

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK  
APPLICATION **m** 2014098 BY JOHANNES CAREL VAN WIERST  
TO REGISTER THE MARK **JACKPOT-FLIGHT**

AND

IN THE MATTER OF OPPOSITION  
THERE TO UNDER OPPOSITION **m** 44846 BY  
SCANDINAVIAN AIRLINES SYSTEMS DENMARK-NORWAY-SWEDEN

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by Scandinavian Airlines Systems Denmark-Norway-Sweden

10 DECISION

Johannes Carel Van Wierst applied on 13 March 1995 (but claiming priority from 12 September 1994) to register the mark JACKPOT-FLIGHT in class 39 in respect of :-

“Travel arrangement services; arrangement of air travel during which games of chance can be taken part in”.

15 The application is opposed by Scandinavian Airlines Systems Denmark-Norway-Sweden, partly on the basis of an earlier registration of the mark SAS JACKPOT! registered in class 39 for identical or similar services, and partly on the basis of prior use of the mark JACKPOT solus.

20 In the Notice of Opposition, the grounds are indicated broadly as relating to section 3 and section 5 of the Act, although the opponent does plead in particular that use of the applicant’s mark in the United Kingdom is liable to be prevented by the law of passing off.

The relevant details of the opponent’s registered mark are as follows:-

<u>No</u>	<u>Mark</u>	<u>Class</u>	<u>Services</u>
1519888	SAS JACKPOT!	39	Air information services; transportation of passengers and goods by air and car; travel agency and booking services; car hire; warehouse storage and bonded storage; all included in class 39; but not including any such services relating to airborne communications.

25 Both parties ask for an award of costs in their favour.

Only the opponent filed evidence in these proceedings and the matter came to be heard on 4 March 1998. At the hearing, the opponent was represented by Ms Linda Bray of Wildbore and Gibbons, and the applicant was represented by Mr Alan Bernard of F J Cleveland & Company.

## Opponent's Evidence

This comprises a Statutory Declaration by Jeffrey Michael Rebello, dated 19 January 1997. Mr Rebello is the marketing services manager of Scandinavian Airlines, a wholly-owned subsidiary of the opponent company. Nothing turns on the relationship between the parent company and its subsidiary; hereafter I shall refer to them both simply as SAS. Mr Rebello gives details of SAS's registration of the mark SAS JACKPOT! (see above). He says the mark was first used in the United Kingdom in October 1992, and has been used continuously since that date. SAS also use the word JACKPOT alone. Both variations have been used in relation to air travel services and related services such as ticket and travel agency services.

Mr Rebello says that his company's JACKPOT service has become so well-known and successful that it has also been used to offer special hotel prices ("HOTEL JACKPOT") in conjunction with the air fares. He declares that SAS's turnover in the JACKPOT services has increased over the years, but he only provides specific figures for 1995 when the turnover is stated to be £10,000,000. In the same year, SAS spent £31,000 on advertising and promoting its JACKPOT services. Exhibited to Mr Rebello's declaration are a number of examples of advertisements from a wide range of publications such as Travel Trade Gazette, Travel Weekly, Anglo Norse Review etc.. There is also a copy of the SAS Travel Book (a comprehensive timetable for SAS flights for the period October 27, 1996 to March 29, 1997) which carries an advertisement for Hotel Jackpot, and a selection of tourism brochures encouraging people to take advantage of SAS Jackpot fares to visit Scandinavia.

That completes my review of the evidence filed in these proceedings.

At the outset of the hearing, Ms Bray indicated that her client intended to pursue this opposition under subsections (a) to (c) of section 3(1), section 3(4), section 3(6), section 5(2)(b) and section 5(4). For convenience, I will deal with them in that order.

### *Section 3(1)(a), (b) & (c)*

This part of the Act reads:

“3.-(1) The following shall not be registered

(a) signs which do not satisfy the requirements of section 1(1),

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) .....

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

Ms Bray confirmed that the substance of the opponent's case under section 3(1) is that the applicant's mark lacks distinctiveness having regard to her client's earlier registration and use of the mark SAS JACKPOT! I indicated at the hearing that, in my opinion, this was an

inappropriate use of section 3. Under the Trade Marks Act 1994, a trade mark application may be refused for two broad categories of reasons. The first of these categories, described in the Act as “Relative grounds for refusal”, is set out in section 5. These grounds are ‘relative’ because they are concerned with the relationship between the mark applied for and earlier trade marks or other earlier rights. The second category is dealt with under section 3 which is described in the Act as “Absolute grounds for refusal”. These grounds are ‘absolute’ in the sense that they are not dependent on any earlier trade mark or other pre-existing right.

