O/0739/24

TRADE MARKS ACT 1994

IN THE MATTER OF

UK REGISTRATION NO. 3701983

IN THE NAME OF QIAN NI LIMITED

IN RESPECT OF THE FOLLOWING TRADE MARK

IN CLASS 28:

AND

AN APPLICATION FOR A DECLARATION OF THE INVALIDITY

THEREOF UNDER NO 505758

BY

FDS GMBH

Background and pleadings

1. Trade mark No. 3701983 shown on the cover page of this decision stands registered in the name of QIAN NI LIMITED ("***the Proprietor***"). It was applied for on 28 September 2021 before the UK IPO with the EU priority date of 28 December 2020[1] and was registered on 8 April 2022 for the following goods ("***the Contested Mark***"):

   Class 28: Stationary exercise bicycles; body-training apparatus; chest expanders [exercisers]; Sit up benches; dumb-bells; waist trimmer exercise belts; machines for physical exercises; punching bags; bar-bells; trampolines; yoga swings; rowing machines; Exercise treadmills; Finger stretching resistance bands; Elliptical trainers; Weight lifting benches; Aerobic step machines; Exercise bars; Squat Racks; Weight lifting machines for exercise.

2. On 24 January 2023, FDS GmbH ("***the Applicant***") filed an application to have this trade mark declared invalid under the provisions of section 5(2)(b) of the Trade Marks Act 1994 ("***the Act***"). This ground may be relied upon in invalidation proceedings by virtue of section 47 of the Act. The application is directed against all of the goods for which the Contested Mark stands registered.

3. The Applicant relies on the following trade mark:

UKTM No. UK00918130652 ("***the Earlier Mark***")

GYMAX

Filing date: 1 October 2019

Registration date: 21 January 2020

Registered for the following goods:

Class 28 Fitness machines and equipment, namely, weights, treadmills, rowing machines, stair stepping machines, resistance machines, stationary

[1] Under Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union, an applicant for a pending EU application could apply to register the same mark and goods/services as covered by that application in the UK, within nine months after the end of the transition period, this being up to and including 30 September 2021, and claim the earlier filing date of the pending EU mark.

cycles; Fitness equipment, namely, straps used for yoga and other fitness activities and for carrying a yoga mat; Exercise equipment in the nature of straps that are affixed to doors, cable machines, exercise equipment for performance of weight resistance exercises; yoga straps; Balance boards for improving strength, toning, conditioning, balance, and proprioception; yoga blocks; Stress relief exercise balls; Exercise equipment, namely, abdominal boards; Physical fitness equipment, namely, exercise bands, training bars; Dumbbells; Fitness equipment, namely, a weighted bar to improve posture and overall fitness; Sporting goods and equipment for speed training, namely, rings, cones, speed ladders, coaching sticks, training arches, ankle bands, resistance chutes, hurdles; Sports equipment for boxing and martial arts, namely, boxing gloves, mixed martial arts gloves, punching mitts, and shin guards; Sports equipment for boxing and martial arts, namely, boxing gloves, boxing bags, punching mitts, belly protectors, groin protectors and shin guards; Physical fitness equipment, namely, resistance bands; Waist trimmer exercise belts; Weightlifting belts.

4. The Applicant's registered mark is a comparable mark (EU)[2]. By virtue of its earlier filing date, the prior registration constitutes an earlier mark within the meaning of section 6 of the Act. As the Earlier Mark had not completed its registration process more than five years before the date of the application for invalidity, it is not subject to proof of use pursuant to section 47(2A) of the Act. The Applicant can, therefore, rely upon all the goods it has identified without having to demonstrate use.

5. The Applicant in the Notice of Cancellation contends that due to the identity or similarity between the marks and the identity of the goods, the Contested Mark should be declared invalid under Section 5(2)(b) of the Act. The Applicant also indicates the related cancellation proceeding number 000056429 at the EUIPO.

[2] Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

6. The Proprietor filed a counterstatement, denying the grounds of invalidation and stating that the cancellation at hand be dismissed in its entirety.

Relevance of EU law

7. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence and submissions

8. The Applicant filed submissions[3] during the evidence rounds which will not be summarised here but will be referred to as and where appropriate during this decision. The Proprietor has filed nothing beyond its counterstatement. Neither party requested a hearing nor filed submissions in lieu. This decision is taken following a careful perusal of the papers.

