

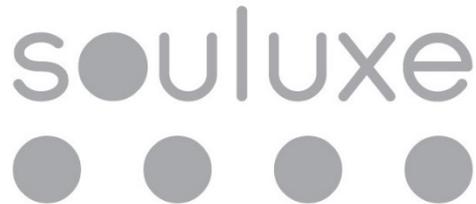
O-445-16

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3114049

BY MATALAN LIMITED

TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 18, 25, 28 & 35:



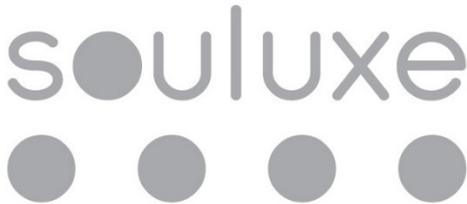
souluxe

AND

OPPOSITION THERETO (NO. 405237) BY SOULCYCLE INC

Background and pleadings

1. This dispute concerns whether the following trade mark should be registered for the following goods and services:



Class 18: Bags made of leather; bags made of imitation leather; sports bags made of leather; sports bags made of imitation leather; trunks and travelling bags; travel cases; luggage; suitcases; hold-alls; portmanteaux; valises; bags; handbags; shoulder bags; toilet bags; carrier bags; rucksacks; backpacks; bum bags; sports bags; casual bags; satchels; beauty cases; wallets; purses; umbrellas; parasols; walking sticks; shooting sticks; parts and fittings for all the aforesaid goods.

Class 25: Clothing; footwear; headgear; articles of outerwear; underwear; sportswear; maternity wear; casual wear; coats; jackets; jumpers; cardigans; sweatshirts; articles of knitwear; t-shirts; sweaters; shirts; trousers; jeans; leggings; shorts; skirts; dresses; sports clothing; sports hats; sports footwear; sports shoes; gymnastic clothing; beach clothes; beach shoes; swimwear; swimsuits; bathing suits and bathing trunks; boots, shoes and slippers; hats; caps; earmuffs; sun visors; stoles; gloves; scarves and shawls; headbands; hosiery; stockings; tights; ties; cravats; belts (clothing).

Class 28: Games, toys and playthings; gymnastic and sporting articles; balls for sports; rackets and bats for games; rackets and bats [sporting articles]; apparatus for use in physical exercise and in weight training; skateboards; training aids; exercise mats; bar-bells; dumb-bells; baseball gloves; batting gloves; boxing gloves; golf gloves; golf bags; golf clubs; hockey sticks; cricket bats; knee guards; shin guards; body building and body training apparatus;

punching bags; weight lifting belts; roller skates; yoga blocks; yoga straps; gym balls for yoga; parts and fittings for all the aforesaid goods.

Class 35: Retail services, retail store services, mail order retail services and electronic or on-line retail services connected with the sale of bags made of leather, bags made of imitation leather, sports bags made of leather, sports bags made of imitation leather, trunks and travelling bags, travel cases, luggage, suitcases, hold-alls, portmanteaux, valises, bags, handbags, shoulder bags, toilet bags, carrier bags, rucksacks, backpacks, bum bags, sports bags, casual bags, satchels, beauty cases, wallets, purses, umbrellas, parasols, walking sticks, shooting sticks, clothing, footwear, headgear, articles of outerwear, underwear, sportswear, maternity wear, casual wear, coats, jackets, jumpers, cardigans, sweatshirts, articles of knitwear, t-shirts, sweaters, shirts, trousers, jeans, leggings, shorts, skirts, dresses, sports clothing, sports hats, sports footwear, sports shoes, gymnastic clothing, beach clothes, beach shoes, swimwear, swimsuits, bathing suits and bathing trunks, boots, shoes and slippers, hats, caps, earmuffs, sun visors, stoles, gloves, scarves and shawls, headbands, hosiery, stockings, tights, ties, cravats, belts (clothing), games, toys and playthings, gymnastic and sporting articles, balls for sports, rackets and bats for games, rackets and bats [sporting articles], apparatus for use in physical exercise and in weight training, skateboards, training aids, exercise mats, bar-bells, dumb-bells, baseball gloves, batting gloves, boxing gloves, golf gloves, golf bags, golf clubs, hockey sticks, cricket bats, knee guards, shin guards, body building and body training apparatus, punching bags, weight lifting belts, roller skates, yoga blocks, yoga straps, gym balls for yoga; advertising services; marketing and promotional services; organisation, operation and supervision of sales and promotional incentive schemes and customer loyalty schemes; information, advisory and consultancy services all relating to the aforesaid services.

