

**O-475-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3114374  
BY STEVEN VARSANO TO REGISTER THE TRADE MARK**

**UBERJET**

**IN CLASSES 35, 39 AND 42**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO 405352  
BY UBER TECHNOLOGIES, INC.**

## Background and pleadings

1) Steven Varsano (“the applicant”) applied to register the trade mark UBERJET in the UK on 22 June 2015. It was accepted and published in the Trade Marks Journal on 31 July 2015 in respect of the following services:

**Class 35:** *Collating and aggregating data relating to private jet travel availability; analysing data relating to private jet travel journeys; providing business and commercial information in the field of business travel management and the business travel industry.*

**Class 39:** *Providing travel information online; providing travel advice; proposing travel itineraries using private jets; travel information services.*

**Class 42:** *Operating search engines which enable users to check the availability of private jets; providing a web site featuring technology that enables internet users to book travel.*

2) Uber Technologies, Inc (“the opponent”) oppose the trade mark on the basis of section 5(2)(b), section 5(3) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). This is on the basis of earlier European Union (formerly Community) Trade Marks and unregistered rights attached to identical signs to these earlier marks. The relevant details of these earlier marks are:

Mark and relevant details	List of services
EUTM 10460442  UBER  Filing date: 1 December 2011	<b>Class 9:</b> <i>Computer software for coordinating transportation services, namely, software for the automated scheduling and dispatch of motorized vehicles; Computer software; Computer peripherals; Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording</i>

<p>Date of entry in register: 24 April 2012</p>	<p><i>discs; Automatic vending machines and mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment and computers; Fire-extinguishing apparatus.</i></p> <p><b>Class 38:</b> <i>Telecommunications services, namely, routing calls, SMS messages, and push-notifications to local third-party motorized vehicle operators in the vicinity of the caller using mobile phones; Telecommunications.</i></p> <p><b>Class 39:</b> <i>Providing a website featuring information regarding transportation services and bookings for transportation services; Transport; Packaging and storage of goods; Travel arrangement.</i></p> <p><b>Class 42:</b> <i>Providing temporary use of online non-downloadable software for providing transportation services, bookings for transportation services and for dispatching motorized vehicles to customers; Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software.</i></p>
<p>EUTM 13004809</p> <p>UBERX</p> <p>Filing date: 17 June 2014</p> <p>Date of entry in register: 16 October 2014</p>	<p><b>Class 9:</b> <i>Computer software for coordinating transportation services, namely, software for the automated scheduling and dispatch of motorized vehicles; Computer software; Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Compact discs, DVDs and other digital recording media; Mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment, computers; Fire-extinguishing apparatus.</i></p> <p><b>Class 38:</b> <i>Telecommunications services, namely, routing calls, SMS messages, and push notifications to local third-party motorized vehicle operators in the vicinity of the caller using mobile phones; Telecommunications.</i></p> <p><b>Class 39:</b> <i>Providing a website featuring information regarding transportation services and bookings for transportation services; Transport; Packaging and storage of goods; Travel arrangement.</i></p>

	<p><b>Class 42:</b> <i>Providing temporary use of online non-downloadable software for providing transportation services, bookings for transportation services and for dispatching motorized vehicles to customers; Design and development of computer software; Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware.</i></p>
<p>EUTM 13009171</p> <p>UBERPOP</p> <p>Filing date: 18 June 2014</p> <p>Date of entry in register: 22 January 2015</p>	<p><b>Class 9:</b> <i>Computer software for coordinating transportation and delivery services; Computer software for providing information on transportation and delivery services; Computer software for the scheduling and dispatch of motorized vehicles, couriers, and messengers; Computer software for planning, scheduling, controlling, monitoring, and providing information on transportation of passengers, assets, and goods; Computer software for providing information concerning pick-up and delivery of passengers, assets, and goods in transit; Computer software that enables customers to communicate with motorized vehicle operators, couriers, and messengers; Computer software that enables customers to manage and track pickup and delivery of passengers, assets, and goods; Transportation software; Computer software for coordinating and matching drivers and passengers for potential ridesharing; Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Compact discs, DVDs and other digital recording media; Mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment, computers; Fire-extinguishing apparatus.</i></p> <p><b>Class 38:</b> <i>Telecommunications services, namely, routing calls, text messages, and push-notifications to local third-party motorized vehicle operators, couriers, and messengers in the vicinity of the caller using mobile phones; Telecommunications services, namely, routing calls, text messages, and push-notifications to customers; Telecommunications; Online document delivery via a global computer network.</i></p>

