

O/1014/23

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3656444  
BY THE TREADRIGHT FOUNDATION**

**TO REGISTER THE TRADE MARK:**

**MAKE  
TRAVEL  
MATTER**  
TREADRIGHT

**IN CLASSES 35, 36, 39 AND 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 430568  
BY TRAVEL MATTERS LTD**

## **Background and pleadings**

1. On 16 June 2021, The TreadRight Foundation (“**the applicant**”) applied to register the trade mark displayed on the front cover of this decision in the UK, under number 3656444 (“**the contested application**”). The contested application was published in the Trade Marks Journal for opposition purposes on 15 October 2021. Registration is sought for the following services:

Class 35: Promoting public awareness in the fields of sustainable tourism, environmental conservation, and wildlife conservation.

Class 36: Philanthropic and charitable foundation services, namely, providing financial assistance for programs and services of others.

Class 39: Travel transport services, namely, organizing, arranging, conducting, and operating transport services for travelers on escorted travel tours, excursions, day trips, and sightseeing tours; making reservations and bookings for air and ground transportation for tourists; travel guide services; travel booking agency services; travel agency services, namely, making reservations and bookings for transportation; travel and transport information services; arranging of cruises; leasing of automobiles and boats; cruise ship services.

Class 41: Educational and entertainment services in the nature of travel services, namely, organizing, arranging, conducting and operating educational and entertainment activities for tourists in the nature of guided travel tours of castles, historical sites, churches, monuments, buildings, cities, towns and villages, countrysides, parks, gardens, zoos, wineries, restaurants, local landmarks, museums, theaters, and malls; guided excursions, guided day trips, and guided sightseeing tours of castles, historical sites, churches, monuments, buildings, cities, towns

and villages, countrysides, parks, gardens, zoos, wineries, restaurants, local landmarks, museums, theaters, and malls.

2. On 17 January 2022, **Travel Matters Ltd** (“**the opponent**”) filed a notice of opposition. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”) and is directed against all the services in the contested application.<sup>1</sup>
3. The opponent relies upon its UK trade mark number 3654074,



(“the earlier mark”)

4. The earlier mark was registered on 26 November 2021. For the purposes of the opposition under section 5(2)(b), the opponent relies upon all of the services for which it is registered, which are found in the Annex to this decision.
5. The earlier mark was filed on 10 June 2021, given the respective filing dates, the opponent’s mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for more than five years at the filing date of the application, it is not subject to the use requirements specified within section 6A of the Act. Consequently, the opponent may rely upon all of the services identified without having to demonstrate genuine use.
6. In its notice of opposition, the opponent contends that the competing marks are similar and that the applied for services are either identical or similar to those of the earlier mark, giving rise to a likelihood of confusion between the signs.

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<sup>1</sup> The opponent originally sought to rely upon additional grounds, namely, s.5(3) and s.5(4)(a). However, due to the opponent’s failure to provide evidence these additional grounds were struck out by the registrar. Its claim is now based solely on s.5(2)(b).

7. The applicant filed a counterstatement denying that its class 35 and 36 services are similar to the opponent's services. It argues that the earlier mark is "inherently non-distinctive and distinguishable" from the applicant's mark. Further, the applicant denies that there is a likelihood of confusion.
8. The opponent is professionally represented by Trademarkit LLP; the applicant is professionally represented by Keltie LLP. Neither party asked to be heard at an oral hearing, though the opponent chose to file written submissions in lieu of a hearing. This decision is taken following careful consideration of the papers before me.
9. Although the UK has left the 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 and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

## **DECISION**

### **Legislation**

10. Section 5(2)(b) of the Act reads as follows:

"5(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."