2. The mark was filed on 19 June 2015 by Matalan Limited (“the applicant”) and was published for opposition purposes on 10 July 2015.

3. SoulCycle, Inc. (“the opponent”) oppose registration under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). A further ground under section 5(3) was initially pleaded, but this was struck out given that the opponent filed no evidence in support. The opponent relies on ten earlier marks as follows:

- i) UK registration 3032657 for the mark **soul run** which is registered for the following goods and services:

Class 25: Articles of clothing.

Class 41: Leisure centre, health club, fitness centre and gymnasium services; provision of training and education relating to gym use, weight training, body building, aerobics, physical exercise, physical rehabilitation, diet, nutrition, health and beauty; instructional services relating to gymnastics, weight training, body building, aerobics, physical exercise, physical rehabilitation, diet, nutrition, health and beauty; personal training services.

- ii) UK registration 3037218 for the mark **get your soul fit** which is registered for the same goods and services as set out above.
- iii) UK registration 3066124 for the series of marks **Soul Studios** and **Soul Studio** which are registered for the same goods and services as mark i).
- iv) UK registration 3029575 for the mark **Soul Gym** which is registered for the same goods and services as mark i).
- v) European Union Trade Mark (“EUTM”) 12825303 for the mark **SOUL** which is registered for the following class 25 goods:

Clothing, namely, pants, drawstring pants, sweat pants, shorts, exercise tights, shirts, short sleeve shirts, tops, sleeveless tops, long-sleeve tops, sweaters, sweatshirts, t-shirts, tank tops, sports bras, jackets, hooded pullovers; headwear, namely, hats, headbands; swimwear; children's clothing; Thermals, Socks, Bandanas, Wristbands, Shoes, Flip-flops,

Neckties, Undergarments, Scarves, Gloves; all the aforementioned goods being in connection with indoor cycling or other sports, fitness or lifestyle activities (both active and after wear).

- vi) EUTM 12825246 for the mark  which is registered for the same goods as set out above.
- vii) EUTM 9957002 for the mark **SOULCYCLE** which is registered in class 25 for “Clothing, footwear, headgear”.
- viii) EUTM 11319324 for the mark **SOULCYCLE** which is relied upon in respect of the following goods and services:

Class 28: Games and playthings; Gymnastic and sporting articles not included in other classes; Decorations for Christmas trees.

Class 41: Education; Providing of training; Entertainment; Sporting and cultural activities.

- ix) EUTM 12752333 for the mark **SOUL** which is registered for the following services in class 41:

Physical fitness training services; Physical fitness conditioning classes; physical fitness instruction and consultation; Providing classes, workshops and seminars in the fields of fitness and exercise; providing fitness and exercise facilities; providing a web site featuring information on exercise and physical fitness accessible through a global computer network and mobile devices; on-line journals, namely, blogs featuring the topics regarding local community, exercise, fitness, wellness and personal development.

- x) EUTM 13189618 for the mark **SOULCYCLE** which is registered for the same services set out above.

4. The opponent claims that due to its marks consisting of, or comprising, the word SOUL, and given the identity/similarity between the goods/services, there is a likelihood of confusion, including a likelihood that the relevant public will consider the goods/services to be provided by the same or an economically liked undertaking. The opponent claims to benefit from an extensive reputation and enhanced distinctive character, however, given that no evidence was filed in support of this (something on which the applicant put the opponent to proof), such a claim is bound to fail.

5. The applicant filed a counterstatement containing a set of basic denials of the pleaded grounds.

6. In relation to the opponent's marks, there is no dispute that they constitute earlier marks for the purpose of these proceedings. Neither is it in dispute that none of the marks are subject to the proof of use provisions given that they all completed their respective registration proceedings within (not before) the five year period ending with the date on which the applicant's mark was published. The opponent is, consequently, entitled to rely on its earlier marks for their specifications as registered/relied upon.

7. Both sides have been professionally represented throughout the proceedings, the applicant by Groom Wilkes and Wright LLP, the opponent initially by King and Wood Mallesons LLP, subsequently by Mishcon de Reya LLP. Neither side filed evidence. A hearing took place before me on 6 September 2016 at which the applicant was represented by Mr Stuart Baran of counsel, instructed by Groom Wilkes and Wright LLP and the opponent by Mr Guy Tritton, also of counsel, instructed by Mishcon de Reya LLP.

