

O/104/21

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. UK00003402773 BY  
UNIVERSAL DELIVERY SOLUTIONS LIMITED

AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 417752 BY  
UNITED PARCEL SERVICE OF AMERICA, INC

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DECISION

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**Background**

1. On 29 May 2019 Universal Delivery Solutions Limited (*'the Applicant'*) applied to register:



(*'the Application'*)

2. The Application, was made in respect of a wide range of services in Class 39 as listed in paragraph [23] of the Hearing Officer's Decision.
3. On 16 September 2019 United Parcel Services of America, Inc (*'the Opponent'*) filed an Opposition under section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (*'the 1994 Act'*).
4. For the purposes of section 5(2)(b) of the 1994 Act the Opponent relied upon 5 earlier trade marks. Two of those marks were registered in respect of **UPS** (UK Registered Trade Mark No. 1297284 relying on all the services for which it was registered in Class 39; and UK Registered Trade Mark No. 2175260 relying on some of the services for which it was registered in Classes 35 and 39) and also formed the basis of the Opposition pursuant to section 5(3) of the 1994 Act.
5. The other trade marks relied upon under section 5(2)(b) were registrations in respect of **UPS WORLDWIDE EXPRESS SAVER** (UK Registered No. 2471843 relying on all the services for which it was registered in Class 39); **UPS SUPPLY CHAIN SOLUTIONS** (UK Registration No. 2311978 relying on some of the services for

which it was registered in Classes 35 and 39); and **UPS SUPPLY CHAIN SYMPHONY** (UK Registration No. 3373453 relying on all the services for which it was registered in Classes 35, 39 and 42).

6. For the purposes of the Opposition under section 5(4)(a) the Opponent relied upon the sign **UPS** in respect of the following services:

Logistics services; transportation of goods by road and by air; arranging the transport of goods by road and by air; transportation of letters, documents, communications, printed matter, and other goods and property by diverse means of transportation, and including related services namely warehousing and storage and packing and delivery; freight forwarding; packaging articles for transportation; logistics management; document delivery and returns.

7. The Applicant filed a Counterstatement denying the claims made. The Applicant did not elect in the Counterstatement to put the Opponent to provide evidence of use and therefore the Opponent could rely upon all the earlier marks relied upon in respect of all of the relied upon services (see paragraph [21] of the Decision).
8. The Opponent filed evidence in support of the Opposition in the form of a witness statement of Scott Casey, a Vice-President of the Opponent, dated 7 January 2020 together with 11 exhibits. The Applicant's evidence was in the form of a witness statement of Neeraj Chawla, the Managing Director of the Applicant, dated 5 March 2020 together with 4 exhibits. No evidence in reply was filed on behalf of the Opponent.
9. The Applicant was unrepresented. The Opponent is represented by D Young & Co LLP. Neither party requested a hearing and only the Opponent filed written submissions in lieu. The decision by the Hearing Officer was accordingly made on the papers before her.
10. In a decision dated 30 September 2020 (O-485-20), Ms Stephanie Wilson, acting on behalf of the Registrar of Trade Marks, allowed the Opposition in part pursuant to section 5(2)(b) and section 5(4)(a) of the Trade Marks Act 1994 and rejected the Opposition in its entirety pursuant to section 5(3) of the 1994 Act (*'the Decision'*).
11. On the basis of these findings the Hearing Officer:
  - (1) Allowed the Application to proceed in respect of the following services in Class 39 *'Consultancy in the field of business travel provided by telephone call centers and hotlines; Consultancy services relating to the distribution of*

*electricity; Courier services (Travel -)*' all being services that were dissimilar to those relied upon by the Opponent<sup>1</sup>; and

- (2) Ordered the Applicant to pay to the Opponent the sum of £1,700 as a contribution towards its costs of the Opposition.

### **The appeal**

12. The Applicant appealed. As noted above the Applicant is unrepresented. The Reasons for the appeal identified by the Applicant in the Form TM55P were as follows:

I believe that our logo has a completely different outlook to the opposing cooperation (sic). The font, text size, tag line and colour are all poles apart.

