O-0991-23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. UK00003782996

SWOOP

IN THE NAME OF BATH TAXIS LIMITED

AND

AN OPPOSITION UNDER NO. 435742

BY WESTJET AIRLINES LIMITED

Background and pleadings

1. On 29 April 2022, Bath taxis limited ("the applicant") applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 20 May 2022 for the following goods and services:

Class 9	Downloadable mobile applications for booking taxis.
Class 39	Providing taxi booking services via mobile applications.

2. The WestJet Airlines Limited ("the opponent") filed a notice of opposition on 22 August 2022 on the basis of sections 5(2)(a) and (b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all the goods and services in the application. For its claim under section 5(2)(a), the opponent relies upon the following goods and services covered by the below-mentioned international registrations designating the UK.

SWOOP

Registration No. WO000001656242
Registration date: 17 December 2021
Designation date: 17 December 2021
Goods and services relied upon:

Class 9	Ear phones; headsets for use with electronic devices, namely, e-books, in-flight entertainment systems, mp3 players, dvd players, audio cassette players, cd players and laptop computers.
Class 39	Air transportation services, namely, transportation of passengers, parcels, freight and cargo by air; arranging for rental of cars; providing information about air transportation and motor transportation, namely, transportation by airplane and motorcar; travel agency services, namely, making reservations and bookings for air transportation.
Class 43	Providing information about hotels and vacation resorts; travel agency services, namely, making reservations and bookings for hotels and vacation resorts.

3. For its claim under section 5(2)(b), the opponent relies upon the following services covered by the below-mentioned international registrations designating the UK.

FLY SWOOP

Registration No. WO0000001643778

Registration date: 17 December 2021

Designation date: 17 December 2021

Services:

Class 39 Air transportation services, namely, transportation of passengers, parcels, freight and cargo by air; arranging for rental of cars; providing information about air transportation and motor transportation, namely, transportation by airplane and motorcar; travel agency services, namely, making reservations and bookings for air transportation.

Class 43 Providing information about hotels and vacation resorts; travel agency services, namely, making reservations and bookings for hotels and vacation resorts.

Registration No. WO0000001643777

Registration date: 17 December 2021

Designation date: 17 December 2021

Services:

Class 39 Air transportation services, namely, transportation of passengers, parcels, freight and cargo by air; arranging for rental of cars; providing information about air transportation and motor transportation, namely, transportation by airplane and motorcar; travel agency services, namely, making reservations and bookings for air transportation.

Class 43 Providing information about hotels and vacation resorts; travel agency services, namely, making reservations and bookings for hotels and vacation resorts.

4. Given their filing dates, the above marks are earlier trade marks in accordance with section 6 of the Act. As the opponent's marks have not completed their protection process more than 5 years before the application date of the contested mark, the marks are not subject to proof of use provisions contained in section 6A of the Act. The opponent can, therefore, rely on all the goods and services it wishes to rely upon.

5. The opponent claims that its earlier mark is SWOOP identical to the applicant's mark and the remaining earlier marks are highly similar. The opponent also claims that the applicant's goods and services are identical or similar to the opponent's goods and services, with the result that there is a likelihood of confusion.

6. The applicant filed a counterstatement denying the grounds of opposition.

7. The applicant is unrepresented and the opponent is represented by HGF Limited. The opponent filed evidence and submissions in lieu. No hearing was requested. The applicant filed submissions in response to the opponent's evidence. This decision is taken after careful reading of all the papers filed by the parties.

8. Although the UK has left the European Union ("EU"), section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Evidence

9. The opponent's evidence consists of the witness statement of Ms Lauren Richardson dated 13 March 2023 together with 4 exhibits. Ms Richardson is a Trade Mark Attorney employed by the opponent's representative.

10. I will return to the evidence later in the decision, where necessary.

My approach

11. The opponent relies on three earlier marks. For the purpose of this proceeding, I will first consider the position in relation to the opponent's claim under section 5(2)(a). I will return to the grounds under section 5(2)(b) only if necessary.

Sections 5(2)(a) and (b)

12. Section 5(2)(a) and (b) of the Act reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> > (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
> >
> > (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."

Sections 5(2)(a)

13. In *S.A. Société LTJ Diffusion v Sadas Vertbaudet SA,* Case C-291/00, the Court of Justice of the European Union ("CJEU") held, that:

> "54 [...] a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer".

14. In this case, both marks are the identical words 'SWOOP/SWOOP'. Both marks are word marks, notwithstanding the fact that the earlier mark appears to be an image of the word SWOOP. I, therefore, accept that the marks are identical under section 5(2)(a) of the Act.

Case law

15. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L.Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

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

(b) The matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) The average consumer normally perceives the mark as a whole and does not proceed to analyse its various details;

(d) The visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing

in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) Nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods and services

16. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon*, the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment:

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

17. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the Treat case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

> (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.

18. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

> "[…] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question".

19. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-325/06, the General Court ("GC") stated that 'complementary' means:

> "[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

20. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C.,

sitting as the Appointed Person, noted in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL O/255/13:

> "It may well be the case that wine glasses are almost always used with wine and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes", whilst on the other hand:
>
> "[…] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together".

Class 9 - Downloadable mobile applications for booking taxis

21. These are a particular form of mobile applications. There is an intrinsic difference between the nature and method of use of the applicant's goods and the opponent's 'arranging for rental of cars' services (in Class 39), as is the case with any goods and services. I am of the view that someone looking for car rentals may choose to book taxis using taxi mobile applications. To that extent, the conflicting goods and services are in competition. The users are likely to coincide. The goods and services are not complementary in the sense described by the case law as downloadable mobile applications are not important for providing the opponent's services. Considering these factors, I find that the applicant's goods are similar to a low degree to the opponent's services.

