

O/022/18

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3169065

BY FITNESS F LIFE LIMITED

AND

OPPOSITION No. 407774

BY 77 MANAGEMENT LIMITED

Background and pleadings

1. This is an opposition by 77 Management Limited (“the opponent”) to trade mark application 3169065 filed on 10th June 2016 (“the relevant date”) by Fitness F Life Limited (“the applicant”). The applicant wishes to register the trade mark shown below.



2. The application covers the following goods in class 25.

“Athletic clothing; athletic tights; athletics footwear; athletics hose; athletics shoes; athletics vests; athletics wear; footwear for men; footwear for sports; footwear for women; hats; head wear; tee-shirts.

3. The opponent is the management company of Andy Murray the tennis player. It deals with Mr Murray’s public relations and commercial interests. It opposes the registration of the trade mark on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The s.5(2) and s.5(3) grounds are based on the opponent’s earlier European Union trade mark (EUTM) 13647573, which is shown below.



4. The opponent says that the earlier mark is derived from Andy Murray's initials and the numeral 77, being the number of years since a previous British player won the men's single title at Wimbledon.

5. The earlier mark is registered for a range of goods/services in classes 9, 16, 18, 25, 28 and 41. The opponent relies on the registration of the earlier mark for all these goods/services. However, for reasons which will become apparent, it will only be necessary to consider the goods/services in classes 25 (clothing) and 41 (sporting services).

6. The opponent claims that the respective trade marks are similar, that the respective goods in class 25 are identical, and that the services covered by the earlier mark in class 41 are similar to the goods covered by the contested mark. It also claims that the earlier mark has acquired a reputation and enhanced level of distinctiveness in relation to goods/services in classes 25 and 41 as a result of the use made of it since the beginning of 2015. Consequently, use of the contested mark would create a likelihood of confusion and/or, without due cause, take unfair advantage of, or be detrimental to, the reputation or distinctive character of the earlier mark. Therefore, registration should be refused under s.5(2) or s.5(3) of the Act.

7. I note that the only head of damage specifically identified for the purposes of the s.5(3) ground is that the public will believe that the opponent is the user of the contested mark or that the user of the contested mark is economically connected with the user of the opponent's mark.

8. Additionally, the opponent claims that it has acquired goodwill in the UK as a result of the use of the earlier mark since March 2015 in relation to:

“Articles of clothing; sporting entertainment services; sporting services; sport coaching services; production of video and/or sound recordings; publication of information relating to sports events on the internet; promotion of goods and services through sponsorship; sports personality promotion; sport management services; public relations.”

9. The opponent claims that use of the contested mark would constitute a misrepresentation to the public which would damage the opponent's goodwill. Consequently, use of the contested mark would be contrary to the law of passing off. Therefore, registration should be refused under s.5(4)(a) of the Act.

10. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of the reputation, goodwill and enhanced distinctiveness claimed for the earlier mark. I note that the applicant also asked the opponent to provide proof of use of the earlier mark in class 25 (clothing). However, the earlier EU trade mark was only filed in January 2015 and was not registered until May 2015. Therefore, it has not been registered for the 5 year period specified in s.6A of the Act before proof of use is required. This means that the opponent can rely on the earlier trade mark in class 25 in this opposition without having to show any use of it in relation to clothing. However, to the extent that the opponent claims that the earlier mark has become more distinctive as a result of extensive use, it will have to prove that.

Representation

11. The applicant is represented by Forde Campbell LLC, solicitors. The opponent is represented by HGF Limited, chartered trade mark attorneys. Neither side asked for a hearing. This decision is therefore taken after careful consideration of the evidence and written submissions filed on behalf of the parties.

The evidence

12. The opponent's evidence consists of witness statements by Matthew Gentry, the opponent's Managing Director, and Katie Goulding, who is a chartered trade mark attorney with HGF Limited.

13. Mr Gentry's evidence is that the opponent changed its name to 77 Management Limited in 2013 as an acknowledgment of Andy Murray's achievement in being the first British man to win Wimbledon in 77 years. The opponent deals with Mr Murray's commercial interests such as sponsorship, charitable partnerships, marketing and

PR, e-commerce and brand licensing, as well as managing his tennis commitments. It owns Andy Murray's intellectual property. Between 2013 when the name changed and Mr Gentry's statement in April 2017, the opponent made over £12m in profits. There is no further information as to which of the company's specific activities generated these profits.