**Class 39:** *Information regarding transportation and delivery services and bookings for transportation and delivery services provided through a website; Transport; Pick-up, transportation, delivery, and storage of goods, packages, parcels, and messages; Travel arrangement; Courier services; Messenger services for messages; messenger courier services; document delivery by non-electronic means; document delivery (hand carried); Express delivery of goods, packages, and messages; Providing information concerning pick-up and delivery of passengers, assets, and goods in transit; Transportation and delivery services; Transportation reservation services; Transportation consulting services; Transportation of passengers, assets, and goods; Packaging and storage of goods.*

**Class 42:** *Providing temporary use of online non-downloadable software for providing transportation and delivery services, bookings for transportation and delivery services and for dispatching motorized vehicles, couriers, and messengers to customers; Providing temporary use of online non-downloadable software for planning, scheduling, controlling, monitoring, and providing information on transportation of passengers, assets, and goods; Providing temporary use of online non-downloadable software for providing information concerning pick-up and delivery of passengers, assets, and goods in transit; Providing a web site featuring software that enables customers to communicate with motorized vehicle operators, couriers, and messengers; Providing a web site featuring software that enables customers to manage and track pickup and delivery of passengers, assets, and goods; Design and development of computer software; Providing temporary use of online non-downloadable software for coordinating and matching drivers and passengers for potential ridesharing; Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software.*

**Class 45:** *Online social networking services; Providing social services, namely providing community outreach programs; Providing a website on the internet for the purpose of social networking; Providing online computer databases and online searchable databases in the field of social networking; Social introduction and networking services; Identification verification services; Providing*

	<p><i>online social networking services for purposes of commentary, comparison, collaboration, consultation, evaluation, advice, discussion, research, notification, reporting, identification, information sharing, indexing, information location, entertainment, pleasure, or general interest; Legal services; Security services for the protection of property and individuals.</i></p>
<p>EUTM 13759394</p> <p>UBEREATS</p> <p>Filing date: 20 February 2015</p> <p>Date of entry in register: 23 June 2015</p>	<p><b>Class 9:</b> <i>Computer software; computer software for engaging and coordinating transportation services; computer software for engaging and coordinating delivery services.</i></p> <p><b>Class 35:</b> <i>Advertising and promotional services; business management; business administration; business administration in the field of transport and delivery; business management services in the field of transport and delivery; ordering services; food and grocery ordering services; product ordering and delivery services; computerized ordering service; on-line ordering service; office functions; on-line retail store services; on-line grocery store services; comparison shopping services; monitoring, managing and tracking of package shipments; monitoring and tracking of package shipments to ensure on-time delivery for business purposes; business management consulting services in the field of transportation and delivery; providing information and tracking information to third parties regarding pickup and delivery status via Internet access and telephone; follow-up services, namely, providing electronic tracking of packages and documents to others; providing a web-based system and online portals in the field of consumer-to-business commerce for consumers to enter, manage and modify their consumer preference information for use by merchants to create and manage offers for delivery to consumers.</i></p> <p><b>Class 38:</b> <i>Telecommunications services, namely, routing calls, SMS messages, and push-notifications to local third-party motorized vehicle operators and food and grocery delivery agents in the vicinity of the caller using mobile phones; telecommunication services, namely, routing calls, SMS messages and push-notifications to retail and delivery services; telecommunications.</i></p> <p><b>Class 39:</b> <i>Providing a website featuring information regarding delivery services and bookings for delivery services; transport; packaging and storage of goods; travel arrangement; document delivery; food</i></p>

	<p><i>delivery; parcel delivery; transport and delivery of goods; message delivery; express delivery of goods by vehicles; pick up, delivery and storage of personal property; providing information concerning collection and delivery of assets in transit; delivery services; temporary storage of deliveries; transportation and delivery services by road.</i></p> <p><b>Class 42:</b> <i>Providing temporary use of online non-downloadable software for providing transportation and delivery services, bookings for transportation and delivery services and for dispatching motorized vehicles to customers; design and development of computer software.</i></p>
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3) The opponent argues that the respective goods and services are identical or highly similar and that the marks are clearly similar.