Representation

9. In these proceedings, the Applicant is represented by Katarzyna Eliza Binder-Sony of Trademarkia and the Proprietor by Debra Lewis of Hoffmann Eitle.

Decision

Section 47

10. The relevant parts of section 47 of the Act are as follows:

"(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground–

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

[3] Dated 19 June 2023

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

…

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless–

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed."

Section 5(2)(b)

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

"(2) A trade mark shall not be registered if because—

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

(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."

"5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

Case law

12. In considering the application for invalidity under this section, the leading authorities which guide me are from the Court of Justice of the European Union (***"CJEU"***): *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;

(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.

Comparison of goods

13. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the 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".

14. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

    a) The respective users of the respective goods or services;

    b) The physical nature of the goods or acts of services;

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

    d) 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;

    e) 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.

15. The General Court ("GC") confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

    "29. In addition, 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".

16. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode*

Trade Mark (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

17. The competing goods are as follows:

Proprietor's goods	Applicant's goods
Class 28	**Class 28**
Stationary exercise bicycles; body-training apparatus; chest expanders [exercisers]; Sit up benches; dumb-bells; waist trimmer exercise belts; machines for physical exercises; punching bags; bar-bells; trampolines; yoga swings; rowing machines; Exercise treadmills; Finger stretching resistance bands; Elliptical trainers; Weight lifting benches; Aerobic step machines; Exercise bars; Squat Racks; Weight lifting machines for exercise.	Fitness machines and equipment, namely, weights, treadmills, rowing machines, stair stepping machines, resistance machines, stationary cycles; Fitness equipment, namely, straps used for yoga and other fitness activities and for carrying a yoga mat; Exercise equipment in the nature of straps that are affixed to doors, cable machines, exercise equipment for performance of weight resistance exercises; yoga straps; Balance boards for improving strength, toning, conditioning, balance, and proprioception; yoga blocks; Stress relief exercise balls; Exercise equipment, namely, abdominal boards; Physical fitness equipment, namely, exercise bands, training bars; Dumbbells; Fitness equipment, namely, a weighted bar to improve posture and overall fitness; Sporting goods and equipment for speed training, namely, rings, cones, speed ladders, coaching sticks, training arches, ankle bands, resistance chutes, hurdles; Sports equipment for boxing and martial arts, namely, boxing gloves, mixed martial arts gloves, punching mitts, and

	shin guards; Sports equipment for boxing and martial arts, namely, boxing gloves, boxing bags, punching mitts, belly protectors, groin protectors and shin guards; Physical fitness equipment, namely, resistance bands; Waist trimmer exercise belts; Weightlifting belts.

Class 28

- '*Stationary exercise bicycles*'

18. The above term is self-evidently identical to the Applicant's '*Fitness machines and equipment, namely, […] stationary cycles*'.

- '*Sit up benches'*

19. The above term is identical to the Applicant's '*abdominal boards*' because the respective terms are alternative ways of describing the same goods.

- *'dumb-bells'*

20. Identical to the Applicant's '*Dumbbells*'.

- '*waist trimmer exercise belts*'

21. Identical to the Applicant's '*Waist trimmer exercise belts'*.

- '*machines for physical exercises*'

22. The Applicant's terms '*treadmills*', '*rowing machines'*, '*stair stepping machines'*, '*resistance machines'*, and '*stationary cycles*' fall within the scope of the Proprietor's general category '*machines for physical exercises*'. It follows that these terms are identical in accordance with the principle outlined in *Meric*.

- '*bar-bells'*

23. Even if worded differently, the Proprietor's term above is identical to the Applicant's '*Fitness equipment, namely, a weighted bar to improve posture and overall fitness'*.

- '*rowing machines; Exercise treadmills'*

24. The terms above are self-evidently identical to the Applicant's respective terms '*Fitness machines and equipment, namely, […] rowing machines*' and '*Fitness machines and equipment, namely, […] treadmills'*.

- '*Aerobic step machines*'

25. The above term is self-evidently identical to the Applicant's '*Fitness machines and equipment, namely, […] stair stepping machines, resistance machines'*.

