

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2205160
BY MR R ST. CLAIR
TO REGISTER A TRADE MARK IN CLASS 41**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 50542
BY NCP MARKETING GROUP INC**

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in Class 41**

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**IN THE MATTER OF Opposition thereto
under No. 50542
by NCP Marketing Group Inc**

BACKGROUND

1. On 6 August 1999, Mr R St Clair applied to register the trade mark “TY-BO” in respect of the following goods:

Class 41:

“Training, practical training; all relating to martial arts, floor and air movements”.

2. On the 22 December 1999, NCP Marketing Group Inc, filed notice of opposition. The grounds of opposition are under section 5(2)(b) of the Trade Marks Act 1994, in that the applicant’s trade mark “TY-BO” is confusingly similar to the opponents’ earlier trade marks, TAE BO. Moreover the services on which the applicant proposes to use the mark are the same or similar to those of the opponents.

3. On the 22 November 2000, the applicant filed a counterstatement in which the ground of opposition is denied.

4. Both sides filed evidence in these proceedings. Both sides asked for an award of costs. In line with the Trade Marks Registry’s practice the parties were told that an oral hearing was not considered necessary in order that a decision could be reached in this dispute. Neither side dissented but both filed written submissions. After a careful study of the pleadings, evidence and written submissions I give the decision set out below.

OPPONENTS’ EVIDENCE

5. This consists of two Witness Statements by Mrs Tracy Ann Arch and Jacqueline Margaret Lake. In the first, dated 29 May 2001, Mrs Arch explains that she is a trade mark assistant with Barker Brettell and confirms that she has full access to the records and files of that firm and is authorised to make this statement on its behalf. The following points emerge from the witness statement:

- The opponents have two relevant rights in respect of the trade mark TAE BO, United Kingdom Registration No 2194377 and a Community Trade Mark

(CTM) No. E1126432. Mrs Arch exhibits copies of the Registration Certificates.

- The specifications of services of each registration is as follows:

2194377	Class 9	Audio and video tapes.
	Class 41	Instructional teaching services for aerobics and martial arts, motivational teaching services.
E1126432	Class 9	Audio and video tapes.
	Class 18	Athletic bags and accessories.
	Class 25	Clothing.
	Class 41	Instructional teaching services for aerobics and martial arts, motivational teaching services.

6. Jacqueline Lake in her Witness Statement, dated 28 March 2001, states that she is the Managing Director of Farncombe International Limited. The following are I believe the relevant points to be taken from this Witness Statement:

- Farncombe International Ltd, in January 2001, were instructed by Barker Brettell to conduct an investigation into the length and extent of use of the Trade Mark TY-BO in the United Kingdom by Mr R St Clair.
- The investigation showed that Mr St Clair used the TY-BO trade mark for a period of about ten months prior to the period of investigation, therefore from about March 2000. This use was in relation to exercise classes only. The actual investigation report is exhibited in support.

APPLICANTS' EVIDENCE

7. This consists of five Witness Statements, two from Richard St Clair (the applicant), and one each from Catherine Ferma, Emma Dixon and Janine Joseph. In his first Witness Statement, dated 3 July 2001, Mr St Clair provides background information on his involvement with fitness and aerobics teaching and how he began to incorporate 'Boxing Stations' within circuit training classes:

- says that there was a demand for martial arts based classes; there were classes which incorporated fighting moves into aerobics and circuit classes, but they only involved punching movements and were therefore unsatisfactory for those with an interest in martial arts;
- says he developed classes which came to be known as "TY-BO". Originally called "Thai-Box-Fit", they were accompanied by slogans such as "Time To Get Tough" and "Take Your Body On". Someone then noticed that the initials of "Take Your Body On" made the word "TYBO". This seemed ideal as it had the phonetic association with Thai Boxing. Once the programme of "TY-BO" classes were properly developed, they commenced at Espree, Royal Mint Court and Holmes Place in Hendon in

February 1998;

- states that he distributed shirts, bra-tops and shorts embroidered with various aspects of the “TY-BO” logo. This was for publicity purposes.

8. The further witness statement from Mr St Clair which is undated states that the company which supplied the merchandising of shirts etc was called Global Licensing Limited. He exhibits a letter from Global Licensing Limited along with a copy of an invoice relating to the first order of t-shirts and bra-tops from them.

