

O-081-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION Nos 2394493A and 2394493B
BY FLY FIRST PLC TO REGISTER THE TRADE MARKS FLY FIRST AND
FIRST FLY AND DEVICE IN CLASSES 16, 36 AND 39**

**AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER NOS 94481 AND 94482
BY FIRSTGROUP PLC**

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by FirstGroup Plc**

BACKGROUND

1) On 16 June 2005, Fly First Plc, of 4th Floor, Saltire Court, 20 Castle Street, Edinburgh, EH1 2EN applied under the Trade Marks Act 1994 for registration of the following series of three trade marks:



FLY FIRST

2) In respect of the following goods and services:

Class 16: Paper, cardboard and goods made from this material, not included in any other classes; paper, paper articles; stationery, books, calendars, posters, photographs, adhesive tickets; tickets; luggage tickets (printed matter); luggage identity labels; tickets of cardboard; tickets of paper; tickets of paper for use with ticket issuing machines; tickets of cardboard for use with ticket issuing machines; model aeroplanes made of card; model aeroplanes made of paper; timetables relating to air travel; instructional and teaching material (except apparatus); adhesives for stationery or household purposes; writing instruments.

Class 36: Insurance services; travel insurance services; provision of holiday insurance; charge card and credit card services; issuing and redemption of traveller's cheques; discount card services; currency and money exchange services; issuing of travel vouchers; cheque account services; financial services relating to airports; information, consultancy and advisory services relating to all the aforesaid services.

Class 39: Air travel services; airline services; aircraft chartering; passenger transport and air cargo transport services; arranging of flights; air ticket booking services; airline bookings; airline check-in services; rental of aeroplanes; air navigation services; advisory services relating to the operational safety of aircraft; leasing of aircrafts; courier services; transport and delivery of goods; travel agency and booking services; sightseeing, tour and cruise arranging services; package holiday services; car hire services; tourist information services; air freight transportation; airline services for the transportation of cargo; airline services for the transportation of goods; airline services for the transportation of passengers; airline transportation services; arrangement for the transportation of goods by air; arrangement for the transportation of passengers by air; arrangement of transportation of goods by air; arrangement of transportation of people; arrangements for transportation by land, sea and air; information, consultancy and advisory services relating to all the aforesaid services.

3) The application was subsequently divided with the word only trade mark becoming one application with the other two trade marks, the subject of a second. The two applications were subsequently advertised in the Trade Marks Journal on 21 April 2006.

4) On 20 July 2006, FirstGroup Plc of 395 King Street, Aberdeen, AB24 5RP filed notices of opposition to both applications. The grounds of opposition are in summary:

a) The applicant's trade marks are contrary to section 3(1)(b) and (c) of the Trade marks Act 1994 (The Act). FirstGroup states that the trade marks consist of a non-distinctive combination of words and consists exclusively of the words FLY and FIRST which describes "the kind and quality of the goods and services provided by the applicant namely transport and related goods and services and in particular first class air travel services."

b) The trade mark applied for is similar to the opponent's earlier trade marks, and is sought to be registered in respect of goods and services that are identical or similar to those for which this earlier marks are registered, such that there exists a

likelihood of confusion. The earlier marks have been used by the opponent throughout the UK in connection with the provision of a wide range of passenger and freight transportation services and related goods and services including tickets, timetables, leaflets and other printed matter, the operation and management of railway and bus stations and depots, travel information and booking services, café, restaurant and catering services, and advertising, marketing, public relations and sales promotion in respect of travel services.

c) The trade marks offend against Sections 5(2)(b), 5(3) and 5(4)(a) of the Act.

5) Details of the earlier marks relied upon by the opponents in these proceedings can be found as an annex to this decision.

6) The applicant subsequently filed a counterstatement denying that its trade marks offend under Section 3(1)(b) or 3(1)(c) of the Act and puts the opponent to strict proof of use. It denies that the opponent's trade marks are sufficiently similar to the applicant's trade marks for there to be confusion under Section 5(2)(b) of the Act. In respect of the opponents registrations 2176592 FIRST and f device, 2176600 FIRSTGROUP and f device and Community Trade Mark 1525559 FIRSTGROUP and f device, it submits that these are over five years old at the date of publication of the application and requests that the opponents provide proof of use in relation to all of the goods and services for which these trade marks are registered. I note however, that the last of these has a registration date of 15 May 2001 which is within the five year period directly preceding the publication of the applicant's trade marks. The applicant also denies that the opponent has a reputation in relation to the opponent's registrations for FIRST and f device such as to qualify protection under Section 5(3) of the Act and further it denies that the applicant's trade marks would take unfair advantage of, or be detrimental to, the alleged distinctive character of the opponent's trade marks. It also denies that the opponent has unregistered rights within the meaning of Section 5(4)(a) of the Act.

7) During the course of the proceedings the oppositions against the two applications were consolidated into a single set of proceedings. Both sides filed evidence. Neither party requested to be heard but the applicant filed written submissions. Both sides seek an award of costs. After a careful study of all the papers, I give my decision.

Opponent's Evidence

8) This takes the form of a witness statement by Louise Ruppel, Group Legal Director of FirstGroup plc and is dated 28 March 2007. Ms Ruppel states that the opponent is a very significant transport operator being the largest surface transportation company in the UK. Its house brands, FIRST and FIRST TRANSFORMING TRAVEL, have been used since 1995 and 2001 respectively. The company has annual revenues of £3 billion and it has approximately 74,000 staff. Its core business is the provision of passenger and freight transportation by bus, rail and tram and the provision of goods and services relating to such services. It carries 250 million rail passengers a year and runs one in five bus services in the UK operating 9,000 buses from forty towns and cities carrying 2.8 million

passengers a day. The opponent's annual reports provided in Exhibit LR1 make a number of references to its rail freight activities which are carried out through a company identified as GB Railfreight. No other UK freight activities are mentioned in these reports or in any other exhibits. Between 1997 and 2001 it owned the majority shareholding in Bristol International Airport but the business was not conducted under the FIRST brand.

9) Ms Ruppel states that the nature and extent of the opponent's use has resulted in high public awareness with its trade marks appearing on trains it operates, and the majority of buses that it operates.

10) Annual revenue figures from within the UK are provided from April 2001 to March 2006 ranging from £1,614.4 million to £2,196.1 million and totalling £9,383.8 million for the same period with a statement that £500,000 a year is spent on brand protection and exploitation.

11) Ms Ruppel attaches to her witness statement the following exhibits:

- LR1 Annual reports for the years 2004 to 2006.
- LR2 List of the opponent's registered trade marks FIRST and FIRST TRANSFORMING TRAVEL in various countries
- LR3 Copies of the relevant public register for the trade marks referred to in exhibit LR2
- LR4 Photographs showing use of FIRST and f device and FIRST TRANSFORMING TRAVEL and f device trade marks on buses, passenger trains and bus and railway stations
- LR5 Examples of bus tickets issued by the opponent bearing the FIRST TRANSFORMING TRAVEL and f device trade mark
- LR6 Extracts from the opponent's website illustrating use of its trade marks FIRST TRANSFORMING TRAVEL and f device, FIRST and f device and the sign FIRST on its corporate information pages and also in relation to bus and passenger rail services and merchandising in the form of stationery, model buses, T-shirts, caps, golf balls and wallets.
- LR7 Examples of marketing and promotional material showing use of FIRST TRANSFORMING TRAVEL and f device in relation to passenger rail transport and use of FIRST and f device, FIRST DAY, FIRST WEEK and FIRST MONTH in relation to bus transport. All these materials are in the form of timetables and publications for the general public that publicise the transport services available.

- LR8 Examples of independent news coverage, including a number of extracts from the BBC News and the Telegraph newspaper websites referring to the opponent's business activities both in the UK and the USA in which it is referred to as FIRSTGROUP and noted to be in the passenger rail and bus operator business.

