

**O/625/17**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION 3177083**

**BY THE TRUE TRAVELLER LIMITED**

**AND**

**OPPOSITION 407899**

**BY THE TRAVELERS INDEMNITY COMPANY**

## Background and pleadings

1. This is an opposition by The Travelers Indemnity Company (“the opponent”) to an application under No. 3177083 filed on 28<sup>th</sup> July 2016 (“the relevant date”) by The True Traveller Limited (“the applicant”) to register the trade mark shown below.



2. The applicant applies to register the trade mark in class 36 in relation to “*Travel insurance services; Agency services for arranging travel insurance; Arranging of travel insurance.*”

3. The application was published in the Trade Marks Journal on 12<sup>th</sup> August 2016.

4. The grounds of opposition are based on s.5(2)(b), s.5(3) and s.5(4)(a) of the Trade Marks Act 1994. The s.5(2)(b) grounds are based on five earlier trade marks. These are shown below.

| Trade Mark   | Filing or priority date | Registration procedure completed | Most relevant services in class 36  |
|--|-------------------------|----------------------------------|---|
| UK 2481284<br><br>Series of two marks | 3/03/2008               | 19/08/2011                       | Insurance; insurance underwriting services; all of the foregoing related to property and casualty insurance (including surety). |

|  |          |          |   |
|--|----------|----------|---|
| EU 12493921<br> | 13/01/14 | 13/10/14 | Insurance; insurance underwriting services for all types of insurance.  |
| UK 2615759<br><b>TRAVELERS INSURANCE</b>   | 26/03/12 | 26/04/13 | Insurance; insurance underwriting services for all types of insurance: but not including the provision of travel insurance. |
| EU 1016708<br><b>TRAVELERS</b>   | 15/12/98 | 16/10/00 | Property, casualty, life and annuity insurance services, except travel and traveller's insurance services.                  |
| EU 10980861<br><b>MYTRAVELERS</b>  | 21/12/11 | 16/11/12 | Insurance.  |

5. The opponent claims that there is a likelihood of confusion with the earlier marks.

6. The opponent also claims that trade marks UK 2481284 (TRAVELERS & Device) and EU 1016708 (TRAVELERS) have reputations in the UK and EU, respectively, in relation to insurance services. The opponent claims that use of the contested mark would, without due cause, take unfair advantage of the reputation of these marks or be detrimental to their distinctive character.

7. Additionally, the opponent claims to have traded extensively under the marks TRAVELERS and TRAVELERS & Device (as registered under UK 2481284) in relation to insurance services and to have acquired a valuable goodwill. According to the opponent, use of the contested mark would amount to a misrepresentation to the public. This would damage the goodwill in the opponent's business. Consequently, use of the contested mark would be liable to be restrained under the law of passing off.

8. The applicant filed a counterstatement denying the grounds of opposition. I note, in particular, that the applicant:

- (i) Put the opponent to proof of use of earlier mark EU 1016708 (TRAVELERS);
- (ii) Denied that the opponent had the necessary goodwill and reputation to support the s.5(3) and s.5(4)(a) claims;
- (iii) Denied that the opponent had any rights in the word TRAVELLERS (or aural equivalents) which could prevent the applicant from using the contested mark in relation to services associated with travel or travellers, including travel insurance services.

9. Both sides seek an award of costs.

### **Representation**

10. The opponent is represented by Keltie LLP, trade mark attorneys. The applicant is represented by Bates, Wells & Braithwaite, solicitors. Neither side asked to be heard. However, both sides filed written submissions in lieu of a hearing and I have taken these into account.

### **The evidence**

11. The opponent's evidence consist of a witness statement by Michael Bucci, who is Chief Intellectual Property Counsel for the opponent. Mr Bucci states that the opponent is an international property and liability insurance organisation of long standing. The opponent provides "*property and casualty insurance, surety products, and risk management to a wide range of businesses, government agencies/departments, associations and individuals.*"

12. In the UK, the opponent does business through several affiliates, including Travelers Insurance Company Ltd, Travelers Syndicate Management Ltd and Travelers Underwriting Agency Ltd. The opponent has licensed the TRAVELERS name and logo mark (as registered under EU 12493921) to these affiliates.

