

O-236-13

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2547975

BY PLYMOUTH CITY COUNCIL

TO REGISTER THE TRADE MARK “PLYMOUTH LIFE CENTRE” IN CLASSES 41 AND
43

AND THE OPPOSITION THERETO UNDER NO 101144 BY AWARENESS LIMITED

DECISION

INTRODUCTION

1. This is an appeal from the Decision of Mr David Landau acting for the Registrar whereby he upheld in part an opposition based on section 5(2) of the Trade Marks Act 1994 (“the Act”) to registration of the mark “PLYMOUTH LIFE CENTRE” on the basis of an earlier registration of “THE LIFE CENTRE” (in various forms) in the name of the opponent/appellant.

Issue on appeal

2. In a decision taken on the papers, the Hearing Officer reviewed the evidence in detail and applied established legal principles. Those principles are not questioned on this appeal. The issues raised by the opponent/appellant are as follows.

3. First, whether the Hearing Officer was wrong to hold that the use by the opponent/appellant (“Awareness”) of its earlier mark “THE LIFE CENTRE” was only proven in respect of “tuition, training and workshop services in respect of yoga”. Awareness says that the Decision took too narrow a view of the use that Awareness had shown, and that, had the Hearing Officer taken a broader view, Awareness’ earlier registration would have been more potent against the Plymouth City Council’s application.

4. Second, whether the Hearing Officer was wrong to hold that yoga was not a “sport” in evaluating the similarity of services in the respective marks. This is relevant because, if it is a sport, it is said to make the services for which Awareness’ earlier mark is registered more similar to the services for which Plymouth City Council is seeking registration.

5. Third, whether the Hearing Officer was wrong to hold that “teaching coaching and instruction in dance” were not similar to services relating to teaching yoga. If they are similar, again that has a potential impact on the extent to which Awareness’ registration affects Plymouth’s application.

6. Overall, Awareness contends that, as a result of these errors, as well as upholding the opposition to certain limited services, the Hearing Officer should have upheld it for a wider range.

APPROACH TO APPEAL

7. This appeal is a review of the Hearing Officer’s Decision. Robert Walker LJ (as he then was) said of such appeals:

“...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle” (*Reef Trade Mark* [2003] RPC 5 at [28]; see also *BUD Trade Mark* [2003] RPC 25).

THE GROUNDS OF APPEAL

I. Awareness' use of the LIFE CENTRE mark

8. Although Awareness does not seek to defend the whole scope of its earlier registration and accepts for present purposes that it has not been used over the whole width, it says that the Hearing Officer ought to have held that use had been shown for a greater range of the following services “*tuition, training and workshop services; tuition, training and workshop services in respect of fitness, yoga, pilates, tai chi, complementary therapies, beauty treatments, massage, bodywork, aromatherapy, osteopathy, homeopathy, reflexology, herbal and nutritional treatments, naturopathy and Chinese medicine.*” The Hearing Officer was of the view that use had only been proved for a limited range (essentially, yoga classes).

9. This broader earlier specification, it is said, should have resulted in the Hearing Officer refusing the PLYMOUTH LIFE CENTRE mark additionally for a range of services including “provision of sports and leisure facilities”, “provision of martial arts studios”, “provision of dance studios”, “teaching coaching and instruction in sports, martial arts, dance” and advisory and consultancy services relating to the aforementioned”.

The Hearing Officer's evaluation of the evidence of use

10. Awareness provided evidence of the provision of Yoga and other classes at its premises in Notting Hill which the Hearing Officer evaluated. He referred to the relevant authorities (including *Ansul* on the overall approach; the well-known observations of Jacob J in *Labratoires Goemar* on the need for particular care in ensuring that the evidence was sufficient to prove use and *Reckitt Benkiser v. OHIM* (T-126-03) on the approach to determining the right scope of a specification). The Hearing Officer also referred to In *Anheuser-Busch Inc v OHIM* Case T-191/07 where the General Court said:

“105 Moreover, the Court of First Instance has held that genuine use of a trade mark could not be proved by means of probabilities or suppositions, but had to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (Case T-39/01 *Kabushiki Kaisha Fernandes v OHIM – Harrison* (HIWATT) [2002] ECR II-5233, paragraph 47).”