8. Although all of the earlier marks contain, or comprise, the word SOUL, the different compositions of the various earlier marks means that if they are to be considered similar to the applicant's mark, they have varying degrees of similarity. The goods and services covered by the earlier marks also vary. Mr Tritton emphasised the careful

approach that would need to be undertaken in respect of the various earlier marks when assessing whether there is a likelihood of confusion due to the different balancing acts that are required. I accept that this is the case. However, I asked Mr Baran, given some of the comments in his skeleton argument, whether earlier mark 12825303 in class 25 for SOUL alone represented one of his stronger cases (at least in relation to the opposition against the class 25 part of the application). He did not disagree with this and, whilst not abandoning any of the other earlier marks, he accepted that it would be sensible to focus initially on that conflict. I will, therefore, first consider whether earlier mark 12825303 succeeds against the class 25 part of the application. I will then return to the other earlier marks to the extent necessary.

Section 5(2)(b)

9. Section 5(2)(b) of the Act states that:

“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.”

10. The following principles are gleaned from the judgments 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

11. When making a comparison, all relevant factors relating to the goods in issue should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

12. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

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

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

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

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

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

13. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

14. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in

question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

15. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd (as he then was) in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

16. Earlier mark 12825303 is registered in class 25 for the following goods:

Clothing, namely, pants, drawstring pants, sweat pants, shorts, exercise tights, shirts, short sleeve shirts, tops, sleeveless tops, long-sleeve tops, sweaters, sweatshirts, t-shirts, tank tops, sports bras, jackets, hooded pullovers;

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

headwear, namely, hats, headbands; swimwear; children's clothing; Thermals, Socks, Bandanas, Wristbands, Shoes, Flip-flops, Neckties, Undergarments, Scarves, Gloves; all the aforementioned goods being in connection with indoor cycling or other sports, fitness or lifestyle activities (both active and after wear).

17. The use of the word “namely” after the word “clothing” and “headwear” limits the goods to those subsequently named. It should be noted that I asked counsel for submissions on what effect the imitation (“; all the aforementioned goods being in connection with indoor cycling or other sports, fitness or lifestyle activities (both active and after wear)”) had at the end of the specification. Mr Baran said it had very little impact because the goods were specified as being not only active wear [for wear during the sport or other activity] but also after wear [for wear after the sport or other activity has taken place]. He also submitted that the listed clothing for “lifestyle activities” covered various pastimes that would not strictly be regarded as a sport – he gave an example of clothes that could be worn whilst going to a spa. Mr Tritton argued that the limitation had a quite limiting effect and would cover clothing for use in sports, or pastimes that were akin to sports, and that the reference to after wear could be that the clothing in question could itself be worn after as well as during the activity.

18. In my view the limitation is not helpfully worded. However, given that it has been applied to the EUTM it must be taken into account. I consider that the best interpretation would be that it limits the goods to articles of clothing used in sports and other leisure pastimes aimed at a healthy lifestyle. The latter covering pastimes such as walking, yoga etc. The reference to after wear is a curious one. Strictly speaking, one can change into anything after undertaking a sport or other activity. However, to give some effect to the limitation I consider that the average consumer would consider this to be a reference to items such as track suits or other similar items of leisure wear that may be slipped on after undertaking the activity.

19. I will make the assessment with reference to the applied for goods in class 25. Goods can be considered identical if a term in the applied for specification falls within the ambit of a term in the earlier specification, or vice versa³. On that basis, I consider

³ As per *Gérard Meric v OHIM*, Case T-133/05

all of the following to be identical to goods covered by the earlier mark as there are either direct counterparts in play or the goods fall within the broad terms of the competing specification (or vice versa):

Class 25: Clothing; footwear; headgear; articles of outerwear; sportswear; t-shirts; leggings; shorts; skirts; sports clothing; sports hats; sports footwear; sports shoes; gymnastic clothing; swimwear; swimsuits; bathing suits and bathing trunks;

20. Regardless of the earlier mark's limitation, it still covers bras and undergarments and, therefore, must be considered identical to the applied for "underwear". Similarly, the earlier mark covers sweaters, sweatshirts and shirts which is to be considered identical to the sweaters, sweatshirts and shirts in the applied for specification. The applied for jumpers is, essentially, an equivalent term to sweaters and, so, is also identical. If it is not then it must be highly similar. "Hats", "headbands", "scarves", "gloves" and "neckties/ties" are covered by both specifications so identity exists there also.