14. Mr Gentry says that the *"significance of '77' has been well documented in the press and the launch of the logo received a lot of media attention."* He provides nine examples.¹ Five are from online versions of newspapers from January 2015, specifically The Guardian, The Telegraph, The Mirror, Daily Mail and The Scotsman. The copies in evidence are difficult to read, but they appear to bear out Mr Gentry's claim that (a) the adoption of the logo corresponding to the earlier mark received press coverage in the UK, and (b) it was reported as being based on Andy Murray's initials and the number 77.

15. The earlier mark has appeared on the banner on Andy Murray's website since January 2015 where it is called the AM77 logo.² The website had been seen by 1.8m visitors by January 2017, about half of which visited the site before the relevant date.³

16. Mr Gentry says that *"the logo first appeared on shirts in January 2015 and has been continually used since that date."* He continues *"it appears on all of Andy Murray's match shirts and the majority of his training shirts, his court bag and on the tongue of his tennis shoes."* TV viewing figures for Wimbledon 2015 (as a whole) were around 30m. UK viewing figures for all the tournaments in 2015 and 2016 in which Andy Murray took part were nearly 150m.

17. According to Mr Gentry, Andy Murray partnered with Standard Life in July 2016 to create a series of 4 short films entitled Master your Dreams. The earlier mark was shown on Mr Murray's t-shirt in each film. The films were shown on a website called www.withandy.com and on YouTube. July 2016 is after the relevant date. These

¹ See exhibit MPG2

² See MPG3

³ See MPG4

films do not therefore seem relevant to the public's perception of the earlier mark at the relevant date. However, Mr Gentry also provides the dates at which each of the films was created. Two of these are before the relevant date (18th January 2016 and 20th May 2016). He also provides viewing figures for these films (18k and 400k, respectively). It is not clear how these films could have been created at the stated dates as a result of a partnership entered into later in 2016. At least one of the dates must be wrong. Mr Gentry provides copies of what he says are screen shots from the films.⁴ However, these are headed 'kit photography' and are dated between 2015 and 2017. They cannot therefore all be screen shots from films created in 2016. This part of Mr Gentry's evidence therefore appears manifestly unreliable. In any event, he does not say how many people viewed the first two films by the relevant date, or how many of them were from the UK. So even if this evidence was internally consistent, it could not have been given substantial weight.

18. Ms Goulding's statement merely introduces the results of some Google searches she conducted. The first uncovered an article published on the UK website creativereview.co.uk in January 2015 about the earlier mark having been designed for Andy Murray by a branding agency. The writer said:

"Of course, this is nothing new – Nike launched the iconic jumpman logo for Michael Jordan branded sneakers over 25 years ago, and almost every major athlete now has their own official fan site or product range – but while this was previously reserved for stars with iconic status, it's now simply commonplace".

The article explains the significance of the number '77' and records that the logo is Mr Murray's personal brand. The writer states that it was intended to be applied to a range of clothing and merchandise and concludes:

"The angular design will likely prove divisive, and I am not sure everyone will recognise the '77' reference, but it's a distinctive marque with a strong athletic look."

⁴ See MPG5

19. A similar article appeared on the website scoreandchange.com in February 2015. The writer said:

“one of the best ways to use a personal logo for branding purposes is through the sale of merchandise... It will take some time before [Andy Murray’s] merchandise hits the market and is actively advertised.”

This article also explained that the mark incorporates Andy Murray’s initials and the number 77.⁵

20. The applicant’s evidence consists of a witness statement by Dennis Otim, who is a director of the applicant. Mr Otim says that the contested mark “*has since, its inception, been available to the public via a range of sporting and urban apparel*” on the applicant’s website. However, he does not say when this was, so there is no evidence that the contested mark was in use at the relevant date.

The section 5(2)(b) ground of opposition

21. Sections 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of goods and services

22. The opponent’s earlier EU trade mark is registered for, inter alia:

⁵ See exhibits KLG1 and 2

Class 25: Articles of clothing; footwear; headgear; shirts, articles of sports clothing, sports footwear and sports headgear.