13. The opponent has a UK website at [www.travelers.co.uk](http://www.travelers.co.uk). The TRAVELERS and TRAVELERS umbrella logo marks are also used on letterheads, business cards, proposal forms, product fact sheets and other company documentation. Examples of promotional material and pages from the opponent's UK website are in evidence.<sup>1</sup> They mostly show use of the TRAVELERS name and logo mark (as registered under EU 12493921), but there are also some examples of TRAVELERS used alone.<sup>2</sup>

14. The information on the opponent's UK website confirms the evidence of Mr Bucci, that the opponent is a provider of property, casualty and risk management services to a range of sectors and professions (such as professional liability insurance for lawyers). I note that this includes the transportation sector, including operators of trains, trams, buses and coaches.

15. According to Mr Bucci, gross written premiums in the UK between 2011 and 2015 amounted to £1.1 billion.

16. The opponent promotes its services in the UK under the marks mentioned in paragraph 13 above through, inter alia, sponsorship of The Lawyer awards (2009-2014).<sup>3</sup> The opponent also sponsors the Travelers Championship, an annual PGA golf tour event held in the USA, but which is covered on UK television.<sup>4</sup> The opponent's TRAVELERS and TRAVELERS name and logo mark (as registered under EU 12493921) are also promoted via YouTube and the opponent's social media pages.<sup>5</sup>

17. The applicant's evidence consists of witness statements by Timothy Riley and James Moore. Mr Riley is a director of the applicant. Mr Moore is a chartered trade mark attorney at Bates, Wells & Braithwaite.

18. Mr Riley says that The True Traveller was set up in 2010. Originally it provided adventure holidays and ran its own travel insurance scheme. However, demand for

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<sup>1</sup> See exhibits MAB1 and MAB2

<sup>2</sup> See, for example, page 2-4 of MAB1

<sup>3</sup> See MAB4

<sup>4</sup> See MAB5

<sup>5</sup> See MAB6

travel insurance exceeded demand for holidays and the holiday side of the business ceased in 2014.

19. Mr Moore provides the results of searches he conducted of the UK trade mark register which revealed that 15 marks are registered for insurance or travel insurance services in class 36 which include the word 'Traveller'. Two of these are existing registrations in the name of the applicant for 'TRUE TRAVELLER INSURANCE' and 'TRUE TRAVELLER travel insurance designed by travellers for travellers'. Apart from Mr Riley's statement about the applicant's use of The True Traveller, there is no evidence that any of these marks are in use. Therefore, this evidence does not shed any light on the familiarity of consumers with these marks, Consequently, this evidence does not assist.

#### Proof of use of EU 1016708

20. Section 6A of the Act is as follows:

"Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),  
(b) or (ba) in relation to which the conditions set out in section 5(1), (2)  
or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed  
before the start of the period of five years ending with the date of  
publication.

(2) In opposition proceedings, the registrar shall not refuse to register the  
trade mark by reason of the earlier trade mark unless the use conditions are  
met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

21. Only EU 1016708 had been registered for 5 years at the date of publication of the contested mark. Therefore, the opponent can rely on the other four earlier marks without having to show proof of use. As far as EU 1016708 is concerned, the applicant disputes that the evidence shows genuine use of this mark in the period

13<sup>th</sup> August 2011 to 12<sup>th</sup> August 2016 (“the relevant period”). The applicant points out, in particular, that:

- There is no detailed evidence as to the distribution of the publications shown in exhibit MAB1;
- The annual report and accounts of Travelers Insurance Company Ltd provides only limited information about the use of TRAVELERS in the UK, and none about use in the (rest of) the EU;
- The sponsorship of The Lawyers Awards shown in MAB4 does not indicate who Travelers is, or what services it provides;
- The same criticism applies to the opponent’s sponsorship of the Travelers Golf Championship;
- The opponent’s evidence of social media promotion refer exclusively to the opponent’s US website and do not show sufficient presence in the UK or EU;
- There is no indication of the market share held under the mark in the UK or EU;
- Mr Bucci’s evidence is directed primarily to the position in the USA and UK;
- Even if the evidence is sufficient to establish genuine use of the mark in the UK, it is insufficient to show genuine use in the EU.