Furthermore, UDS is classified as a freight forwarder and courier. From the research that I have formulated through different cases that I have studied, I have come to the conclusion that we have next to no similarity that should be challenged for our UKIPO by the opponent.

I truly believe that this objection should be reviewed. No matter how large the cooperation (sic) size is our logo shouldn't be disregarded due to an overlap in letter choice.

Through the UKIPO process I have been granted to (sic) trademark for the travel and courier industry. So personally, I do not see why it should not be granted for the freight forwarding and logistics sector. Branding is everything, and it is important to me and my business that this is looked at once again.

13. A Respondent's Notice was filed. In the Respondent's Notice it was indicated that:

- (1) The Applicant wished the Registrar's decision to refuse the Application pursuant to section 5(2)(b) and 5(4)(a) of the 1994 Act to be upheld.

#### *Section 5(2)(b)*

- (2) In addition to the reasons for the findings of visual similarity between the Application and the marks UPS WORLDWIDE EXPRESS SAVER, UPS SUPPLY CHAIN SOLUTIONS and UPS SUPPLY CHAIN SYMPHONY set

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<sup>1</sup> I note that in paragraph [35] of the Decision the reference to the word 'travel' in the specification was said by the Hearing Officer to be such as to make the specification '*likely to relate exclusively to the transport of people*'.

out in paragraphs [53] and [54] of the Decision the Hearing Officer could and should have relied upon the fact that the aforesaid marks being word marks could have been written in the same format and font(s) as the Application with UPS presented in the line above, for example, SUPPLY CHAIN SYMPHONY.

- (3) In addition to the Hearing Officer's findings with regard to the average consumer she should have additionally found that there was a difference between the average consumer being members of the general public and those of the business public and that in the present case the lower level of attention of the general public was such as to make the likelihood of confusion (whether direct or indirect) more likely.
- (4) In addition to the findings made with regard to the likelihood of confusion made by the Hearing Officer further support could have been found by reason of the interdependency principle as described in the judgment of the CJEU in Case C-39/97 Canon Kabushiki Kaisha v. Metro Goldwyn Mayer Inc.

*Section 5(4)(a)*

- (5) That in addition to damage by way of diversion of sales the Hearing Officer could and should have found damage by reason of injury to the reputation of the Opponent.

*Other*

- (6) There was no material to suggest that the Applicant had been discriminated against on the basis of corporation size.
14. The hearing of the appeal took place by video link on 5 February 2021. At that hearing Mr Chawla, the Managing Director of the Applicant, appeared for the Applicant and Ms Jennifer Heath of D Young & Co LLP appeared on behalf of the Opponent. Both parties also filed written submissions which were of further assistance to me.

**Standard of review**

15. An appeal against decisions taken by the Registrar is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. See Reef Trade Mark [2003] RPC 5; and Actavis Group PTC v. ICOS Corporation [2019] UKSC 1671 at [78] to [81].

16. Moreover, where the decision below involves the making of a value judgment the decision maker on appeal must be especially cautious about interfering with that judgment on appeal: see most recently Actavis (above) at [80]:

80. What is a question of principle in this context? An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. What is the nature of such an evaluative error? In this case we are not concerned with any challenge to the trial judge's conclusions of primary fact but with the correctness of the judge's evaluation of the facts which he has found, in which he weighs a number of different factors against each other. This evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible:

*Assicurazioni Generali SpA v Arab Insurance Group (Practice Note)* [2002] EWCA Civ 1642; [2003] 1 WLR 577, paras 14-17 per Clarke LJ, a statement which the House of Lords approved in *Datec Electronic Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23; [2007] 1 WLR 1325, para 46 per Lord Mance.

17. In Fage UK Ltd v. Chobani UK Ltd [2014] EWCA Civ 5; [2014] E.T.M.R. 26 at paragraphs [114] and [115] Lewison LJ said:

114 Appellate courts have been repeatedly warned, by recent cases at the highest level, not to interfere with findings of fact by trial judges, unless compelled to do so. This applies not only to findings of primary fact, but also to the evaluation of those facts and to inferences to be drawn from them. The best known of these cases are: *Biogen Inc v Medeva plc* [1977] RPC 1; *Piglowska v Piglowski* [1999] 1 WLR 1360 ; *Datec Electronics Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23 [2007] 1 WLR 1325 ; *Re B (A Child) (Care Proceedings: Threshold Criteria)* [2013] UKSC 33 [2013] 1 WLR 1911 and most recently and comprehensively *McGraddie v McGraddie* [2013] UKSC 58 [2013] 1 WLR 2477 . . .