- '*Exercise bars*;

26. The above term is identical to the Applicant's '*Physical fitness equipment, namely, […] training bars*'.

- '*punching bags*'

27. Even if worded differently, the above term is identical to the Applicant's '*Sports equipment for boxing and martial arts, namely, […] boxing bags*'.

- *'Finger stretching resistance bands'*

28. The above term falls within the Applicant's general category of '*Physical fitness equipment, namely, resistance bands*'. The terms are identical according to the principle outlined in *Meric*.

- '*body-training apparatus*'

29. Most of the Applicant's goods can be defined as 'body training apparatus' such as, for example, '*treadmills'*, *'rowing machines'*, *'stair stepping machines'*, *'resistance machines'*, *'stationary cycles'.* Thus, the respective goods are identical according to *Meric*.

- '*Elliptical trainers'*

30. The term above is identical or at least highly similar to the Applicant's '*Fitness machines and equipment, namely, […] resistance machines*'. Both goods have the same nature and intended purpose being exercise machines, with the only possible slight difference being in their respective uses as elliptical trainers do not create resistance for the user. However, both goods are likely to address the same users and share the same channels of trade.

- '*chest expanders [exercisers]*'

31. The Proprietor's term '*chest expanders [exercisers]*' is identical or at least highly similar to the Applicant's '*Physical fitness equipment, namely, exercise bands'.* These goods share the same nature (fitness equipment), the same purpose (muscle growth), and might have the same method of use because both parties' goods can be used to exercise chest muscles. The users might be the same and these goods are usually sold through the same trade channels.

- '*Weight lifting benches*'

32. The term above is similar to '*Exercise equipment, namely, abdominal boards*'. Both goods have the same nature (exercise equipment in the form of a bench) and intended purpose (muscle growth), but they might differ in their method of use. However, these goods are very likely to share the same users and to be sold through the same channels. Therefore, I find that these terms to have a high degree of similarity.

- *'Squat Racks; Weight lifting machines for exercise*'

33. The terms above are identical or at least highly similar to the Applicant's term '*Fitness machines and equipment, namely, […] resistance machines'*. The respective goods share the same nature (machines to enable physical exercise), intended purpose, and method of use. These goods are very likely to have the same users and be sold through the same channels of trade.

- '*yoga swings'*

34. It is my understanding that '*yoga swings*' consist of a special kind of hammock to enable the user to exercise yoga positions and overall body flexibility. I believe '*yoga swings'* share the same nature and intended purpose as the Applicant's '*yoga straps*' as both are exercise props that enable the user to exercise yoga positions. The respective goods are likely to have different methods of use, but they are likely to overlap in users and share the same channels of trade. Therefore, I find these goods to be similar at least to a medium degree.

- '*Trampolines'*

35. Trampolines can be used for a wide range of fitness exercises involving different parts of the body as well as to improve balance. It is my view that the above term

has at least a medium degree of similarity to some of the Applicant's terms such as, for example, '*Physical fitness equipment, namely, exercise bands*' and '*Balance boards for improving strength, toning, conditioning, balance, and proprioception*'. This because the respective goods share a similar nature (pieces of fitness equipment), intended purpose (body exercise and balance), share the same channels of trade, and address the same users.

The average consumer and the nature of the purchasing act

36. It is necessary to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited*, *The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), 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".

37. The average consumer of the category of products concerned is deemed to be the reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96, *Gut Springenheideand Tusky* [1998] ECR I-4657, paragraph 31).

38. For the purposes 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 in question.[4]

[4] *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, (Case C-342/97, para 26).

39. The average consumer of the goods at issue will be a member of the general public at large as well as businesses, organisations, and/or associations (such as gyms and sports clubs i.e., 'commercial consumers').

40. In some instances, the goods would be sold through a range of retail outlets (and their online equivalents) such as specialist sports and fitness retailers, catalogues, and online marketplaces, in which case they are available to all consumers; in other instances, the goods may be directed primarily at commercial consumers for example, large pieces of gym equipment made/designed especially for commercial usage rather than at-home use.

41. Depending on the size of the goods, they are likely to be displayed on shelves or in dedicated display areas where they can be viewed and self-selected by the consumer. A similar process will apply online and with catalogues where the consumer will select the goods having viewed an image of the goods displayed on a webpage/page. The selection of the goods is therefore primarily visual, although I do not discount that aural considerations may play a part by way of word-of-mouth recommendations and advice from sales assistants. However, even where the goods are selected by making requests to staff, the selection process prior to purchase would be visual in nature. Accordingly, visual considerations dominate.