Applicant's Evidence

12) This consists of a witness statement by Eleanor Gail Coates dated 2 July 2007. Ms Coates is a trade mark attorney with Murgitroyd & Company Limited who is representing the applicant and states that her statements are made from her own knowledge or from documents accessible to her.

13) Ms Coates points to the size of the UK travel industry stating that in 2005 there were 6,500 travel agents with a joint turnover of €43 million. She identifies other companies operating in this industry that incorporate the word FIRST in their name, for example FIRST CHOICE together with numerous other third parties using the word FIRST as part of a trade mark in the travel industry. This correlates to the state of the UK Register. These examples are presented to illustrate that protection in the opponent's trade marks rest not in the word FIRST itself, but in the combination of elements and in particular, the stylised F device.

14) Ms Coates attaches to her witness statement the following exhibits:

- EC1 Extracts from the European Travel Agents and Tour Operators Association's website showing the number of travel agents and tour operators in the UK demonstrating the size of the UK travel industry.
- EC2 Details of use of the trade mark FIRST CHOICE by First Choice Holidays Plc
- EC3 Extracts illustrating use of trade marks incorporating the word FIRST by other third parties in the travel industry. The first of these is a rail ticket entitled FIRST ADVANCE. This does not appear to be trade mark use as it is used to describe a first class ticket that can be booked in advance. Other examples include TRAVEL FIRST and THE FIRST RESORT for travel agency services and FIRST FESTIVAL TRAVEL for festival and event tour services.
- EC4 Extract of the Registry's Work Manual showing the Registry practice on FIRST trade marks which is that FIRST can be descriptive but may be acceptable for registration in combination with other descriptive or non-distinctive words.

Opponent's Evidence in reply

15) This is a further witness statement by Louise Ruppel and is dated 25 September 2007.

16) Ms Ruppel states that the "travel industry" referred to by the applicant, in its evidence, is in fact two distinct industries, namely transport services and tourism. The differences need to be explained in order to appreciate the markets in which the opponent and applicant operate. The business of tourism includes tour operators who organise and provide package holidays and travel agents who give advice, sell and administer bookings for tour operators. On the other hand, the transport service sector relates to the commercial movement of freight and passengers. Ms Ruppel contends that both the applicant and the opponent operate within the transport sector.

17) Ms Ruppel also addresses a number of the FIRST trade marks that the applicant alleges are being used by other third parties. She points to a number of factual inaccuracies by the applicant that result from company reorganisations and re-branding concerning these trade marks, but does not draw any conclusions as to the effect of these inaccuracies. My view is that the possible existence of these inaccuracies does not materially affect the outcome of the case and I will not comment further on this. Ms Ruppel also draws attention to the fact that many of these operators are in the tourism sector rather than the transport sector, the area in which both the opponent and the applicant appear to have their core interests.

18) Ms Ruppel attaches to her witness statement a number of further exhibits, the most relevant of which are:

- LR1 Oxford English Dictionary definition of "tourism"
- LR2 Extracts from the Federation of Tour Operators' website explaining the role of tour operators and travel agents
- LR7 Internet extract of a Scotland on Sunday news article identifying the applicant as a business-class only airline

19) On the basis of this evidence I find that the opponent's FIRST and f device marks enjoyed a substantial reputation with the public at the date of the applications in respect of rail and bus passenger transport services. However, significantly, it has not demonstrated a reputation in respect to air transportation. Ms Ruppel does draw attention to the opponent owning a majority shareholding in Bristol International Airport between 1997 and 2001, but this fact alone is insufficient in demonstrating a reputation in respect to air transportation. In fact, the relevant consumer for air transportation services is either the general public or businesses who require the transportation of freight. In both cases, it is unlikely that they would have any awareness of the financial ownership details of an airport.

20) There is also no evidence of a reputation in respect to rail freight services. In this respect, the evidence is limited to a series of references in the annual reports provided in Exhibit LR1 of the opponent's evidence-in-chief. These references are to FirstGroup's rail freight activities being conducted through a franchise known as "GB Railfreight" and as such it would appear that any reputation would be attached to this name and not to FIRST.

DECISION

Section 3(1)(b) and 3(1)(c)

21) The opponent contends that the three trade marks of the applicant are contrary to Section 3(1)(b) and 3(1)(c) of the Act. This reads:

"3. - (1) The following shall not be registered –

...

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,"

22) In the judgment issued by the European Court of Justice (ECJ), *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-191/01 P, (DOUBLEMINT), the Court gives the following guidance on the scope and purpose of Article 7(1)(c) of the Community Trade Mark Regulation (equivalent to Section 3(1)(c) of the Act):

"28. Under Article 4 of Regulation No 40/94, a Community trade mark may consist of any signs capable of being represented graphically, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or rendering of the service, or other characteristics of the goods or service are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to

the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No 40/94.

31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 73).

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

23) I also take account of the judgment of the ECJ in *Postkantoor* Case C-363/99 which again considered the registrability of combinations of descriptive elements:

“96. If a mark, such as that at issue in the main proceedings, which consists of a word produced by a combination of elements, is to be regarded as descriptive for the purpose of Article 3(1)(c) of the Directive, it is not sufficient that each of its components may be found to be descriptive. The word itself must be found to be so.

97. It is not necessary that the signs and indications composing the mark that are referred to in Article 3(1)(c) of the Directive actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that those signs and indications could be used for such purposes. A word must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned (see to that effect, in relation to the identical provisions of Article 7(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), Case C-191/01P *OHIM v Wrigley* [2003] ECR I-0000, paragraph 32).

98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark.

100. Thus, a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the second case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purpose of the same provision.”

24) Section 3(1)(c) of the Act has common roots with Article 7(1)(c) of the Community Trade Mark Regulation, and is substantially identical to that provision. Accordingly, the ECJ’s guidance with regard to that provision may be taken to apply equally to Section 3(1)(c) of the Act. The provision excludes signs which may serve, in trade, to designate the kind of goods and services or other characteristics of services. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the goods and services in question.

25) The opponent asserts that all three trade marks fall foul of Section 3(1)(b) and (c) because they all consist of a non-distinctive combination of words which immediately informs the average consumer of the nature of the goods and services and all consist exclusively of words which describe the kind and quality of the goods and services. The applicant denies this.

26) In the first instance, I will consider the two trade marks comprising the words and device. In its written submissions, the applicant contends that different arguments apply to its word and device trade marks than to its word only trade mark. In its written submissions, the opponent puts forward arguments (that I shall return to later) as to why the word element of the trade marks is descriptive and contends that “words speak louder than devices, so the inclusion of the leaf/feather device....does nothing to distinguish the Applicant’s goods and services from those of the Opponent or of any other undertaking”.

27) I do not accept this latter contention. Section 3(1)(c) of the Act prohibits trade marks which consist **exclusively** of signs or indications designating characteristics of the goods and services from being registered. These two trade marks both consist of the words FLY FIRST set against a significant device depicting what appears to be a twisted feather or leaf. This device has at least equal prominence as the word elements in the trade marks and has no relevance or meaning in relation to the goods and services claimed. Whatever significance that can be attached to the words FLY FIRST, it is not possible to say that these two trade marks consist **exclusively** of a sign or indication designating a characteristic of the goods and services and I find that both these trade marks are acceptable under Section 3(1)(c).

28) I have established that the device element of both these trade marks has no significance with respect to the goods and services claimed and that this element of the trade marks is significant and not *de minimis*. It follows that the trademarks, when viewed as a whole, are distinctive for the goods and services claimed and I also find that they are both acceptable under Section 3(1)(b) of the Act.