23. In *Gérard Meric v OHIM*⁶ the General Court stated that:

“29.the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM-Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

24. Taking this guidance into account, I find that the respective goods in class 25 are identical.

25. The opponent's earlier mark is registered in class 41 for the following services:

“Educational services; training services; organisation and conducting of sporting competitions and sporting events; sporting entertainment services; sporting services; organisation of sporting, recreational and cultural activities; education academy services; sports academy services; sport coaching services; sport tuition services; television and radio entertainment services; sound recording and video entertainment services; entertainment services by concert, musical and video performances; entertainment services provided over the internet or from a website; digital music [not downloadable] provided from the Internet; ring tones [not downloadable] provided from the Internet; production of video and/or sound recordings; presentation, production and performance of shows, musical shows, concerts, videos, multimedia videos and radio and television programmes; recording, film, video and television studio services; audio, film, video and television recording services; music publishing; sound recording, film and video production and distribution services; arranging and conducting of seminars, conferences and exhibitions;

⁶ Case T- 133/05

publication of books, magazines and other texts; publication of information relating to sports events on the Internet.”

26. The opponent submits that there is a link between *sporting services* in class 41 and *clothing* in class 25, including clothing for use in sports. According to the opponent:

“They concern the same field (sports) and target the same public (people interested in sports, spectators and participants in sports). Attendees at sports events often wear sport branded attire and particularly because of the closeness of these goods and services by sponsorships. See for example the presence of the trade mark of pension company, Standard Life, in the exhibits to Mr Gentry’s witness statement.”

27. In support of this submission the opponent draws attention to the extracts from the online articles in Ms Goulding’s evidence set out above.

28. In *Canon*⁷ the Court of Justice of the European Union (CJEU) stated at paragraph 23 of its judgment that:

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

29. *Sporting services* are manifestly different in nature to clothing. The purpose of the services and goods is also different. *Sporting services* (in a commercial context) are a form of entertainment service intended to entertain the public, as well as to promote the sport in question. The main purpose of *clothing*, including athletics clothing, is to provide suitable attire for people playing particular sports. The method

⁷ Case C-39/97

of use of such goods is manifestly different to the way that *sports services* are used. The respective goods/services are not in competition.

30. I acknowledge that in *Kurt Hesse v OHIM*⁸ the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*⁹ the General Court had earlier stated that “complementary” meant:

“...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”.

31. In *Sanco SA v OHIM*¹⁰ the General Court found that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services was very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*:¹¹

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

⁸ Case C-50/15 P

⁹ Case T-325/06

¹⁰ Case T-249/11

¹¹ BL-0-255-13

32. The opponent's evidence that sports stars often have personal logos that are used to identify their merchandise (or merchandise they endorse) appears to be intended to show that the public might believe that the responsibility for the applicant's clothing might lie with the same undertaking that provides sports services under the earlier mark, or with an economically connected undertaking. However, the difficulty with this submission is that it is not based on the inherent characteristics of *clothing* and *sports services*, or the usual marketing conditions for such goods/services. Instead it depends on the goods marketed under the earlier mark being those of a sports star, which is not a clear or precise sub-category of clothing.

33. The opponent's approach would mean that the same goods and/or services might be regarded as being similar or dissimilar, depending on the reputation of the earlier mark. Taken to its logical conclusion it would also mean that any potential merchandise could be regarded as similar to *sports services*, notwithstanding the absence of any objective similarity between the goods and services. Adopting such an 'elastic' approach to similarity of goods/services would undermine the requirement in s.5(2) of the Act for the respective goods/services to be objectively similar, at least to some extent. It would also make it unduly difficult for other operators in the market sectors concerned to assess whether a particular mark is free for use in relation to particular goods/services. I therefore reject the approach proposed by the opponent.

34. There is no evidence that any clothing has been marketed under the earlier trade mark. Nor is there any evidence that the public would normally expect clothing, including sports clothing, to be marketed by, or with the consent of, undertakings that provide *sports services*. I therefore find that *clothing* is not complementary to *sports services* in the sense required by the case law.

35. It is true that users of sports clothing may also be users of sports services. However, this is not sufficient, by itself, to justify a conclusion that the respective goods/services are similar. I therefore reject the opponent's submission that the respective goods/services in classes 25 and 41 are similar in any material way.

36. In doing so, I note that the courts have rejected similar attempts to broaden the protection afforded to marks under provisions of law equivalent to s.5(2) of the Act when it comes to marks claiming to have a particular kind of reputation with the public. For example, in *Compagnie des montres Longines, Francillon SA v OHIM*,¹², the General Court rejected the argument that sunglasses, jewellery and watches were similar to clothing on the basis that they were all types of luxury goods and the earlier mark had a reputation as a luxury brand. The court held that:

“54. In that regard, in particular, it must also be stated that the applicant has not proved its claim that, in the luxury and fashion sector, it is generally the trade mark and its prestige among consumers that motivate the consumer’s decision to purchase a specific item and not the actual necessity to purchase that item, inter alia for its functionalities and to fulfil a very specific need. Likewise, it is necessary to reject as not proved the applicant’s claim that, as the appearance and value of the goods prevail over other factors relating to their nature, consumers in the sector concerned are principally in search not of specific goods, but of satisfaction for their ‘hedonistic needs’ or that they seek the instant gratification generated by an impulse purchase.