9. Catherine Ferma’s Witness Statement is dated 1 July 2001. She was employed as a fitness manager from September 1997 for Esporta Health Club at Medway. In August 1998, she was promoted to operations manager and remained in this position until October 1999, when she became operations manager for Esporta at Croydon. She remained at Croydon in this position until December 2000. I take the following points from the witness statement:

- In February 1998, Richard St Clair started working for Esporta, Medway as a Spin Class instructor (stationary bikes) and began taking classes called “Ty-Bo/Circuit” on an experimental basis.
- When she left Esporta, Medway, Mr St Clair was continuing to teach these classes. Ms Ferma invited Mr St Clair to teach the same class at Esporta in Croydon’.
- She is aware of items of sports wear bearing the name “TY-BO” and recalls in particular the logo:
Take
Your
Body
On

Ms Ferma recalls this and a complimentary T-shirt she was given, during early 1999.

10. Emma Dixon in her Witness Statement, dated 2 May 2001, says that she is employed as the General Manager of Eden Health Club. Prior to this she was employed as General Manager of Esporta Health and Fitness Club, a post she held from June 1999 until December 2000. While working at Esporta, Ms Dixon became aware that Mr St Clair was teaching a number of weekly classes including Ty-Bo on Saturdays. This class had been taught since August 1998 and was very popular; Ms Dixon continued to employ Mr St Clair and he continued on her departure from the club.

11. Janine Joseph in her Witness Statement, dated 30 June 2001, says she was employed by Esprey at Royal Mint Court between November 1995 and December 2000 as a Studio Co-ordinator. In early 1998, Mr St Clair, who she employed as an instructor, suggested the development of a class which would incorporate martial arts movements into the circuit training workout. These classes started in February 1998 under the name TY-BO, understood to be a snappy reference to Thai Boxing. Various items of training kit with a “TY-BO” logo were worn by members.

12. That concludes my review of the evidence in so far as it is necessary.

DECISION

13. The opposition is based upon section 5(2)(b) of the Act, which states:

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

(a)

(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.”

14. An earlier trade mark is defined in Section 6(1) as follows:

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

- (a) 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,
- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”

15. The opponents’ are the registered proprietors of United Kingdom trade mark registration No. 2194377 for the trade mark TAE BO for classes 09, 18, 25 and 41 and CTM No. 1126432 again for the trade mark TAE BO. Both pre-date the application in suit and in doing so qualify as earlier trade marks within the meaning of section 6(1) of the Act.

16. In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;

- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (d) 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* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 8, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;
- (h) further, 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; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 9 paragraph 29.

17. In considering the matter under section 5(2)(b), I first of all consider the respective goods and services of the application and the earlier registrations. In doing so I take into account the views of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* whose views were supported by the Court of Justice in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] ETMR 1. Where it said:

“In assessing the similarity of the goods or services concerned, all the relevant factors relating to the goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use

and whether they are in competition with each other or are complimentary”.

18. The applicants’ services in Class 41 are identical to some of those covered by the opponents’ services in the same Class set out in the registrations; “training, practical training; all related to marshal arts, floor and air movements, all in Class 41” must be the same services as “instructional teaching services for aerobics and martial arts’. The opponents goods in Class 9, audio and video tapes are adjuncts to the applicants services; I am aware that videos often accompany physical training programmes. However, I am not prepared to hold that the remainder of the opponents’ goods are similar to, or an adjunct to, the services of the applicant. The link between sports clothing and fitness instruction has not been established here, for example.

19. Having decided that the services provided by the applicant are the same as services covered by the opponents’ registrations and that some of the opponents’ goods are similar to the applicants services I go on to compare the trade marks themselves, having particular regard to visual, aural and conceptual similarities. For convenience the two trade marks are shown below:

Applicant’s Mark

Opponents’ Mark

“TY-BO”

“TAE BO”

20. Visually, the two trade marks consist of two elements, the second being identical. Also, the first letter of the first element is the same. But I believe that, overall, the visual differences between two outweigh their similarities. “TY” and “TAE” look very different and even allowing for imperfect recollection, I do not think that these trade marks are visually confusingly similar.

21. In terms of the conceptual similarity, the opponents’ have in their written submissions argued as follows:

“We would begin by drawing attention to the fact that the Opponent’s Mark is an invented name with no direct conceptual significance or meaning in relation to the goods and services for which it is registered....Similarly , we would contend that no conceptual meaning can readily be attributed to the Applicant’s Mark.”