11. The following principles are gleaned from the decisions 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 C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive

role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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 services**

12. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

13. All relevant factors relating to the services should be taken into account, which include, inter alia:<sup>2</sup>

- the physical nature of the goods or acts of service;
- their intended purpose;
- their method of use / uses;
- who the users of the goods or services are;
- the trade channels through which the goods or services reach the market;
- in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
- whether they are in competition with each other (taking into account how those in trade classify goods or services, for instance whether market research companies put them in the same or different sectors)

Or

- whether they are complementary to each other. Complementary signifying that "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 or services lies with the same

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<sup>2</sup> See Canon, Case C-39/97, paragraph 23; and British Sugar PLC v James Robertson & Sons Ltd., [1996] R.P.C. 281 – the "Treat" case.

undertaking”.<sup>3</sup> Noting that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.<sup>4</sup>

14. When interpreting the terms in a specification, I bear in mind that it is necessary to focus on the core of what is being described and that trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. Nevertheless, the principle should not be taken too far and where words or phrases in their ordinary and natural meaning are apt to cover the category of goods or services 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 or services in question.<sup>5</sup>

15. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Merici')*,<sup>6</sup> the General Court (“GC”) held that goods or services can be considered as identical when the goods or services designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

16. Furthermore, I bear in mind the approach in *Sky v Skykick*,<sup>7</sup> where Lord Justice Arnold set out the correct approach to interpreting broad and/or vague terms.

17. With these factors in mind, the competing services to be compared are as set out in paragraph 1 and the Annex to this decision.

### Class 35

### ***Promoting public awareness in the fields of sustainable tourism, environmental conservation, and wildlife conservation.***

18. Marketing is the promotion and sale of goods and services, as such, “*Promoting public awareness*” describes the very essence of what a marketing campaign does.

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<sup>3</sup> *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82, see also *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL O/255/13

<sup>4</sup> *Kurt Hesse v OHIM*, Case C-50/15 P, see also *Sanco SA v OHIM*, Case T-249/11

<sup>5</sup> *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

<sup>6</sup> Case T-133/05, paragraph 29

<sup>7</sup> [2020] EWHC 990, (Ch),

Therefore, I find the applicant's above term to be encompassed within the opponent's broad term "Marketing campaigns". Consequently, I find that these services are *Merit* identical.

### Class 36

#### ***Philanthropic and charitable foundation services, namely, providing financial assistance for programs and services of others.***

19. The opponent argues that the applicant's above services are "similar to and/or complementary to "Organisation of educational events; Arranging of educational events; Education services relating to conservation; Organising of competitions for education" in Class 41 of the Opponent's registration". It contends that "Philanthropic and charitable foundation services are often closely associated with educational services".<sup>8</sup> However, I disagree with this rationale for similarity, as I understand it, based on complementarity. Philanthropic and charitable foundation services, namely those for providing financial assistance for programs are not, as a matter of course, important or indispensable to the provision of education services nor vice versa. Philanthropic and charitable foundation services can be for various intended projects or services other than education, such as community care or environmental projects. Equally, educational services are capable of functioning without any financial assistance from philanthropic and charitable foundations. Furthermore, in my view, there is no reason why consumers of these competing services would believe that the responsibility for providing them lies with the same undertaking. Moreover, there is no similarity in nature, method of use or intended purpose of these services as one is to provide financial assistance for programs through philanthropic and charitable foundations, whilst the core purpose of the other is to provide education. The users would differ; users of the applicant's services being project organisers or co-ordinators, whereas users of educational services are more likely to be individuals. The channels of trade would also differ. Accordingly, I find the services identified to be dissimilar.

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<sup>8</sup> Opponent's written submissions, paragraph 19

20. For completeness I have also compared the applied for services in class 36 with the other services relied upon by the opponent and found none to be similar.

Class 39

***Travel transport services, namely, organizing, arranging, conducting, and operating transport services for travelers on escorted travel tours, excursions, day trips, and sightseeing tours; making reservations and bookings for air and ground transportation for tourists; travel guide services; travel booking agency services; travel agency services, namely, making reservations and bookings for transportation; travel and transport information services; arranging of cruises; Leasing of automobiles and boats; cruise ship services.***

21. The applicant's above services are all in relation to organising, arranging, reserving, booking and providing information for travel, including the provision of transport for travelling. It is clear that these services would fall into the opponent's more general terms, "*Travel reservations; Travel services; Travel organisation; Travel arrangements; Travel agent services for arranging travel; Travel agency services for arranging holiday travel; Organisation of travel; Escorting travellers*". Therefore, these services are *Merit* identical.