55. Moreover, it must be stated that to accept that such claims are well-founded would be tantamount, in essence, to rendering irrelevant any differentiation between goods which belong to the luxury sector and are protected by the respective marks, since the applicant’s theory relating to the impulse purchase aimed at the instant gratification of consumers leads to the conclusion that a likelihood of confusion may actually exist irrespective of the goods concerned, on the sole condition that they all fall within that sector. Such an approach, by which the applicant in actual fact alleges that all the goods at issue are interchangeable, is manifestly contrary to the principle of speciality of marks which the Court must take into account in its analysis in accordance with Article 8(1)(b) of Regulation No 207/2009 and would improperly extend the area of protection of trade marks. For the same reasons, it is necessary to reject as irrelevant the applicant’s claim that the

¹² Case T-505/12

goods are interchangeable inasmuch as each of them may be given as a gift and the consumer impulsively chooses one or other of them. To accept such a vague connection would lead to holding that goods which are manifestly different in their nature and intended purpose are similar.”

37. It follows from the above findings that the opposition under s.5(2)(b) of the Act based on the registration of the earlier mark in class 41 fails. This is because the requirement for similarity between the respective goods/services is a mandatory requirement of this provision.¹³

Global comparison

38. Having decided that the earlier mark is registered in relation to identical goods in class 25, it is necessary to carry out a global comparison of the likelihood of confusion.

Relevant principles

The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

¹³ See *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

(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 great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Average consumer and the selection process

39. 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*.

40. The average consumer of the goods covered by the contested mark is a member of the general public, including the public interested in sports/athletics. There is nothing about the goods covered by the contested mark which leads me to believe that they will be selected with a lower or higher degree of attention than usual. I therefore find that the average consumer will pay a normal degree of attention when selecting such goods.

41. The opponent submits that clothing is primarily a visual purchase and therefore the visual similarities between the marks are most important. In support of this submission my attention was drawn to the judgment of the General Court in *New Look Ltd v OHIM*¹⁴ where the court stated that:

“50.Generally, in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take

¹⁴ Joined cases T-117/03 to T119/03 and T-171/03

place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

42. I accept the opponent’s submission on this point.

Distinctive character of earlier mark

43. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,¹⁵ 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).”

¹⁵ Case C-342/97

44. The opponent submits that the earlier mark has acquired an enhanced distinctive character “*whether per se or in connection to sports merchandise including attire and/or sporting services.*” In this connection it relies on Mr Gentry’s evidence that:

- The earlier mark has been visible on Andy Murray’s t-shirts since January 2015;
- The t-shirts worn by Mr Murray have received wide exposure through the broadcasting of tennis events;
- The earlier mark has featured on Andy Murray’s website since January 2015;
- The launch of the logo received high press attention;
- The publication on the internet of the 4 films created in partnership with Standard Life in which the earlier mark could be seen.

45. The applicant submits that as the earlier mark has not been used in relation to the marketing of clothing, it cannot have acquired an enhanced level of distinctiveness for such goods.

46. As to the inherent characteristics of the earlier mark, there is no suggestion that the mark is descriptive or even allusive of any characteristic of clothing. On the other hand, I do not consider that average consumers of clothing would find it particularly striking and therefore highly memorable. On the contrary, the mark appears to be a relatively straightforward geometrical design. I note that the author of the article on the website creativereview.co.uk thought that the logo was “*a distinctive mark with a strong athletic look*”. However, there is no reason to believe that the reaction of the author is likely to be typical of that of an average consumer of clothing. In any event, it does not appear to be at odds with my own overall assessment that the earlier mark has a normal degree of inherent distinctiveness in relation to clothing.

47. Turning to the arguments about enhanced distinctiveness through use, I consider that there is force in the applicant’s submission that in the absence of any use of the mark in relation to the marketing of clothing to the public, the mark cannot have acquired an enhanced level of distinctive character as a trade mark for clothing.¹⁶

¹⁶ See Neuberger J. (as he then was) in *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767

48. However, even if I am wrong about that, I do not consider that the evidence is sufficient to establish that the use of the earlier mark as Andy Murray's personal logo had materially enhanced the distinctiveness of the earlier mark by the relevant date. I have already explained why I cannot place much weight on the showing of the earlier mark in the 4 films created in partnership with Standard Life.