11. The Hearing Officer noted correctly that care had to be taken when applying judgments relating to cases which were the subject of appeal from OHIM but that this overall approach of

EU law on evaluating evidence of use relating to CTMs was in line with the English law as exemplified by *Laboratoires Goemar*.

12. The Hearing Officer made several criticisms of the quality of the evidence of use beyond Yoga classes and concluded at para [24]:

Taking into account the absence of turnover figures at all, or in relation to specific services, and the nature of the evidence, all that can be concluded, without recourse to probabilities or suppositions, bearing in mind the constant identification of the Life Centre with yoga, is that genuine use has been established in the material period in relation to *tuition, training and workshop services in respect of yoga*. The evidence as submitted does not allow for any wider use to be concluded as it does not allow for consideration of whether the use is warranted in the marketplace. In reaching this conclusion it is taken into account that there is no *de minimis* quantum of use but Awareness has to establish on an evidential basis that any particular use is warranted in the marketplace. In relation to non-yoga services the evidence is marked by its lacunae.

13. Awareness says that this conclusion takes an overly critical view of the evidence that was provided. It says that the fact that the use was overwhelming in relating to Yoga classes should not have obscured the fact that there was also use proven in relation to a wider range of services and that there was use “warranted in the economic sector” in the *Ansul* sense. Awareness therefore contends that the finding that there was in effect no use proven other than in relation to yoga was not open to the Hearing Officer on the evidence. These points have, at their heart, the contention that there was, in the evidence, material from which the Hearing Officer could and should have found use beyond Yoga classes. It is therefore necessary to consider the evidence upon which Awareness relies. In the light of the criticism of the Hearing Officer as being unduly picky, some general observations on the evidence of use are warranted at the outset.

General observations

14. Trade marks registers in this country and elsewhere are becoming increasingly crowded. That gives additional force to the observations made by Floyd J (as he then was) in *Galileo International Technology, LLC v European Union (formerly European Community)* [2011] EWHC 35 (Ch):

“39. The unrestricted specification is of enormously wide scope. The Hearing Officer wisely reminded himself of what Laddie J had said about wide specifications for

computer software in *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850. Laddie J considered that:

"... there is a strong argument that a registration of a mark simply for "computer software " will normally be too wide. In my view the defining characteristic of a piece of computer software is not the medium on which it is recorded, nor the fact that it controls the computer, nor the trade channels through which it passes but the function it performs. A piece of software which enables a computer to behave like a flight simulator is an entirely different product to software which, say, enables a computer to optically character read text or design a chemical factory. In my view it is thoroughly undesirable that a trader who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those which are far removed from his own area of trading interest. If he does he runs the risk of his registration being attacked on the ground of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act."

40. That was a case decided under the Trade Marks Act 1938, but, like Laddie J, I see no reason why the views there stated should not apply under the Act."

15. If anything, the proliferation of trade mark registrations and applications and the fact that the Community Trade Mark system has created an increased risk of conflict with prior rights makes these observations all the more apposite in cases arising under the Trade Marks Act 1994.

16. That is particularly so because there is, in practice, limited control at the application stage on the width of specifications that proprietors may obtain. Trade mark applicants and their advisors naturally want (indeed, in the case of professional advisors, may be obliged to obtain) as broad a scope of coverage as they reasonably can get. Because of this, applications for revocation for non-use make a real contribution to the smooth working of the trade mark system. Since earlier registrations not only preclude later undertakings from using but also from registering marks of their own, challenges to use (or the scope of use) of earlier marks in opposition proceedings are no less important.

17. Just as wide specifications give rise to problems, so does generalized and non-specific evidence seeking to support wide specifications once challenged for non-use. That is particularly

so given the approach that tribunals must take to the issue of proof of use in the case of such specifications. Tribunals considering the issue of what use has been proven and what specification is appropriate in the light of such use apply the principles summarized in *NIRVANA O/262/06*. In that case, the Appointed Person (Mr Richard Arnold QC) set them out as follows at [58]-[59]:

“I derive the following propositions from the case law reviewed above:

- (1) The tribunal’s first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].
- (2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].
- (3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].
- (4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].
- (5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].
- (6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].
- (7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].
- (8) The exercise of framing a fair specification is a value judgment: *ANIMAL* at [20].

59. I would add a point which in my judgment is implicit in most of the decisions, although not explicit, which is that it is for the tribunal to frame a fair specification and not the parties.”