21. In relation to the applied for "coats and jackets", whilst it may not be common to wear such items whilst playing sports, they could well be worn for other activities such as walking. Coats and jackets, of a suitable type, could also be worn as after wear. I consider that the goods fall within the scope of the earlier mark's specification and are, thus, identical.

22. In relation to "beach clothes", this could well be classed as a type of clothing for a lifestyle activity and, therefore, would also fall within the scope of the earlier mark. Further, such goods would also include swimwear which is also covered by the earlier mark. Again, the goods may be considered as identical. In relation to "beach shoes", this would include items such as the flip-flops covered by the earlier mark and, therefore, identity exists on the *Meric* principle.

23. The applied for "shawls"/"stoles", "cravats" and "cardigans" are extremely similar to the earlier mark's "scarves", "neckties" and "pull-overs/sweaters" respectively in

terms of nature, purpose, method of use etc. Notwithstanding the limitation applied to the earlier marks, these goods are still highly similar.

24. The applied for “casual wear” will cover a broad range of goods which, in my view, would include many of the items listed in the specification of the earlier mark. There is identity on the *Meric* principle.

25. “Hosiery; stockings; tights” could fall within the ambit of thermals and/or undergarments. The goods may, therefore, be considered identical.

26. “Maternity wear” would include items for wear during sports or other lifestyle activities and, as such, may be considered identical on the *Meric* principle.

27. In respect of the applied for “dresses” and “slippers”, these are not replicated by any of the terms of the earlier mark nor are they an item which has any great application to sports or other lifestyle activities. Even in comparison to the more general items of clothing/footwear listed in the earlier mark’s specification such as sweaters, pants, or shoes, the nature of the competing products is not that close. Although they correspond in terms of being items of outerwear/footwear, I consider any similarity to be low.

28. In respect of the applied for “articles of knitwear” there is no reason why items in the earlier mark’s specification such as pullovers could not be knitted. The goods may be considered identical on the *Meric* principle.

29. The applied for “trousers” would include those for particular lifestyle activities such as walking. In view of this, I consider them to be highly similar to items such as pants and sweat pants covered by the earlier mark.

30. “Shoes” are listed in both specifications so may be considered identical. The applied for “boots” would include those for a particular lifestyle activity such as walking, so must be considered to be highly similar, for obvious reasons, to the shoes (for that purpose) covered by the earlier mark.

31. The “hats” of the earlier mark would include the applied for “caps”. The goods are identical.

32. The applied for “earmuffs” are similar to items in the earlier mark’s specification such as “scarves” and certain types of “hats” as they could all be used during certain activities to keep one’s ears warm. However, given the difference in nature, the degree of similarity should be pitched at a medium level.

33. The applied for “sun visors” are similar to the earlier mark’s “hats” because one type of hat would be a cap which serves a similar purpose of shielding the wearer’s eyes from the sun. As a result there is similarity of purpose, methods of use and they may also be in competition. I would pitch the level of similarity as medium.

34. The final term is “belts (clothing)” which could be used in conjunction with the earlier mark’s “pants” and “shorts”. There was much discussion at the hearing (albeit not in relation to the clash I am considering here) about the issue of complementarity. Although a belt may not be indispensable for the use of trousers, there is nonetheless a relevant connection of the type where the average consumer would assume, unlike the wine and wine glasses example⁴ quoted by Mr Tritton, that the same undertaking would be responsible for both. Although the nature and purpose of the items is different, the channels of trade would be similar. This, coupled with the complementary relationship, means that there is, in my view, a low degree of similarity here.

Average consumer and the purchasing act

35. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc*,

⁴ A reference to *Waterford Wedgwood plc v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-398/07

Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

36. The average consumer will be a member of the general public, or, in the case of sportswear and lifestyle activity clothing, members of the general public (and sportsmen/women) who wish to play sports or undertake a particular lifestyle activity. The goods are not overly expensive and purchased fairly frequently which suggests a purchasing process that is no higher or lower than the norm. The goods are likely to be selected from websites, brochures or physical premises. This could be either from specialist sports shops, but also more general clothing retailers. The manner of selection indicates that the visual impact of the marks will take on more importance, although any other aspects of similarity are not to be ignored completely from the analysis.