49. I acknowledge that millions of UK tennis watchers will have seen Mr Murray appearing in tennis tournaments during 2015 and the first half of 2016. However, it is not clear to me how many of them would have noticed the logo on the sleeve of his t-shirt (and his sports bag). Further, it is even less clear how many of the public who did notice it would have understood that it was his personal logo (as opposed to (say) that of a sponsor). Further, even those who noticed it and recognised it as his personal logo may reasonably have thought that it was being used on his t-shirt (and bag) but in relation to himself. In other words the appearance of the mark on his t-shirt may not have created any particular association between the mark and clothing as goods. The same applies to the use of the mark on Mr Murray's website and in newspaper reports in January 2015.

50. Admittedly, those who read the articles that appeared on the websites creativereview.co.uk and scoreandchange.com in January and February 2015 may have made a connection between the earlier mark and clothing, as well as with Mr Murray himself. However, there is no evidence that these sites are followed by large numbers of the general public, as I might be able to infer when it comes to publications such as The Telegraph etc.

51. I therefore find that the earlier mark had not acquired an enhanced level of distinctiveness by the relevant date in relation to clothing.

Comparison of marks

52. The marks are shown below.

	
Earlier trade mark	Contested trade mark

53. The CJEU stated at paragraph 34 of its judgment in *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.”

54. The opponent submits that:

- (i) Both marks consist of three bold vertical lines with two bold horizontal lines positioned across the top and crossing the middle of the vertical lines;
- (ii) The crossed lines create two ‘windows’ at the top of each mark;
- (iii) In both cases the vertical lines lean to the right;
- (iv) There is a plus sign in the middle of each mark;

(v) The differences between the marks are limited to (a) the lines in the earlier mark are not all full lines, some have a 45 degree angle, and (b) the presence of the words “Fitness for Life” in the contested mark.

55. As to the last point, the opponent submits that the words “Fitness for Life” are barely legible in the contested mark and the dominant and distinctive element of that mark is therefore the device element.

56. According to the opponent, both marks are open to interpretation and it cannot be assumed that the section of the public who are unfamiliar with the story behind the creation of the mark will recognise the earlier mark as being derived from the letters AM and/or the numeral 77. The opponent says that, if letters or numerals are perceived at all, which they may not be, then there are many possible interpretations, including AAL, AA, AFL, FA, FAL, ML, M, ITL, AM, AML, and ITL. The opponent submits that this also applies to the device element of the contested mark.

57. The opponent further submits that as the earlier mark has no verbal element, no verbal (or aural) comparison is possible. However, the visual similarity between the marks is “striking”.

58. The applicant submits that the earlier mark consists of “*illusionary ‘3-dimensional’ intersecting elements, combining a ‘3-dimensional’ letter ‘T’ on its side which intersects with a ‘3-dimensional’ number 77.*” By contrast, the contested mark is said to consist of the words ‘Fitness For Life’ and a device comprising “*a stylised 2-dimensional representation of the letters ‘FFL’ in bold in a fused state, so as to create two white rectangular parallelograms framed by a solid black border supported by three solid black forward leaning straight lines, the right hand one of which forms a leaning ‘L’ shape.*” The applicant therefore submits that the opposition is “*completely groundless*” and should be dismissed. I take this to mean that there is no similarity between the marks.

59. In *Ravensburger AG v OHIM*¹⁷ the General Court held that:

¹⁷ Case T-243/08

“27. It is appropriate at the outset to reject that complaint as unfounded. The reputation of an earlier mark or its particular distinctive character must be taken into consideration for the purposes of assessing the likelihood of confusion, and not for the purposes of assessing the similarity of the marks in question, which is an assessment made prior to that of the likelihood of confusion (see, to that effect, judgment of 27 November 2007 in Case T-434/05 *Gateway v OHIM – Fujitsu Siemens Computers (ACTIVY Media Gateway)*, not published in the ECR, paragraphs 50 and 51).”