Class 41

***Educational and entertainment services in the nature of travel services, namely, organizing, arranging, conducting and operating educational and entertainment activities for tourists in the nature of guided travel tours of castles, historical sites, churches, monuments, buildings, cities, towns and villages, countrysides, parks, gardens, zoos, wineries, restaurants, local landmarks, museums, theaters, and malls; guided excursions, guided day trips, and guided sightseeing tours of castles, historical sites, churches, monuments, buildings, cities, towns and villages, countrysides, parks, gardens, zoos, wineries, restaurants, local landmarks, museums, theaters, and malls.***

22. The above services are all for the arrangement of educational and entertainment activities for tourists in the form of guided travel tours in various locations. I note that within its counterstatement, the applicant explicitly denies similarity of its class 35 and 36 services, however, does not deny similarity of its class 39 and 41 services. Therefore, it appears that the applicant accepts that there is at least some degree of similarity between the competing services. In my view, the applicant's services would be covered under the opponent's term "*arranging of guided educational tours*" which is wider in scope. As a result, I find that the opposed services are *Meric* identical.

23. As some degree of similarity between the services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition must fail against services of the application that I have found to be dissimilar, namely:<sup>9</sup>

Class 36: Philanthropic and charitable foundation services, namely, providing financial assistance for programs and services of others.

### **The average consumer and the nature of the purchasing act**

24. As indicated in the caselaw cited above, it is necessary to decide who the average consumer is for the parties' goods and services and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."<sup>10</sup> The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.<sup>11</sup>

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<sup>9</sup> eSure Insurance v Direct Line Insurance [2008] ETMR 77 CA

<sup>10</sup> *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).

<sup>11</sup> *Lloyd Schuhfabrik Meyer*, Case C-342/97.

25. Due to the nature of the services at issue, I find that the average consumer will predominantly consist of members of the general public, however, for those services in class 35, I find the average consumer will be business users.
26. For the general public, purchases will primarily be visual in nature, for example, after consulting websites or holiday brochures. However, I do not discount that there may be an aural component where the selection and purchase of these services involves either discussions with sales representatives or word-of-mouth recommendations. The frequency with which the services are purchased is likely to vary, but it is unlikely to be often. Equally, the cost of these services will vary depending on the package, and in some cases the duration and location, but it is unlikely to be at the highest end of the scale. Consumers will consider relevant factors such as, value, quality and convenience of the service as well as the packages available. Consequently, I find that members of the general public will pay an average level of attention during the selection process.
27. As for business users of class 35 services, the services are likely to be purchased either on a continuous basis to maintain the profile of the business or more infrequently to satisfy a specific business need. The cost will vary according to the exact nature. This is likely to be a relevant factor along with the specific needs of the business and quality of service. Purchases will predominantly be visual in nature after viewing websites or attending the premises of agencies offering such services, although I do not discount an aural component such as discussions with sales representatives. Overall, I find that business users will pay an above average level of attention when purchasing the relevant services at issue.

### **Distinctive character of the earlier mark**

28. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. 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 or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

29. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services to those with high inherent distinctive character, such as invented words which have no allusive qualities. Dictionary words which do not allude to the goods or services will be somewhere in between. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion, since the more distinctive the earlier mark, the greater may be the likelihood of confusion.

30. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use (nor was it required to do so). Consequently, I have only the inherent position to consider.

31. The earlier mark is a figurative mark that consists of the conjoined words “travelmatters” at the top in small writing, the word “MAKE” evenly spread across the centre, and the conflated words “travelmatter” below. I observe that where the word “travel” appears in the mark it is in slightly bold font. The words appear in fairly standard font in the colour purple. The merged words “travel” and “matters” at the top of the mark may be seen as laudatory and promotional, whilst the word “travel” by itself, (which will be easily identified by the average consumer) will be perceived as descriptive of the type of services offered. However, what affords the earlier mark distinctive character is the use of the words in combination, i.e. “travelmatters MAKE travelmatter”, keeping in mind that a registered trade mark must be assumed to have at least some distinctive character overall.<sup>12</sup> Therefore, in my view, the earlier mark possesses a low level of distinctive character.