22. The opponent submits that the evidence is sufficient to show genuine use of EU 1016708 in the relevant period.

23. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

24. The burden is therefore on the opponent to show use of EU 1016708 in the relevant period. In *The London Taxi Corporation Limited v Frazer-Nash Research*

*Limited & Ecotive Limited*,<sup>6</sup> Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use.* In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237 ). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaf” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of

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<sup>6</sup> [2016] EWHC 52

the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

25. In *Awareness Limited v Plymouth City Council*,<sup>7</sup> Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is

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<sup>7</sup> Case BL O/236/13

all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

26. It is not therefore essential to provide particular types of evidence, but the evidence must, when considered as a whole, show that the mark at issue has been used in the EU. I am satisfied that the opponent’s evidence shows use of TRAVELERS in the UK. It is true that the evidence could have been clearer and more complete. However, it is clear from Mr Bucci’s evidence that the opponent had a significant business in the UK during the relevant period in relation to “*property and casualty insurance.*” The UK based licensees primarily used the TRAVELER and umbrella logo mark as registered under EU 12493921. However, there was also use of the word TRAVELER alone, for example on the opponent’s UK website. More importantly, use of a composite mark may also constitute use of the word element of that mark provided that the word element alone identifies the trade source of the services.<sup>8</sup> That is likely to be the case where the element in question has an independent distinctive role in the mark. The word TRAVELER is plainly an independent element of the composite mark (in the sense that it is not physically or conceptually tied to the umbrella device). In my view, TRAVELER is also distinctive in relation to “*property and casualty insurance, except travel and traveller’s insurance services.*” Indeed this must have been the basis on which the word-only mark was registered. In these circumstances, I find that use of the composite mark also constitutes use of the word TRAVELERS in the UK.

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<sup>8</sup> See *Colloiseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, CJEU at paragraphs 31 to 35 of the judgment. For an example of the application of this principle, see the recent decision of Iain Purvis QC as the Appointed Person in *Marriott Worldwide Corporation v Dr Sascha Salomonowitz* in BL O/549/17 at paragraphs 13 to 24.

27. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot

therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

28. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

29. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

30. The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of a EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of a EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

31. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i) the scale and frequency of the use shown;
- ii) the nature of the use shown;
- iii) the goods and services for which use has been shown;
- iv) the nature of those goods/services and the market(s) for them;
- iv) the geographical extent of the use shown.

32. The UK is a significant part of the EU market for insurance services. The opponent's use of TRAVELER in the UK during the relevant period is more than trivial. The use appears to have been stable and consistent. It is plainly trade mark use. The nature of the market indicates that the use was directed, geographically, at the whole of the UK market for "*property and casualty insurance.*" Therefore, despite the fact that the EU market at issue is not limited to, or particularly concentrated in, the UK, I find that the use of EU 1016708 in the UK is sufficient to constitute genuine use of that mark in the EU.

33. This means that the opponent can rely on the registration of that mark in relation to "*property and casualty insurance, except travel and traveller's insurance services.*"

34. Mr Bucci does not mention any use of the mark in relation to “*life and annuity insurance services*” and I see no clear evidence of any use of the mark in the UK in relation to these services during the relevant period. Therefore, the opponent cannot rely on EU 1016708 insofar as it is registered in relation to these services.

### **Section 5(2)(b) grounds of opposition**

35. Section 5(2)(b) of the Act is 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”.

36. It is convenient to start by considering the opponent’s case based on EU 1016708, **TRAVELERS**.

#### Comparison of services

37. The respective services are shown below.

| EU 1016708   | Contested mark  |
|--|---|
| Property and casualty insurance, except travel and traveller’s insurance services. | Travel insurance services; Agency services for arranging travel insurance; Arranging of travel insurance. |

38. The services are not identical because they involve the provision, or arranging of, different types of insurance. In the judgment of the CJEU in *Canon*,<sup>9</sup> the court stated that:

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<sup>9</sup> Case C-39/97, 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”.

39. The insurance services in question are the same in nature. The purpose of the services is also the same when considered at a high level: to insure against an unexpected event or failure. However, the specific purpose of travel insurance is different to property and casualty insurance. Consequently, they are not in competition. Nor are they complementary, because one is not essential or important for the use of the other. However, they could be provided by the same undertaking. Overall, I find that the services are similar to a high degree.

#### Global comparison

40. 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.

#### *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 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 great 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 the earlier mark to mind, 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

#### Average consumer and method of selection

41. 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: *Lloyd Schuhfabrik Meyer*.

42. Property insurance is a relatively important purchase. It is usually purchased on a fixed term basis, often annually. It may therefore be expected that consumers will pay at least a normal degree of attention when selecting a service provider. Casualty insurance is likely to be an important service purchased by private and public sector businesses and organisations, as well as by professionals, such as lawyers. Consumers in these groups are likely to pay an above average degree of attention when selecting a service provider.