60. Consequently, even if the earlier mark had a relevant reputation at the relevant date, it is not relevant to the similarity between the marks. Leaving the claimed reputation of the earlier mark to one side, I find it unlikely that average consumers will see any letters or numbers in the earlier mark. Further, as average consumers normally perceive marks as a whole and do not proceed to analyse their various details, it is also unlikely that such consumers will notice “*windows*”, “*plus signs*” or “*rectangular parallelograms*” in the earlier mark. Instead it will strike them as an abstract geometrical device consisting, broadly, of three vertical lines crossed by two horizontal ones (or possibly by one line across the middle and two half lines across the top). I agree with the applicant that the device has a certain three dimensional quality. However, although it is more than negligible, this makes only a small impact. The use of angles so that the horizontal lines merely ‘touch’ in three places, rather than fully join, makes more of a contribution to the overall visual impression created by the earlier mark. The use of angles also means that the bottom of the three vertical lines in the earlier mark have downward pointed ends, which also contributes to the overall impression created by that mark.

61. The device is the dominant and distinctive element of the contested mark. It is also formed of a number of vertical lines crossed in roughly the same places by two horizontal ones. However, the lines in the contested mark are solid, uniform and unbroken. Further, the additional horizontal line extending right from the base of the final vertical line breaks up the impression of three vertical lines and instead makes the right hand side of the device look rather more like a letter ‘L’. In my view, average consumers who read the words “Fitness For Life” beneath the device are likely to

see the device as stylised letters FFL. However, the words in the contested mark are relatively small. I therefore accept the opponent's submission that not all average consumers will read them.¹⁸ For those average consumers who do not (or cannot) read the words, the contested mark is likely to convey the impression of an abstract geometrical device with the characteristics mentioned above.

62. Taking all relevant factors into account (including that both marks 'lean' to the right to different degrees), I find that for those average consumers who see the device in the contested mark as stylised letters FFL, there is very little visual similarity with the earlier mark (which plainly does not represent the letters FFL). For those average consumers who do not (or cannot) read the words in the contested mark, and who therefore are more likely to see it as an abstract geometrical device, I find that although the devices at issue have certain high level similarities, the overall impressions they create are quite noticeably different. In my view, the degree of visual similarity between them is therefore moderate (at most).

63. Those average consumers who read the word "Fitness For Life" in the contested mark are likely to verbalise it accordingly. I agree with the opponent that the earlier mark has no verbal element. Therefore, the above words will aurally distinguish the contested mark from the earlier mark.

64. I also agree with the opponent that no aural comparison is possible for those consumers who see no verbal element in either mark.

65. Neither device has any concept which is discernible just from its inherent qualities. For those consumers who read the words "Fitness For Life" in the contested mark, the concept of that mark will be idea of keeping fit for a healthy life. Consequently, to that section of average consumers, the concept of the contested mark will help to distinguish it from the earlier mark.

¹⁸ There is no single meaning rule: See *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch), Mann J. at paragraphs 27 and 28 of the judgment.

Likelihood of confusion

66. I find that for those average consumers who read the word “Fitness For Life” in the contested mark, and who are therefore likely to see the device element as stylised letters FFL, there is no likelihood of confusion. This is because the earlier mark is highly resistant to the interpretation FFL and the degree of overall similarity between the marks (based on this perception of the contested mark) is very low. In these circumstances, the identity of the goods is not enough to overcome the differences between the marks.

67. I find that for those average consumers who do not (or cannot) read the words in the contested mark, and who may therefore see it as an abstract geometrical device, the moderate degree of overall visual similarity between the marks is still not sufficient to create a likelihood of confusion, despite the identity between the goods. In reaching this view, I have allowed for a degree of imperfect recollection of the marks. However, I find that the overall impressions created by the marks are sufficiently different so as to avoid confusion amongst reasonably observant average consumers.

68. I see no reason for a likelihood of indirect confusion amongst those average consumers who recognise that the marks are different. For example, there is no ‘family’ resemblance between them that might suggest that they are used by the same or related undertakings.

69. The opponent’s evidence appears to be intended to show that the earlier mark has been well publicised as Andy Murray’s personal logo. The publicity in question, which is mostly around the launch of the logo in January 2015, informed the public that the logo was intended to represent the number 77 and, possibly, also Mr Murray’s initials. However, in my view, irrespective of whether consumers recognise the device in the contested mark as being based on the letters FFL, they will not see the device element of the contested mark as being based on the letters ‘AM’ and/or the numeral 77. The joined solid lines of the device combined with the horizontal line extending from the right hand side of the base of the device render it positively resistant to the interpretation ‘77’ and/or ‘AM’. Consequently, those consumers who

have seen the publicity about Mr Murray's personal logo are no more likely to be confused than those who have not. Consequently, it would not have made any difference if I had found that the earlier mark had acquired an enhanced level of distinctiveness by the relevant date as Andy Murray's personal logo.