### **Comparison of the marks**

32. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

“34. [...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

33. It would therefore be wrong to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to

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<sup>12</sup> *Formula One Licensing BV v OHIM*, Case C-196/11P

give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create.

34. The respective trade marks are shown below:

Earlier mark	Contested mark
	

Overall impressions

35. The earlier mark is a figurative mark that consists of the conjoined words “travelmatters” at the top in small writing, the word “MAKE” evenly spread across the centre, and the conjoined words “travelmatter” below. I observe that where the word “travel” appears in the mark it is in slightly bolder font. The words appear in fairly standard font in the colour purple. The overall impression lies predominantly in the words “MAKE travelmatter”, with the first conjoined words “travelmatters” at the top of the mark providing a smaller contribution due to its size. The colour of the font will also play a lesser role.

36. The contested mark is also a figurative mark which contains the words “MAKE TRAVEL MATTER” in large letters, in standard bold black font. Each word presented on a separate line in the centre of the mark. Superimposed onto the word “TRAVEL” is the word “TREADRIGHT”. Although consumers will identify that something is obstructing the word “TRAVEL”, the letters comprising the word

“TREADRIGHT” are so small in comparison with the mark as a whole, that they are virtually undecipherable, unless they are magnified in some way or are viewed upon very close inspection. Therefore, in my view, the word “TREADRIGHT” will likely be overlooked in the overall impression. Instead, the overall impression lies in the words “MAKE TRAVEL MATTER”.

#### Visual comparison

37. The competing marks are visually similar as they both contain the identical words “make”, “travel” and “matter”, albeit they use different case font and are found in different positions within the respective marks. Furthermore, the words “travel” and “matter” are conflated in the earlier mark unlike in the contested mark, and the word “travel” appears in slightly bold font within the earlier mark. However, I acknowledge that these are all minor differences. Moreover, the earlier mark contains the additional conjoined words “travelmatters” at the top of its mark, which is not replicated in the applied for mark. In contrast, the contested mark includes the word “TREADRIGHT” which is superimposed in relatively tiny lettering over the word “TRAVEL”, a feature which is absent from the earlier mark. The competing marks also use different colour fonts. Taking into account the overall impressions, I find that the competing marks are visually similar to a medium degree.

#### Aural comparison

38. The competing marks contain the same five identical syllables in the words “MAKE TRAVEL MATTER”. In the contested mark, as discussed above, consumers will be unable to adequately identify the word “TREADRIGHT” superimposed over the word “TRAVEL” and, consequently, will fail to pronounce it. Equally, whilst I accept that some consumers might articulate the conflated words “travelmatters” within the earlier mark, due to its size and positioning, many will not. Therefore, in my view, there will be a significant proportion of average consumers who will only articulate the words “MAKE TRAVEL MATTER”. For these consumers, the marks are aurally identical.

### Conceptual comparison

39. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>13</sup> The common words within the respective marks i.e. “MAKE TRAVEL MATTER”, conveys the identical message that travel should be made important. In reference to the services at issue, it is indicative of their type and purpose, i.e. travel services. This conceptual idea of travel being important applies equally to the additional words in the earlier mark “travelmatters”. As for the additional word “TREADRIGHT” superimposed over the word “TRAVEL”, as discussed above, in my view, this is so miniscule when compared to the mark as a whole, that it would be overlooked by consumers. Therefore, overall, the marks are conceptually identical.

### **Likelihood of confusion**

40. Whether there is a likelihood of confusion must be assessed globally, taking into account a number of factors. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. It is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the goods and services and the nature of the purchasing process.