4) Further, or in the alternative, the opponent argues that because of its use of its marks over “many years”, they have acquired a reputation in the UK. It claims that UBER marks are synonymous with the opponent. As a result, it claims that the application should be refused under section 5(3) of the Act because its use would, without due cause, take unfair advantage or, or be detrimental to, the distinctive character or the repute of its marks. This, it claims, would be especially so if the services provided by the applicant are of inferior quality.

5) Further, or in the alternative, the opponent claims that its use of the signs the same as those of its registrations confer upon it the right to prohibit registration of the opposed mark by virtue of the law of passing off. As a result, it claims that the application should be refused under section 5(4)(a) of the Act.

6) The applicant filed a counterstatement denying the claims made.

7) Only the opponent filed evidence in these proceedings and both sides filed written submissions. I will summarise the opponent’s evidence to the extent that I consider it appropriate/necessary. A hearing took place on 16 August 2016, with the opponent represented by Mr Simon Malynicz QC of Counsel, instructed by Lane IP Limited

and the applicant by Mr Chris Aikens of Counsel, instructed by Penningtons Manches LLP.

### **Opponent's Evidence**

8) This takes the form of two witness statements. The first of these is by Steven Lane, Director of Lane IP Limited, the opponent's representative in these proceedings. His Exhibit SL1 consists of printouts of dictionary definitions illustrating that UBER originates from the German language and is an adjective meaning "super", and an adverb meaning "very, really, extremely".

9) The second witness statement is by Jay Choi, Senior Counsel, IP with the opponent. He provides a history of the opponent. He states the opponent company was founded in 2009 (in the USA) and developed a mobile application that allows users to connect with, and request on demand, location-based transportation services ("the app"). The opponent expanded internationally and, in 2012, it began providing the app in the UK.

10) Mr Choi states that the UBER name was first used in the UK in London in June 2012 and, at Exhibit JC1, he provides an article that appeared on the opponent's website, dated 15 June 2012, documenting the first UBER user in London.

11) Mr Choi states that the opponent's services were also available through the app in Birmingham, Bristol, Leeds, Manchester, Newcastle and Sheffield "well before 22 June 2015" [being the filing date of the contested mark and the relevant date in these proceedings]. He further states that, since that date, the opponent has further expanded to Edinburgh, Glasgow, Merseyside, Nottingham, Portsmouth "and other locations". To support this statement, Mr Choi provides, at Exhibit JC2, a range of exhibits, including articles that appeared in/on:

- Business Insider magazine announcing the UBER app launch in Birmingham on 12 February 2015;



- [www.bristolpost.co.uk](http://www.bristolpost.co.uk) recording that the UBER app launch in the city with 30,000 customers downloading it. No date is visible;
- the Manchester Evening News announcing UBER's launch in the city. It is dated 8 May 2014;
- [www.chroniclive.co.uk](http://www.chroniclive.co.uk) announcing the launch in Newcastle, dated 17 April 2015;
- [www.thestar.co.uk](http://www.thestar.co.uk) announcing the launch in Sheffield, dated 5 June 2015;
- The Scotsman announcing the launch in Edinburgh, dated 6 November 2015

12) The same exhibit also includes extracts from the opponent's *Twitter* feed announcing that its UBER app has launched in Leeds (from at least May 2015), Glasgow (29 January 2016), Merseyside (7 August 2015), Nottingham (6 November 2015) and Portsmouth (27 November 2015).