Class 39 - Providing taxi booking services via mobile applications

22. The opponent submits that there is very little difference between arranging for the rental of cars in the opponent's specification and the applicant's taxi booking services via mobile applications as both involve the use of a vehicle for transportation purposes.[1] The opponent also submits that they have the same

[1] Opponent's submissions, para 14.

end users and the same intended purpose – to travel from A to B.[2] In her witness statement, Ms Richardson states that the opponent's evidence demonstrates that the average consumer is well accustomed to seeing taxi services being offered alongside flights and/or package holidays, directly or indirectly provided by the airline.[3] Referring to that evidence, the opponent submits that both types of services share the trade channels.

23. The applicant disputes the opponent's claim that the channels of trade are shared. According to the applicant, the term 'taxi services' referred to in the opponent's evidence suggests airport transfers offered by flight and holiday companies and that those are ancillary services purchased in addition to flight or package holiday.[4] The applicant submits that the common understanding of "taxi services" is the booking of a private hire car by the purchaser directly from the provider for the exclusive use of the purchaser for transport between two locations in a specific geographic catchment area of the service provider in the normal course of the purchaser's daily life.[5]

24. I note that in the opponent's specification, a semi-colon has been used to separate 'arranging for rental of cars' from the rest of the terms. Using a semi-colon means that arranging for the rental of cars is a stand-alone term in the specification. Unlike other services listed in Class 39, it need not be provided in connection with air transportation services. With that in mind, I will compare the applicant's services with the opponent's arranging for rental of cars services. Broadly speaking, both parties agree that their services concern the movement of people over a distance by car. There is, therefore, a similarity in respect of the nature and purpose of the services. The services are likely to be in competition as customers may choose to contact a car rental service provider to travel between locations or use the mobile application to book a taxi instead. While there is some evidence of airlines or tour agents providing taxi services between airports and hotels, in the absence of evidence, it does not appear that an undertaking that offers car rentals also provides taxi services and vice versa.

[2] *Ibid*
[3] Para 3.
[4] Applicant's submissions, para 2.4
[5] *Ibid*

Therefore, I do not think that there is an overlap in the channels of trade. Considering these factors, I find that the services are similar to a medium degree.

The average consumer and the nature of the purchasing act

25. I will proceed to determine who the average consumer is for the respective parties' goods and services discussed above.

26. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median".

27. The average consumer of the respective parties' services and the applicant's goods are likely to be members of the general public. The applicant's goods in Class 9 entail little or no cost, they are downloaded infrequently, and the average consumer will pay at least a medium level of care to ensure that what is being downloaded is fit for its purpose. The applicant's services are likely to be chosen more frequently than the opponent's services. The applicant's services are used primarily for daily commutes or to travel between two locations, while the opponent's services are for leisure or long-distance travel. The average consumer is likely to pay attention to factors such as reliability, customer reviews and best price when choosing the service provider. These factors suggest that the average consumer is likely to pay a medium degree of

attention during the selection process. Visual considerations are likely to dominate the selection process for the goods and services. There may be aural considerations when the choice is made further to references or recommendations.

Distinctive character of the earlier mark

28. The distinctive character of the earlier mark must be considered. The more distinctive the mark is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does does not contain an element descriptive of the goods or services for which it has been registered, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

29. Invented words usually have the highest degree of distinctive character, while words which are allusive of the goods have the lowest. Distinctiveness can also be enhanced through the use of the mark. Although the opponent has filed evidence, it does not show the use of the earlier mark. Therefore, I only have the inherent position to consider. The earlier mark SWOOP means to move suddenly or quickly.[6] In respect of the opponent's services in Class 39, the word is allusive of quick and easy car rental services. I find that the opponent's mark is inherently distinctive to a medium degree.

Likelihood of confusion

30. In determining whether there is a likelihood of confusion, I need to bear in mind several factors. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective goods and services may be offset by a greater degree of similarity between the trade marks (*Canon* at [17]). It is also necessary for me to bear in mind the distinctive character of the opponent's trade mark, as the more distinctive the trade mark is, the greater the likelihood of confusion (*Sabel* at [24]). I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks, relying instead upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

31. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertaking being the same or related).

32. I have found the respective marks to be identical. I also found that the goods and services will be selected primarily by visual means, with a medium degree of attention by the general public The goods and services are similar to varying

[6] See https://www.collinsdictionary.com/dictionary/english/swoop accessed 16 October 2023.

degrees. I also concluded that the distinctiveness of the earlier mark is medium, and it has not been enhanced through the use.

33. I am of the view that the identity between the marks and the similarity between the goods and services is likely to lead to direct confusion. The average consumer who pays a medium degree of attention is likely to mistake the opponent's mark for the applicant's mark and /or vice versa and think that the goods and services originate from a single undertaking. I, therefore, conclude that there is a likelihood of direct confusion.

34. As the opposition has succeeded under section 5(2)(a), an assessment of claims made under section 5(2)(b) is unnecessary.

Conclusion

35. The opposition has been successful. The application is refused.

Costs

36. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Tribunal Practice Notice ("TPN") 2/2016. I award costs to the opponent on the following basis:

Preparing a statement of case and Considering other side's statement:	£200
Filing evidence:	£250
Filing written submissions:	£300
Official fee:	£100
Total:	£850

37. I order Bath taxis limited to pay WestJet Airlines Limited the sum of £850. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of October 2023

Karol Thomas
For the Registrar
The Comptroller-General