43. Insurance is likely to be selected mainly by visual means, from brochures, websites etc. However, word of mouth orders via brokers is likely to pay an important part too, so oral orders are also relevant.

#### Distinctive character of earlier mark

44. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, 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).”

45. The likelihood of confusion must be assessed amongst consumers in the territory in which registration is sought, i.e. the UK. Therefore, I must assess the level of distinctiveness of the earlier mark from the perspective of relevant UK consumers.

46. Earlier I found that TRAVELERS had been put to genuine use in the UK (and the EU) in relation to property and casualty insurance. Part of my reasoning was that the word is inherently distinctive in relation to such services. This is because it does not describe such services. Consequently, I find that the mark has an average degree of inherent distinctive character in relation to the registered services.

47. The opponent claims that the earlier mark has acquired an enhanced level of distinctiveness through use. The applicant disputes this.

48. As I also noted earlier, the opponent's use of the mark in the UK appears stable and consistent. However, as the applicant points out, it is not clear what share TRAVELERS has of the relevant UK insurance market. Mr Bucci states that gross written premiums in the UK between 2011 and 2015 amounted to £1.1 billion. This sounds (and is) a lot of money, but in context may only represent a small fraction of the relevant market. Further, although the opponent has provided some information

about promotion of the mark, information specific to the UK market is limited, essentially to a UK website and some sponsorship activities. There is little evidence of third party recognition of the mark, e.g. in press articles. In my view, the evidence is insufficient to establish that the distinctive character of TRAVELERS had been materially enhanced at the relevant date to the point where it had more than an average or 'normal' degree of distinctive character. Alternatively, if the mark had acquired an above average degree of distinctive character amongst a significant proportion of consumers, it would have been mainly amongst private and public sector businesses and organisations, as well as individual professionals, to whom it has directed its services.

### Comparison of marks

49. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 in *Bimbo SA v OHIM*<sup>10</sup> 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.”

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

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<sup>10</sup> At paragraph 34 of its judgment in Case C-591/12P

The respective trade marks are shown below:

|                    |   |
|--------------------|---|
| TRAVELERS          | <br>travel insurance designed by travellers |
| Earlier trade mark | Contested trade mark  |

51. The words ‘true traveller’ are the dominant and distinctive element of the contested mark. The strapline ‘travel insurance designed by travellers’ is not quite negligible, but it is so relatively small that it contributes very little to the overall visual impression created by the mark. These words are unlikely to be verbalised, so the strapline adds nothing to the aural identity of the mark. The contrasting orange and black colour scheme, and the orange arrow device in the letter ‘a’, make more of an impression on the eye, but still less than the words ‘true traveller’.

52. The earlier mark only has one visual and aural element – the word TRAVELERS.

53. The marks are visually similar to the extent that the earlier mark comprises the word that appears as the second word in the contested mark, albeit in plural form and with an alternative spelling. The words TRAVELERS and TRAVELLER will sound very similar when spoken, so this coincidence of words also introduces a (slightly higher) degree of aural similarity between the marks.

54. On the other hand, the first part of the contested mark – TRUE – has no counterpart in the earlier mark. And as this word appears at the beginning of the contested mark, it is not easily missed when the mark is seen or heard.<sup>11</sup> The get-up

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<sup>11</sup> In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of words tend to have more visual and aural impact than the ends.

of the contested mark also adds to the visual difference between it and the earlier mark.

55. Overall, I find that the marks are visually similar to a moderate degree and aurally similar to a medium degree.

56. Conceptually, the word TRAVELERS will be given the same meaning as 'travellers', i.e. people who travel. The words 'truetraveller' will be understood as having the more specific meaning of a 'real' or 'dedicated' traveller. Therefore, there is a certain degree of conceptual similarity, but also a specific difference.

57. Overall, I find the marks are similar to a medium degree.

#### Likelihood of confusion

58. The medium degree of similarity between the marks is offset to an extent by the high degree of similarity between the services. However, even allowing for imperfect recollection, I find it unlikely that there will be any significant direct confusion between the contested mark (and the travel insurance services offered under that mark) and the earlier mark (and the property and casualty insurance services offered under it). This is because the visual, aural and conceptual differences between the marks (combined with the different specific insurance services) are too great to be missed by average consumers paying at least a normal degree of attention.