42. The goods vary in terms of functionality and as a result of this, they can range from affordable, not too expensive small items to large, relatively expensive apparatus.

43. When purchasing the goods, the average consumer is likely to take into account such things as functionality, purpose, quality, durability, weight and size. Whether the goods are expensive or relatively inexpensive, the average consumer is likely to pay the degree of attention necessary to ensure that the goods meet their specific needs and requirements. I think these considerations will apply whether the consumer is buying the goods for their own personal use or whether they are for commercial use. For the most part, I would expect the average consumer to pay a medium degree of attention. However, for certain larger more expensive items (such as elliptical trainers) the degree of attention that will be paid is likely to be somewhat higher.

Comparison of trade marks

44. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

45. 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".

46. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

47. The trade marks to be compared are as follows:

Proprietor's trade mark	**Applicant's trade mark**

	**GYMAX**

Overall impression

48. The Contested Mark is a figurative mark which is composed of the word 'GEEMAX' in black and presented in uppercase, bold letters. 'GEEMAX' does not have any particular stylised font, however I notice that the letter 'G' is more rounded than the other letters. Above the word element, the mark features two geometric black shapes of different form and size that, when seen combined, seem to form a stylised 'X' with a white line cutting across it. The device might also be seen as an abstract figurative device.

49. Whilst the elements making up the Contested Mark (i.e. the word element and the figurative device) both contribute to its overall impression, it is the word element, 'GEEMAX', that has the greatest dominance in that overall impression since, generally speaking, the mind of the average consumer 'latches on' to them, and it is the word element that the average consumer will most likely use to refer to the Contested Mark.

50. In that regard, it should be noted that, "*according to well-established case-law, in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word*

elements to identify the mark concerned, the figurative elements being perceived more as decorative elements".[5]

51. The overall impression of the Applicant's mark resides in the single word 'GYMAX'.

Visual similarity

52. The word featured in the Contested Mark is six letters long and the Applicant's Mark is five letters long. The competing marks are therefore similar in length and overlap in their initial letter 'G' and the ending '-MAX'. They differ in the letters 'EE' and 'Y' following the initial letter 'G'.

53. The Contested Mark also features a figurative device resembling a stylised 'X'; this represents a point of visual difference between the marks.

54. Overall, I find the respective marks to have a medium degree of visual similarity.

Aural similarity

55. The word in the Contested Mark is comprised of two-syllables: 'GEE/MAX'. The Applicant's Mark is also formed by two syllables: 'GY/MAX'. Both marks begin with the letter 'G', terminate in 'MAX' and respectively differ in the letters following the letter 'G': 'G-**EE**' (to rhyme with 'bee') and 'G-**Y**' (where the 'Y' is short, as in 'gin'). Despite that latter difference, I find the marks to be aurally similar to an above-medium degree. I make this finding on the basis that I do not consider it likely that the device element in the Contested Mark will be vocalised. However, even if it is vocalised because some consumers perceive it to be a letter 'X', and pronounce it accordingly, there is still a medium degree of aural similarity between the marks overall.

Conceptual similarity

56. The Applicant submits that "*[…] both marks appear to be built upon the combination of the words GYM and MAX, allusively directing customers attention towards physical exercises and sporting activity, likely at a gym*"[6] and that "*the letters MAX can be considered to be a shortened version of the word MAXIMUM"*.[7]

[5] *Migros-Genossenschafts-Bund v EUIPO* - Luigi Lavazza (CReMESPRESSO), Case T-189/16, paragraph 52.
[6] Submissions dated 20 May 2023.
[7] Notice of Cancellation dated 1 February 2023.

57. I appreciate the Applicant's argument for which both marks share the abbreviation 'MAX' that commonly means "maximum". However, whilst both marks share the abbreviation 'MAX', I disagree with the Applicant's argument that both marks allude to a "gym". This is because I do not find that the relevant consumer will readily understand 'GEEMAX' as meaning "GYM + MAX". I find that for a significant proportion of consumers, 'GEEMAX' may evoke the concept of 'maximum' stemming from the 'max' ending of the mark but nothing more. I also find that for a separate significant proportion of consumers, 'GEEMAX' is likely to be perceived as a meaningless invented word with no allusive qualities at all.