18. Arnold J returned to this topic recently in *Stichting BDO & Ors v BDO Unibank, Inc & Ors* [2013] EWHC 418 (Ch) and considered the extent to which the *NIRVANA* approach might be said to differ from that adopted by the CFI. Having set out the *NIRVANA* approach, he said at [56]-[58]:

56. In *EXTREME Trade Mark* [2008] RPC 2, again sitting as the Appointed Person, I considered the decision of the CFI in Case T-256/04 *Mundipharma AG v OHIM* [2007] ECR II-449 and continued as follows:

"54 Although at first blush this suggests an approach which is somewhat different to that laid down by the English authorities considered in *NIRVANA*, I consider that the difference is smaller than might appear. The essence of the domestic approach is to consider how the average consumer would fairly describe the goods in relation to which the trade mark has been used. Likewise, paragraph [29] of *Mundipharma* indicates that the matter is to be approached from the consumer's perspective.

55 To the extent that there is a difference between them, I remain of the view expressed in *NIRVANA* that I am bound by the English authorities interpreting section 46(5) of the 1994 Act and Article 13 of the Directive and not by the CFI's interpretation of Article 46(2) of the CTM Regulation since, as already noted above, there are differences between the two legislative contexts. Nevertheless I consider that English tribunals should endeavour to follow the latter so far as it is open to them to do so. *Mundipharma* suggests that, within the spectrum of domestic case law, the slightly more generous approach of Jacob J. in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch), [2004] FSR 19 is to be preferred to the slightly less generous approach of Pumfrey J. in *DaimlerChrysler AG v Alavi* [2001] RPC 42."

57. In *Daimler AG v Sany Group Co Ltd* [2009] EWHC 1003 (Ch), [2009] ETMR 58 Geoffrey Hobbs QC sitting as a Deputy High Court Judge summarised the correct approach at [10] as follows:

"... the aim should be to arrive at a fair specification by identifying and defining not the particular examples of goods for which there has been genuine use, but the particular categories of goods they should realistically be taken to exemplify. ..."

58. As Mr Hobbs added when sitting as the Appointed Person in *Euro Gida Sanayi Ve Ticaret Ltd v Gima (UK) Ltd* (BL O/345/10) at 11:

"For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. Use should be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (to use the words of *Anheuser-Busch* – see above).

20. Providing evidence of use is not unduly difficult. If an undertaking is sitting on a registered trade mark, it is good practice in any event from time to time review the material that it has to prove use of it. Courts and tribunals are not unduly harsh as to the evidence they are prepared to accept as establishing use. In *Almighty Marketing Ltd. v Milk Link Ltd.* [2005] EWHC 2584 (Ch) (18 November 2005) a case primarily concerning the requirements of rule 31 of the Trade Mark Rules which require a proprietor to show prima facie use at the first stage of proceedings, Kitchin J (as he then was) analysed the requirements of evidence of use by reference to the authorities and said:

17. In *Carte Bleue Trade Marks* [2002] RPC 31 Mr. Knight, the principal hearing officer acting for the registrar, observed at paragraph 35:

"Therefore it seems to me that the Act and the Rules indicate that at least initially the registered proprietor in seeking to defend himself against an allegation of non-use need only show use at the outset which indicates clearly to those concerned that a proper defence is, and can be, mounted in relation to the allegation that the trade mark has not been used. "

If, in using the expression "proper defence", the hearing officer meant an arguable defence then I respectfully agree with him. After referring to another decision by one of the registrar's hearing officers in *Adrenalin* [O/BL336/99] he continued, at paragraph 37:

"From my point of view I would simply reinforce what has been said in these decisions and in the Manual, that the sort of evidence that one would normally hope to see is copies of brochures, catalogues, pamphlets, advertisements, etc all of which show use of the trade mark in question together with some indication of the sales of goods, or the provision of services during the relevant periods. Clearly this cannot be an exhaustive list and is merely an example of documents which might be sent in."

I agree with the hearing officer that evidence of this kind is highly desirable. If the proprietor files such evidence it will assist in clarifying the issues at an early stage and may even serve to shorten the proceedings. It is not, however, a requirement of rule

31(3). If the proprietor is able to establish that it has an arguable defence to the application without filing such evidence then, in my judgment, it is not obliged to do so.