59. Turning to the possibility of indirect confusion, I note that In *L.A. Sugar Limited v By Back Beat Inc*,<sup>12</sup> Mr Iain Purvis Q.C., as the Appointed Person, 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

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<sup>12</sup> Case BL O/375/10

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.”

60. In my view, the high point of the opponent’s case is that consumers might assume that the presence of the word ‘traveller(s)’ in the contested mark denotes a connection with the opponent. The fact that ‘traveller’ is ‘separated’ from ‘true’ by the use of colour, and ‘travellers’ appears on its own in the strapline of the contested mark, might increase the likelihood of such a connection being made. On the other hand, ‘traveller(s)’ appears highly descriptive of travel insurance. Therefore, when the contested mark is used in relation to travel insurance (and closely related services), there is strong likelihood that the word will be seen as referring to the users of travel insurance rather than to the opponent. The likelihood of average consumers having this reaction to the contested mark is increased, in my view, by the fact that the dominant and distinctive element of the mark - ‘truetraveller’ - forms a unit having a different meaning (i.e. a ‘real’ or ‘dedicated’ traveller) to that of the words taken separately.<sup>13</sup> This conclusion is not undermined by the fact that word ‘traveller’ appears in a different colour to the word ‘true’.<sup>14</sup> I therefore find that ‘traveller’ (within ‘truetraveller’) does not have an independent distinctive role in the contested mark. The same applies to the word ‘travellers’ in the strapline of the contested mark. In context, it will most likely be taken as referring to travel insurance for travellers designed by people who are themselves travellers.

61. For the sake of completeness, I would have reached the same conclusion even if I had found that the earlier mark had an enhanced degree of distinctiveness at the relevant date through use. In reaching this conclusion I have borne in mind that the section of the public to whom the opponent’s mark may have become more

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<sup>13</sup> See the CJEU’s judgment in *Bimbo* and paragraph 20 of Arnold J.’s judgment in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

<sup>14</sup> See the decision of James Mellor QC as the Appointed Person in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, at paragraph 63

distinctive are the same group of consumers I found would pay an above average degree of attention when selecting a service provider. These factors balance each other out. Therefore, in my judgment, there is no higher likelihood of confusion amongst this section of the public.

62. It follows that the s.5(2)(b) opposition based on EU 1016798 fails.

#### EU 12493921

63. I will next consider the s.5(2)(b) ground based on earlier trade mark EU 12493921. This mark is registered for *insurance* and *insurance underwriting services* without limitation. Therefore, unlike EU 10980861 considered above, it covers identical services to those covered by the contested mark.

#### Average consumer and selection process

64. The consumers for these services are the same as those considered above except that the wider range of insurance increases the size of the section of consumers comprised of the general public. The inclusion of underwriting services also makes insurance companies themselves potential customers.

#### Distinctive character of earlier mark

65. So far as the distinctive character of the earlier mark is concerned, subject to the following caveats, I adopt my earlier findings at paragraphs 44-48 above.

66. The first caveat is that the distinctiveness of the earlier mark for travel insurance, or underwriting of travel insurance, is low. This is because the word TRAVELERS describes the intended consumer of travel services. In doing so it serves to designate the kind of insurance services. Admittedly, there is no evidence that 'travellers' is a generic term for a type of insurance. The word TRAVEL appears to be the generic term. Nevertheless, 'travellers' identifies who is being insured just as accurately as TRAVEL identifies the activity that is the subject of the insurance. In that sense, 'travellers' is no less descriptive than (say) 'motorists' is for motor

insurance. This means that when it comes to the inherent distinctiveness of the earlier mark in relation to travel insurance (including underwriting such insurance), the distinctiveness of the earlier mark must largely depend on the red umbrella device in the mark.

67. The second caveat is that there is no evidence that EU 12493921 has been used in relation to anything other than property and casualty insurance and risk management services. Therefore, the mark (specifically the word TRAVELERS) cannot have acquired a secondary meaning as a trade mark for travel insurance and related underwriting services.

Comparison of marks

68. The respective trade marks are shown below:

|   |  |
|---|--|
|  |  |
| <p>Earlier trade mark</p>   | <p>Contested trade mark</p>  |

69. With the following caveat, I adopt my earlier findings at paragraphs 51 – 56 above. The caveat is that the level of visual similarity between the above marks is less than in the previous comparison because the earlier mark in this case includes the red umbrella. This makes a more-than-negligible contribution towards the distinctive character of the earlier mark. The presence of this distinguishing feature means that the overall level of visual similarity between the marks is low (rather than moderate as in my earlier comparison with the word TRAVELERS alone).