115 It is also important to have in mind the role of a judgment given after trial. The primary function of a first instance judge is to find facts and identify the crucial legal points and to advance reasons for deciding them in a particular way. He should give his reasons in sufficient detail to show the parties and, if need be, the Court of Appeal the principles on which he has acted and the reasons that have led him to his decision. They need not be elaborate. There is no duty on a judge, in

giving his reasons, to deal with every argument presented by counsel in support of his case. His function is to reach conclusions and give reasons to support his view, not to spell out every matter as if summing up to a jury. Nor need he deal at any length with matters that are not disputed. It is sufficient if what he says shows the basis on which he has acted. These are not controversial observations: *see Customs and Excise Commissioners v A* [2002] EWCA Civ 1039; [2003] Fam. 55; *Bekoe v Broomes* [2005] UKPC 39; *Argos Ltd v Office of Fair Trading* [2006] EWCA Civ 1318; [2006] U.K.C.L.R. 1135.

18. That this is the correct approach was agreed by the Opponent. That it was the correct approach was explained to the Applicant at the Hearing of the Appeal.
19. I have kept in mind these principles in reaching my Decision and to the extent that the Grounds of Appeal and/or the submissions made before me on behalf of the Applicant can be taken to suggest that the appeal should proceed by way of a rehearing as opposed to by way of a review, I reject them.

### **Decision**

20. Although not conventionally set out the Grounds of Appeal appeared to indicate that it was maintained on behalf of the Applicant on this appeal that the Hearing Officer had erred in her assessment of (1) the similarity of the sign/marks in issue; (2) the similarity of the services in issue; and as a result (3) her conclusion as to the likelihood of confusion/misrepresentation.

#### *Appeal against findings under section 5(2)(b)*

21. As became apparent from the written materials filed in support of the appeal and the submissions made at the hearing of appeal the crux of the appeal being put forward on behalf of the Applicant was that the Hearing Officer had not proceeded with her analysis on the basis of a ‘real world’ comparison. That is to say in the context of the comparison of:
  - (1) The sign/marks: submissions were made on the basis of the Application and a logo said to be used by the Opponent in the course of trade in the form set out, by way of example, below:



It was further said that the respective presentation of the two logos, for example on company vehicles, were such as to have ‘*a completely different look, from colour to logo*’.

- (2) The services: submissions were put forward on the basis of a comparison between the Applicant being a ‘*SME based near Heathrow and service freight and logistic requirement around the M25 radius, with handful (sic) of clients in the rest of the U.K. . . . acting as a freight forwarder/ Broker using other carrier, Airlines GSA and shipping corporation to provide service to their clients*’ and the Opponent being ‘*a multinational corporation providing services to all their clients and doing everything in house*’.

22. The difficulty with way the matter is put forward on this appeal is that this is not the correct approach as a matter of law. Not only that but the Applicant made the same submissions at first instance which were expressly considered and then quite correctly rejected by the Hearing Officer as follows (emphasis added):

### **Comparison of trade marks**

47. . . .

48. Mr Chawla states that the applicant mainly works in the Indian market and notes that the opponent’s focus is Europe and the US. Mr Chawla makes the following points, by way of submission:

- “1. Distinct difference between the branding colours of both company logos, UPS: Brown & Yellow in comparison to Universal Delivery Solutions: Red White and Black.
2. Both logos are far from being identical in anyway or form.
3. UPS have used lower case on their logo, Universal Delivery Solutions have used upper case on their logo.
4. The font is completely different for Universal Delivery Solutions & UPS.
5. UPS have a shield around their logo, which makes their logo very distinctive.
6. Universal Delivery Solutions has a arrow going through the first 2 letters of their logo.