29) I now turn to an assessment of acceptability under Section 3(1)(b) and (c) of the word only trade mark FLY FIRST. Firstly, I shall consider acceptability under Section 3(1)(c). The applicant, in its written submissions argues that the term FLY FIRST is not in use in relation to the goods and services for which protection is sought. In this respect, I am mindful of the *Doublemint* judgment referred to above that found it is not necessary that the trade mark actually be in use, in a way that is descriptive, at the time of the application for registration but it is sufficient that it could be used for such purposes. A finding that the term FLY FIRST is not in current descriptive use is not a criterion for assessing acceptance under Section 3(1)(c). It is sufficient that the term may be used in trade to designate a characteristic of the goods and services in the future.

30) It follows that I must make an assessment as to whether the words FLY FIRST may, when viewed as a whole, designate a characteristic of the goods and services claimed. The opponent, in its written submissions, contends that the applicant intends to use the trade marks in the operation of a business-class air travel service. It goes on to state that the word FLY is clearly intended to mean, and will be perceived as meaning, the imperative of the verb “to fly” and that FIRST is used in the laudatory sense “best” or “first class”. The opponent contends that the individual elements of the applicant’s trade mark are descriptive and relies upon the *Postkantoor* case referred to above when it states that a trade mark consisting of such elements is itself considered to be descriptive unless

there is a perceptible difference between the word(s) and the sum of its parts. It goes on to contend that in this case, no such perceptible difference exists.

31) The applicant, in its written submission, contends that the term FLY FIRST is not in descriptive use in relation to the goods and services for which protection is sought and has not been shown to be so by the opponent, pointing to the failure on the part of the opponent to provide any evidence of the term being in use by third parties in relation to types of tickets in the travel and aviation industry.

32) The opponent claims that the word FIRST would be perceived as meaning either “best” or “first class”. If I were to assume the first of these meanings the applicant’s trade mark would be understood as meaning “fly best”. This is not a natural construction and applying the guidance provided in the *Postkantoor* case, I find that this meaning would result in a perceptible difference between the descriptive nature of the individual words and the sum of their parts.

33) It follows that for the opponent’s contention to be correct the word “first” within the term FLY FIRST must be understood as designating “first class”. This is a reasonable contention in view of other terms such as “fly economy” or “fly business” that, in the same field of trade, could serve to designate flying economy class or flying business class respectively. Simon Thornley QC, sitting as the appointed person, provided some guidance on abbreviations of descriptive terms in *Where All Your Favourites Come Together* BL O/573/01:

“Mr. James, on the other hand, contended that a slight extension of the slogan so that it read, "This is where all your favourites come together in one box" would plainly be unregistrable and that the average consumer would see WHERE ALL YOUR FAVOURITES COME TOGETHER as being an abbreviation for the longer expression.

...

I have reached the conclusion in this case that when used in relation to confectionery as a whole, Mr. James's submission carries weight. I believe the average consumer would see the abbreviation for what it is, namely, an abbreviation for the expression, "This is where all your favourites come together in one box."”

34) Similarly, I find that FLY FIRST is no more than an obvious abbreviation of the term FLY FIRST CLASS. Such an abridgement of the full term fails to take away its obvious and immediate descriptive nature and the relevant public will immediately attach a descriptive meaning to the term. I find that this abridged construction fails to lose its function of designating goods and services that relate to first class air travel. Accordingly, the trade mark is excluded from registration under Section 3(1)(c) of the Act for such goods and services.

35) It follows that I must now consider which goods and services listed in the applicant's specifications relate to first class air travel. The opponent's written submission is somewhat contradictory on this issue. At paragraph 11 it contends that the trade mark is descriptive of characteristics of the goods and services in respect of which registration is sought implying that the descriptiveness relates to ALL the goods and services. On the other hand, at paragraph 13 it contends that the trade mark tells "business-class airline passengers that when they travel with the Applicant they will fly first-class..." implying that the descriptiveness relates only to goods and services in the field of passenger airline services. In sharing the latter view, I find that the following goods and services relate, or can relate, to the provision of first class air travel and the trade mark is excluded from registration by Section 3(1) (c) of the Act in respect to these:

Class 16: goods made from this material [the material being paper and cardboard], not included in any other classes; paper articles [as such terms can include tickets for first class travel]; adhesive tickets; tickets; luggage tickets (printed matter); luggage identity labels; tickets of cardboard; tickets of paper; tickets of paper for use with ticket issuing machines; tickets of cardboard for use with ticket issuing machines; timetables relating to air travel.

Class 36: (D)iscount card services; issuing of travel vouchers [as such services can be specific to first class travel]; information, consultancy and advisory services relating to all the aforesaid services.

Class 39: Air travel services; airline services; aircraft chartering; passenger transport; arranging of flights; air ticket booking services; airline bookings; airline check-in services; transport and delivery of goods; travel agency and booking services; sightseeing, tour and cruise arranging services; package holiday services; tourist information services; airline services for the transportation of goods; airline services for the transportation of passengers; airline transportation services; airline transportation services; arrangement for the transportation of goods by air; arrangement for the transportation of passengers by air; arrangement of transportation of goods by air; arrangement of transportation of people; arrangements for transportation by air; information, consultancy and advisory services relating to all the aforesaid services.

36) I have made a distinction between services relating to the transportation of cargo and freight and services relating to the transportation of goods. I recognise that airlines offer different luggage allowances and luggage check-in arrangements as part of a service provided to first class passengers and could be delivered as part of a service marketed to first class passengers. As such, I have found that services relating to the transportation of "goods" are open to objection. I view references to "cargo" and "freight" as being to a discreet transport service related to the loads carried by the aircraft, but not to luggage services merely provided as a subsidiary service to passengers.

37) I therefore find that the opposition under Section 3(1) (c) of the Act is successful in so far as it relates to the list of goods and services at paragraph 33 and the application survives for the following list of goods and services:

Class 16: Paper, cardboard; stationery, books, calendars, posters, photographs; model aeroplanes made of card; model aeroplanes made of paper; instructional and teaching material (except apparatus); adhesives for stationery or household purposes; writing instruments.

Class 36: Insurance services; travel insurance services; provision of holiday insurance; charge card and credit card services; issuing and redemption of traveller's cheques; currency and money exchange services; cheque account services; financial services relating to airports; information, consultancy and advisory services relating to all the aforesaid services.

Class 39: air cargo transport services; rental of aeroplanes; air navigation services; advisory services relating to the operational safety of aircraft; leasing of aircrafts; courier services; car hire services; air freight transportation; airline services for the transportation of cargo; information, consultancy and advisory services relating to all the aforesaid services.

38) It was held in the *Postkantoor* case that:

“86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.”

39) Thus an objection under Section 3(1) (c) also carries through to one under Section 3(1) (b). Having found that this trade mark is to be excluded from registration by Section 3(1)(c) of the Act for certain goods and services, then by extension the same goods and services are also excluded from registration by Section 3(1) (b). I shall therefore go on to determine the matter under section 3(1)(b) of the Act, but only in relation to the goods and services not found to be excluded from registration under Section 3(1) (c). There is no additional or different information available to me in relation to this ground of objection.

40) The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been summarised by the ECJ in its Judgment in *Linde AG, Windward Industries Inc and Rado Uhren AG* Joined Cases C-53/01 to C-55/01:

“37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being

represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

.....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings."

41) In order to achieve registration I acknowledge that there is no requirement for a trade mark to possess a specific level of linguistic or artistic creativity or imaginativeness. I must determine whether the trade mark applied for is capable of enabling the relevant consumer of the goods and services in question to identify the origin of the services and thereby to distinguish them from other undertakings. In *SAT.1 SatellitenFernsehen GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-329/02 the ECJ provided the following guidance:

"41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings."

42) In paragraph 70 of *Cycling Is... Trade Mark*, [2002] R.P.C. 37, Mr Hobbs indicated that:

“The relevant perspective is that of the average consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonably observant and circumspect”.