70. For the reasons given above, the opposition under s.5(2)(b) based on the registration of the earlier mark in class 25 fails. The opponent can be no better off relying on the registration of the earlier mark for similar goods in class 18 or any other class. Consequently, the opposition under s.5(2)(b) is rejected.

Opposition under section 5(4)(a)

71. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

72. The opponent claims to have acquired goodwill under Mr Murray's personal logo in relation to:

“Articles of clothing; sporting entertainment services; sporting services; sport coaching services; production of video and/or sound recordings; publication of information relating to sports events on the internet; promotion of goods and services through sponsorship; sports personality promotion; sport management services; public relations.”

73. On the basis of *Starbucks (HK) Limited and Another v British Sky Broadcasting Group plc*¹⁹, the opponent accepts that custom (not just reputation) is needed to establish goodwill under the law of passing off. However, the opponent has provided no evidence of any sales or marketing of clothing under Mr Murray's logo. This element of the opponent's case must therefore fall at the first hurdle.

74. In the alternative, the opponent relies on the goodwill attached to its business for *sporting services*. In fact there is very little evidence about this either, although it is obvious that Mr Murray has acquired a valuable goodwill as a professional tennis player.

75. In *Irvine v Talksport Ltd*²⁰ the Court of Appeal approved Laddie J.'s analysis that the tort of passing off was wide enough to cover false endorsement. Parker L.J. stated that:

"31. In his first judgment, Laddie J, after setting out the relevant facts, turned first to a submission made by Mr Hicks that the cause of action in passing off does not cover a case where the claimant is represented as having 'endorsed' a particular product or service unless it can also be shown that the claimant and the defendant shared a common field of activity or that the 'endorsement' will, at least in the short term, result in some financial loss to the claimant.

32. Having conducted what is, if I may respectfully say so, an impressive analysis of the historical development of the tort of passing off, the judge rejected Mr Hicks' submission, concluding (in paragraph 38 of his judgment) that it is not necessary for a claimant who has been falsely represented as endorsing a particular product or service to establish these additional facts in order to recover substantial damages in passing off. The judge continued:

'Of course there is still a need to demonstrate a misrepresentation because it is that misrepresentation which enables the defendant to make use or take advantage of the claimant's reputation.'

¹⁹ UKSC 31

²⁰ [2003] F.S.R. 35

33. In paragraph 46 of his judgment, the judge said this:

‘It follows from the views expressed above that there is nothing which prevents an action for passing off succeeding in a false endorsement case. However, in order to succeed, the burden on the claimant includes a need to prove at least two, interrelated, facts. First, that at the time of the acts complained of he had a significant reputation or goodwill. Second, that the actions of the defendant gave rise to a false message which would be understood by a not insignificant section of his market that his goods have been endorsed, recommended or are approved of by the claimant..... .’ ”

76. I will assume that Mr Murray had acquired a substantial goodwill as a professional tennis player providing *sporting services* at the relevant date, and that the opponent is entitled to take action to enforce the legal rights associated with his goodwill. I will also assume that Mr Murray’s personal logo was distinctive of his goodwill at the relevant date to a significant number of his fans/watchers, who are potential customers for clothing etc.

77. The difference between clothing etc. in class 25 and *sporting services* is not such as to defeat a passing off claim in a false endorsement case. Moreover, although it will no doubt be easier to make out such a case where the claimant can show that he or she has already engaged in commercial endorsements of products of the kind in question (or at least engaged in commercial endorsements of some kind), this is not an essential requirement. Rather, as the above case law makes clear, what is required as a minimum is that *“the actions of the defendant gave rise to a false message which would be understood by a not insignificant section of his market that his goods have been endorsed, recommended or are approved of by the claimant.”* The false message need not be deliberate.

78. In my judgment, the opponent’s case under s.5(4)(a) falls down at this point. This is because for the reasons I gave in my analysis under s.5(2)(b), the contested mark is unlikely to be mistaken for Mr Murray’s personal logo. Consequently, use of the

mark would not constitute a misrepresentation to the public. The s.5(4)(a) ground of opposition is therefore also rejected.

Opposition under section 5(3)

79. Section 5(3) states:

“(3) A trade mark which-
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

Reputation

80. The opponent claims that the earlier mark has acquired a reputation in relation to clothing and sporting services. In paragraphs 47 to 51 above I set out my reasons for rejecting the opponent’s claim that the earlier mark had acquired an enhanced level of distinctiveness in relation to clothing. For the same reasons, I find that the mark had not acquired a reputation for clothing by the relevant date.