Comparison of marks

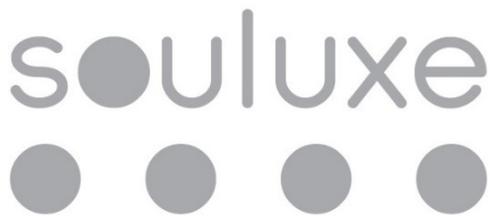
37. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means

of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

39. The earlier mark I am considering at this stage consists of the word **SOUL**. That word comprises the only aspect of its overall impression. The applied for mark looks like this:



40. As can be seen, the mark consists of the word souluxe in a particular but unremarkable font, where the letter O of that word is shaded, together with four other evenly spaced shaded circles below that word. The shading of the letter “O” in souluxe does not prevent the word from being seen as souluxe. The eye will still see it as a single word as opposed to the letter “s” and the word “uluxe” separated by a shaded circle. Mr Baran submitted that the word element “souluxe” dominated the overall impression. I agree, but I also accept Mr Tritton’s submission that it is still important to take into account all of the elements that contribute to the overall presentation of the mark, including the shaded circles. In that respect, I find that the shaded circles make a far from negligible contribution to the overall impression even if they do not carry most weight.

41. Mr Baran also submitted that within the word souluxe, the word soul would have more significance. He submitted that it was a portmanteaux comprised of a co-elision of the words SOUL and LUXE. The reason that Mr Baran felt that SOUL had more

significance was because of the combined effect of SOUL being at the beginning of the word, together with that word being distinctive, unlike LUXE. I return to this point in more detail below, but either way, I do not consider that what has been put forward by Mr Baran equates to the word SOUL comprising an element which dominates the overall impression of the mark.

42. Visually, the fact that the letters/word “soul” comprises the first part of the more dominant element of the applied for mark creates an aspect of similarity with the word SOUL alone. Due to the rule of thumb that more attention is normally paid to the beginnings of words/marks, Mr Baran felt that this emphasised the similarity that exists. On the other hand, Mr Tritton submitted that, taken as a whole, the marks were either not similar or that any visual similarity was low. Whilst I agree to a certain extent that the common element being at the beginning of the words/marks means that the similarity that does exist will not be overlooked or missed, I nevertheless consider that the differences inherent in the additional letters UXE and the shaded circles plays a significant part in limiting the degree of similarity that the average consumer will observe. I consider the degree of visual similarity, when comparing the marks as a whole, whilst bearing in mind my assessment of the respective marks’ overall impressions, is of only a low degree.

43. Aurally, SOUL will be articulated as in the type of pop music. There are two main ways in which the applied for mark could be articulated: SOUL-UCKS or SO-LUCKS. The first articulation has a slightly higher (but not much higher) degree of aural similarity to the earlier mark than the second, but both are still in the realm of having a medium degree of aural similarity.

44. Conceptually, Mr Tritton argued that the average consumer would not break the mark down as SOUL and LUXE and would, instead, see it simply as an invented word. Mr Baran argued that the average consumer would break the mark down in the same way as he/she may break down marks such as VAPOURUB (VAPOUR and RUB) and DELIVEROO (DELIVER and ROO), with the consequence that the conceptual meaning of the applied for mark would be based upon the word SOUL and the word LUXE (the latter being indicative of luxury), the former being a distinctive word with no specific relationship to the goods. This is the type of case where there is no binary

answer. Some will see the mark as wholly invented without any form of evocative concept. Others may break the mark down at least in a way in which they will appreciate that the mark begins with the word SOUL. For those that see the mark as wholly invented then there is no conceptual similarity with the earlier mark, the concept of the earlier mark being based upon a type of music or the spiritual part of a being. For those that appreciate that the applied for mark begins with the word SOUL, this creates some conceptual similarity, but this should not be placed at a high level because of the way in which that word combines with the rest of the verbal element of the mark creating either a meaningless word as a whole, or an invented word combination (if it is seen as a co-elision of SOUL and LUXE) that indicates luxury as well as the meaning of SOUL.