70. I find that the overall of similarity between these marks is moderate.

### Likelihood of confusion

71. The moderate degree of similarity between the marks is offset to an extent by the identity between the services. However, even allowing for imperfect recollection, I find it unlikely that there will be any significant direct confusion between the contested mark and the earlier mark. This is because the visual, aural and conceptual differences between the marks are too great to be missed by average consumers paying at least a normal degree of attention.

72. It is again necessary to also consider indirect confusion. However, I find that there is no likelihood of indirect confusion either. My reasons are similar to those given in paragraph 60 above with regard to the comparison with earlier trade mark EU 1016708. The one difference is that I must make allowance in this comparison for the possibility that the earlier mark could also be used in future in relation to travel insurance and underwriting of such insurance. However, if it were used in relation to those services, average consumers would most likely regard the word TRAVELERS as a description of the services. Consequently, they would have no more reason to regard the word element 'truetraveller', or the words 'travel insurance designed by travellers', as designating a connection with the opponent than was the case with EU 1016708.

73. The opposition based on EU 12493921 therefore also fails.

### The s.5(2) opposition based on the other earlier marks

74. None of the other earlier marks gives the opponent a better case than the case based on EU 1016708 and EU 12493921. I therefore reject the opposition under s.5(2)(b) based on earlier marks UK 2481284, UK 2615759 and EU 10980861.

### The s.5(2) opposition based on a 'family' of marks

75. The opponent claims that the likelihood of confusion is increased by virtue of the existence of a 'family' of TRAVELER marks. However, in order to bring an opposition based on a family of marks it is necessary to show that the marks are present on the

market. There is no evidence that MYTRAVELERS was present on the UK market at the relevant date. Without that mark the opponent's 'family' of marks are basically the word TRAVELERS with and without the umbrella device. That is not a 'family' of TRAVELER marks in the sense covered in the case law. Therefore, this argument does not assist the opponent.

### **The passing-off right ground**

76. The ground of opposition based on s.5(4)(a) does not appear to take the opponent's case any further than the grounds based on s.5(2). The only services identified in the notice of opposition in which the opponent claims to have goodwill are insurance services. The signs claimed to be distinctive of these services are the same signs I considered as earlier trade marks under the s.5(2)(b) grounds. I do not doubt that the opponent has sufficient business and goodwill in the UK to warrant protection of these signs under the law of passing off. However, it has not persuaded me that use of the contested mark would create a likelihood of confusion amongst a substantial number (or indeed any) of the relevant public. If that is right, then use of the contested mark will not constitute a misrepresentation to the public. This is fatal to the ground of opposition based on s.5(4)(a) of the Act. Therefore, it fails too.

### **Section 5(3) grounds of opposition**

77. The opponent claims that the trade marks registered under UK 2481284 have a reputation in the UK. The marks are:



78. The opponent's pleaded case is that these marks have reputations for, inter alia:

Insurance; insurance underwriting services; all of the foregoing related to property and casualty insurance (including surety).

79. The opponent's pleaded case is that EU 1016708 - **TRAVELERS** - has a reputation in the EU in relation to:

“Property, casualty, life and annuity insurance services, except travel and traveller's insurance”

80. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

81. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, General Motors, [1999] ETMR 950, Case 252/07, Intel, [2009] ETMR 13, Case C-408/01, Adidas-Salomon, [2004] ETMR 10 and C-487/07, L'Oreal v Bellure [2009] ETMR 55 and Case C-323/09, Marks and Spencer v Interflora. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; General Motors, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; General Motors, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; Adidas Saloman, paragraph 29 and Intel, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; Intel, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; Intel, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; Intel, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; Intel, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; Intel, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; L'Oreal v Bellure NV, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any

financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).

82. It is convenient to start by examining the case based on EU 1016708.

### Reputation

83. In *General Motors*, Case C-375/97, the CJEU stated that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

84. I see no evidence that EU 1016708 had a reputation in the EU at the relevant date in relation to life or annuity insurance. I accepted earlier that the mark had been put to genuine use in the EU in relation to, inter alia, property and casualty insurance. This appears to be the core of the opponent's business.