13) Exhibit JC8 includes (at page 123) an article that appeared on the *Telegraph* newspaper's website. It is dated 15 November 2014 and is reporting the opponent's launch of its lower cost service "UberX" in Leeds. The article refers to both UBER and UberX and also states that "Uber is now available in three UK cities – Leeds, London and Manchester ..."

14) Mr Choi states that in 2015 there were:

- more than 30,000 UBER drivers in the UK;
- 1.5 million customers in London;
- 3 million UBER trips in London per month.

15) Mr Choi states that the opponent's UK-specific *Twitter* page has 32,000 followers.

16) Mr Choi states that UBER has been used as part of a number of sub-brands but, of the ones referred to, only UberX is one of the earlier marks/rights relied upon. Consequently, I do not detail the others. Exhibit JC8 includes an article, dated 11

July 2013, on the website [www.thenextweb.com](http://www.thenextweb.com), detailing the opponent's launch of its UberX lower cost service in London.

17) Mr Choi states that the opponent has used its UBER mark in conjunction with a suffix corresponding to the particular mode of transport. One of these is UBERJET, used in respect of a service to fly customers to the Cannes Film Festival. I glean from the articles provided in Exhibit JC9 that the service was provided from Le Bourget Airport in France in May 2014.

18) Mr Choi relies on the fact that the opponent's "UberX" service is offered for airport pick-ups (Exhibit JC10 provides confirmatory articles that this is available in a number of locations in the USA) and he claims it is, therefore, linked to the idea of "jets". In addition, Mr Choi provides evidence (at Exhibit JC10) of the opponent using its UBER mark with a suffix, namely UBERBOAT (in Boston, USA) and UBERCOPTER (Cannes, France).

19) Mr Choi states that UBERPOP was launched in Paris in the "first half" of 2014 and is used in respect of drivers without professional taxi or chauffeur licenses. He also explains that UBEREATS relates to a service of delivering food from spots local to the customer. Exhibit JC13 provides articles about these services but none can be identified as originating in, or relating to use in, the UK.

20) At Exhibit JC14, Mr Choi provides examples of press coverage including an article that appeared on the website of the *Telegraph* on 20 January 2016 and a capture of a *YouTube* clip of a debate held, in London, between the opponent and one of its competitors that has attracted 18,000 views. The former reports that "Uber is used by more than 1 million people in London and has more than 20,000 drivers in the capital since launching in 2012".

21) Mr Choi also provides information at Exhibit JC15 to support that claim that the opponent has participated in numerous exhibitions and events in the UK.

22) Mr Choi provides the following annual account information for Uber London Limited that, he states, is an "indirectly wholly-owned subsidiary of the [opponent]":

	<b>2013</b>	<b>2014</b>
<b>Turnover (£)</b>	1,078,732	11,343,683
<b>Gross Profit (£)</b>	708,910	11,343,683
<b>Profit/Loss (£)</b>	(343,141)	866,302

## **DECISION**

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

23) The opponent relies upon four earlier marks, but I will begin my analysis by considering the opponent's case based upon its earlier EUTM 10460442 UBER.

24) 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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

### **Comparison of goods and services**

25) In the judgment of the Court of Justice of the European Union in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

26) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

***The applicant's Class 35 services***

27) The applicant's services are:

*Collating and aggregating data relating to private jet travel availability; analysing data relating to private jet travel journeys; providing business and commercial information in the field of business travel management and the business travel industry.*

28) In the opponent's written submissions it is claimed that these services are similar to numerous of the opponent's goods and services. I will begin by considering

similarity with the opponent's *Providing temporary use of online non-downloadable software for providing transportation services, bookings for transportation services and for dispatching motorized vehicles to customers* in Class 42. These software and booking services are not limited solely to motorized vehicles and the reference to "transportation" includes transportation by private jet. In order to operate, the opponent's software will require access to data of the kind referred to in the applicant's term. As a consequence there is complementarity in the sense described in *Boston Scientific*, namely that one is indispensable or important for the use of the other in such a way that customers may think that responsibility for the respective goods/services lies with the same person.