Distinctive character of the earlier mark

45. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested

by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

46. As stated already, the claim that the earlier marks have an enhanced level of distinctiveness must be rejected due to absence of evidence on the point. Nevertheless, Mr Baran submitted that the earlier mark still had a relatively high level on inherent distinctive character as the word SOUL has no allusive connotations in respect of the goods for which it is registered. Mr Triton argued that the earlier mark’s inherent distinctiveness was very low. He submitted that whilst the earlier mark may not be allusive or suggestive of a descriptive characteristic, it nonetheless had little distinctiveness, akin to words such as SEX, FUNK and COOL which one might see used in relation to the type of goods at issue. In his skeleton argument he also referred to SOUL as being a type of music and in his oral submission he referred to the word being evocative of goods which were inspired by the mind, spirit and soul.

47. It is not open to me to find that the earlier mark has no distinctiveness. Nevertheless, the degree of inherent distinctiveness a particular mark may possess could vary from low to high on the spectrum. Whilst I understand the submission made by Mr Tritton, I am not satisfied that what he submitted means that the mark should be afforded only a low degree of distinctiveness. That said, neither do I consider it to be highly distinctive. It is, in my view, a mark possessed of a medium degree of distinctiveness, no higher or lower than the norm.

Likelihood of confusion

48. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be

direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of direct confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

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

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

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

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

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

49. I come to the firm view that there is no likelihood of direct confusion. This is so regardless of how the average consumer sees the applied for mark. Even bearing in mind that some of the goods involved are identical or highly similar, and whilst also bearing in mind the concept of imperfect recollection, I consider that the differences that exist between the marks are more than sufficient to prevent them from being mistaken for one another. Whilst he did not abandon direct confusion altogether, Mr Baran’s main submission was more on the basis of indirect confusion to which I turn next.

50. Mr Baran’s submission here was that the average consumer would notice that the applied for mark began with the word SOUL and that they would consider the mark as a whole to be a variant or sub-brand of SOUL, with the goods sold under it being the “LUXE” or luxury part of the range. Mr Tritton argued that this was not the case, principally because SOUL would not stand out, but also because the whole construction of the mark would not appear (to the consumer) to be a logical or obvious brand extension – he submitted that to come to the conclusion that the respective undertakings were the same or related required too great a depth of analysis, a level of analysis that the average consumer would not deploy. He also argued that the submission made by Mr Baran was more of a family of marks argument for which no evidence had been provided and, therefore, this was not a submission open to him.

51. I do not accept that the submission made by Mr Baran was not open to him. His submission is not, in my view, a family of marks argument. He is arguing that the construction and make-up of the applied for mark is such that it would lead the average consumer to believe that the goods sold under it are the responsibility of the same or related undertaking to that of the goods sold under the earlier mark. That is what (in)direct confusion is all about and that is the basis of the submission.

52. For consumers who do not see the word SOUL in SOULUXE then there will be no likelihood of indirect confusion, for obvious reasons. I must, though, countenance

the possibility of confusion in respect of what is likely to be a sufficiently significant proportion of people who would see SOULUXE as an invented (or portmanteaux) word which starts with the word SOUL. Having carefully considered the matter, I consider that the construction of the word element of the applied for mark is such that it is asking too much of the average consumer to come to the conclusion Mr Baran has put forward. It does not strike me as a normal way in which a sub or variant brand will be presented. Further, it does not help (the opponent) that SOUL in the applied for mark does not perform an independent distinctive role in the mark - the way in which it has been constructed puts pay to that. Neither is the common element highly distinctive. Even if LUXE (if seen as part of a coalesced portmanteaux) gives a suggestive connotation of luxury, the unusualness of the end result (SOULUXE) does not indicate a variant brand of SOUL. I conclude that there is no likelihood of (in)direct confusion even in respect of identical or highly similar goods.

The other aspects of this conflict

53. I have so far dealt purely with earlier mark 12825303 and then only in relation to the identical or highly similar goods in class 25. It seems to me that if the opponent cannot succeed with this earlier mark in relation to such goods then it is in no better position to argue that it would succeed on the basis of its other earlier marks. However, in case of appeal, I will give brief views on the other aspects of this conflict which may be taken into account on appeal if it is found (on appeal) that I was wrong to have held that there is no likelihood of confusion, be it direct or otherwise.