85. As I noted earlier, there is no evidence as to the share of the EU (or UK) market held by the mark or the amount spent promoting it. However, the mark appears to have been present on the EU market for at least 5 years and it received a certain level of exposure in the EU, mainly through sponsorship activities. Additionally, the market for property and casualty insurance will be much smaller than the whole insurance market. Therefore, TRAVELERS is likely to be better known in the EU market for those products than it would have been if it had been trading on the same level, but spread across multiple insurance products.

86. I therefore find that the opponent's mark had a qualifying reputation in the UK (and therefore the EU) at the relevant date.<sup>15</sup>

#### Link?

87. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

*The degree of similarity between the conflicting marks*

88. I earlier found that the marks are similar overall to a medium degree.

*The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public*

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<sup>15</sup> See the judgment of the CJEU in *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07

89. The services at issue are insurance. The services for which the earlier mark has a reputation are highly similar to the travel insurance services covered by the contested mark. Although consumers in the market for which the earlier mark has a reputation are likely to make up only a proportion of the market for travel insurance, which is mainly the general public, I recognise that there will be some overlap between the relevant groups of consumers for these insurance services.

*The strength of the earlier mark's reputation*

90. The earlier mark may be very well known in the USA. On the evidence before me, I cannot say that it had more than a moderate reputation in the UK (and therefore the EU) at the relevant date. As I noted before, this reputation is likely to be concentrated amongst users of casualty and property insurance to which it has directed its services, i.e. private and public sector businesses and organisations, as well as individual professionals. The reputation of TRAVELERS amongst the general public in the EU (if any) is likely to have been very low.

*The degree of the earlier mark's distinctive character, whether inherent or acquired through use*

91. The earlier mark has an average or 'normal' degree of inherent distinctiveness in relation to casualty and property insurance. As I noted earlier, it may have acquired an above average level of distinctiveness in the specific markets in which the opponent operates. For the purposes of this assessment, I will assume that it had.

*Whether there is a likelihood of confusion*

92. The likelihood of confusion would be decisive of the existence of the necessary link. However, the absence of a likelihood of confusion is not decisive. Consumers could still make a mental link between the marks, without being confused.

93. Applying these factors to the marks at hand, I find that no significant number or proportion of consumers are likely to link the contested mark to the earlier mark, if the contested mark is used in relation to travel insurance. My reasons for coming to

this decision are essentially the same as the reasons I gave at paragraph 60 above for my finding that there is no likelihood of confusion.

94. The opponent appears particularly concerned that the use of the word ‘travellers’ in the strapline of the contested mark will trigger an association with TRAVELERS. However, this concern appears to me to be unfounded. This is because:

- (i) The earlier mark does not appear to have a particularly strong reputation in the UK or EU;
- (ii) The strapline ‘travel insurance designed by travellers’ is very much a subsidiary element of the contested mark;
- (iii) In the context of the mark as a whole and when used in relation to travel insurance, it will most likely be taken as referring to travel insurance for travellers designed by people who are themselves travellers;
- (iv) The strapline is therefore purely descriptive in nature.

Indeed by using the words “...*except travel and traveller’s insurance*” in the description of the services for which the earlier mark has a reputation, the opponent’s own pleadings appears to recognise the descriptiveness of the word ‘traveller’s’ in relation to travel insurance.

95. Taking all these matters into account I find that the public will make no link between the marks. If that is right, the s.5(3) ground based on EU 1016708 is bound to fail. However, even if I am wrong about that, I would hold that any such link that may be made would be so weak and fleeting as to be incapable of leading to the contested mark taking unfair advantage of TRAVELERS, or diluting its distinctiveness in relation to the services for which it has a reputation.

96. It follows that the s.5(3) ground based on EU 1016708 fails.

97. The opponent has no stronger case based on UK 2481284. Therefore all the s.5(3) grounds fail.

## **Outcome**

98. The opposition has failed. The contested trade mark will be registered.

## **Costs**

99. The applicant has been successful and is entitled to a contribution towards its costs. I calculate these as follows:

- (i) £400 for considering the notice of opposition and filing a counterstatement;
- (ii) £800 for considering the opponent's evidence and filing evidence in response;
- (iii) £200 for filing written submissions.

100. I order The Travelers Indemnity Company to pay The True Traveller Limited the sum of £1400. This sum to be paid within 14 days of the end of the period allowed for appeal.

**Dated this 6th Day of December 2017**

**Allan James  
For the Registrar**