With regard to a similar situation under the 1938 Act, Kerly's Law of Trade Marks and Trade Names (twelfth edition) states at footnote 2 to Chapter 10-01 (page 143):- “Strictly, a mark that offends against Section 11 or Section 12(1) cannot be distinctive; but it is convenient to treat separately the objections under these sections and under Section 9 or Section 10.”

I note that the Registrar’s hearing officer has already dealt with an analogous situation under the 1938 Act in the Nucleus case<sup>1</sup>. In his decision (as yet unreported) the hearing officer said:-

“It is particularly convenient in cases such as this, of course, because here we have identical marks which have been used but which are in different proprietorship. The terms of Section 12(2) clearly envisage the possibility of identical marks in different proprietorship nonetheless being registrable, and it is therefore important to treat the essential or inherent qualities of the mark as a separate matter from issues of proprietorship since the outcome under Sections 11 or 12 could be that both are registrable. (An adverse finding under Section 11 or Section 12, of course, would make refusal mandatory. A retrospective finding that the mark was therefore not distinctive under Section 9 might be interesting, but it could have no practical effect other than perhaps to complicate an appeal against the Section 11 or Section 12 finding).

The Trade Marks Act 1994 employs the term "absolute grounds of refusal" in relation to Section 3 (equivalent to Sections 9 and 10 of the old Act), and "relative grounds of refusal" in relation to Section 5 (equivalent to Sections 11 and 12 of the old Act), and it seems clear enough that these provisions are to be applied separately from one another.

All this confirms me in my belief that even under the old Act, issues such as seniority or proprietorship are best dealt with under Sections 11, 12(3) and 17(1), and kept out of considerations under Sections 9 and 10. Accordingly, I propose to deal with the Section 11 ground as a separate matter from that under Section 9.”

Consequently, I intend to deal with any ‘relative grounds’ issues under the corresponding provisions of section 5.

As for the absolute grounds of section 3, Ms Bray helpfully conceded that, when considered in isolation, the applicant’s mark did not lack distinctiveness. Indeed I note that Mr Rebello in his evidence on behalf of the opponent describes the word JACKPOT as being “inherently distinctive” for the services concerned. Moreover the opponent has put forward no evidence to suggest that the mark JACKPOT-FLIGHT is, prima facie, non-distinctive and therefore I formally find that the opposition under section 3(1)(a), (b) & (c) fails.

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<sup>1</sup>SRIS m O\190\96. Decision dated 30 July 1996.

*Section 3(4)*

This section reads:

“(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of community law.”

5 Ms Bray indicated that she was pursuing this ground on the basis that the opponent could prevent use of the applicant’s mark by virtue of the law of passing off. For similar reasons to those which I have set out above, I believe this ground of opposition is more appropriately dealt with under section 5(4). Ms Bray agreed. No other rule of law or provision of community law has been identified as relevant under this section and therefore I formally find  
10 that the opposition under section 3(4) also fails.

*Section 3(6)*

The opposition under this subsection rests on an allegation that the applicant does not have any bona fide present and definite intention to use the trade mark on or in relation to the services covered by the application. This is a requirement for an application to register a trade  
15 mark, and is found in Section 32(3). That is:

“(3) The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used.”

The application form used in this case contains a statement that “the trade mark is being used  
20 by the applicant or with his consent in relation to the services stated, or there is a bona fide intention that it will be so used.” This statement has been signed by the authorised agents acting on the applicant’s behalf. Any challenge that this statement was made in bad faith must be proven in evidence. Ms Bray did urge me to consider the contents of a number of letters which she passed up at the hearing, which she said provided proof that the application had  
25 been made in bad faith. Not surprisingly, Mr Bernard objected to the lateness of this material, but more significantly he reminded me that according to rule 49 of the Trade Marks Rules 1994, evidence in proceedings before the Registrar must be in the form of a statutory declaration. The material put forward by Ms Bray was not sworn, neither was it exhibited to a statutory declaration or affidavit. For this reason, I refused to admit the letters into the  
30 proceedings as evidence, and I have not considered them or their contents in reaching my decision. In the absence of evidence which proves otherwise, I must conclude that the application was made in good faith. The opposition under section 3(6) fails accordingly.