Opposition based on earlier mark 12825303 against the applied for goods not yet considered

54. I have so far considered the matter in relation to the identical or highly similar goods in class 25. For the remaining goods there is less similarity, which ranges from medium to low. It follows that the opponent is in a weaker position here and there is no likelihood of confusion. Even I am found to be wrong on my initial finding above, and that I should have held that there was a likelihood of confusion in relation to the identical or highly similar goods in play, it does not follow that such a conclusion should be applied to the remaining goods. As stressed by both counsel at the hearing, one

must give due regard to the interdependency principle. The lesser degree of similarity between the goods here, combined with the similarity between the marks as assessed already, would not lead to confusion, be it direct or otherwise. There is no greater propensity for the marks to be mistaken for one another, and the likelihood of consumers seeing a brand variant, for even more distant goods, is slim. This applies in equal measure to any conflict with the other applied for goods and services beyond class 25. Whilst I accept Mr Baran's submission that being in different classes does not prevent a finding of similarity (or confusion), I consider the similarities in play (for which I accept that there is some, but certainly not high, between clothing and the retailing thereof, between sports clothing and certain sports equipment and between some clothing and bags) there is no likelihood of confusion after undertaking the global assessment.

Opposition based on earlier mark 12825246

55. This earlier mark is registered for the same goods as per the first earlier mark considered. It also comprises the word SOUL, albeit the O of the word is represented by a wheel. Whilst this creates an additional visual difference, the overall significance is marginal. Given this, I consider that exactly the same outcome as per 12825303 is applicable.

Opposition based on earlier mark 12752333

56. This earlier mark consists of the word SOUL and is registered for the following services:

Class 41: Physical fitness training services; Physical fitness conditioning classes; physical fitness instruction and consultation; Providing classes, workshops and seminars in the fields of fitness and exercise; providing fitness and exercise facilities; providing a web site featuring information on exercise and physical fitness accessible through a global computer network and mobile devices; on-line journals, namely, blogs featuring the topics regarding local community, exercise, fitness, wellness and personal development

57. Based on the findings already made, there is no likelihood of confusion. If my earlier decision regarding the identical goods in class 25 is held to be wrong, I would still find that there is no likelihood of confusion here. It is not as though there are any identical services here. There was a discussion at the hearing as to the degree (if any) of similarity between fitness training services and sporting equipment such as dumbbells etc (which would be covered by the applied for specification in class 28). Mr Baran argued that there was similarity due to the complementary relationship that exists. Mr Tritton argued that the goods were not important or indispensable for the services (or vice versa) and were not of the type where the consumer would assume that the goods/services would be the responsibility of the same undertaking. I disagree with Mr Tritton on his first point but not the second. There is in my view a sufficiently pronounced (albeit not indispensable) link between certain fitness training services (which goes beyond personal trainers) and goods which may be used during the activity. However, whilst evidence is not needed in every case, this is the type of case where I would have required evidence to understand the marketing conditions and whether the respective goods and services would be linked “in such a way that customers may think that the responsibility for those goods lies with the same undertaking”. The goods/services are not similar. However, even if they were similar they would only be similar to a low degree which, given my findings already made, and even if my initial assessment is wrong in terms of the class 25 conflict assessed above, there is still no likelihood of conclusion.

Opposition based on earlier mark 3037218

58. Notwithstanding that this earlier mark is registered for identical goods to those applied for in class 25, I consider that the additional differences, visually, aurally and conceptually between the earlier mark “**get your soul fit**” and the applied for mark means that the opponent is in a virtually hopeless position. The marks are so far removed that there is no likelihood of confusion.

The opposition based on the remaining marks

59. The remaining marks comprise the word SOUL together with an element which is either descriptive or allusive of the goods or services: SOUL RUN, SOUL STUDIO,

SOLU GYM, SOUL CYCLE. I will deal with these briefly. Although there are some identical goods in play, at least in applied for classes 25 and 28, there is no likelihood of confusion, be it direct or otherwise. Again, even if the additional point of difference is descriptive, it nonetheless creates a further distinction, so reducing any visual and aural similarity. The likelihood of the marks being mistaken for one another is even less. Further, the nature and composition of the mark gives not greater likelihood of the applied for mark being seen as a brand variant or sub-brand, indeed, it is even less likely to be seen as one.

Conclusion

60. The opposition fails completely. Subject to appeal, the applicant's mark may proceed to registration.

Costs

61. The applicant having been successful, it is entitled to a contribution towards its costs. My assessment is set out below:

Preparing a counterstatement and considering the other side's statement of case - £300

Attending the hearing - £700

Total - £1000

62. I order SoulCycle, Inc. to pay Matalan Limited the sum of £1000 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of September 2016



Oliver Morris

For the Registrar,

The Comptroller-General