TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. UK00003822122

BY BATH TAXIS LIMITED

TO REGISTER A SERIES OF FOUR TRADE MARKS

SWOOP TAXIS, SWOOP Taxis,

Swoop Taxis, swooptaxis

IN CLASS 39

AND

AN OPPOSITION UNDER NO. 437286

BY WESTJET AIRLINES LTD

Background and pleadings

1. On 21 August 2022, Bath taxis limited ("the applicant") applied to register the trade marks shown on the cover page of this decision. The application was published for opposition purposes on 2 September 2022 for the following services:

   Class 39: Taxi services

2. The WestJet Airlines Ltd ("the opponent") filed a notice of opposition on 4 November 2022 on the basis of section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all the services in the application. For its claim, the opponent relies upon the following services covered by the international registrations designating the UK:

   Mark 1: SWOOP

   Registration No. WO000001656242

   Registration date: 17 December 2021

   Designation date: 17 December 2021

   Services relied upon:

   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.

   Mark 2: 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.

Mark 3: 

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.

3. 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 applicant's marks, 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 services it wishes to rely upon.

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

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

6. 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.

7. 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

8. 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.

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

My approach

10. 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 earlier mark SWOOP as it is closest in terms of similarity with the applicant's marks. I will return to the other earlier marks only if necessary.

Section 5(2)(b)

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

> "5(2) A trade mark shall not be registered if because –
>
> (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."

Case law

12. 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 services

13. When making the comparison, all relevant factors relating to the services 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".

14. 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.

15. 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".

16. I will now compare the applicant's taxi services in Class 39 with the opponent's services.

17. The opponent contends that there is very little difference between arranging for the rental of cars in Class 39 covered by its specification and the applicant's taxi services as both involve the use of a vehicle for transportation purposes.[1] The opponent also submits that they have the same end users and the same intended purpose – to travel from A to B and, therefore, the services are similar to a high degree.[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

[1] Opponent's submissions, para 14.
[2] *Ibid*
[3] Para 3.

evidence, the opponent submits that both types of services share the trade channels.

18. 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]

19. 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 a taxi instead. While there is some evidence of airlines or tour agents providing taxi services between airports and hotels, the evidence does not demonstrate that an undertaking that offers car rentals also provides taxi services and vice versa. 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

[4] Applicant's submissions, para 2.4
[5] *Ibid*

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

21. 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".

22. The average consumer of the respective parties' services is likely to be members of the general public. 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 services. There may be aural considerations when the choice is made further to references or recommendations.

Distinctive character of the earlier mark

23. 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 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)."

24. 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.

[6] See https://www.collinsdictionary.com/dictionary/english/swoop accessed 8 November 2023.

Comparison of marks

25. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> ".....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."

26. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

Opponent's mark	Applicant's marks
SWOOP	SWOOP TAXIS, SWOOP Taxis, Swoop Taxis, swooptaxis

27. The opponent's mark is a word-only mark for SWOOP. The overall impression of the mark lies in that word.

28. The applicant's marks are a series of 4 marks. Other than the fact that the words Swoop and Taxis are presented in upper case/lower case/combination of the two and with or without a space between them, there is no material difference

between the marks in the series. Therefore, I will consider the marks together for the purpose of comparison. Both 'SWOOP' and 'TAXIS' contribute to the overall impression of the marks. However, given that the word 'TAXIS' will be seen as descriptive of the applicant's taxi services, its relative weight in the overall impression is lesser than that of the word 'SWOOP'.

29. Visually, the opponent's mark SWOOP is wholly contained in the applicant's marks. In terms of difference, the applicant's marks contain the additional word 'TAXIS', which does not have a counterpart in the opponent's mark. I note that the identity arising from the word SWOOP which is at the beginning of the marks, is likely to have a significant impact on the average consumers.[7] Considering these factors, I find that the marks are visually similar to a high degree.

30. Aurally, respective parties' marks will be given their conventional pronunciation. I note that one of the marks in the applicant's series is presented as one word, 'swooptaxis'. Notwithstanding that fact, the average consumer will identify the words 'swoop' and 'taxis' and take a pause between those words. That makes the pronunciation of that mark identical to the rest of the applicant's marks in the series. As the respective parties' marks coincide in the pronunciation of the word 'SWOOP', which is at the beginning, I find that the marks are aurally similar to a high degree.

31. Conceptually, the word SWOOP introduces an identical concept in both parties' marks. I have already mentioned that the word SWOOP means to move suddenly or quickly. The applicant's marks contain an additional concept introduced by the word 'taxis', which is understood as a vehicle used to transport passengers. Considering these factors, I find that the marks are conceptually similar to a high degree.

Likelihood of confusion

[7] *El Cortes Inglés v OHIM - González Cabello and Iberia Lineas Aéreas de España* (MUNDICOR) [2004] ER

32. 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 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 services, 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]).

33. 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).

34. The difference between direct and indirect confusion was explained in the *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

35. I have found the respective marks to be visually, aurally and conceptually similar to a high degree. I also found that the services will be selected primarily by visual means, with a medium degree of attention by the general public. The services are similar to a medium degree. I also concluded that the inherent distinctiveness of the earlier mark is medium, and the distinctiveness has not been enhanced through its use.

36. I am of the view that the similarity between the marks arising from the shared word SWOOP at the beginning and the similarity between the services is likely to lead to a likelihood of direct confusion. The word 'Taxis' in the applicant's marks is descriptive of its taxi services. In imperfect recollection, the average consumer is unlikely to recall this descriptive word and mistake the opponent's mark for the applicant's marks and vice versa and think that the services originate from a single undertaking. I, therefore, conclude that there is a likelihood of direct confusion.

37. Even if one recalls the difference, given the descriptive nature of the word 'Taxis' in relation to the applicant's services, the consumers are likely to think that the applicant's marks are sub-brands or brand extensions of the opponent's mark (point (b) in *LA Sugar* case discussed above). Therefore, I find that there is a likelihood of both direct and indirect confusion.

Conclusion

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

Costs

39. The opponent has been successful and is entitled to a contribution towards its costs. During the opposition proceedings, this proceeding was consolidated with another opposition (no. 435742) between the same parties. Accordingly, the parties only filed one set of evidence and submissions in respect of both opposition proceedings. I have already issued a decision in the opposition number 435742 and awarded the opponent £850 towards the cost. That includes the costs for filing evidence and written submissions. I, therefore, do not intend to award any more costs to the opponent other than the official fee (£100) paid to launch this proceeding.

40. I order Bath taxis limited to pay WestJet Airlines Ltd the sum of £100 (official fee). 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 15th of November 2023

Karol Thomas
For the Registrar
The Comptroller-General