

**O-413-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3271967**

**BY HAMID SHEIKH**

**TO REGISTER THE FOLLOWING TRADE MARK:**



**IN CLASS 39**

**AND**

**OPPOSITION THERETO UNDER NO. 412242**

**BY JUST AIRPORTS CHAUFFEUR SERVICES LIMITED**

## BACKGROUND AND PLEADINGS

1. On 21 November 2017, Hamid Sheikh (“the applicant”) filed trade mark application number UK00003271967 for the mark detailed on the cover page of this decision. The application was accepted and published for opposition purposes on 19 January 2018, in respect of the following services:

Class 39      Transportation of passengers and/or goods by car, bus, bike or plane.

2. Just Airports Chauffeur Services Limited (“the opponent”) opposes the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon United Kingdom trade mark (“UKTM”) no. 2248049, the pertinent details of which are as follows:

**Filing date:**            9 October 2000

**Registration date:** 16 March 2001

**Services:**              Class 39 Transportation of passengers and/or goods by car, bus, bike or plane.

**Representation:**



3. For the purposes of these proceedings, the opponent relies upon all the services for which its mark is registered. The mark qualifies as an earlier mark in accordance with section 6 of the Act. Given its registration date, it is subject to the proof of use provisions contained in section 6A of the Act. To this extent, the opponent made a statement of use corresponding to the services on which it relies.

4. The opponent's case under section 5(2)(b) is that the applied for mark is visually, aurally and conceptually similar to its earlier mark and that the respective services are identical, resulting in a likelihood of confusion.

5. The applicant filed a counterstatement in which it denies a likelihood of confusion based on the marks at issue not being similar. The applicant requested the opponent provide proof of use of its UKTM no. 2248049 for the services upon which it relies. The applicant attached a letter to its counterstatement containing further submissions relating to these proceedings, which I will deal with in due course.

6. Both parties filed evidence. Neither party requested a hearing. The opponent filed written submissions in lieu of a hearing. The opponent is represented by National Business Register LLP. The applicant represents itself.

## **PRELIMINARY ISSUES**

7. As mentioned in paragraph 5 of this decision, the applicant relies on a number of factors which it says will avoid any likelihood of confusion. Before going any further into the merits of this opposition it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

- i. The Intellectual Property Office ("IPO") initially accepted the application and is now "refusing" it.

Firstly, it is important to note that the IPO has not yet "refused" the application. The IPO does not refuse applications based on earlier similar marks. The IPO is, however, obliged to publish the application in order for third parties to contest the application by claiming, as is the case here, that it is likely to cause confusion in the marketplace and therefore should be refused. In this instance, the opponent has filed an opposition which the IPO must consider. I am required to make a decision, based on the law, the case law and all the evidence before me, as to the likelihood of confusion between the marks at issue and, subsequently, the success or failure of the opposition.

- ii. Many companies within the same industry use the phrase 'airport services'.  
If I were to be satisfied that the words 'airport services' were in regular use within the same industry as the parties in these proceedings, I would need to be provided with evidence to support the same, and I have not been.
  
- iii. The applicant already holds an operator's licence under the name JUST AIRPORTS LONDON.  
The applicant has provided copies of such licence as part of its evidence. I will deal with this in due course.
  
- iv. The applicant has "the right to apply" for the trade mark as no application for the same trade mark has been made previously.  
The applicant is correct in that it has the right to apply for a trade mark, as it has done. However, a person who believes they have an earlier right which prevents the use of the applied-for trade mark, is entitled, during the opposition period, to oppose such trade mark application, as the opponent has done. It is then the IPO's responsibility to make a decision as to the outcome of that opposition.
  
- v. The applicant's company and the opponent's company operate from different locations and have different telephone numbers.  
The opponent's earlier trade mark is a UK trade mark and is therefore entitled to protection across the whole of the UK. As such, whether or not the parties' companies operate from different locations is not relevant to the decision I am required to make. Similarly, having a different telephone number is not a factor that can avoid a likelihood of confusion.

## **EVIDENCE**

### **The opponent's evidence**

8. The opponent's evidence consists of a witness statement and eight exhibits from Nirbhai Singh Mangat, the opponent's Managing Director.

9. Mr Mangat's witness statement is dated 14 September 2018 and simply explains what is contained within each exhibit.

10. Exhibit NSM1 contains copies of the opponent's operator licences issued to Just Airports Chauffeur Services Ltd by Transport for London. One licence expires on 13 August 2016, one is dated 14 August 2016 to 13 August 2017 and the third is dated 14 August 2017 to 13 August 2021. The trading names listed on the licences are "Just Airport Chauffeur Services", "Just Airport Chauffeurs" and "Just Airports".