22. I do not find this submission convincing. In comparing trade marks from a conceptual point of view one must put that comparison into the context of the goods or services in question. In relation to the services involved here the average consumer will be aware of Tae Kwon Do, the well known martial art and in relation to martial arts training, which both the applicants and opponents have in their specifications, the trade mark “TAE BO” would in my view communicate to a potential consumer that the training or exercise class was in some way connected with martial arts or would involve the spirit of martial arts. The same I believe can be said for the applicants’ trade mark “TY-BO” which in the applicant’s own words “seemed ideal as it had the phonetic association with Thai Boxing”. There is therefore some conceptual similarity between the two trade marks.

23. The most important consideration in this case, in my view, is that of aural similarity. The opponents' argue that "the "TAE" element of the Opponent's trade mark and the "TY" element of the Applicant's trade mark are both capable of being pronounced in the same manner, pronounced as one would pronounce the English noun 'tie'". The opponents' say that this is the way that their trade mark is referred to the United Kingdom and worldwide. The applicant on the other hand argues that "TAE" is not inevitably pronounced "tie" and could in fact be referred to as "tay". From my own limited knowledge of the martial arts world (set out above) I am aware that "TAE" in the term tae kwon do, is pronounced "tie" thus I give weight to the opponents' submissions. Both trade marks are likely to be pronounced in the same way thus leading me to the conclusion that the two trade marks are aurally identical. In *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel & B.V.* [2000] FSR. 77 the Court of Justice indicated that aural similarity can be the significant factor in carrying confusion. With that in mind I note the opponents' submission as follows:

"It should therefore also be borne in mind that a fair amount of the public's contact with the marks may be fleeting or indeed may be purely oral. With leisure and fitness facilities it is often the case that classes are advertised on noticeboards within the relevant premises. Reference to the availability of classes may be noticed in passing in such circumstances by individuals with an interest but without means of noting class details which would have to be memorised. Similarly enquiries in relation to classes and times are very often made over the phone where there is no visual context for the Marks."

24. There is substance to these submissions, particularly that it is likely for a customer to ring up a health/fitness club and ask about a particular class that they may have heard of. Also, I am sure that the popularity of fitness classes is often dependant upon recommendations made by word of mouth (a scenario which the applicant fully accepts). In this kind of situation, it is difficult to see how these two trade marks could be distinguished from one another. I do not agree with the applicant's contention that the name of the class would be irrelevant in this context and that a recommendation of a class would only refer to it's nature or quality. I consider it to be highly likely that the name of the class would be mentioned in a personal recommendation in conjunction with the actual format/content of the classes.

25. Considering all the above factors I reach the view that in relation to the respective goods and services which I have held to be the same or similar, the average circumspect user would be confused as to their origin if the applicants trade mark was to be accepted for registration. Thus the application for registration must be refused under the provisions of Section 5(2)(b).

26. This would usually be the end of the matter and the opposition would succeed. However, in considering the matter globally, as I am required to do, I note that the applicant has filed witness statements showing use of his trade mark, perhaps in an effort to claim the benefits of the honest concurrent user provisions of Section 7 of the Act the relevant provisions of which reads as follows:

"7.—(1) This section applies where on an application for the registration of a trade mark it appears to the registrar——

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

but the applicant shows to the satisfaction of the registrar that there has been honest concurrent use of the trade mark for which registration is sought.

(2) In that case the registrar shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(3) For the purposes of this section "honest concurrent use" means such use in the United Kingdom, by the applicant or with his consent, as would formerly have amounted to honest concurrent use for the purposes of section 12(2) of the [1938 c. 22.] Trade Marks Act 1938."

27. The first point to note is that Section 7 and honest concurrent use was not pleaded in defence of the application. That being so I need not consider the matter, but as to do so produces no different result in this case, I set out my views.

28. The provisions of Section 7 of the Act were considered by the Hearing Officer in C.D.S. Computer Design Systems Ltd v Coda Ltd (BL 0/372/00) dated 6 October 2000. In that decision the Hearing Officer said:

“ First of all I note that this provision of the Act does not derive from Council Directive No. 89/104/EEC of December 21, 1998 to approximate the laws of the Member States relating to trade marks. It is thus a piece of home spun legislation which can only be interpreted as complementing rather than conflicting with the Directive. I say that because Article 5 of the Directive (the equivalent of Section 5 of the Trade Marks Act) requires a trade mark to be excluded from the register if it conflicts with an earlier trade mark or other earlier right. However, the fifth recital to the Directive gives Member States latitude as to the stage at which such relative grounds are to be taken into consideration. The fifth recital states:
"Whereas Member States also remain free to fix the provisions of procedure concerning the registration, the revocation and invalidity of trade marks acquired by registration; whereas they can, for example, determine the form of trade mark registration and invalidity procedures, decide whether earlier rights should be invoked either in the registration procedure or in the invalidity procedure or both and, if they allow earlier rights to be invoked in the registration procedure, have an opposition procedure or an *ex officio* examination procedure or both; whereas member states remain free to determine the effects of revocation or invalidity of trade marks.

