

# What does an *entertainment software app* have to do with a *fitness club* ?

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# Introduction

1. On-line counterfeit of the trademark  related to an app

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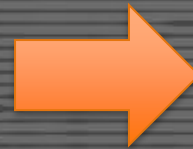
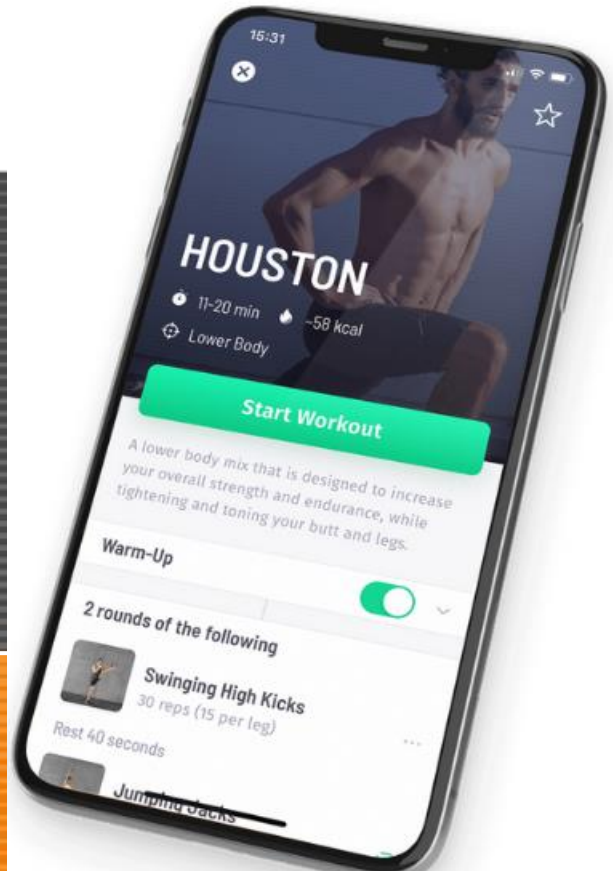
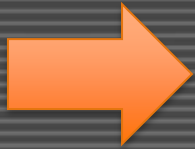
2. E.U. Opposition about confondibility of trademarks



vs.



# Situation



A personal trainer app boasts 400+ workouts.



# Situation



A fitness club, offering science-based, highly-efficient 30 minute workouts and a fitness lifestyle program.







Can the **similarity** between **two marks**



**prevail** on the low similarity between the goods and services, based on the argument that it is irrelevant if the “*entertainment activity, exercise and fitness workouts*” are performed by a trainer online through a mobile app, or physically in a gym or in a health club ?



# Facts of the case




- ✓ 2018-2019: Bending Spoons – an Italian tech company focused on creating and marketing mobile apps - filed and registered the EUTM  N. 017925097 for “*software app*” (class 9)
- ✓ 2020: Bending Spoons traced the use of the mark  for a “*fitness club*” by the German company Haslbeck Sports UG. on the Internet.  
The mark was also used on different social networks e.g.:   
- ✓ At the same time, the TM watching service traced the publication of the EUTM  N. 018171617 which was filed on February 2020, *inter alia*, for “*Health club services [health and fitness training]*” (class 41) by the above German company.
- ✓ April and July 2020: Bending Spoons immediately filed an opposition before EUIPO and at the same time sent to Haslbeck Sports UG a cease and desist letter with the request of stopping the use of the mark 
- ✓ August 2020: Haslbeck Sports UG replies “no”! Arguing that the marks were not confusingly similar in relation to the related goods and services.

So, .....the opposition went on.....

before



## Claims of the opponent:

- The two marks  and  are confusingly similar since they share the same ordinal number “30”.
- The prior mark  has **acquired distinctiveness and reputation**, since it has been extensively used in Italy and in the other E.U. countries during the past 2 years (proved with many documents) for a *“personal trainer app”*
- Goods in class 9: *“Entertainment software; Games software”*

are similar to

services opposed in class 41: *“training services relating to fitness health club services [health and fitness training]”*, as




**it is irrelevant if the *“entertainment activity, exercise and fitness workouts”* are performed by a trainer online through a mobile app, or physically in a gym or in a health club.**



**The goal of both related goods and services is to provide workouts and entertainment.**



## Decision of EUIPO issued on September 29, 2021

- Opposition No. B 003117287 is upheld for all the contested services.
- European Union trademark application No 18171617  is rejected in its entirety.
- The applicant bears the costs, fixed at EUR 620.

**EUIPO states the following:**



*“no clear boundary can be identified between a **fitness training activity** and **an entertainment activity**, since nowadays different fitness routines and exercises are also promoted as being fun and entertaining to perform, and include music and/or dancing routines”*



based on the claim that “*fitness games software available for computers, mobile phones or gaming consoles that interconnects fitness and entertainment are **well established on the market**”.*

# Legal effects

**The EU decision is important for the results achieved, but also useful for:**

**acting as counterfeit and passing off actions off-line and online**

**requesting and obtaining the closure of the websites and social networks of the Applicant**

# Our recommendations

❖ **Make sure to register your trademarks!**

❖ **Make sure to always use your trademarks and store your proofs of use!**

❖ **Make sure to activate a Trademark watching system!**

❖ **Make sure to activate an Internet brand protection service!**

❖ **Make sure to activate an App watching system on trademarks!**





Thank you for your attention!

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