11. Exhibit NSM2 contains four invoices dated between 1 December 2014 and 28 February 2017 issued to JUST AIRPORTS by ROCS Computer Services in relation to – what the opponent describes as – computer software used for their radios, mobile phones, PDAs, SATNAV, vehicle tracking and WEB booking systems. The costs associated with these services have been redacted from the invoices by the opponent.

12. Exhibit NSM3 contains 10 invoices dated between 1 March 2013 and 28 February 2017, described by Mr Mangat as sales invoices relating to the opponent's taxi and chauffeur services. The invoices show numerous trips to and from London airports including Gatwick, Stansted, Heathrow, City and Luton. As with the invoices at exhibit NSM2, the associated costs have been redacted from the invoices, as have the names and addresses of the customers. The marks used on each invoice are as follows:

(i)



(ii)



The wording contained within mark (ii) reads: “JUST AIRPORT Chauffeurs 020 8900 1333 www.justairportchauffeurs.com”.

13. Exhibit NSM4 contains a printout from the website who.is.com showing that the domain name justairports.com was registered on 29 January 2000. The page was printed from the website on 21 September 2018.

14. Exhibit NSM4a contains printouts from Google showing the results of a search for “just airports”. The first listing in the results is justairports.com.

15. Exhibit NSM4b contains a printout from justairports.com, printed on 21 September 2018. The website describes the services as “providing premium airport chauffeur services in the London area...” Listed on the website are the vehicles that are available to book and how many passengers and suitcases those vehicles can carry. The vehicles listed are a saloon, an estate, an MPV, an executive, an MPV 7 and an MPV 8. The website displays the following mark:



16. Exhibit NSM4c contains two invoices dated 3 November 2017 and 14 December 2017, respectively. These are described in Mr Mangat’s witness statement as invoices from Mithilesh Gupta in respect of the opponent’s pay per click (“PPC”) and search

engine optimisation. Nowhere on the invoices is the opponent's earlier mark visible. The majority of information on both invoices has been redacted.

17. Exhibit NSM5 contains an order form from Yell dated 7 March 2017, described by Mr Mangat as relating to the opponent's monthly PPC contract. The order form states the customer name as Just Airports Chauffeur Services Ltd.

### **The applicant's evidence**

18. The applicant's evidence consists of a witness statement dated 17 December 2018, an attached letter containing submissions, and four pieces of evidence (not in exhibit format). What is contained within the evidence is as follows:

- i. A copy of the applicant's operator licence issued to Hamid Sheikh by Transport for London. The licence has a start date of 11 January 2018 and an expiry date of 10 January 2023. The trading names listed on the licence are "Asher Cars", "www.airportcars.london", "www.churchillcars.london" and "www.justairports.london".
- ii. A letter addressed to the applicant from the Head of Planning at Ealing Council, which grants the applicant use of one room at the specified address for "administration purposes for the operation of a licensed chauffer business".
- iii. A letter addressed to the applicant from Chief Planning Officer at Ealing Council, which grants the applicant use of a room at the specified address as a "mini-cab booking office".
- iv. Two pages of printouts from Google Ads, which, according to the applicant, "clearly indicate a huge difference" between the two names, Just Airports London and Just Airports Chauffeur Service. Below is what has been provided:

# Google Ads All campaigns

All campaigns

Enabled and Paused

Just Airports

Removed campaigns are hidden

- Overview
- Recommendations
- Campaigns
- Ad Groups
- Ads & extensions
- Landing pages
- Keywords
- Audiences
- Demographics
- Settings
- Locations
- Ad schedule
- Devices
- Advanced bid adj.
- Change history