*Section 5(2)(b)*

The next issue for me to decide therefore is whether, in view of SAS’s registration of the mark  
35 SAS JACKPOT!, registration of the mark JACKPOT-FLIGHT would be contrary to section 5(2)(b) of the Act. This section of the Act reads:-

“(2) A trade mark shall not be registered if because -

- (a) .....
- 40 (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.”

It was common ground at the hearing that the services specified in the application in suit are identical with or similar to those for which the earlier trade mark is protected. Thus I need only decide whether the marks are so similar that there exists a likelihood of confusion on the part of the public.

5 So far as I am aware, the test propounded by Parker J in Pianotist Co's application [1906] RPC 23 is still good law. At page 777 line 26, he says:-

10 "You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to  
15 confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case."

(At this point I will stress that the marks I am comparing are JACKPOT-FLIGHT and SAS JACKPOT! Although the opponent has shown use of JACKPOT solus, that is not a matter for section 5(2)(b) since the registered mark is SAS JACKPOT!)

20 It is also appropriate that I have regard to the decision of the Court of Justice of the European Communities in *Sabel v Puma*<sup>2</sup>, and in particular paragraph 23 which reads:

25 "23. That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive — "... there exists a likelihood of confusion on the part of the public ..." — shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details."

30 In my opinion, the distinctive and dominant component of the applicant's mark is the single word JACKPOT. Although it is combined with the word FLIGHT, I regard this second word as entirely descriptive (and non-distinctive) for the services involved. Turning to the opponent's mark, JACKPOT is preceded by the abbreviation SAS, which almost certainly stands for Scandinavian Airlines Systems, and which, more importantly, is unlikely to be  
35 pronounced as a separate word in ordinary speech. In my view, JACKPOT is certainly a distinctive and prominent part of the opponent's mark, perhaps even the dominant component.

That is not to say that the marks are identical, but that a prominent part of the opponent's registered mark appears as the dominant component of the applicant's mark. Considering the overall impression conveyed by the two marks, I do not believe that the existence within the  
40 applicant's mark of a highly descriptive element (FLIGHT) will deflect the attention of the

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<sup>2</sup>*Sabel BV v Puma AG, Rudolf Dassler Sport* [1998] ETMR 1

public away from the dominant component (JACKPOT) sufficiently to ensure that there is no likelihood of confusion with the opponent's mark, in which the word JACKPOT also features prominently. Rather, in the words of Section 5(2), I believe that there exists a likelihood of confusion on the part of the public, if the applicant's mark proceeds to registration. That  
5 being the case, I find that the opposition under Section 5(2)(b) succeeds.

*Section 5(4)*

I turn now to the opposition under Section 5(4), which reads as follows:-

'(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

10 (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

15 A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark.'

As suggested above, Ms Bray submitted that the opponent would be able to prevent use of the applicant's mark by virtue of the law of passing off. Much of the evidence filed by the opponent in these proceedings appears to be directed towards this claim. However, at the  
20 hearing before me, Mr Bernard (for the applicant) carried out a fairly exhaustive "demolition job" on this evidence, and in my view not enough survived the attack for this ground of opposition to succeed.

To begin with, Mr Bernard attacked the status of Mr Rebello's evidence in these proceedings on the grounds that it was hearsay and should be struck out accordingly. At Paragraph 3 of  
25 his declaration, Mr Rebello states:

"The information contained in this declaration is within my own personal knowledge or derived from my Company's and related companies' records to which I have full access as well as information given to me directly by my Company's employees."

30 Mr Bernard submitted that any information which had been given to Mr Rebello by other employees was hearsay, and that because Mr Rebello does not indicate which information he received in this way, the whole declaration is thus susceptible to a charge of hearsay. Regardless of the merits of Mr Bernard's submission on this point, it seems to me that a serious objection such as this could have, and indeed should have, been raised much sooner  
35 and not sprung upon the opponent's representative at the substantive hearing. Consequently I refused to rule out Mr Rebello's evidence on the grounds that it is hearsay.