43) I must, therefore, put myself in the place of someone who encounters the mark FLY FIRST used in relation to the goods and services listed in paragraph 37 and determine how they would react. FLY FIRST is, of course, a combination of ordinary words of the English language but it conveys no obvious information about these goods and services. I am inevitably drawn to the conclusion that the average consumer “who does not know there is a question” would not consider FLY FIRST to be devoid of any distinctive character for this limited list of goods and services and would have no reason to suppose that it could not function as an indication of origin. I find that the Section 3(1)(b) objection fails for these goods and services.

44) Having decided the issue under Section 3(1) (b) and (c) I will now go on to consider the remaining grounds.

Section 5(2)(b)

45) Section 5(2)(b) reads:

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

(a) ...

(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.”

46) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the

goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

47) With regard to the grounds under Section 5(2) (b) of the Act, it is my view that the opponent's best case rests with Community trade mark (CTM) registration number 1525484 FIRST and f device, UK registration 2251196 FIRST DESIGNED TO MOVE YOU! and f device and UK registration 2347359 FIRST TRANSFORMING TRAVEL and f device ("the opponent's closest trade marks"). The first trade mark because it consists only of the house mark, including the word FIRST, which the opponent contends will be offended by the applicant's proposed use. The second because it covers Class 16 goods and some services in Classes 36 and 39 that are additional to those covered by the former registration and the third because it contains the broad Class 36 term *financial services* which is relevant when identifying the opponent's best case for similarity of services. These registrations were less than five years old at the date of the publication of the applicant's marks and do not therefore trigger the proof of use requirements.

48) There are two distinct assessments I am required to make. Firstly, an assessment of the likelihood of confusion between the opponent's earlier trade marks and the applicant's two composite trade marks (the subject of application 2394493B) and in respect of the full list of goods and services for which the application has been advertised. Secondly, an assessment of the likelihood of confusion between the opponent's earlier trade marks and the word only trade mark of the applicant (2394493A) in relation only to the surviving goods and services following my decision in relation to Section 3 of the Act. I shall consider the assessment in relation to the applicant's word and device trade marks first.

2394493B FLY FIRST and device

The average consumer

49) How would the relevant consumer judge the respective trade marks? Ms Ruppel, at paragraph 22 of her witness statement dated 28 March 2007 refers to public awareness of the opponent's trade marks, but does not discuss further the nature of the relevant consumer of the opponent's goods and services. Ms Coates, at paragraph 5 of her witness statement dated 2 July 2007 refers to other operators that I recognise as being part of the retail travel industry and have names incorporating the word "First". I infer from both these witness statements that both parties are in agreement that the relevant consumer for the core goods and services of transportation of passengers is the general public. These goods and services are non-specialised, but not necessarily always low cost. This leads me to conclude that a reasonable degree of care may be required when purchasing, but not the greatest degree of care.

50) The applicant's trade mark also contain more specialist services such as *financial services relating to airports* in Class 36 and; *aircraft chartering; air cargo transport services; rental of aeroplanes; air navigation services; advisory services relating to the operational safety of aircraft; leasing of aircrafts; air freight transportation; airline*

services for the transportation of cargo in Class 39. Although some of these services can be provided to the general public, all will usually be supplied at a business to business level where specialist knowledge of the air transport industry will result in a greater awareness and a high degree of care when purchasing these services.

51) Similarly, the opponent's trade marks also cover many business to business services. I will not list them all, but by way of illustration, the *brokerage, leasing, management and rental of commercial, bus depot, bus station, railway station, rail depot and airport premises* in Class 36 and *provision and operation of bus station, bus depot, rail depot and railway station facilities* and *provision and operation of airport facilities* in Class 39 of registration 2251196 FIRST DESIGNED TO MOVE YOU! and f device all fall into this category and will require a higher degree of care when purchasing.

52) I therefore conclude that the relevant average consumer is in most cases an ordinary member of the public paying a reasonable degree of attention, but in some cases the consumer will be a more specialised business consumer with a high degree of knowledge and paying a high degree of attention.

Comparison of marks

53) I have identified three of the opponent's trade marks as representing their best case. These are CTM 1525484 FIRST and f device, UK registration 2251196 FIRST DESIGNED TO MOVE YOU! and f device and UK registration 2347359 FIRST TRANSFORMING TRAVEL and f device. I intend to consider them together as it is my view that the additional elements DESIGNED TO MOVE YOU! and TRANSFORMING TRAVEL in the latter two trade marks do not add or detract from the central issue of likelihood of confusion as it serves only as a non-distinctive strap line for the opponent's FIRST and f device house mark and its presence or absence will therefore have a negligible impact on the public. Consequently, in focussing on the FIRST and f device in these trade marks I do not believe that I am engaging in an artificial dissection of the trade marks, but rather I am focussing on the distinctive component which totally dominates these trade marks.

54) In its written submissions, the applicant contends that the respective trade marks can be distinguished visually, conceptually and aurally and points to the f device element of the opponent's FIRST and f device trade marks as being the most distinctive and dominant element of the trade marks. The opponent, in its written submissions, puts forward an argument that the relevant public's perception of the respective trade marks is based on the word elements and that the appropriate comparison is therefore between the words FIRST and FLY FIRST.

55) The device element of the applicant's two trade marks (that vary from each other only immaterially in that the word element of one is in black and in the other, the colour blue) consists of, what appears to be, either a twisted feather or a twisted leaf device presented behind the words FLY FIRST and extending out from both the beginning and the end of the word elements to approximately double the width of the word element of the trade

mark. In other words, the device element is a distinctive and dominant component of the trade mark when viewed as a whole. Whether this element is in fact a feather or a leaf is not significant as in my mind they are both distinctive signs for the goods and services at issue and conceptually far removed from any impression created by the ‘f’ device in the opponent’s trade marks. Visually, the device of a twisted leaf or feather is wholly unlike the opponent’s f device in terms of size, appearance, and position within the trade mark. The word “first” as it appears in the applicant’s composite trade marks has no more dominance than the other elements when the trade mark is viewed as a whole.

56) I conclude that the common word FIRST creates only a modest degree of similarity between the applicant’s composite marks and the opponent’s FIRST and f device trade marks.

Distinctive Character of the Earlier Marks

57) I have already established that the word FIRST has a descriptive function in relation to goods and services that relate to, or involve first class travel. Accordingly, for these goods and services, the earlier trade marks as wholes have a low level of inherent distinctive character and the relevant part of the marks for the purpose of this opposition – the word FIRST - has no inherent distinctiveness. For the other goods and services for which the opponent’s closest trade marks are registered, although not directly descriptive, the word FIRST carries a somewhat laudatory significance. In relation to these goods and services the word FIRST therefore contributes only a lowish level of inherent distinctiveness to the average level of *prima facie* distinctiveness of the marks as wholes.

58) I must also consider the effect of the opponent’s use on the distinctive character of its marks at the date of the applications. Mr David Kitchen Q.C. (as he then was) sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04) observed, at paragraph 17, that:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar

descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

59) In its evidence, the opponent has demonstrated that in relation to rail and bus passenger transport it enjoys a considerable reputation and this will have substantially increased the distinctive character of the FIRST and f device marks for these services. Further, the evidence indicates that this enhanced distinctive character is distributed much more evenly than the *prima facie* examination of the trade marks suggests and that, at least for these services, the word FIRST contributes significantly to distinctiveness of the trade mark as a whole. Indeed it appears that the word FIRST has acquired an average distinctive character in its own right for these services. I put it no higher than that because the acquired distinctive meaning of the word FIRST has not yet completely displaced its primary descriptive meaning as a class of travel, which is still widely used as such (at least for rail travel). However, a word may have more than one meaning (*Doublemint*). A descriptive sign which has acquired a secondary distinctive meaning becomes protectable at the point where it is established that a substantial proportion of the public have come to rely on it to identify the goods or services of one undertaking (*Windsurfing Chiemsee*). I am prepared to infer from the opponent’s evidence that the word FIRST passes that threshold in relation to bus and rail passenger services.