29) The applicant's services, by virtue of being in Class 35, are a business service, however the opponent's services, whilst being in Class 42, are the type of services that may have private individuals or businesses as customers and, as I have already noted, includes such services relating to private jet hire. Therefore, there is overlap in trade channels. Further, complementarity exists because a booking service for private jets requires data relating to jet availability. The consumer may believe that the same undertaking is responsible for both. Whilst there are differences in nature and methods of use, these similarities are sufficient for me to conclude that the respective services share a medium to medium high level of similarity.

30) In light of this finding, I will not consider the similarity of these services to other of the opponent's goods and services.

31) The applicant's remaining Class 35 services are *providing business and commercial information in the field of business travel management and the business travel industry*. The opponent claims that these are similar to its *Providing a website featuring information regarding transportation services and bookings for transportation services; Transport; Packaging and storage of goods; Travel arrangement* in Class 39.

32) Once again, the applicant's services relate to providing business and commercial information where its customers will be other businesses. The opponent's services include the provision of a website providing transportation services information and

also the provision of travel arrangements. Such services, whilst not being limited to being provided to businesses would certainly be used by them. Consequently, the respective services may share trade channels and provide their services to businesses in the field of transportation. They are different in nature, intended purpose and method of use. The applicant's services are business information for business management and the business travel industry, whereas, the opponent's services are the provision of travel arrangements and information relating to transportation services. Taking all of this into account, I conclude that the respective services share a low to medium level of similarity.

### ***The applicant's Class 39 and Class 42 services***

33) The applicant's services are:

**Class 39:** *Providing travel information online; providing travel advice; proposing travel itineraries using private jets; travel information services.*

**Class 42:** *Operating search engines which enable users to check the availability of private jets; providing a web site featuring technology that enables internet users to book travel.*

34) At the hearing Mr Aikens conceded that these services are identical to at least some of the services listed in the corresponding classes of the earlier EUTM. I find that this is the case when considering earlier EUTM 10460442 UBER. Here, the respective services are at least each highly similar, if not identical.

### **Comparison of marks**

35) 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 Court of Justice of the European Union 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.”

36) It would be wrong, therefore, to artificially 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.

37) The respective marks are shown below:

<b>Earlier mark</b>	<b>Contested trade mark</b>
UBER	UBERJET

38) The earlier mark consists of the single word UBER and it follows that this is the dominant and distinctive element. The contested mark consists of the word UBER and the word JET conjoined. The mark will be perceived as these two words conjoined and, consequently, each word will retain its identity within the mark. The combination of the two words creates an allusive totality with both words sharing equal dominance in creating this allusive whole.

39) From a visual and aural perspective, both marks are similar in that they both use the word UBER. The contested mark also contains the word JET. Being three letters and one syllable compared to the four letters and two syllables of the word UBER, and being placed at the end of the mark, the word JET has a slightly less visual and aural prominence within the mark. Taking all of this into account, I conclude that the

level of visual and aural similarity is higher than moderate (as submitted by Mr Aikens). I would put it as moderately high.

40) In respect of conceptual similarity, the word UBER, present in both marks is a German word. Mr Malynicz submitted that the UK consumer would also understand it as a German adjective meaning “super” or an adverb meaning “very, really, extremely”. I agree that a proportion will. I consider that the average consumer is likely to recognise the word as being a German word and that whilst not all of them will know its meaning, a significant number of them will and they will perceive it as an intensifier. Having concluded this, there is some similarity between the marks because of the shared concept created by the word UBER in both marks either as a German word (where the meaning is not known by the consumer) or a German word meaning “super” or similar. The contested mark also contains the word JET that is a point of difference. Mr Aikens submitted that there is a conceptual difference created by the fact that UBER is an adjective and is “left hanging” in the earlier mark, but qualifies the word JET in the contested mark. I do not consider that the UK consumer’s knowledge of the German language will extend to identifying that the word UBER in the earlier mark is “left hanging”. Taking all of this into account, I conclude that the respective marks share a medium to medium high level of conceptual similarity.

#### **Average consumer and the purchasing act**

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, Case C-342/97*.