In relation to all applications for registration under the Act, the Trade Marks Registry must examine them against the provisions of sections 3 and 5 and undertake a search under the provisions of section 37 for that purpose. If, and when, as a result of the search an earlier trade mark or earlier right is identified which is considered to be the same or similar in respect of both the trade mark and the specification of goods and services, then the Trade Marks Registry must raise an objection to the application for registration. However, if the applicant is able to show, to the satisfaction of the Trade Marks Registry, that there has been honest concurrent use of the trade mark the subject of the application with the earlier mark, under the provisions of section 7, and with due regard to the fifth recital, the application may be accepted and published. Where the concurrent use has not been in respect of all of the goods or services for which the application is sought to be registered, the acceptance will be for those goods where there has been honest concurrent use. If there is no opposition to the application for registration either from the owner of the earlier right against which the applicant for registration claims honest concurrent use or any third party, then the application will in due course be registered. However, if opposition is filed then the registrar must determine whether the grounds for refusal upon which the opposition is based are made out. If the opposition is based upon section 5 then the provisions of the appropriate subsections must be considered. The fact that honest concurrent use has been shown at the examination stage cannot overcome the objection.

If, for example, the trade mark the subject of the application for registration and the trade mark the subject of the earlier right were identical, and the specification of goods or services of the application was identical to the specification of the goods or services covered by the earlier trade mark, then refusal must follow under section 5(1), which bars absolutely the registration of identical trade marks *248 in respect of identical goods or services (unless the proprietor of the earlier trade mark consents to the registration of the later trade mark). But in relation to section 5(2) the respective trade marks or respective specifications of goods or services may only be similar and the fact that there has been actual use of the trade mark in suit concurrently with the earlier trade mark, may be relevant in determining whether there is a likelihood of confusion.

In the circumstances and for the reasons above, I reject Mr Hacon's submission that because the proprietor of the earlier trade mark against which the applicant for registration has claimed honest concurrent use has opposed the application, the provisions of section 7(2) make the refusal mandatory. However, as I have already said, the mere fact that there has been honest concurrent use is not a defence, which in itself will save an application, but it is one of the "relevant" factors which should be taken into account in determining whether there is a likelihood of confusion."

29. The simple fact that there has been concurrent use of a trade mark the subject of an application for registration alongside a trade mark or trade marks on which an opposition is based will not in itself save an application. It is but one of the relevant factors to be taken into account in determining whether or not there is a likelihood of confusion. Further, this particular factor can only apply if there is sufficient information available to satisfy the tribunal that, as a result of the parallel use, the relevant public appears to

distinguish between the goods and services of the parties and that the confusion envisaged by the Act is therefore, unlikely.

30. The evidence of use provided by the applicant in this case is in the form of three witness statements as detailed above. The statements of Catherine Ferma, and Janine Joseph states that Mr St Clair began teaching “TY-BO” classes in February 1998 with Emma Dixon stating that the classes began in August 1998 and that they have continued to the present day. This is the extent of the evidence of use filed by the applicant, who himself argues in written submission that “the sector of the public who have occasion to come across the applicant’s mark are existing and prospective members of the establishments where the mark is used and not any wider public”. It seems unlikely therefore that the relevant public at large has been exposed to both trade marks and are consequently able to distinguish between them. On the basis of the use filed by the applicant, and in the context of the global assessment which I am required to make, I find it impossible to conclude that there is no likelihood of confusion between the two trade marks as a result of the use the applicant has made of his trade mark. The ground of opposition based upon section 5(2)(b) of the Act therefore is confirmed.

31. As the opponents have succeeded in these proceedings, they are entitled to an award of costs. I therefore order the applicant to pay to the opponents’ the sum of £800. 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 02 day of August 2002

**M KNIGHT
For the Registrar
the Comptroller-General**