21. Having considered the evidence and the observations of the Hearing Officer, Kitchin J continued:

22. In my judgment the hearing officer fell into error...in seeking to apply the decision *Carte Bleue* as if it were laying down a code as to the specific documentary evidence which must be filed in order to satisfy rule 31(3). In particular, and as is apparent from paragraph 25 of the decision, he appears to have been of the view that it was incumbent upon the appellant to provide information such as brochures, catalogues, pamphlets, advertisements or the like together with an indication of the sales of goods achieved under the mark during the relevant period. There is no requirement upon the proprietor to provide such information although it may be desirable for him to do so. The rule only requires that the evidence, considered as a whole, establishes that the proprietor has an arguable defence to the application for revocation.

22. The burden lies on the registered proprietor to prove use. However, that and other cases show that there is no particular way in which use must be established. At the initial stage of revocation proceedings, where all he has to show is an arguable case, the approach may be more relaxed but even when the matter comes to be finally determined there is also no hard and fast way in which use must be proved. Evidence which may be sufficient to establish an arguable case that there has been use for the purpose of rule 31 may be insufficient ultimately to prove that there has been such use on the balance of probabilities. However, it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more, so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.

The evidence in this case

23. Ms Stanley, who is a director of and who runs Awareness, provided a relatively short witness statement in which she said, inter alia:

“My firm has made consistent use of the registered trade mark THE LIFE CENTRE in the United Kingdom in relation to the following services within the five year period immediately preceding the publication of the opposed application:

Tuition, training and workshop services; tuition, training and workshop services in respect of fitness, yoga, Pilates, tai chi, complementary therapies, beauty treatments, massage, body work, aromatherapy, osteopathy, homeopathy, reflexology, herbal and nutritional treatments, naturopathy and Chinese medicine.”

24. A number of documents were exhibited to back this statement up which I consider below. Before turning to the detail of that material it is appropriate to make some observations on the evidence as a whole.

25. First, as the Hearing Officer held, the general statement that Awareness had made “consistent” use of the mark in relation to “tuition, training and workshop services” was unsupportable. The Hearing Officer held that such a description of services covered a very wide spectrum “from classes for pre-school children to post graduate supervision, from finger painting classes to training as a gas fitter”. One might add that it also covers tuition in respect of activities for which a mark “THE LIFE CENTRE” might be particularly suitable for use by others – such as, for example, drawing or first aid.

26. A wide claim of use of the kind made by Ms Stanley is not straightforwardly false (since it might be said that the fact that some tuition, training are workshop services, however narrow, would form a basis for it). I am nonetheless of the view that broad conclusory statements of that kind in evidence of use should be avoided, unless they are properly justified.

27. This sort of thing is not unduly difficult to avoid, especially for represented litigants. The Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and other Regulated Persons give guidance in paragraph 14 to the effect that a such persons must not submit orally or in any documents or pleading, inter alia, a) statements of fact or contentions that are not supported by the evidence or instruction of the client; b) contentions that he cannot justify as prima facie arguable. So attorneys engaged in contested proceedings in which use is in issue will, in any

event, be regularly turning their minds to the question of the supportability of claims of use as part of their professional obligations.

28. I do not know whether the evidence in this case was prepared with professional assistance and I make no criticism of those involved in this case. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted. Excising the unjustifiable is as much a part of the exercise of dotting the i’s and crossing the t’s of the evidence (referred to in *Laboratoires Goemar*) as is reinforcing the justified.

29. Second, in my view, the overall criticisms made by the Hearing Officer of this evidence were warranted.

30. Ordinarily, given that the use was relatively recent, one would expect general statements about use of the kind made by Ms Stanley to be backed up with detailed evidence of turnover in respect of each of the services in question identifying, with precision, the dates upon which such services were provided and the amount of trade conducted (or, in appropriate cases, the nature of the promotional activity). Or one would, at least, expect a cogent explanation for why such material was unavailable. In the case of potentially wide categories such as “Chinese medicine” and “nutritional treatments”, one would expect the evidence to descend into considerable detail as to the range of services offered to make it clear that a specification of that kind could be supported. One would expect itemized invoices or other financial records showing the volume of business in the specific areas so that it was possible properly to assess the nature of the use in its context. Although it is true that such material is not strictly necessary in that, in appropriate cases, a case will not automatically fail for the want of it, the failure to provide a cogent

documented record where there is no real reason for not doing so is something the court can take into account.