58. Turning to 'GYMAX', I agree with the Applicant that a significant proportion of the relevant public is likely to perceive the Applicant's mark as being evocative of the words 'gym' and 'maximum' conjoined. However, I also consider that a separate significant proportion of consumers are likely to perceive no meaning at all from GYMAX.

59. It follows that, for some consumers there will be some conceptual similarity between the words GEEMAX and GYMAX owing to the common allusion to 'maximum' (notwithstanding that the Earlier Mark also alludes to the word 'gym') but for another significant proportion of consumers (those who perceive no clear meaning from either word), the words GEEMAX and GYMAX will be conceptually neutral. As for the device element in the Contested Mark, I find that for some consumers this is likely to be perceived as an abstract device and for others it may be perceived as a stylised letter 'X'. Either way, the device element portrays no immediately graspable concept (bearing in mind that a letter does not truly evoke any clear concept, as such).

Distinctive character of the Earlier Mark

60. 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 *WindsurfingChiemsee* 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)."

61. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the services, to those with high inherent distinctive character, such as invented words. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the Earlier Mark, the greater the likelihood of confusion.

62. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the Applicant makes no claim to enhanced distinctiveness through the use made of the Earlier Mark and nor has it filed any evidence of use. Accordingly, I have only the inherent position to consider.

63. The Earlier Mark is a word-only mark comprising of the single word 'GYMAX' presented in a standard typeface. As stated above, a significant proportion of consumers will perceive the Earlier Mark as an invented word with no meaning. For those consumers the Earlier Mark is high in distinctive character. For the other, separate, part of the relevant public that will perceive the Earlier Mark as a neologism deriving from the juxtaposition of 'GYM' + 'MAX', I still consider the Earlier Mark to have a fairly high distinctive character given that, as a whole, it has the appearance of an invented word, albeit one that has some allusion to the goods.

Likelihood of confusion

64. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

65. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. The concept of indirect confusion was explained by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10 as follows:

> "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".

66. I have found the respective goods to range from medium similarity to identity. The relevant consumer is likely to pay in general a medium level of attention in their selection (which might increase to a higher level of attention for more expensive purchases). The distinctiveness of the Applicant's Mark is high or fairly high. The marks have a medium degree of visual similarity and either an above-medium or medium degree of aural similarity. In terms of concept, the marks have either some

conceptual similarity or are conceptually neutral. The purchase of the contested goods is considered to be mainly visual but the potential for aural use is borne in mind. Weighing all of these factors, and bearing in mind the effects of imperfect recollection, I find that the average consumer is likely to mistake the Earlier Mark for the Contested Mark. I find this to be the case regardless of whether the marks are perceived as having some conceptual similarity or as being conceptually neutral. I also find it to be the case regardless of whether the marks are aurally similar to a medium or above-medium degree. Thus, there is a likelihood of direct confusion.

67. Even if I am wrong about that and the consumer notices the differences between the marks, this is likely to be because they recall that the Contested Mark has a device element (which may or may not be recognised as a letter 'X') but the Earlier Mark does not. In those circumstances, the average consumer is still likely, in my view, to misremember the respective words in the marks as being the same and merely believe that the addition of the device element is consistent with a brand extension of the Earlier Mark. There is, therefore, also a likelihood of indirect confusion.

68. For the avoidance of doubt, I would still have found direct and indirect confusion even if I had found that the distinctiveness of the Earlier Mark is of a medium level (rather than high/fairly high).

Conclusion

69. The application for invalidity against the Proprietor's mark has succeeded in full. As a result, the Proprietor's mark is, subject to any successful appeal, hereby declared invalid and deemed as if it had never been registered for any of the goods covered by its specification.

Costs

70. As the successful party, the Applicant is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice (TPN) 2/2016. The sum is calculated as follows:

Official fee	£200

Filing the Form TM26(I) and considering the counterstatement	£200
Filing written submissions	£300
Total:	**£700**

71. I therefore order QIAN NI LIMITED to pay FDS GmbH the sum of **£700**. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 7th day of August 2024

Andrea Rossi

For the Registrar