60) I conclude that, with two exceptions, the opponent’s FIRST and f marks have an average level of distinctiveness for most of the goods and services for which they are protected. The first exception is bus and rail passenger transport services, for which the opponent’s trade marks have a highly distinctive character to which the word element FIRST makes a significant contribution. The second exception is air passenger transport services and related goods and services, for which the word FIRST remains purely descriptive of a class of travel because it has not acquired any distinctiveness through use as (or as part of) a trade mark for these services. It follows that to the extent that the opponent’s composite marks are protected for these services they have only a low level of distinctiveness which is distributed unevenly in favour of the ‘f’ device element of the earlier marks.

Comparison of goods and services

61) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law. In *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281, Mr Justice Jacob commented:

“...I think the following factors must be relevant in considering whether there is or is not similarity:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive.

This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

62) I shall consider each class of goods and services in turn, beginning with Class 16. The goods of the applications in suit are:

Paper, cardboard and goods made from this material, not included in any other classes; paper, paper articles; stationery, books, calendars, posters, photographs, adhesive tickets; tickets; luggage tickets (printed matter); luggage identity labels; tickets of cardboard; tickets of paper; tickets of paper for use with ticket issuing machines; tickets of cardboard for use with ticket issuing machines; model aeroplanes made of card; model aeroplanes made of paper; timetables relating to air travel; instructional and teaching material (except apparatus); adhesives for stationery or household purposes; writing instruments.

63) The opponent’s earlier trade mark 2251196 FIRST DESIGNED TO MOVE YOU! and f device includes the following Class 16 goods:

Paper articles; cardboard articles; printed publications; printed matter; charts; photographs; maps; timetables; tickets; tickets for travel.

64) These goods are identical to or are covered by the terms *goods made from this material* [being paper or cardboard], *not included in any other classes; paper articles; stationery, books, calendars, posters, photographs, adhesive tickets; tickets; luggage tickets (printed matter); luggage identity labels; tickets of cardboard; tickets of paper; tickets of paper for use with ticket issuing machines; tickets of cardboard for use with ticket issuing machines; model aeroplanes made of card; model aeroplanes made of paper; timetables relating to air travel; instructional and teaching material (except apparatus)* covered by the applicant’s trade mark.

65) *Paper* and *cardboard* are similar to (*p*)*aper articles* and *cardboard articles* in that they are the same material and therefore have the same nature. They could be found in the same shops or in the same area of shops in department stores, the stationery areas and therefore share the same channels of trade. These respective goods could be sold in the same sets of stationery and can be considered complementary. Taking all this into account, I find that these goods share a high degree of similarity.

66) I do not consider the remaining goods to be similar. These are *adhesives for stationery or household purposes; writing instruments.*

67) The applicant's claim to Class 36 services is:

Insurance services; travel insurance services; provision of holiday insurance; charge card and credit card services; issuing and redemption of traveller's cheques; discount card services; currency and money exchange services; issuing of travel vouchers; cheque account services; financial services relating to airports; information, consultancy and advisory services relating to all the aforesaid services.

68) The opponent's registration 2251196 FIRST DESIGNED TO MOVE YOU! and f device contains the Class 36 terms *insurance services, currency exchange services and advisory, consultancy and information services relating to all the aforesaid services.* These terms are identical to or cover *(i)nsurance services; travel insurance services; provision of holiday insurance; issuing and redemption of traveller's cheques; currency and money exchange services* covered by the applicant's trade marks.

69) In addition, the opponent's registration 2347359 FIRST TRANSFORMING TRAVEL and f device covers *financial services* in Class 36. The terms *charge card and credit card services; discount card services; issuing of travel vouchers; cheque account services; financial services relating to airports; information, consultancy and advisory services relating to all the aforesaid services* of the applicants trade mark are all covered by this wide term.

70) The opponent, in its written submissions, claims all the applicant's Class 39 services are identical and the applicant concedes that there is some similarity with the opponent's goods and services. In her witness statement of 25 September 2007, Ms Ruppel goes to some length in an attempt to demonstrate that the transport industry and tourism industry are two distinct sectors and that the applicant and the opponent are both operating in the transport sector. The reason for putting forward this argument is to demonstrate that the core services of both the opponent and applicant are transport services and for the purposes of any consideration of likelihood of confusion, the respective services are very similar or identical. I note and accept the similarity of the core services, whilst at the same time recognising that both the opponent's trade marks and the application in suit also contain terms that can clearly fall into the tourism sector, for example, *travel agency services* and *tourist information services*. I take all this into account when making the following analysis of the similarity between the various Class 39 services.

71) The applicant's claim to Class 39 services is:

Air travel services; airline services; aircraft chartering; passenger transport and air cargo transport services; arranging of flights; air ticket booking services; airline bookings; airline check-in services; rental of aeroplanes; air navigation services; advisory services relating to the operational safety of aircraft; leasing

of aircrafts; courier services; transport and delivery of goods; travel agency and booking services; sightseeing, tour and cruise arranging services; package holiday services; car hire services; tourist information services; air freight transportation; airline services for the transportation of cargo; airline services for the transportation of goods; airline services for the transportation of passengers; airline transportation services; arrangement for the transportation of goods by air; arrangement for the transportation of passengers by air; arrangement of transportation of goods by air; arrangement of transportation of people; arrangements for transportation by land, sea and air; information, consultancy and advisory services relating to all the aforesaid services.

72) The services highlighted above are identical to the opponent's (r)oad, rail and air transportation services; delivery and storage of goods; courier services; travel agency services; booking services; travel and tourist information services; arranging and conducting of tours and sightseeing; airport services; airport passenger, luggage, cargo and freight handling services; aircraft and vehicle rental, leasing and chartering services relating to all the aforesaid services in the opponent's earlier trade mark 2347359 FIRST TRANSFORMING TRAVEL and f device.

73) With regard to the applicant's "air navigation services [and] advisory services relating to the operational safety of aircraft", my view is that they are at least similar to "airport services; provision and operation of airport facilities; airport ground support services; airport passenger, luggage, cargo and freight handling services; aircraft... rental, leasing and chartering services" in the opponent's earlier trade mark 2347359 FIRST TRANSFORMING TRAVEL and f device. They share end consumers and trade channels in that such services will be provided through an airport for aircraft operators. In the *Canon* judgement mentioned earlier, complementary use is identified as a further factor to be taken into account when assessing the similarity of goods and services. In this case, the intended purpose and nature of the applicant's services relating to air navigation and operational safety of aircraft are such as to complement the more general airport services and aircraft leasing and chartering services of the opponent. I find that there is a high level of similarity between these services.

74) The application also covers "cruise arranging services; package holiday services; car hire services; ...arrangements for transportation by... sea; information, consultancy and advisory services relating to all the aforesaid services." These services could all be carried out under the general heading of "travel agency services" and "travel and tourist information services" covered by the scope of all the opponent's closest trade marks and I find that there is identity between these respective services.

Likelihood of confusion

75) It is clear that the common element shared by both the applicant's trade marks and the opponent's closest trade marks is the word "first" and it is the net effect on the relevant types of consumers of this similarity, the (varying) distinctive character of the earlier marks for the various goods and services at issue, the identity or degree of

similarity between the respective goods and services, and the distinguishing effect of the non-common features between the respective marks, that will determine the likelihood of confusion.