7. Universal Delivery Solutions use the term 'Logistics Simplified' as part of their logo. UPS has just the 3 letters as part of their logo.

8. Distinct difference in the advertising on company vehicles. UPS advertises their logo and Worldwide Services, Universal Delivery Solutions Have the logo & the services listed as well as the freight forwarders associations of which we are members of.

9. Under the UDS logo, on the vans or in fact, any advertising, UDS have their full company name printed. Universal Delivery Solutions. UPS do not..."

**49. For the avoidance of doubt, it is the marks as applied-for/registered that are relevant to my assessment. The opponent relies upon word only marks in these proceedings and it is these marks that I must consider** when assessing the likelihood of confusion.

23. Although not expressly dealt with in the Decision as a separate point under the heading 'Comparison of Services' at paragraphs [23] to [42] of the Decision the Hearing Officer carefully went through the comparison that she had to make with regard to the similarity of services. She did so, as she was required to do, by reference to a comparison of the services contained in the specification of the earlier trade marks relied upon by the Opponent for the purposes of the Opposition and the Applicant's services as specified in the Application.
24. In the circumstances in so far as the Applicant maintained on this appeal that the Hearing Officer took the wrong approach to the comparisons that she was required to make I reject those submissions.
25. In so far as the Applicant raised a point on this appeal with regard to the comparison of the marks in issue it was said that in making her assessment of similarity the Hearing Officer had failed to give any or any sufficient weight in that assessment to the stylisation of the arrow in the Applicant's mark; the differentiation in the form of the words '*Logistics Simplified*'; and the colour red.
26. The Hearing Officer set out her analysis of the respective trade marks as follows:

51. The applicant's mark consists of the letters UDS presented in red, overlaid with a white arrow device. Beneath these letters is a thin line and the words "Logistics Simplified" in title case. Although the letters UDS are overlaid with the arrow device, I consider that the average consumer will still identify them as these letters, particularly given the propensity to identify letters within trade marks. Given their size and positioning, I consider the letters UDS play the greater role in the overall impression,

with the arrow device, colour and words “Logistics Simplified” playing a lesser role.

52. The First and Second Earlier Marks consist of the letters UPS. There are no other elements to contribute to the overall impression of the marks, which lies in the combination of these letters. The Third, Fourth and Fifth Earlier Marks all consist of the letters UPS followed by series of other words (WORLDWIDE EXPRESS SAVER, SUPPLY CHAIN SOLUTIONS and SUPPLY CHAIN SYMPHONY respectively). These all appear to be slogans or service descriptions, and so I consider that the letters UPS play a greater role in the overall impression of these marks, with the following words playing a lesser role.

### Visual Comparison

#### *The First and Second Earlier Marks*

53. The marks all overlap in the presence of the letters U-S. The point of visual difference between the marks, is the presence of the letter P in the earlier marks and the letter D in the applicant’s mark. However, I note that the letters P and D do themselves share a degree of visual similarity. I do not consider that the use of red in the applicant’s mark has any impact, as registration of a mark in black and white (as is the case in respect of the earlier marks) will cover use of that mark in any colour. The additional point of visual difference is the arrow device in the applicant’s mark, and the words “Logistics Simplified” which have no counterpart in the earlier marks. Taking this into account, I consider the marks to be visually similar to a medium degree.

#### *The Third, Fourth and Fifth Earlier Marks*

54. The same comparison applies in relation to the letters UPS and UDS in each of the marks. The arrow device remains a point of visual difference. However, in the case of these earlier marks the letters UPS are followed by words which appear to be a slogan or service description. Taking all of this into account, I consider the marks to be visually similar to between a low and medium degree.

### Aural Comparison

#### *The First and Second Earlier Marks*

55. The First and Second Earlier Marks will be pronounced YOU-PEE-ESS. The letters UDS in the applicant’s mark will be pronounced YOU-DEE-ESS. I do not consider that the

presence of the arrow device will alter this pronunciation. I also do not consider that the words “Logistics Simplified” are likely to be pronounced, as they are likely to be seen as a slogan or service descriptor. Consequently, I consider the marks to be aurally highly similar.