31. The documented record of use beyond yoga classes was slight. The majority of the exhibits to Ms Stanley's evidence by volume consisted of articles and directory entries referring to THE LIFE CENTRE almost exclusively as a place at which to do and learn Yoga of various kinds. The impression given by this material is that THE LIFE CENTRE is basically a high quality and well renowned yoga centre. In this connection, he referred to the relevant authorities (among which were *Euro Gida Sanayi Ticaret* and the cases such as *Thomson v. Norwegian* and *Animal* from which the principles summarized in *NIRVANA* are derived, as well as *Almighty Marketing* and *Anheuser Busch*) in defining an appropriate specification.

32. It is therefore understandable that the Hearing Officer came to the conclusion that this was all that the mark had been used for. The dominance of yoga-related material and the fact that the parties invited decision on the papers (thereby forgoing any interactive opportunity to point out specific matters to the Hearing Officer upon which it particularly relied) did not put the Hearing Officer in a good position to take account of the less obvious material relating to the provision of other services.

Use for services other than yoga classes

33. Awareness contends, somewhat non-specifically, that the Hearing Officer was wrong to dismiss the clear evidence of its use in relation to services other than Yoga classes "(in particular but not limited to, Pilates tai chi and massage)" (Awareness skeleton argument, para. 6). Plymouth City Council points out that the appeal documentation is rather unclear as to what use it is said should have been held proven.

34. The Hearing Officer analysed the evidence in some detail in the Decision and, in the light of the criticisms leveled at his approach, I have reviewed it all again. I will not however, set out here a full summary but, instead, extract from it references to any services other than yoga classes to determine whether there is a basis for a wider specification. I deal with the exhibits which appear to have greatest relevance and focus on these because, in my judgment, it is unsafe

to rely on the generalized statements in the principal witness statement without independent support.

35. Ms Stanley says that classes were offered in yoga, Pilates, children's activities and Tai Chi. The schedules of classes at ES2 show, in addition to yoga, classes in Pilates (normal and pregnancy) and Tai Chi. There is also reference to massage, shiatsu, breathing exercises, breastfeeding, and spinal exercise. Although there is no direct evidence that these classes took place they are said to be representative of the classes undertaken by Awareness during the relevant period. The fact that Pilates and baby massage classes were offered as well as yoga is to some extent supported by ES4 (THE LIFE CENTRE studio timetable valid from October 2006) which again strongly suggests that Yoga is the key focus of activity. There is further modest support for the fact that a somewhat wider range of activities was engaged in from the fact that a range of activities were licensed by the local authority to take place at THE LIFE CENTRE in 2007 for a period ending in 2008. A number of persons were thereby approved to give treatments of various kinds which included acupuncture, aroma therapy, facials, massages of various kinds including shiatsu, manicure/pedicure, reflexology. There was, at least during that period, no license to use the premises for osteopathy, homeopathy, herbal or nutritional treatment, naturopathy or Chinese medicine. No other licences for other periods are exhibited and this license relates to the administration of treatments rather than training for such.

36. The adverts, directory entries and articles in the exhibits all refer to yoga (of various kinds and including facial yoga). In some, THE LIFE CENTRE is described as one of London's "original", "leading" or "premier"... "yoga centre[s]". In some, the publications also refer to THE LIFE CENTRE offering a wide range of treatments without specifying which. In others, there is some reference to THE LIFE CENTRE offering massages of various kinds. There is also some support for a wider range of classes than yoga from the contracts with the individual tutors or therapy providers. These show that it was contemplated that at least the following would be provided as well as yoga: massage (of various kinds) pilates, osteopathy, hypnotherapy, reiki, homeopathy, Chinese herbs and acupuncture, reflexology. However, it is not possible to tell from the very brief evidence which therapist offered which kind of therapy or whether this was in the relevant period. It is also necessary to view that kind of evidence with care because all it shows is that therapists were in a position to offer services of various kinds

through THE LIFE CENTRE, not that any such services were in fact offered (whether under THE LIFE CENTRE mark or otherwise). In the case of massage, there is very thin evidence that tuition, training or workshop services were offered with respect to massage (in the sense of teaching others how to do massage as opposed to administering it) with the possible exception of baby massage.