76) Taking a balanced view and adopting the global approach advocated by case law, I consider that with respect to:

a) goods and services that relate to passenger land transport, for which the opponent's trade marks have a heightened distinctive character. In respect of these services the word FLY in the applicant's trade marks is liable to be seen as an allusive reference to being transported quickly and the word FIRST as a reference to a specific undertaking. In this instance, the heightened distinctiveness of the earlier trade marks will have the effect of focusing the relevant consumer on the similarity between the respective marks and the presence in the applicant's trade mark of the word FIRST will outweigh the effect of the differences between the respective trade marks. Therefore, I find that there is a likelihood of confusion with respect to *passenger transport...services* in Class 39.

b) goods and services that relate to passenger air travel, the descriptive function of the word elements FLY FIRST in the applicant's trade marks are sufficiently strong to neutralise any trade origin significance they may otherwise have and the consumer's attention will instead focus on the device element of the trade marks, which is quite different to any feature of the opponent's trade marks. I therefore do not consider there is any likelihood of confusion even though the services are identical.

c) air freight transportation services, for which the word "fly" in the applicant's trade marks is purely descriptive but for which the word "first", despite being somewhat laudatory, does not have an obvious descriptive meaning. I have considered this carefully, particularly as identical services are involved, but I have concluded that there is no likelihood of confusion either amongst business consumers or ordinary members of the public. I have reached this view because the FIRST element of the earlier marks has not been shown to have an enhanced distinctive character through use in relation to air services or freight services. It is therefore only weakly distinctive for these services. I do not therefore consider that relevant consumers would be as likely to assume that the presence of the word FIRST in the applicant's trade marks indicated a connection with the opponent's air freight services as would be the case if the respective trade marks were used for passenger transport services. In these circumstances I consider that the distinguishing device elements in both marks would be sufficient to avoid direct confusion or indirect confusion arising because of a false assumption that the marks are being used by the same or economically linked undertakings.

d) all remaining goods and services, in respect of which the opponent's family of FIRST and f device trade marks in which the word FIRST has only a modest level of inherent distinctiveness which has not been shown to have been

enhanced through use. It follows that the modest level of overall similarity between the respective trade marks is in these circumstances insufficient to give rise to a likelihood of confusion.

77) Accordingly, with regard to the applicant's composite trade marks, I find that the opposition under Section 5(2) (b) is successful with respect to *passenger transport services* but fails in respect to all other goods and services.

2394493A FLY FIRST (word only)

78) The analysis required regarding the applicant's word only trade mark is somewhat different as it does not benefit from the visual and conceptual impact of the device element of the applicant's composite trade marks. I have already found that the word only trade mark FLY FIRST will be understood by the average consumer as being a reference to flying first class in relation to a number of goods and services. I do not intend to make a separate analysis of the trade mark under Section 5(2) insofar as I have already found the opposition to be successful. I shall limit my analysis to the goods and services I considered acceptable under Section 3, which are:

Class 16: Paper, cardboard; stationery, books, calendars, posters, photographs; model aeroplanes made of card; model aeroplanes made of paper; instructional and teaching material (except apparatus); adhesives for stationery or household purposes; writing instruments.

Class 36: Insurance services; travel insurance services; provision of holiday insurance; charge card and credit card services; issuing and redemption of traveller's cheques; currency and money exchange services; cheque account services; financial services relating to airports; information, consultancy and advisory services relating to all the aforesaid services.

Class 39: air cargo transport services; rental of aeroplanes; air navigation services; advisory services relating to the operational safety of aircraft; leasing of aircrafts; courier services; car hire services; air freight transportation; airline services for the transportation of cargo; information, consultancy and advisory services relating to all the aforesaid services.

Comparison of marks

79) As with the assessment of the applicant's composite trade marks, I intend to consider the similarity of the word only trade mark FLY FIRST to the opponent's three closest trade marks.

80) The applicant's word only mark is plainly more similar to the opponent's mark than is the composite marks considered above. This is because the common word FIRST makes up a larger proportion of the applicant's word only mark and there is less distinguishing material. There is therefore a higher (but still not the highest) level of

visual similarity. The opponent's marks may be referred to as FIRST trade marks or as FIRST f trade marks. In either event there is a reasonable, but not the highest degree of aural similarity to FLY FIRST. Conceptually, the word FIRST invokes a somewhat laudatory meaning for surviving goods and services of the application and has the same meaning in relation to the goods or services covered by the earlier trade marks to the extent that these overlap with the goods and services of the application. There is therefore some conceptual similarity.

The Distinctive Character of the Earlier Marks

81. I adopt the earlier analysis of the distinctive character of the earlier marks.

Comparison of goods and services

82) I have already conducted a comparison of goods and services based upon the complete lists claimed by the applicant. In doing so, I found that all the services in Class 36 and Class 39 to be identical or similar to those of the opponent. It follows that the list of Class 36 and Class 39 services that survive following my analysis of the Section 3 issue are also identical or similar in the same way that I found earlier. I do not intend to repeat that analysis here, but will take it into account when considering likelihood of confusion. I shall go on to consider the surviving Class 16 goods listed in paragraph 37.

83) As I found earlier, *stationery, books, calendars, posters, photographs, model aeroplanes made of card, model aeroplanes made of paper and instructional and teaching material (except apparatus)* are either identical to or covered by the opponent's UK registration 2251196 FIRST DESIGNED TO MOVE YOU! and f device and that *(p)aper and cardboard* are similar to *(p)aper articles and cardboard articles*.

84) I do not consider the remaining goods to be similar. These are *adhesives for stationery or household purposes; writing instruments*.

Likelihood of Confusion

85) In the applicant's word only trade mark the first word "fly" is used as a verb to communicate a mode of transport and the word "first" conveys a laudatory meaning for the applicant's surviving goods and services. In general, neither word dominates the significance of the other. However, I am mindful of the fact that a word can have more than one meaning and acknowledge that it is conceivable that the words FLY FIRST may be perceived by the relevant public as being a reference to flying with a specific undertaking, especially where used in relation to goods and services where FLY has an immediate and obvious descriptive meaning and FIRST does not. For example, I am not aware that there are different classes of transportation for freight and no evidence has been presented that this may be the case. It is, however, obvious that the word "fly" is purely descriptive for air services. In the absence of an obvious descriptive meaning for the word FIRST for such services, it is possible that the words FLY FIRST will be perceived by relevant consumers as a reference to air transportation of freight supplied by

an undertaking represented by the word “first”. Further, in the case of the applicant’s word only mark there is no striking and unfamiliar device feature to help to dispel any speculation in the consumer’s mind as to an economic link between two companies (notionally) providing air freight services under the marks FIRST and f device and FLY FIRST. I do not regard the matter as clear cut but on the balance of probability I find that, in relation to such services, there is a likelihood of confusion.

86) Regarding other air services, I recognise that these are aimed at the business to business sector. *(A)ir navigation services; advisory services relating to the operational safety of aircraft; rental of aeroplanes and leasing of aircrafts* in Class 39 will involve only business consumers with a higher level of attention. Nevertheless, I find that for these services there is also a likelihood of confusion with all three of the opponent’s closest trade marks, which I have found to be registered for closely similar services.

87) In respect to goods and services not directly linked to transportation by air, the apparent link to the opponent company is weakened and the conceptual meaning of FLY FIRST becomes more abstract as it does not obviously refer to flying and therefore does not focus attention onto the word “first” in the same way. As such, for the remaining goods and services at issue, the similarity between the respective trade marks is insufficient to cause a likelihood of confusion between the marks even where the respective goods and services are identical and the consumer an average member of the general public.

88) I therefore find that there is no likelihood of confusion for the remaining goods and services, namely *(p)aper, cardboard; stationery, books, calendars, posters, photographs; model aeroplanes made of card; model aeroplanes made of paper; instructional and teaching material (except apparatus); adhesives for stationery or household purposes; writing instruments* in Class 16, *insurance services; travel insurance services; provision of holiday insurance; charge card and credit card services; issuing and redemption of traveller’s cheques; currency and money exchange services; cheque account services; financial services relating to airports; information, consultancy and advisory services relating to all the aforesaid services* in Class 36 and *car hire services* in Class 39.