42) 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.”

43) The contested mark’s specifications include both general terms and terms relating specifically to jet travel. The purchasing process in respect of the latter is likely to be more highly considered than less costly forms of travel but still will not have the highest levels of care and attention. The opponent’s goods and services can be characterised as essentially consisting of transportation related goods and services. Consequently, there is a significant overlap in the respective average consumers. The purchasing act is most likely to be visual in nature given they are likely to be internet based but I don’t ignore that aural considerations may also play a part.

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

44) 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).”

45) I also keep in mind the guidance of Mr Iain Purvis Q.C. sitting as the Appointed Person in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, paragraph 38 where he observed that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element of the marks that are identical or similar. The earlier mark consists only of the word UBER and this is an element in which the mark’s distinctive character resides and it is identical to the first element of the contested mark.

46) As Mr Malynicz submitted, regardless of whether the word UBER is recognised or not (and I have found that it is likely that it will be), it is distinctive. Mr Aitkens disagreed claiming that the word will be understood as English slang in use as a superlative adverb (as shown in Exhibit SL1) and that this is different to usage of the word in the German language, where it is not used alone. I do not exclude that UBER may have acquired some sort of slang use in the UK, but this does not preclude it from retaining some distinctive character when used in trade to identify goods and services. Whilst it may not be highly distinctive, I find that it is endowed with a medium level of inherent distinctive character.

47) Mr Malynicz also submitted that “there can be no serious doubt” that the mark has an enhanced distinctive character through use, stating that the evidence demonstrates that UBER has a “very significant reputation as a high profile ‘disruptor’ of the private vehicle hire market in the UK”. I accept that UBER has received a high level of press coverage concerning its activities in this field, but this is off-set to a degree by the fact that the evidence demonstrates that its first

presence in the UK was in June 2012, just three years before the relevant date in these proceedings. That said, I accept that the earlier mark is endowed with an enhanced distinctive character in respect of private vehicle hire.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

48) The following principles are gleaned from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

49) Mr Malynicz submitted that because the marks and goods/services are highly similar and because the opponent's earlier mark is endowed with an enhanced level of distinctive character there is a likelihood of both direct and indirect confusion. I have not wholly shared Mr Malynicz's view regarding the some of the elements of the global assessment, however, I agree with his submission that I must take account of the effect of normal and fair use of the earlier mark in relation to all of the goods/services for which it is entitled to protection (a principle expressed by Kitchen L.J. in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, paragraph 78) and that it is necessary to consider all the circumstances in which the mark applied for

might be used if it were registered and not just in respect of the way it may currently be used (see the comments of the CJEU in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66).

50) What I have found is that the respective marks share a moderately high level of visual and aural similarity and a medium to medium high level of conceptual similarity. I have also found that in respect of the applicant's Class 35 services its *Collating and aggregating data relating to private jet travel availability* and *analysing data relating to private jet travel journeys* share a medium to medium high level of similarity to certain of the opponent's Class 42 services. In respect of the applicant's remaining Class 35 services, namely, *providing business and commercial information in the field of business travel management and the business travel industry*, I have found that they share a low level of similarity to certain of the opponent's Class 39 services.

51) In respect of the applicant's Class 39 and Class 42 services, Mr Aikins sensibly conceded that these are identical or similar to the opponent's services in the same classes which I have found to be at least highly similar.

52) I have also identified that the purchasing process is likely to be predominantly visual, but that I do not ignore aural considerations. I have found that the level of care and attention given to the purchasing process will vary and, insofar as it relates to jet travel, the additional costs involved will result in a higher degree of care and attention being applied to the purchasing act.

53) In respect of the level of distinctive character of the earlier mark, I have found it has a medium level of inherent distinctive character and that, in respect of private vehicle hire, it has acquired an enhanced level of distinctive character.