37. In my judgment, taking the evidence as a whole, it shows, as the Hearing Officer held, use in relation to tuition, training and workshop services in respect of yoga. In my judgment, with a slight exception, this evidence is simply not solid enough to show in the manner required any wider use within the specification than that. The slight exception is Pilates classes. In that case, I think that there was sufficient evidence to justify a finding that Awareness had proved use of THE LIFE CENTRE in relation to Pilates classes which would fall under the description tuition, training and workshop services in respect of Pilates. Pilates was on the calendar, there was a specific contract with a Pilates teacher, it was specifically mentioned in the written evidence (and it was specifically referred to in the original letter concerning use from Kilburn & Strode). I think there was just enough material, in relation to Pilates classes, to show that sufficient non-token use had been made for them in the relevant period, although the case is somewhat marginal. I do not think that any wider category of fitness training or massage than Pilates classes has been adequately proven, notwithstanding the brief references to them. The Hearing Officer was right to say that in relation to non-yoga services, the evidence was marked by its lacunae.

38. In my judgment, this is a case in which it would not be correct to say that the Hearing Officer was plainly wrong with respect to this slight adjustment and I have hesitated before even going this far. I think the better description is that the evidence of use was so thin overall save as to yoga classes and he did not have the benefit that I had of being directed to parts of it at a hearing (since the case below was decided on the papers alone) that he reasonably did not pick up on this slightly greater scope of proven use. It is therefore appropriate to address it on this appeal.

39. Accordingly, I consider that the right specification of Awareness's earlier mark for considering the rest of the case is as follows:

“Tuition, training and workshop services in respect of yoga and Pilates.”

40. It may be that THE LIFE CENTRE has in fact used the mark for a wider range of services. It may be that it regularly offered massages of various kinds. That would not, however, justify a registration for “tuition, training and workshop services in respect of massage” but might support a registration in respect of “massage services” themselves. It may also be that it offered Tai Chi training or baby massage classes during the period but the evidence is so slight in relation to these that I do not think it would be right to say that it had provided sufficiently solid evidence of use (despite the slight mention in ES2 and Ms Stalney’s statement). I am not saying that THE LIFE CENTRE did not offer such services, merely that the evidence is insufficient to prove use to the required standard on this application. That said, I do not think this issue matters because, for the reasons that the Hearing Officer gave in relation to yoga, the opposition would be no better even if Tai Chi or baby massage classes were included.

II. Yoga as a sport

41. Awareness contends that the Hearing Officer should have treated yoga as a sport. He said of this issue at para. [35] of the Decision

Awareness in its submissions refers to yoga being on the list of sports councils as if this is evidence that yoga is a sport. Yoga is under the heading of exercise and fitness, which does not make it a sport. The list also includes ballroom and highland dancing and caving. It is difficult to envisage anyone in the normal course of affairs, as describing these as sports. Awareness’s own evidence at ES6 states “[y]oga is not a sport”.

42. Significant weight was placed on the classification by Sports Councils of yoga as a sport. I am un-persuaded by this argument. The fact that something is a physical activity (such as ballroom dancing) which requires skill and training for its proper execution and in which people may develop high levels of proficiency does not make it a sport as commonly understood. Moreover, in my judgment, it is necessary to consider not what “sport” means in the abstract but what the term “sport” means in the relevant specifications under challenge. The Hearing Officer rightly referred to the well known observations in *British Sugar plc v. James Robertson & Sons Ltd* [1996] RPC 281 to the effect that when construing words in a specification one was concerned with how the product or service was as a practical matter regarded for the purpose of trade.

43. In my view, “sporting....activities”, “sports centre services”, “sports and leisure facilities” and other services referring to sport do not encompass an activity such as yoga. It is noteworthy that one of the yoga specialists quoted in one of the journals says that “yoga is not a sport” although I do not place particular reliance on that. Nonetheless, it reflects ordinary usage. I am unable to detect any error of principle in the manner in which the Hearing Officer evaluated the matter in rejecting the argument that yoga was a “sport” in this context. I am also satisfied that, if yoga is not properly to be regarded as a sport, neither is Pilates. Pilates is, as is well known, a form of physical fitness and body conditioning training. It has, in my view even less claim to be classified as a sport, than yoga.