41. In relation to assessing the likelihood of confusion where the common element has no or low distinctiveness, I keep in mind that in *Face2FaceHR Partners Limited v Peninsula Business Services Limited*,<sup>14</sup> Emma Himsworth K.C. as the Appointed Person, reviewed the case law in *Whyte and Mackay v Origin*<sup>15</sup> and *Nicoventures Holdings Limited v The London Vape Co Ltd*,<sup>16</sup> as well as guidance in the Common Communication on the Common Practice of Relative Grounds of

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<sup>13</sup> *Ruiz Picasso v OHIM* [2006] E.T.M.R 29.

<sup>14</sup> O/0368/23

<sup>15</sup> [2015] EWHC 1271 (Ch)

<sup>16</sup> [2017] EHC 3303 (Ch),

Refusal - Likelihood of Confusion (impact of non-distinctive/weak components) dated 2 October 2014, which is referred to in the case law. Ms Himsworth summarised the correct approach as follows, at paragraph 44:

“(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.

(2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.

(3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.

(4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.

(5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.

(6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical.” (My emphasis added).

42. I note that in *General Ecology, Inc. v Wan Jou Lin & Great Ins Company Ltd*,<sup>17</sup> Professor Phillip Johnson, as the Appointed Person, found that marks **NATURE**



**PURE**, and were confusingly similar, despite the common elements only having low distinctiveness. Furthermore, I remind myself that a low level of distinctiveness does not preclude a likelihood of confusion.<sup>18</sup>

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<sup>17</sup> O/0331/23

<sup>18</sup> *L'Oréal SA v OHIM*, Case C-235/05 P

43. I have found that the applicant's services are identical to those of the earlier mark, and that the average consumer of the services at issue will be either the general public who will pay an average level of attention, or business users who will pay an above average level of attention. The purchasing process will be largely visual, however, I have not discounted aural considerations. The overall impressions of the respective marks predominantly lies within the common word elements "MAKE TRAVEL MATTER"/"MAKE travelmatter" which play a greater role, as discussed above. I have found that the competing marks are visually similar to a medium degree, there is a significant proportion of average consumers for which the marks are aurally identical, and that the marks are conceptually identical. I have also found that the earlier mark possesses a low level of inherent distinctive character.

44. The competing marks differ in case, colour and style of the fonts used, although both use a standard typeface. Further, the word "travel" within the earlier mark is in slightly bold font. However, as acknowledged above, these are all minor differences. The earlier mark contains the additional conflated words "travelmatters" at the top of its mark, but this is in small writing that may easily be overlooked as it has the same conceptual message that is common to both marks, and therefore, would be seen as simply reinforcing that message. I acknowledge that the contested mark contains the word "TREADRIGHT" superimposed over the word "TRAVEL", which is absent in the earlier mark. Nevertheless, as discussed above, it is so miniscule in comparison to the rest of the mark that it will undoubtedly be overlooked. Whilst I accept that the words differ in the way that they are presented, they coincide in their distinctive components i.e. "MAKE TRAVEL MATTER", which is the concept retained in consumer's minds and even though this element is low in distinctiveness, the differences between the marks are even less distinctive, and, as such, are likely to be lost in the imperfect recollection of the marks, which is driven by the conceptual and aural identity. Taking into account the overall levels of similarity between the marks, the small differences, even in totality, are insufficient to distinguish between the competing marks. Therefore, in my view, it is highly likely that consumers, even those paying an above average level of attention during the purchasing process, would misremember the marks for one another and fail to recall the differences (identified

above) between the respective marks, especially given the identity of the services. I remind myself that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind. Consequently, I find there is a likelihood of direct confusion.

## **Conclusion**

45. The opposition under section 5(2)(b) of the Act has been partially successful. Subject to any appeal against my decision, the application will be refused in relation to the following services:

Class 35: Promoting public awareness in the fields of sustainable tourism, environmental conservation, and wildlife conservation.

Class 39: Travel transport services, namely, organizing, arranging, conducting, and operating transport services for travelers on escorted travel tours, excursions, day trips, and sightseeing tours; making reservations and bookings for air and ground transportation for tourists; travel guide services; travel booking agency services; travel agency services, namely, making reservations and bookings for transportation; travel and transport information services; arranging of cruises; leasing of automobiles and boats; cruise ship services.