54) I do not rule out the chances of direct confusion, especially in a situation where the respective marks were being used in respect of goods or services relating to the same kind of travel, e.g. jet travel. In such circumstances, the word "jet" would have a descriptive role and would be less likely to be remembered by the consumer. However, I find that there is a likelihood of indirect confusion where the consumer

will be aware of the differences between the marks but will nonetheless be likely to believe that the goods or services provided under the respective marks originate from the same or linked undertaking in respect of all of the applicant's services. This finding is more arguable in respect of the services where I found a low to medium level of similarity, but on balance, I find that a likelihood of confusion will still exist.

55) In respect of these less similar services, I note that insofar as the opponent relies upon its earlier EUTM 13759394, UBEREATS, it includes Class 35 services. None of these appear to be identical to the applicant's *providing business and commercial information in the field of business travel management and the business travel industry*, but this earlier EUTM does contain *business management consulting services in the field of transportation and providing information ... regarding pickup and delivery status ...*. Mr Malynicz submitted that consulting services includes the provision of information. This might be so of any service that involves imparting knowledge or advice, but the providing of business information is a discrete service separate to business consultation, and consequently, I do not agree that the respective services are identical. However, there is a good deal of similarity and the consumer may consider that both services would be provided by the same undertaking. There is overlap of trade channels. There is also overlap in nature and intended purpose in the way Mr Malynicz contended.

56) This higher level of similarity of services compared to when the opponent relies upon its earlier EUTM 10460442 points towards a greater likelihood of confusion, however, this is offset by a lesser degree of similarity between the respective marks, namely UBEREATS and UBERJET. This lesser degree of similarity may have been offset to a degree if the opponent could succeed in showing that its earlier marks are part of a family of marks. Mr Aikins submitted the requirements set out by the CJEU in *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06 have not been met because only two of the opponent's marks have been used in the UK and because two marks to constitute a family of marks. The two marks used are UBER and UberX. Mr Malynicz submitted that there is no minimum number of marks for constituting a family and that use of other UBER marks in the EU must also be taking into consideration. On the latter point, it is the perception of the UK consumer that is at issue, and there is no evidence that the UK average consumer will be aware of UBER marks used

outside the UK. In the UK, the opponent is using two marks in respect of private vehicle hire. I have found that its UBER mark is used in a number of UK cities, but I cannot reach the same conclusion regarding its UberX mark. Use in the UK in respect of this mark is only shown in one city (Leeds) and then only 7 months before the relevant date. Consequently, I reject the opponent's claim to a family of marks. Having done so, I conclude that its case insofar as it relies upon UBEREATS is not strengthened by the fact that the applicant's mark will be seen as one of a family of marks.

57) Taking all of this into account, I conclude that whilst reliance upon earlier EUTM 10460442 UBEREATS provides the opponent with more similar services than when it relies upon EUTM 10460442 UBER, this is offset by the lesser similarity between the marks. This lesser similarity is not negated by a claim to a family of marks. Consequently, reliance upon its UBEREATS mark places it in no stronger position in respect of the applicant's *providing business and commercial information in the field of business travel management and the business travel industry* in Class 35.

58) Reliance upon its remaining two earlier marks does not improve on the opponent's success as based upon its UBER mark.

59) In summary, I find that the opponent has been wholly successful in its opposition based upon section 5(2)(b) insofar as it relies upon its earlier EUTM 10460442 UBER and its case is not improved by reliance upon its other earlier marks.

### **Section 5(3) and Section 5(4)(a)**

60) In light of the opponent being wholly successful based upon its section 5(2)(b) grounds, it is not necessary for me to also consider its grounds based upon section 5(3) or section 5(4)(a).

## **COSTS**

61) The opponent has been successful and is entitled to a contribution towards its costs. I take account of the fact that a hearing has taken place, that written submissions were provided by both sides and that the opponent filed evidence. I award costs on the following basis:

Preparing Notice of Opposition and considering other side's statements	£500
Preparing and filing evidence	£700
Preparing for and attending hearing	£700
<b>TOTAL</b>	<b>£1900</b>

62) I therefore order Steven Varsano to pay Uber Technologies, Inc. the sum of £1900. The above sum should be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 6th day of October 2016**

**Mark Bryant**  
**For the Registrar,**