*The Third, Fourth and Fifth Earlier Marks*

56. The letters UPS and UDS in each of the marks will be pronounced as described above. Again, I consider that the additional wording in each of the earlier marks (WORLDWIDE EXPRESS SAVER, SUPPLY CHAIN SOLUTIONS and SUPPLY CHAIN SYMPHONY respectively) are unlikely to be pronounced as they will be seen as slogans or service descriptors. As noted above, I also do not consider that the words “Logistics Simplified” in the applicant’s mark will be pronounced. The marks will be aurally highly similar.

Conceptual Comparison

57. Clearly, the letters used in each of the marks have some meaning to the parties. It appears that UDS stands for “Universal Delivery Solutions” and UPS stands for “United Parcel Service”. However, those meanings are not apparent from their respective trade marks and will not, in my view, be identified by the average consumer. I consider that the average consumer will view both UDS and UPS as acronyms with no particular meaning. Consequently, the conceptual position in respect of these elements will be neutral. The wording “Logistics Simplified” in the applicant’s mark, and the additional wording in each of the Third, Fourth and Fifth Earlier Marks clearly carry different specific meanings and will act as a point of conceptual difference between the marks.

27. In these paragraphs the Hearing Officer set out her reasoning and conclusions on this issue. In doing so the Hearing Officer expressly considered the stylisation of the arrow in the Applicant’s mark; the differentiation in the form of the words ‘*Logistics Simplified*’; and the colour red.
28. In these circumstances it seems to me that if the points raised by the Proprietor were to be considered afresh by me then as stated by Geoffrey Hobbs QC sitting as the Appointed Person in NICO LONDON TM (O-338-20) at paragraph [36]:

. . . the Decision would end up being re-taken by this Tribunal under the guise of reviewing it for error. However, it is necessary in order to maintain the required distance between the role of decision taker at first instance and the role of decision taker on appeal for this Tribunal to proceed on the basis that the Decision below should stand unless the matters

on which the [Applicant] relies are by force of what they reveal sufficient to establish that the Decision is vitiated by error.

29. I have reviewed the Decision in the light of the alternative put forward by the Proprietor. Having done so I am satisfied that the conclusion the Hearing Officer reached is not one that is vitiated by error rather it is one that it was open to her to reach for the reasons that she gave.
30. With regard to the issue of the comparison of the services the Applicant did not raise any *specific* point of complaint, save as set out above, by reference to the findings of similarity of the services made by the Hearing Officer. This is not satisfactory, for the reasons identified by Iain Purvis QC sitting as the Appointed Person in GREYBOX TM (0-106-20) at paragraph [9].
31. In any event, as noted in paragraph 23 above, the Hearing Officer carefully considered and made detailed findings with regard to the issue of the similarity of the services in this case. Having read the relevant paragraphs of the Hearing Officer's Decision I am satisfied that the findings that the Hearing Officer made were right for the reasons that she gave. In this connection it seems to me that, contrary to the suggestion of the Applicant, it was open to the Hearing Officer to draw a distinction between those services for which registration was allowed and services in the '*freight forwarding and logistics sector*' for the reasons explained in her decision.
32. With regard to the findings on the likelihood of confusion no separate criticism was made of the findings of the Hearing Officer from those as outlined above. Again, the Hearing Officer set out her reasoning in detail at paragraphs [63] to [71] of her Decision. Given that I have rejected the Applicant's appeal with regard to the assessment of similarity it seems to me that there is no basis upon which it is open to me to overturn the Hearing Officer's findings of a likelihood of confusion. Even were that not the case, having reviewed those paragraphs of the Decision I am satisfied that the conclusion the Hearing Officer reached is not one that is vitiated by error rather it is one that it was open to her to reach for the reasons that she gave.

