the trade marks, as indicated by the applicant in the counterstatement, the visual, aural and conceptual similarities are sufficiently strong for confusion to arise.

Evidence of Exten

12) This consists of a witness statement by Stephen John Martin Kinsey. Mr Kinsey is the representative of Exten in this case. Mr Kinsey exhibits at SJMK1 a copy of an extract from “The Concise Oxford Dictionary”. The extract includes the following:

“energetics • pl. n. the properties or behaviour of something in terms of energy”

Exhibited at SJMK2 is a copy of another extract from “The Concise Oxford Dictionary”. This extract relates to the use of the ending –genic. It advises that the ending is used in two senses: “producing or produced by” and “well suited to”. In relation to the first sense the following words are listed: abiogenic, allergenic, allogenic, authigenic, carcinogenic, cryogenics, cryptogenic, erotogenic, eugenics, hypo-allergenic, neurogenic, pathogenic and pyrogenic. In relation to the second sense the following words are listed: photogenic, telegenic, mediagenic and radiogenic.

13) Mr Kinsey states that EXERGENICS is an invented word which has been formed from the first two syllables of the word exercise in combination with the ending –genic.

DECISION

Likelihood of confusion – section 5(2)(b) of the Act

14) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“a registered trade mark, international trade mark (UK) or Community trade mark 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”

The trade mark upon which Intersport relies is an earlier trade mark as defined by the Act.

15) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

16) Intersport furnished written submissions. Intersport claims that the way in which Exten’s trade mark has been formed, from the combination of the first two syllables of the word exercise and the –genic ending, is irrelevant to whether or not the respective trade marks are “confusingly” similar.

17) Intersport states that it is clear from Mr Kinsey’s statement that Ms Martin was incorrect when she stated that ENERGETICS is not a dictionary word. It states that even if ENERGETICS is a dictionary word this does not mean that it is not a perfectly valid and distinctive trade mark. Intersport states that the comparison between the trade marks must be made on the basis of the eyes of the average consumer of the goods. Intersport submits that the average consumer of the goods concerned would not make a conceptual analysis of the two trade marks but would more likely make an aural and visual comparison of the trade marks. Intersport goes on to reiterate various submissions made in Ms Martin’s witness statement.

18) Intersport states that the products will be purchased in the marketplace by a cross-section of the public, some of whom will be highly educated and will have the intellectual capacity to compare products under the two trade marks, but the majority of whom will be less educated and, therefore, less able to distinguish between products sold under the two trade marks. Intersport goes on to submit the following:

“Would the Hearing Officer be certain that his revenue is not going to drop because of his customers buying EXERGENICS accessories for the

ENERGETICS machines they have at home by failing to see a difference between the two trade marks in a shop, or erroneously buying additional EXERGENICS machines for the same reason. It is respectfully submitted that the Hearing Officer cannot be certain and would even anticipate a sales drop that has nothing to do with normal competition on the market. So do the Opponents and this is why they oppose registration of the application.”

Comparison of goods

19) The goods of Intersport’s registration are:

gymnastic and sporting articles included in Class 28, appliances for gymnastic, body-building apparatus, machines for physical exercises, chest expanders (exercisers), as well as weights, parts and fittings of the aforesaid goods included in Class 28, dumb-bells, exercise benches, balls, rings and stretch bands for physical exercises, stationary exercise bicycles and rollers therefor, stationary rowing exercisers.

The goods of the application are:

gymnastic and sporting articles; apparatus for achieving physical fitness; indoor and outdoor fitness apparatus; parts and fittings for all the aforesaid goods.

It is clear that the goods of the application are encompassed by the goods of the registration. The goods are, therefore, identical. (I note that the recital of goods of the registration in the notice of opposition does not include the first part of the specification. However, the witness statement of Ms Martin includes the full class 28 specification. There has been no argument from Exten that the respective goods are not identical.)

Comparison of trade marks

20) The trade marks to be compared are:

Earlier trade mark:

Applicant’s trade mark:

ENERGETICS

EXERGENICS

The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 he/she is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). “The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception

of the relevant public” (the Court of First Instance (CFI) in *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02).