Class 41: Educational and entertainment services in the nature of travel services, namely, organizing, arranging, conducting and operating educational and entertainment activities for tourists in the nature of guided travel tours of castles, historical sites, churches, monuments, buildings, cities, towns and villages, countrysides, parks, gardens, zoos, wineries, restaurants, local landmarks, museums, theaters, and malls; guided excursions, guided day trips, and guided sightseeing tours of castles, historical sites, churches, monuments, buildings, cities, towns

and villages, countrysides, parks, gardens, zoos, wineries, restaurants, local landmarks, museums, theaters, and malls.

46. The application will proceed to registration in the UK in respect of the following services against which the opposition has failed:

Class 36: Philanthropic and charitable foundation services, namely, providing financial assistance for programs and services of others.

### **Costs**

47. The opposition has been successful. The opponent is, therefore, entitled to a contribution towards its costs based on the relevant scale published in Annex A of Tribunal Practice Notice 2 of 2016, with a reduction to reflect the degree of success shared by the applicant. In the circumstances, I award the opponent the sum of £555, which is calculated as follows:

Official fee:	£100 <sup>19</sup>
Preparing the notice of opposition and considering the applicant's counterstatement:	£180
Preparing written submissions:	£275
<b>Total:</b>	<b>£555</b>

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<sup>19</sup> The official fee connected with the filling of the Form TM7 is not subject to a reduction.

48. Accordingly, I hereby order **The TreadRight Foundation** to pay **Travel Matters Ltd** the sum of **£600**. 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 30<sup>th</sup> day of October 2023**

**Sarah Wallace  
For the Registrar**

## **Annex**

### **Goods and services of UKTM no: 3654074**

#### **(The earlier mark)**

Class 35: Market campaigns; Development of promotional campaigns; Preparation of advertising campaigns; Developing promotional campaigns for business; Developing promotional campaigns for businesses; Business consultancy services relating to the promotion of fund raising campaigns.

Class 39: Reservation (Travel -); Travel reservations; Travel services; Travel organisation; Travel organization; Travel consultancy; Escorting travellers; Travel arrangements; Travel reservation; Travel arrangement; Travel guide and travel information services; Travel agents services for arranging travel; Travel information; Travel agency services for business travel; Travel agency services for arranging travel; Arranging for travel visas and travel documents for persons travelling abroad; Escorting of travellers; Travellers (Escorting of -); Arrangement of travel; Travellers (Transport of -); Travel agency services for arranging holiday travel; Organisation of travel; Travel reservation services; Arranging holiday travel; Travel route planning; Travel booking agencies; Arranging of travel; Travel arrangement services; Arranging travel tours; Transportation of travellers; Air travel services; Accompanying of travellers; Escorting of travelers; Travel information services; Travel guide services; Guide services (Travel -); Organizing of travel; Organising of travel; Organization of travel; Transport of travellers; Transport of travelers; Arranging for travel visas, passports and travel documents for persons traveling abroad; Travel agency services,

namely arranging transportation for travelers; Travel agency services relating to travel by omnibus; Arranging transport for travelers; Organizing transport for travelers; Arranging of coach travel; Holiday travel reservation services; Organisation of travel tours; Transportation of travellers' baggage; Reservation services for travel; Providing tourist travel information; Tourist travel reservation services; Ticketing services for travel; Organising of foreign travel; Organizing and arranging travel; Travel ticket reservation services; Ticket reservation services (Travel - );Organization of travel tours; Escorting [accompanying] of travellers; Agents for arranging travel; Organisation of holiday travel; Arranging of business travel; Booking of seats (travel); Provision of travel information; Arranging of air travel; Itinerary travel advice services; Arranging escorts for travellers; Arranging of travel tours; Tours (Arranging of travel -); Travel and passenger transportation.

Class 41: Educational information; Provision of educational information; Organisation of educational events; Arranging of educational events; Developing educational manuals; Education services relating to conservation; Organising of competitions for education; Arranging of guided educational tours.