Mr Bernard also pointed out that the only evidence of use which is supported by financial data (eg turnover and advertising) relates to 1995. Even if I were to disregard the applicant's claim to priority in September 1994, it would still not be clear what proportion of the turnover and

advertising figures given for the year 1995 relate to the period before the applicant's filing date in March of that year. Furthermore, if I were to regard the material date (at which the opponent must show that he could succeed in an action for passing off) as 12 September 1994, then the opponent's case would become weaker still.

5 It is also the case that a number of the advertisements exhibited to Mr Rebello's declaration (showing use of the marks SAS JACKPOT! and JACKPOT) do not bear printed dates. In some cases the date and other information has been added in manuscript. For example, exhibit JMR1 includes an advertisement for "Jackpot fares to Scandinavia". In the margin, the words "Travel weekly June 17 1992" have been written by hand. Mr Bernard submitted that I should  
10 not regard this as evidence that the advertisement in question appeared in the June 17<sup>th</sup> 1992 edition of that publication. I have carefully weighed Mr Bernard's criticism of these exhibits, but I cannot escape the conclusion that the correct way for the applicant to have challenged this aspect of the opponent's evidence was to put in evidence of their own. It would have been a relatively straightforward task for the applicant to rebut this evidence by filing eg a  
15 copy of the June 17<sup>th</sup> 1992 edition of Travel Weekly as proof that the opponent's facts were incorrect. But they have not done so. In the circumstances it would be inappropriate for me to underrate, to any extent, the evidential value of these exhibits. They have been filed as sworn evidence in these proceedings, and the applicant has chosen (for whatever reason) not to file any evidence to disprove them.

20 In support of his proposition that the opponent had not made out a sufficient case to succeed under section 5(4), Mr Bernard took me to the Jif Lemon case<sup>3</sup>. The three limbs of the test for passing off are summarised in the head note to that decision. For convenience, I reproduce the relevant paragraph from page 342 below:

25 *"(1) The law of passing off could be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it could be expressed in terms of the three elements, each a question of fact, which a plaintiff had to prove in order to succeed. These were (a) that there was a goodwill or reputation attached to the goods or services which he supplied in the mind of the purchasing public by association with their identifying get-up, (b) that there was a  
30 misrepresentation to the public likely to lead the public to believe the goods or services offered by him were the goods or services of the plaintiff, and (c) that he was suffering or was likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation. It was irrelevant whether or not the public was aware of the plaintiff's identity as the manufacturer or supplier of the goods in  
35 question, as long as they were identified with a particular source (p.406)."*

Put simply, Mr Bernard maintained that to succeed in passing off, it was necessary to prove that there was a goodwill or reputation attached to the services in the mind of the purchasing public. It was not sufficient merely to show that the mark had been used. On the other hand, Ms Bray contended that it would be unreasonable to expect parties to opposition proceedings  
40 before the Registrar to prepare evidence to the same rigorous and exhaustive standard demanded by the Courts.

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<sup>3</sup>Reckitt & Colman Products Ltd v Borden Inc and others [1990] RPC 341



In the Wild Child case<sup>4</sup>, Mr Geoffrey Hobbs QC (acting as the appointed person for the purpose of appeals under section 76) accepted that:

“... the Registrar is often required to act upon evidence that might be regarded as less than perfect when judged by the standards applied in High Court proceedings.”

5 Nevertheless, he went on to say:

“However, I am not willing to regard assertions without any real substantiation as sufficient to sustain an objection to registration under Section 5(4). On my assessment of the evidence the asserted “*earlier right*” remains unsubstantiated and the question of conflict does not arise.”

10 Taking the best view I can of the evidence before, it does not strike me as being anyway near sufficient to succeed in an action for passing off. Though the standard of evidence necessary to succeed under section 5(4) in opposition proceedings under the 1994 Act may well be lower than that demanded by the Court to establish passing off, I do not accept that evidence of use alone can suffice.

I therefore find that the opposition fails under Section 5(4).

15 The opponent, having been successful in these proceedings, is entitled to a contribution towards the costs of mounting the opposition. I therefore order the applicant to pay to the opponent the sum of **£750**.

**Dated this 11th day of March 1998**

20 **S J Probert**  
**Principal Hearing Officer**  
**For the Registrar, the Comptroller-General**

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<sup>4</sup>In the Matter of Opposition m 43414 in the name of Pinwise Ltd to Application m 2013102 to Register a Trade Mark in Class 25 in the name of Rajan Imports Ltd. (As yet unreported.)