21) People from both sexes, of all socio-economic backgrounds and of all ages undertake sporting activities and seek physical fitness. I consider that the average consumer will be the public at large. In its submissions Intersport proposes that the consumer who should be considered should be someone who is less educated and, therefore, less able to distinguish between the products sold under the two trade marks. I do not see why or how the level of education will affect the ability to differentiate between the respective trade marks for the goods that they encompass. The submission appears also to be in direct contradiction of the judgment of the ECJ which deems the average consumer to be reasonably well informed and reasonably circumspect and observant. I am also not aware that brand consciousness and the differentiation between brands is something that is based upon educational achievements and intellectual ability. The nature of the goods is such that they are likely to be the subject of intermittent rather than regular purchases; one does not regularly replace such goods. In my own experience a reasonable degree of care is taken in purchasing such goods. The nature and the quality of the goods will, in my view, be considered; these are not the sort of goods that are likely to be the subject of impulse buying. The likely intermittent nature of the purchase will, however, make the purchaser more likely to be a victim of imperfect recollection. So, it appears to me, that the degree of care in the purchase will be balanced to some extent by the intermittent nature of the purchase.

22) Intersport appears to argue that there is a different test to be applied in this case because of safety issues. Such arguments have been put previously in relation to pharmaceuticals (see paragraphs 20-26 of decision BL O/308/03 for instance). The issue before me is whether the respective trade marks are similar and taking into account other factors, to make a global appreciation, as to whether there is likelihood of confusion. It is not my job to consider safety issues. In any case the argument is circular in its nature, there would only be issues of safety if there is a likelihood of confusion; no likelihood of confusion, no safety issue. So, I do not see that the safety argument furthers the case of Intersport. I will consider the issues of the similarity of the trade marks and any consequent likelihood of confusion on the normal basis.

23) Exten argues that EXERGENICS is an invented word formed by the first two syllables of the word exercise and the ending -genic. Intersport does not contest this. The public do not indulge in the philological analysis of trade marks. I am of the view that the average consumer will perceive the word as a whole and treat it as invented word. I do not consider that the trade mark will give rise to any conceptual association. The trade mark **might** give a notion of exercise but I consider that this would only be likely to arise if the average consumer decides to start dissecting the trade mark; which is not what the average consumer does normally. Exten has shown that ENERGETICS is a dictionary word. However, this says little. It is the effect of the word upon the average consumer that is relevant. There are many words in dictionaries that are unknown to those outside specialist fields. On the page exhibited at SJMK1 there are, inter alia, the words endophyte, endoplasm, endothelium and enduro, all of which are unlikely to be known by the public at large. In this case I do not consider that the relevant average consumer for the goods of the application will be aware of the word ENERGETICS. I certainly was not, which may well just be

symptomatic of my ignorance, and neither was spell check. Exten states that ENERGETICS is a plural form of the common adjective energetic. To the best of my knowledge and experience the English language does not have plural forms for adjectives. Nevertheless, I consider that the average consumer will associate ENERGETICS with energetic and so it will have a conceptual association with the latter word. In her witness statement Ms Martin states:

“It is submitted that energy and exercise go hand in hand. In order to exercise one has to expend energy, in other words be energetic. Thus the conceptual elements of the respective Marks EXERGENICS and ENERGETICS although different are confusingly similar.”

I am afraid that I don't understand how the conceptual elements can be different and “confusingly” similar; the statement verges upon the oxymoronic. As I have said, I consider that EXERGENICS does not have a conceptual association and ENERGETICS does. I am of the view that the trade marks are, therefore, conceptually dissimilar; as far as such a concept can exist in relation to an invented word. The conceptual dissonance is not of the most extreme kind, which arises where two words have different conceptual associations. However, the trade marks are not just conceptually not similar but are conceptually dissimilar.

24) I accept Ms Martin's submission that the trade marks should be divided into the following syllables: EX-ER-GEN-ICS and EN-ER-GET-ICS. The trade marks do only differ by two letters. This in itself matters little, in my view; two letters out of ten can make an enormous difference; it depends upon the facts of the case. Taking into account the length of the respective words, the places where the differences in the letters occur, the nature of the phonetic differences, the pattern of the letters and sounds in the words and bearing in mind the perception of the average consumer, I have come to the conclusion that the trade marks have a degree of visual and phonetic similarity.