III. Similarity of services – dance and yoga

44. The Hearing Officer held that “teaching coaching and instruction in dance” were not similar to services relating to teaching yoga. His reasoning was as follows, in para. [39] of the Decision:

Teaching, coaching and instruction in sports, martial arts, dance are all teaching services. At this high level of generality there is a coincidence with the services of the earlier registration. However, as noted above training related services cover an enormous spectrum of activity, as does computer software. None of the services rehearsed above are encompassed by the services of the earlier registration. Persons giving such services are unlikely to be the same persons who give the services of the earlier registration. The person using such services is seeking an expertise in a different area to that supplied by Awareness. There is nothing to connect martial arts and dance with the services of the earlier registration. Despite the list of the sports councils, dance is primarily an artistic activity and not a sporting activity. Yoga may be used by sportspersons but giving instruction in yoga is not giving instruction in a sport.

Taking into account the core of the activities, teaching, coaching and instruction in sports, martial arts, dance are not similar to the services of the earlier registration. (That there may be a similarity at the most general level, ie teaching being involved, does not give rise to the services being similar. On a reductio ad absurdum basis, all goods and services would be found similar as at some level there will be a similarity.)

45. Awareness submits that the Hearing Officer went wrong because dance was considered to be a sporting activity by Sports Councils along with yoga, that yoga was a physical discipline for which people will pay for supervision and professional training and that there was no evidence to show that dance was primarily an artistic rather than a sporting activity.

46. None of these arguments are persuasive. The relevant similarity between the services in question is such that the average consumer would be likely to consider that they originated from the same trade source if similarly marked. The Hearing Officer captured this by saying that the people giving the respective services were unlikely to be the same.

The consequences for the scope of the PLYMOUTH LIFE CENTRE registration

47. I have held above that the scope of registration of THE LIFE CENTRE mark should be somewhat greater than the Hearing Officer said but not by much. I turn then to whether this has any impact on the overall result, having regard to the evaluation of the likelihood of similarity. Having identified an aspect where the Hearing Officer should have taken a somewhat more generous view of the evidence, I will consider the matter afresh albeit with due regard to the Hearing Officer's evaluation in paras. [27]-[44] of the Decision.

48. In those paragraphs, the Hearing Officer set out the characteristic of the average consumer and the nature of the purchasing decision (see para. [27]). In essence, he held that many of the respective services were likely to be purchased as a result of a careful and educated decision although some were more likely to be purchased because of proximity (such as swimming in the applicant's services). He thought that visual similarity was more likely to be important than aural. No criticism is made of this as an approach.

49. The Hearing Officer also compared the marks and held (see para [28]), that the marks were similar "to a high degree", PLYMOUTH being geographically descriptive. Again, no criticism is made of that approach. He held that THE LIFE CENTRE had a "reasonable degree of distinctiveness" (see para. [44]).

The Hearing Officer's conclusions

50. The Hearing Officer concluded that, having regard to the scope of Awareness' earlier registration, that Plymouth City Council's registration should be in respect of the following services:

“sporting and cultural activities; provision of sports and leisure facilities; rental of sports facilities; provision of sports hall and sports court facilities; provision of martial arts studios; provision of dance studios; provision of swimming, diving and leisure pools;

provision of bowls facilities; provision of indoor climbing facilities; teaching, coaching and instruction in sports, martial arts and dance; entertainment services; organisation of exhibitions and cultural events; organisation of sporting events; advisory and consultancy services relating to the aforementioned”.

51. He had previously held that the mark should not be allowed for “recreation, leisure and sports centre services” on the basis that this was an exceptionally vague term which could cover any of the services which take place within such centers including the services of the earlier registration. He therefore held that the earlier mark was registered for identical services and because THE LIFE CENTRE and PLYMOUTH LIFE CENTRE were similar to a high degree, there was a likelihood of confusion. He also held that the mark should not be allowed for “education services” and “teaching, coaching and instruction in physical fitness” on a similar basis.

52. The closest that the Plymouth City Council specification that the Hearing Officer allowed gets to Awareness’s more expansive registration of “Tuition, training and workshop services in respect of yoga and Pilates” is “teaching, coaching and instruction in sports, martial arts and dance”. I have set out the Hearing Officer’s conclusions on this above in the discussion of similarity with dance and add a few further observations in the light of the way that the argument developed more generally with respect to these classes of services.