81. Turning to the matter of whether the mark had acquired a reputation for *sporting services*, I find that there is room for argument as to whether the earlier mark has been used in relation to *sporting services* provided by, or with the consent of, Mr Murray (as opposed to just used in relation to Mr Murray himself). However, for present purposes I will assume that it has been used in relation to such services.

82. I note that the requirements for establishing a qualifying reputation under article 5(2) of the Trade Mark Directive (section 5(3) of the Act) were considered by Advocate General Jacobs in *General Motors*.²¹ The Advocate General noted that

²¹ Case C-375/97

Article 5(2) did not appear in the initial proposal for the Directive put forward by the Commission which considered that such extensive protection was not justified for national trade marks, but should be restricted to a limited number of Community marks, namely marks of wide repute.²² However, in the course of negotiations in the Council, a provision protecting marks with a reputation was included at the request of the Benelux countries, and became Article 5(2) of the Directive. The Advocate General concluded that a trade mark with a reputation within the meaning of Article 5(2) of the Directive should be interpreted as meaning a mark which is known to a significant part of the relevant sectors of the public, but which need not attain the same degree of renown as a mark which is well known within the meaning of the Paris Convention.

83. The CJEU essentially followed the Advocate General's Opinion in finding that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade

²² See the Commission proposal, OJ 1980 C 351, p. 1 and *EC Bulletin*, Supplement 5/80.

mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

84. It is clear from this that the ‘reputation’ required in order for a trade mark to qualify for protection under s.5(3) cannot be equated with the requirement for goodwill and reputation under the common law of passing off. The latter protects businesses with even a modest local reputation against damaging misrepresentations by third parties. The former provides more extensive protection to registered marks “*known by a significant part of the public concerned by the products or services*” “*in a substantial part of [the EU]*”.

85. Applying the criteria proposed by the CJEU to the facts before me I find that:

- There is no evidence of the share of the sporting services market held by the mark (if any);
- There is no evidence as to the value or volume of sporting services provided under the mark;
- The mark was used for about 18 months prior to the relevant date and received substantial exposure through television coverage of Andy Murray playing at tennis tournaments;
- There is no evidence as to the amount spent promoting the mark (if any).

86. In my view, the evidence fails to establish that the mark had acquired a reputation for sporting services amongst “*a significant part of the [EU] public concerned by the products or services covered by that trade mark.*” If I am wrong about that, then I find that the mark had acquired only a modest reputation by the relevant date.

Link

87. Assuming that the earlier mark had a qualifying reputation at the relevant date, it is necessary to evaluate whether the public when confronted with the later mark would make a link with the earlier reputed mark, which is the case where the public

calls the earlier mark to mind.²³ Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness.²⁴ Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future.²⁵

88. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

Consumers who see the device element of the contested mark as a stylised representation of the FFL mark will see (at most) only a very low degree of similarity between the marks. For those that do not, the degree of similarity is no more than moderate.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

Clothing is dissimilar to sporting services and not usually provided by the same undertakings. However, clothing can be used for promotional or merchandising purposes and so there is a connection of sorts between the goods/services.

The strength of the earlier mark's reputation

I find that it is modest (at most).

²³ CJEU, *Intel*, Case C-252/07, paragraph 63

²⁴ *Intel*, paragraph 79.

²⁵ *Intel*, paragraph 68

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

The earlier mark has a normal degree of inherent distinctiveness. Even if it had acquired a modest reputation by the relevant date, it was not enough to have made the earlier mark highly distinctive.

89. Taking all the relevant factors into account I find that the public would not have made a link between the earlier mark and the contested mark. It follows that the contested mark could not have caused any of the types of injury set out in the section. In any event, the only type of injury that the opponent specifically pleaded was that the opponent will be perceived as the user of the contested mark, or that the user of the contested mark will be perceived as economically connected with the user of the opponent's mark. I have already rejected this proposition in my analysis under s.5(2) and s.5(4)(a). The section 5(3) ground was therefore bound to fail too.

90. The s.5(3) ground is rejected accordingly.

Outcome

91. The opposition has failed. The contested mark will be registered.

Costs

92. The applicant has been successful and is entitled to a contribution towards its costs. I calculate these as follows:

£350 for considering a notice of opposition and filing a counterstatement
£500 for considering the opponent's evidence and filing submissions in response.

93. I therefore order 77 Management Limited to pay Fitness F Life Limited the sum of £850. The above sum should be paid within 14 days of the expiry of the appeal period.

Dated this 9th day of January 2018

**Allan James
For the Registrar**