*Appeal against the findings under section 5(4)(a)*

33. Again, the Applicant did not identify any specific grounds of appeal with respect to the findings under section 5(4)(a) of the 1994 Act. The Opponent submitted before me that there was no appeal at all directed to this ground. I do not accept that this is the case. It seems to me that the effect of the Grounds of Appeal as filed on behalf of the Applicant was to raise the same issues with regard to the assessment of similarity under the section 5(4)(a) ground as it had under the section 5(2)(b) ground. That is to say that in a 'real world' scenario there would be no conflict.
34. However, that is not what the situation with which the Hearing Officer was concerned. For the purposes of the section 5(4)(a) ground the Hearing Officer had to consider whether the normal and fair use of the mark with respect to the services

specified in the Application could be restrained by the Opponent by way of a claim for passing off. For the purposes of section 5(4)(a) the Opponent relied upon the sign **UPS**, i.e., the same sign as 2 of the earlier trade marks relied upon for the purposes of the opposition under section 5(2)(b), with respect to the services identified in paragraph 6 above. I also note that it has not been suggested by the Applicant that the Opponent does not have a protectable right in the sign **UPS** for such services.

35. The Hearing Officer clearly understood that was the task in hand and clearly recognised that this exercise was not identical to the one that she had undertaken for the purposes of the objection under section 5(2)(b) as she explained in particular at paragraphs [95] and [96] of her Decision.
36. In the circumstances it does not seem to me that the Applicant has identified any error of principle or identified any finding that was clearly wrong such that an interference in the conclusions of the Hearing Officer is appropriate.

*Other*

37. Finally, in so far as there has been a suggestion that the Applicant has been treated differently from the Opponent by the Hearing Officer in reaching her Decision by reason of the size of their respective businesses, I entirely reject it. There is nothing what so ever to support that suggestion in the Decision or indeed in the papers before me.

*The Respondent's Notice*

38. In addition to supporting the Hearing Officer's decision for the reasons that she gave the Respondent's Notice also relied on a number of points that it says provide further support for the conclusions of the Hearing Officer.
39. In considering the points raised in the Respondent's Notice it is necessary for me to keep in mind the guidance provided by: (1) in Fage UK Ltd v. Chobani UK Ltd (above) at [115] that '*[t]he primary function of a first instance judge is to find facts and identify the crucial legal points and to advance reasons for deciding them in a particular way. He should give his reasons in sufficient detail to show the parties . . . the principles on which he has acted and the reasons that have led him to his decision. They need not be elaborate. There is no duty on a judge, in giving his reasons, to deal with every argument presented by counsel in support of his case. His function is to reach conclusions and give reasons to support his view, not to spell out every matter as if summing up to a jury*' ; and (2) in NICO LONDON TM (above) that the decision below should not be retaken in the guise of reviewing the decision for error. In the light of such guidance and given that I have upheld the Hearing Officer's decision it does not seem appropriate in this case for me to consider whether there were additional reasons that the Hearing Officer could have relied upon in support of her conclusion.

40. However, there are two points raised in the Respondent's Notice which I take the view should be briefly dealt with.
41. First, with regard to the additional support that it is said could have been found by reference to Case C-39/97 Canon (above). Whilst there is no specific reference to the case in the Hearing Officer's Decision it is clear that she had the principles clearly in mind as she expressly and correctly identified them in paragraph [63] of her Decision.
42. Second, with regard to the issue of damage under section 5(4)(a) it would not appear from the pleadings or evidence that damage by reason of injury to reputation was expressly relied upon by the Opponent under this ground of Opposition and therefore the Hearing Officer cannot be criticised for not relying upon such damage in her reasons for upholding the section 5(4)(a) claim.

### **Conclusion**

43. To conclude, for the reasons set out above, it does not seem to me that there is any error of principle or material error in the Hearing Officer's decision. Moreover, it is not in my view appropriate to interfere with the evaluations that the Hearing Officer made in reaching the decision that she did. In the result the appeal fails and is dismissed.
44. Since the appeal has been dismissed the Opponent is entitled to a contribution towards its costs of the appeal. I will therefore make an order that the Applicant pay to the Opponent a contribution of £1,500 towards its costs of the appeal. This sum should be paid in addition to the costs of £1,700 below. I therefore order Universal Delivery Solutions Limited to pay to United Parcel Service of America, Inc the sum of £3,200 by 4pm on 9 March 2021.

Emma Himsworth QC  
Appointed Person  
16 February 2021