53. First, I do not think there is any basis for suggesting that yoga or Pilates are “martial arts” as that term would be understood on the specification. Second, I have also considered the Hearing Officer’s evaluation of other aspects of the argument on similarity in paragraphs [27]-[38] as well as the more specific findings of more direct relevance to the appeal in determining whether there is a likelihood of confusion and am satisfied that the Hearing Officer’s conclusions taking these into account, at para. [39] were within the range of reasonable views. Third, it is said by Awareness that the Hearing Officer’s conclusion that yoga was not similar to sport was wrong and inconsistent with a finding that teaching yoga was identical to teaching physical fitness. I do not see that there is this inconsistency. His point there was that physical fitness was so broad as to encompass, inter alia, yoga and the mark was to be rejected on that basis. I do not take him to be saying that anything which could be described at some level of generality as teaching physical fitness (e.g. teaching dance) was similar to anything else which could be so described (e.g. teaching yoga). The scope of services that the Hearing Officer permitted were

ones in which there was no real risk of confusion, having regard to all of the circumstances, despite the fact that to some degree they all involved elements of teaching different kinds of physical activity.

54. Although others may have taken a different view, he was, in my judgment, entitled to find that the specific services under comparison were not similar to one another. I do not think that this evaluation is open to challenge on this appeal, having regard to the *REEF* principles. The reasoning underlying it applies equally to the Pilates-related services. Finally, it should also be noted that Awareness does not have a registration that covers the premises at which the various activities are conducted. That is a further point of difference and means that if the opposition fails in relation to the “teaching” aspects of the specification, it cannot do better on the “premises” aspects.

55. More specifically, I do not regard tuition, training and workshop services in respect of Pilates as more similar to any of the services for which registration was permitted than tuition, training and workshop services in respect of yoga. To the contrary, it seems to me that if anything, the argument in respect of Pilates is weaker. First, Pilates is not even arguably a sport on the basis of a Sports Council categorization. Second, Pilates is no more a dance or dance-like than yoga is. Third, Pilates is not a martial art or similar to a martial art and there is no evidence that it would ever be so regarded. It is a rather specific physical fitness training regime.

56. Finally, having regard to the nature of the marks, the similarity and the differences between them (including the use in one of “Plymouth” which is a geographical but nonetheless noticeable qualifier) and the careful and educated way in which the average consumer would go about purchasing the respective teaching services, even were these services to be regarded as somewhat similar (which I think is the highest it could be put) I would not consider that there was a real risk of confusion. So, in my view, the overall conclusion of the Hearing Officer would remain unaffected even if he had been clearly wrong in his evaluation of similarity of services.

57. Although I have identified one aspect in which the Hearing Officer should have adopted a somewhat more generous approach as to evidence of use, it has no impact on the result. For the reasons given above, in my judgment, the slight increase in the scope of services in respect of

which I think Awareness has shown use of the earlier mark does not alter the overall decision with respect to the services for which registration should be permitted. I say nothing as to the point made in the evidence that Plymouth City Council is not, in fact, using the mark as proposed to be registered but the (more similar) LIFE CENTRE since the analysis for present purpose must be conducted on a mark for mark basis.

58. Finally, stepping back from the detail, it is useful to consider whether the overall outcome reached by the Hearing Officer is reasonable, in the light of the parties' respective areas of activity as reflected in the allowed scope of registration of PLYMOUTH LIFE CENTRE and the defensible scope of registration of THE LIFE CENTRE. In my judgment, it is. Put simply, THE LIFE CENTRE is an established, well-regarded mainly Yoga centre in Notting Hill and, more recently, Islington. PLYMOUTH LIFE CENTRE, both from the scope of registration and the evidence looks to be a full function sports and leisure centre in Plymouth in the traditional mould. It is hard to see any way in which these two very different undertakings could come into sensible trade mark conflict.

CONCLUSION

59. For these reasons, despite the attractively developed submissions on behalf of Awareness, this appeal must be dismissed.

Costs

60. The parties made no special submissions as to costs. The Hearing Officer made no order as to costs below because Awareness had only been partially successful. There was no cross-appeal and this appeal was brought in an attempt to do better than the limited success below.

61. Having regard to the scale of costs, the fact that both sides instructed counsel, the limited length of the hearing and the relatively short skeleton arguments on both sides, in my judgment, Awareness should pay Plymouth City Council £500 in respect of the costs of this appeal.

DANIEL ALEXANDER QC

Appointed Person

28 May 2013

Ben Longstaff, instructed by Kilburn & Strode for the appellant/opponent.

Simon Malynicz, instructed by Michelmores LLP for the respondent/applicant.