Summary of findings under Section 3 and Section 5(2) of the Act

89) In relation to the applicant’s two word and device trade marks, the opposition is successful only in respect of *passenger transport services* in Class 39 as this term covers land transport services for which the opponent’s earlier marks enjoy a high reputation and enhanced distinctiveness. For all other goods and services I find that the applicant’s trade marks neither designate a characteristic of the goods and services claimed nor are devoid of any distinctive character. Further, the visual and conceptual characteristics of these trade marks are such that, even where identical goods and services are involved, there is no likelihood of confusion.

90) With regard to the applicant’s word only trade mark, the opposition is partially successful in that I find the applicant’s trade mark designates a characteristic of the goods

and services insofar as they relate to air transportation of passengers. I also find that where the goods and services relate to air transportation, other than of passengers, there is a likelihood of confusion with the opponent's trade marks. The opposition fails in respect of the remaining goods and services.

Section 5(4) (a)

91) The opponent relies upon the unregistered rights in the word only FIRST, FIRSTGROUP and also in FIRST and f device and FIRSTGROUP and f device. The applicant contends that the opponent has failed to show the elements of passing off as set out under *WILD CHILD* [1998] RPC 455. It contends that the opponent has failed to show it has used the signs in a word only format to such an extent as to gain goodwill, has failed to demonstrate that misrepresentation has occurred, which in turn has failed to give rise to damage. The opponent, in its submission also refers to the elements of passing off as identified in *WILD CHILD* but argues that there is adequate evidence that the opponent has built up a sufficient goodwill in the word FIRST so that the applicant's use of FLY FIRST (with or without the device) would be passing off.

92) The evidence demonstrates occasional use of the word FIRST in the opponent's annual reports (Exhibit LR1), on its "corporate information" pages of its website (Exhibit LR6) and within the body of data in some of its bus timetables (Exhibit LR7). Evidence of use of the word only FIRSTGROUP is even more limited and can be seen even less frequently in the annual reports and also in media reports on the business dealings of the applicant (Exhibit LR8). With respect to the opponent's annual reports and corporate information pages on its website and also to business media reports, it is used primarily to inform business readers rather than the users of the opponent's services. In this respect, I am not convinced that this evidence demonstrates any goodwill for the word FIRST in relation to the relevant consumers which would enhance the opponent's case over and above the case I have already considered under Section 5(2). This leaves the use of the word only FIRST within the text of some bus timetables. This is relevant use, but insufficient on its own to demonstrate a significantly better case under Section 5(4) (a). As such, the opponent's best case remains around the reputation of its FIRST and f device sign where I have already found the opponent enjoys a significant reputation which extends to the word FIRST. In respect to both applications and for the surviving goods and services, my finding that use of the trade marks in suit would not result in confusion with the opponent's FIRST and f device trade mark means that the necessary misrepresentation required by the tort of passing off would not occur. Therefore, with respect to both the applications, the opposition under Section 5(4) (a) does not succeed to any greater extent than the opposition under Section 5(2).

Section 5(3)

93) The opponent contends that use of the applicant's trade marks on all the goods and services claimed would take unfair advantage of, and be detrimental to, the distinctive character or reputation of its earlier trade marks 2176592 and CTM 1525484, both for FIRST and f device. It further contends that the extent of the reputation in the earlier

trade marks would lead users to think that goods and services provided by the applicant under the trade marks applied for were provided by the opponent, thereby taking unfair advantage of the opponent's reputation in its earlier trade marks leading to dilution of the distinctiveness of the opponent's trade marks. The applicant contends that the opponent cannot claim an exclusive right in the word "first" alone and that the respective trade marks are not sufficiently similar for Section 5(3) to apply.

94) It is common ground, or at least not denied by the applicant that the evidence demonstrates that, in relation to bus and train passenger transport, the opponent enjoys a considerable reputation in respect to its FIRST and f device trade mark. I must consider if this reputation is sufficient to lead the relevant consumer, upon seeing the applicant's trade marks to make a link between the earlier trade marks and those of the applicant (*Adidas Salomon v. Fitness World* [2004] ETMR 10). This link must be real and not theoretical in its effect (*Intel v. Sihra* and *Intel Corporation Inc v. CPM United Kingdom Ltd* [2006] EWHC 1878 (ch)). I am also mindful of the comments of Neuberger J in *Premier Brands UK Limited v. Typhoon Europe Limited* [2000] FSR 767, that the provision is not aimed at every sign whose use may stimulate the relevant public to recall a trade mark which enjoys a reputation with them.

95) Taking account of the average level of distinctive character that resides in the element "first" in the earlier trade mark for rail and bus passenger services and the low level of distinctiveness of the word for the surviving goods and services, I find that the similarity between the trade marks is insufficient to create the necessary link between them. Therefore, for the surviving goods and services of both applications, the opposition under Section 5(3) fails.

Costs

96) FirstGroup Plc has been partially successful and is entitled to a contribution towards its costs. I take account the fact that the decision has been reached without a hearing taking place, though with written submissions having been prepared. I award costs on the following basis:

Opposition fee	£200
Notice of opposition	£300
Considering the counterstatement	£200
Preparing and filing evidence	£500
Considering evidence	£250
Filing written submissions	£200
TOTAL	£1650

97) I order First Fly Plc to pay FirstGroup Plc the sum of £1650. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18 day of March 2008

**Mark Bryant
For the Registrar,
the Comptroller-General**

ANNEX

List of opponent's closest trade marks

Trade Mark	List of Goods and Services
<p data-bbox="231 465 343 499">2347359</p> 	<p data-bbox="783 465 1125 499">List of Goods and Services</p> <p data-bbox="783 470 1340 678">Class 35: Business management and administration; airport management and administration; advertising and promotional services; advisory, consultancy and information services relating to all the aforesaid services.</p> <p data-bbox="783 719 1324 996">Class 36: Financial and insurance services; currency exchange services; provision of credit for fuel and expenses; estate agency services; brokerage, leasing, management and rental of commercial and airport premises; advisory, consultancy and information services relating to all the aforesaid services.</p> <p data-bbox="783 1037 1348 1637">Class 39: Road, rail and air transportation services; delivery and storage of goods; courier services; travel agency services; booking and reservation services; timetable, travel and tourist information services; arranging and conducting of tours and sightseeing; escorting of travellers; bus station, bus depot, rail depot, and railway station services; provision and operation of bus station, bus depot, rail depot and railway station facilities; airport services; provision and operation of airport facilities; airport ground support services; airport passenger, luggage, cargo and freight handling services; aircraft and vehicle rental, leasing and chartering services relating to all the aforesaid services.</p> <p data-bbox="783 1677 1356 1886">Class 43: Café, restaurant, bar and catering services; booking services relating to temporary accommodation; arranging of temporary accommodation; advisory, consultancy and information services relating to all the aforesaid services.</p>

2251196

First 
designed to *move* you!

First 
designed to *move* you!

First  **Glasgow**
designed to *move* you!

First  **Glasgow**
designed to *move* you!

Class 16: Paper articles; cardboard articles; printed publications; printed matter; charts; photographs; maps; timetables; tickets; tickets for travel.

Class 35: Business management and administration; administration, management and operation of airports, railway stations, bus stations, rail depots and bus depots; advertising and promotional services; telephone answering services; advisory, consultancy and information services relating to all the aforesaid services.

Class 36: Insurance services; administration of financial affairs; financial management; financial planning; financial advice and appraisals; provision of finance; credit services; currency exchange services; provision of credit for fuel expenses; estate agency services; brokerage, leasing, management and rental of commercial, bus depot, bus station, railway station, rail depot and airport premises; advisory, consultancy and information services relating to all the aforesaid services.