25) Section 5(2)(b) of the Act, for a likelihood of confusion to be considered, requires that trade marks are similar. It is not a matter of whether they have similarities but whether they are similar; it will be a rare case where an opposition has been brought where there are no similarities. Without a decision that the trade marks are similar the case must fail. The global appreciation can only come into play when it has been decided that the trade marks are similar/identical and the goods/services are similar/identical. As the ECJ stated in *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models) (OHIM) C-106/03 P [2005] ETMR 23*:

“53 After making a comparative study, at paragraphs 48 to 59 of the judgment under appeal, of the two marks in the visual, aural and conceptual senses, the Court of First Instance concluded, as stated at paragraph 65 of the judgment, that the marks could in no way be regarded as identical or similar for the purposes of Article 8(1)(b) of Regulation No 40/94.

54 Having found that there was no similarity between the earlier mark and the mark applied for, the Court of First Instance correctly concluded that there was no likelihood of confusion, whatever the reputation of the earlier mark

and regardless of the degree of identity or similarity of the goods or services concerned.”

26) It is difficult to make a purely a priori judgement as to whether signs are similar. In practical terms part of the judgement will be a posteriori; taking into account all the relevant factors in relation to a global appreciation, is there a possibility of likelihood of confusion? If there is such a possibility then the trade marks are similar for the purposes of section 5(2)(b) of the Act. If there is not, they are not. This is not to state that a finding of confusion will be an automatic sequitur where the trade marks are similar; merely that, subject to there being similarity/identity of the goods/services, the global appreciation can take place and a decision as to confusion can be made on the basis of that global appreciation. Having decided that trade marks are similar it will also be necessary to consider the degree of similarity.

27) In favour of Exten’s case is the conceptual dissimilarity. The CFI in *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH* Case T-292/01 [2004] ETMR 60 held:

“54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient - where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

A conceptual dissimilarity can have an enormous effect on whether it is decided that trade marks are similar. In support of Intersport’s case there is, in my view, a good deal of phonetic and visual similarity. In considering the respective trade marks I need to consider the effects of the differences as well as the similarities (see *Croom’s Trade Mark Application* [2005] RPC 2).

28) Despite the conceptual dissimilarity I consider that the phonetic and visual similarities of the respective trade marks are such that they are similar within the meaning of section 5(2)(b) of the Act.

Conclusion

29) Intersport in its submissions refers to the potential loss of sales it could suffer from use of Exten's trade mark. This strikes me as another circular argument. The only potential loss of sales is if there is confusion; if there is no likelihood of confusion there is no likelihood of a loss of sales. So the argument put forward by Intersport does not advance its case.

30) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case the respective goods are identical. It is necessary to consider the distinctive character of the earlier trade marks; the more distinctive the earlier trade marks (either by nature or nurture) the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)* [2002] ETMR 91). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ETMR 585). In its counterstatement Exten claims that ENERGETICS has a low degree of distinctiveness in relation to goods for physical exercise. The word ENERGETICS will not be known, in my view, to the average consumer of the goods. However, the average consumer is bound to see a clear association with energetic. The goods of the earlier registration will require the expending of energy when used, however, one does not normally describe inanimate objects as being energetic; nor do I consider that one would describe the goods of the earlier registration as being energetic. Of course, the trade mark is ENERGETICS not energetic; as English does not have plural adjectives normally, the addition of the s is unusual. If ENERGETICS is allusive it is allusive at some distance, one has to go through a chain of thought: exercise equipment, the user of the exercise equipment will expend energy, the adjective from energy is energetic and Intersport's trade mark is ENERGETICS. I am of the view that in relation to the goods the trade mark ENERGETICS enjoys a good degree of inherent distinctiveness. In considering whether there is a likelihood of confusion the nature of the purchasing decision needs to be considered. As I have indicated above I am of the view that a reasonably carefully and educated purchasing decision will be made. However, also as indicated above, the intermittent nature of the purchasing decision could give rise to a greater chance for the perils of imperfect recollection to come into play; the purchaser does not compare trade marks directly. **Taking into account all of the above factors I consider that there is a likelihood of confusion and that the application should be refused in its entirety.** Whilst writing the decision I have regularly confused which trade mark belongs to which undertaking. This has not, in any way, been determinative of my decision but certainly is indicative of the likelihood of confusion.

COSTS

31) IIC – Intersport International Corporation GmbH having been successful is entitled to a contribution towards its costs. I order Exten Fitness Systems Limited to pay IIC – Intersport International Corporation GmbH the sum of £1050. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of January 2006

**David Landau
For the Registrar
the Comptroller-General**