Class 39: Road, rail and air transportation services; transportation of passengers and of goods; delivery and storage of goods; courier services; travel agency services; booking and reservation services; timetable, travel and tourist information services; arranging and conducting of tours and sightseeing; escorting of travellers; bus station, bus depot, rail depot and railway station services; provision and operation of bus station, bus depot, rail depot and railway station facilities; airport services; provision and operation of airport facilities; airport ground support services; passenger, luggage, cargo and freight handling services; aircraft and vehicle rental, leasing and chartering service; advisory, consultancy and information services relating to all the aforesaid services; but not including private car and motorbike

	<p>rental services.</p> <p>Class 42: Café, restaurant, bar and catering services; booking services relating to temporary accommodation; arranging of temporary accommodation; lost property services; advisory, consultancy and information services relating to all the aforesaid services.</p>
<p>CTM 1525484</p> 	<p>Class 35: Business management and administration; airport management and administration; advertising and promotional services (other than via narrow-band and broad-band in Germany); advisory, consultancy and information services relating to all the aforesaid services.</p> <p>Class 36: Provision of credit for fuel expenses; real estate services; brokerage, leasing, management and rental of commercial and airport premises; advisory, consultancy and information services relating to all the aforesaid services, but excluding financial and insurance consultancy and information services.</p> <p>Class 39: Transportation services; delivery and storage of goods; courier services; travel agency services; booking and reservation services; timetable, travel and tourist information services; arranging and conducting of tours and sightseeing; escorting of travellers; airport services; provision and operation of airport facilities; airport ground support services; airport passenger, luggage, cargo and freight-handling services; vehicle rental, leasing and chartering services; advisory, consultancy and information services relating to all the aforesaid services, all excluding product logistics (namely the entire organisation of transport of goods from manufacturer to supplier, storage and delivery to the ultimate consignee (customer) in Germany).</p>

	Class 42: Café, restaurant, bar and catering services; booking services relating to temporary accommodation; arranging of temporary accommodation; advisory, consultancy and information services relating to all the aforesaid services.
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List of opponent's other earlier trade marks relied upon

Trade Mark	List of Goods and Services
2302368A FIRST DAY	Class 16: Tickets for travel by omnibus or coach; tickets for travel by rail; all printed on cardboard or paper and all included in Class 16. Class 39: Transportation of passengers and parcels by road; transportation of passengers and parcels by rail; omnibus and coach transport services; rail transport services; services for arranging travel by road or rail; all included in Class 39.
2302368B FIRST WEEK	Class 16: Tickets for travel by omnibus or coach; tickets for travel by rail; all printed on cardboard or paper and all included in Class 16. Class 39: Transportation of passengers and parcels by road; transportation of passengers and parcels by rail; omnibus and coach transport services; rail transport services; services for arranging travel by road or rail; all included in Class 39.
2302368C FIRST MONTH	Class 16: Tickets for travel by omnibus or coach; tickets for travel by rail; all printed on cardboard or paper and all included in Class 16. Class 39: Transportation of passengers and parcels by road; transportation of passengers and parcels by rail; omnibus

	and coach transport services; rail transport services; services for arranging travel by road or rail; all included in Class 39.
<p>CTM 2367035</p>  <p>The logo for 'First transforming travel' features the word 'First' in a large, bold, sans-serif font. To its right is a circular emblem containing a stylized white 'f' shape against a dark background. Below 'First' is the tagline 'transforming travel' in a smaller, lowercase, sans-serif font.</p>	<p>Class 35: Business management and administration; airport management and administration; advertising and promotional services; advisory, consultancy and information services relating to all the aforesaid services.</p> <p>Class 36: Financial and insurance services; currency exchange services; provision of credit for fuel and expenses; estate agency services; brokerage, leasing, management and rental of commercial and airport premises; advisory, consultancy and information services relating to all the aforesaid services.</p> <p>Class 39: Road, rail and air transportation services; delivery and storage of goods; courier services; travel agency services; booking and reservation services; timetable, travel and tourist information services; arranging and conducting of tours and sightseeing; escorting of travellers; bus station, bus depot, rail depot, and railway station services; provision and operation of buss station, bus depot, rail depot and railway station facilities; airport services; provision and operation of airport facilities; airport ground support services; airport passenger, luggage, cargo and freight handling services; aircraft and vehicle rental, leasing and chartering services relating to all the aforesaid services.</p> <p>Class 42: Café, restaurant, bar and catering services; booking services relating to temporary accommodation; arranging of temporary accommodation; advisory, consultancy and information services relating to all the aforesaid services.</p>
2176592	Class 35: Business management and administration; administration, management and operation of airports,



railway stations, bus stations, rail depots and bus depots; advertising and promotional services; telephone answering services; advisory, consultancy and information services relating to all the aforesaid services.



Class 36: Insurance services; administration of financial affairs; financial management; financial planning; financial advice and appraisals; provision of finance; credit services; currency exchange services; provision of credit for fuel expenses; estate agency services; brokerage, leasing, management and rental of commercial, bus depot, bus station, railway station, rail depot and airport premises; advisory, consultancy and information services relating to all the aforesaid services.

Class 39: Road, rail and air transportation services; delivery and storage of goods; courier services; travel agency services; booking and reservation services; timetable, travel and tourist information services; arranging and conducting of tours and sightseeing; escorting of travellers; bus station, bus depot, rail depot, and railway station services; provision and operation of bus station, bus depot, rail depot and railway station facilities; airport services; provision and operation of airport facilities; airport ground support services; airport passenger, luggage, cargo and freight handling services; aircraft and vehicle rental, leasing and chartering services; advisory, consultancy and information services relating to all the aforesaid services.

Class 42: Café, restaurant, bar and catering services; booking services relating to temporary accommodation; arranging of temporary accommodation; lost property services; advisory, consultancy and information services relating to all the

	aforesaid all services.
<p>2176600</p>  	<p>Class 35: Business management and administration in the transport, travel, tourism and catering industries; administration, management and operation of airports, railway stations, bus stations, rail depots and bus depots; advertising and promotional services; telephone answering services; advisory, consultancy and information services relating to all the aforesaid services.</p> <p>Class 36: Insurance services; administration of financial affairs; financial management; financial planning; financial advice and appraisals; provision of finance; credit services; currency exchange services; provision of credit for fuel expenses; estate agency services; brokerage, leasing, management and rental of commercial, bus depot, bus station, railway station, rail depot and airport premises; advisory, consultancy and information services relating to all the aforesaid services.</p> <p>Class 39: Road, rail and air transportation services; delivery and storage of goods; courier services; travel agency services; booking and reservation services; timetable, travel and tourist information services; arranging and conducting of tours and sightseeing; escorting of travellers; bus station, bus depot, rail depot and railway station services; provision and operation of bus station, bus depot, rail depot and railway station facilities; airport services; provision and operation of airport facilities; airport ground support services; airport passenger, luggage, cargo and freight handling services; aircraft and vehicle rental, leasing and chartering services; advisory, consultancy and information services relating to all the aforesaid services.</p>

	<p>Class 42: Café, restaurant, bar and catering services; booking services relating to temporary accommodation; arranging of temporary accommodation; lost property services; advisory, consultancy and information services relating to all the aforesaid services.</p>
<p>CTM 1525559</p> <p>FirstGroup </p>	<p>Class 35: Business management and administration; airport management and administration; advertising and promotional services; advisory, consultancy and information services relating to all the aforesaid services.</p> <p>Class 36: Financial and insurance services; currency exchange services; provision of credit for fuel expenses; real estate services; brokerage, leasing, management and rental of commercial and airport premises; advisory, consultancy and information services relating to all the aforesaid services.</p> <p>Class 39: Transportation services; delivery and storage of goods; courier services; travel agency services; booking and reservation services; timetable, travel and tourist information services; arranging and conducting of tours and sightseeing; escorting of travellers; airport services; provision and operation of airport facilities; airport ground support services; airport passenger, luggage, cargo and freight-handling services; vehicle rental, leasing and chartering services; advisory, consultancy and information services relating to all the aforesaid services.</p> <p>Class 42: Café, restaurant, bar and catering services; booking services relating to temporary accommodation; arranging of temporary accommodation; advisory, consultancy and information services relating to all the aforesaid services.</p>