CAMPAIGNS

AUCTION INSIGHTS

Campaign status: All but removed Add filter

Campaign

Just Airports


Total: All but removed campaigns

Total: Account

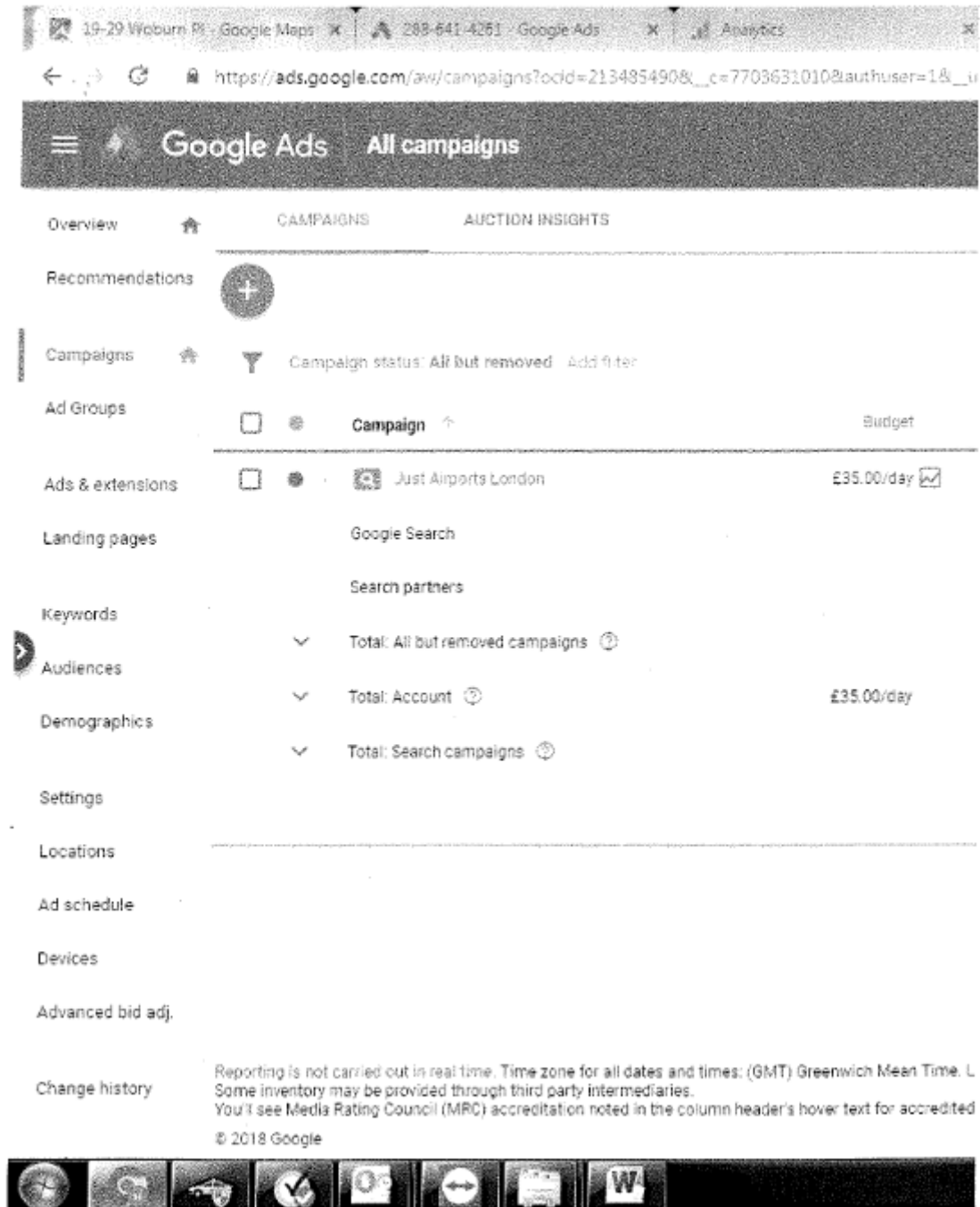
Total: Search campaigns

Reporting is not carried out in real time. Time zone for all dates are Some inventory may be provided through third party intermediarie You'll see Media Rating Council (MRC) accreditation noted in the c

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19. It is not necessary to separately summarise the submissions, since I have either already dealt with the points raised or will do so in due course.

20. It is unclear why the applicant has provided the evidence that it has, as it does not assist them in proving there is no likelihood of confusion. Ownership of an operator's licence is not equivalent to ownership of a trade mark, neither is a grant of a planning application. As such, these pieces of evidence are not relevant to the decision I am

required to make. It is not clear how the Google Ads evidence proves there is no similarity between the marks at issue, in fact, it is not clear what this evidence proves at all, as it has not been explained in any detail.

## **DECISION**

### **Proof of use**

21. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier marks. The relevant statutory provisions are as follows:

“6A Raising of relevant grounds in opposition proceedings in case of non-use

(1) This section applies where-

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

(b) there is an earlier trade mark 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 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 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 condition 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.”

22. Section 100 of the Act is also relevant, which reads:

“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.”

23. The relevant period in the current case, in which the opponent must prove use of its mark (no claim for proper reasons for non-use having been made), in accordance with section 6A of the Act, is 20 January 2013 to 19 January 2018 (“the relevant period”).

24. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on grounds of non-use. In *Walton International Ltd & Anot v Verweij Fashion BV*,<sup>1</sup> Arnold J. summarised the case law on genuine use of trade marks:

“114. The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Behher BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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 Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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

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<sup>1</sup> [2018] EWCH 1608 (Ch) (28 June 2018)

which have another origin: Ansul at [36]; Sunrider at [70]; Verein at [13]; Silberquelle at [17]; Leno at [29]; Centrotherm at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: Gözze at [43]-[51].

(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] and [22]. 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]; Reber at [29].

(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]; Leno at [29]-[30], [56]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34].

(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] and [76]-[77]; *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].”

#### Variant use

25. In accordance with section 6A(4)(a) (which corresponds to section 46(2)) of the Act, use of the mark in a form differing in elements which alter the distinctive character of the mark in the form in which it is registered will not qualify as illustrating use of the registered mark.

26. As per my evidence summary, above, the opponent has filed evidence containing two variants of the mark, including:

(i)



(ii)



27. In *Nirvana Trade Mark*,<sup>2</sup> Mr Richard Arnold QC (as he then was) sitting as the Appointed Person summarised the test under section 46(2) as follows:

“33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

28. Applying this to variant (i), I find that the main difference between this variant and the mark as registered – the removal of the words ‘Chauffeur Service’ – does not alter the distinctive character of the mark in its registered form, firstly, because the difference visually is minimal, and secondly, because the removed words are descriptive of the services for which the mark is registered so they do not add to the distinctive character of the registered mark. The change from uppercase (JUST AIRPORTS) to the capitalisation of each word (Just Airports) does not affect the distinctive character of the mark,<sup>3</sup> neither do the slight stylistic differences in the

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<sup>2</sup> BL O/262/06

<sup>3</sup> See Professor Ruth Annand’s comments in *Bentley Motors Limited v Bentley 1962 Limited* BL O/158/17

figurative aeroplane and car elements, since they are likely to go unnoticed. I am satisfied that variant (i) is an acceptable variant of the registered mark.

29. Since variant (ii) only appears on pages of the evidence which also display variant (i) – an acceptable variant – whether variant (ii) is an acceptable variant of the registered mark does not impact the decision I will make in relation to genuine use.

### Sufficient use

30. I will now consider whether the evidence filed is sufficient to constitute genuine use of the mark.

31. As I have found in relation to the applicant's evidence, ownership of an operator's licence is not equivalent to use of a trade mark, neither is ownership of a domain name. As such, exhibits NSM1 and NSM4 do not assist the opponent in proving use of its mark.

32. The invoices in relation to PC software at exhibit NSM2 are internal documents that would not be available to the public and, as such, do not show use by way of real commercial exploitation of the mark on the market for the relevant services.

33. The opponent's evidence includes 10 invoices which include use of the earlier mark (albeit in a satisfactory variant manner) all within the relevant period. Whilst the sales values have been redacted, they are a clear indication of genuine use of the mark.

34. The Google results at exhibit NSM4a, displaying the opponent's website, [www.justairports.com](http://www.justairports.com), as the first natural listing, would not by itself prove use of the mark. However, it is supported by a printout of the opponent's website (exhibit NSM4b), clearly displaying the mark in relation to the relevant services. The correct approach to assessing evidence is to view the picture as a whole, including whether



individual exhibits corroborate each other<sup>4</sup>, which these exhibits do. Although exhibit NSM4b is dated outside the relevant period (21 September 2018), I find it reasonable to conclude, on the balance of probabilities, that the website was up and running and displaying the mark during the relevant period, given the fairly short period of time between the end of the relevant period and the date on which the website was accessed.

35. Since the invoices and order form at exhibits NSM4c and NSM5: (i) do not show the opponent's trade mark; (ii) would not be available to the public, and (iii) show very little detail, I am not satisfied that they are sufficient to show actual use of the mark, in relation to the relevant services, which guarantees the identity of the origin of the services to the consumer.

36. Although some of the evidence filed has not assisted the opponent in proving use of its mark, the picture presented by the opponent's website and the invoices of sales is sufficient for me to establish that the opponent has used its mark in the relevant period.

#### Fair specification

37. I must now consider whether, or to what extent, the opponent has shown use of the earlier mark in relation to the services for which it is registered.

38. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*,<sup>5</sup> Mr Geoffrey Hobbs QC as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average

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<sup>4</sup> See the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *Brandconcern BV v Scooters India Limited* [2014] WL 517611

<sup>5</sup> BL O/345/10

consumer of the goods or services concerned.”

39. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*,<sup>6</sup> Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed

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<sup>6</sup> [2016] EWHC 3103 (Ch)

independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

40. The only evidence that explicitly refers to the services offered by the opponent is contained within the sales invoices at exhibit NSM3 and the printout from the opponent’s website at exhibit NSM4b. The only vehicles used, as shown on the invoices, are: “StdCar”, which I take to be a standard car; “Estate”, which is a car with a long body and rear doors;<sup>7</sup> and “MPV” (Multi-Purpose Vehicle), which is a larger car typically seating six or more.<sup>8</sup> The available vehicles on the website are a saloon, an estate, an MPV, an executive, an MPV 7 and an MPV 8, all of which are types of cars. The opponent’s website describes the services as chauffeur services offering transfers to and from airports in London. There is no evidence of transportation by bus, bike or plane. Neither is there any evidence of transporting goods via any mode of transport. Accordingly, the opponent may rely on what I consider to be a fair specification of “transportation of passengers by car” for the purposes of this opposition.

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

41. Section 5(2)(b) of the Act states that:

“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,

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<sup>7</sup> Definition from Collins English Dictionary

<sup>8</sup> Definition from Dictionary.com

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

## **Relevant law**

42. 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.

### **Comparison of services**

43. The competing services are shown in the table below:

<b>Earlier mark</b>	<b>Applied-for mark</b>
Class 39: Transportation of passengers by car	Class 39: Transportation of passengers and/or goods by car, bus, bike or plane

44. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, the court stated at paragraph 23 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”.

45. The relevant factors for assessing similarity, identified by Jacob J. (as he then was) in the *Treat* case,<sup>9</sup> were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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<sup>9</sup> [1996] R.P.C. 281

46. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*<sup>10</sup> that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

47. It is self-evident that the “transportation of passengers by car” is identical in both parties’ specifications.

48. Following the proof of use assessment, I have found that the opponent may rely upon “transportation of passengers by car”. These services are aimed at transporting a person or persons from A to B, for example, taxis, chauffeur driven cars, etc. The applicant’s services also include the transportation of passengers, but by ‘bus, bike or plane’. I consider transportation of passengers by bus and bike to be similar to a medium degree to the earlier services since the nature is the same, i.e. to transport someone from A to B. They are also in competition since depending on the number of passengers one may have to decide whether to travel by bus (which is sufficiently broad to cover minibuses, which are generally provided by taxi companies) or car. The end users are also similar. These services are similar to a medium degree.

49. The position is less clear with regard to the applied-for “transportation of passengers by plane”. They are similar in purpose since they are both intended to transport passengers, but the nature differs since one is by land and the other by air. Broadly speaking, the end user is the same since those who travel by air are inevitably also likely to seek transportation via car. They are not in competition and they are not complementary. I consider them to be similar to a low degree.

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<sup>10</sup> Case T-133/05

50. This leaves the applied-for “transportation of goods by car, bus, bike or plane”. The nature of these services is similar since they both involve transportation; however, the uses differ in that they transport different things, i.e. passengers on the one hand and goods on the other. The end users of these services are unlikely to overlap since on the one hand you have consumers who wish to send goods, and on the other hand would be consumers looking to have transport for themselves and/or others. The services are unlikely to be complementary or in competition with one another plus the trade channels are likely to differ. I consider there to be a low degree of similarity.

### **The average consumer and the nature of the purchasing act**

51. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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*.<sup>11</sup>

52. 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*,<sup>12</sup> 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.”

53. The average consumer of the parties’ services may be either a member of the general public or a company or businessperson. The price of the services varies depending on the length of the journey, but they are not, generally speaking,

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<sup>11</sup> Case C-342/97

<sup>12</sup> [2014] EWHC 439 (Ch)



particularly expensive. Members of the general public will use transportation services fairly frequently, and a company or businessperson making regular business trips will use them even more frequently. I bear in mind that the average consumer, when selecting the relevant services, is likely to consider, for example, the vehicle used and the cost of the service. Taking all of these factors into account, the level of care and consideration that will be adopted during the purchasing process would be average. The purchase is likely to be predominantly visual: the services will be selected by browsing the internet or a phone book. However, I do not discount that there may be an aural element with word of mouth recommendations playing a part in the selection.



### **Comparison of the marks**

54. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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.”

55. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

56. The marks to be compared are as follows:

Earlier mark	Applied-for mark
	

57. The applicant has not made any submissions on the similarities (or differences) of the marks, except for “2 different names and also both logos are entirely different”. The opponent has made slightly more detailed submissions, which I take into account when making my decision.

#### Overall impression

58. The earlier mark consists of the words JUST AIRPORTS Chauffeur Service written in black in a fairly standard typeface and contained within a black oval device. There are two figurative elements in the mark: an aeroplane to the top-left of the oval, and a car to the top-right of the oval. I consider that the words JUST AIRPORTS have the greatest impact in the overall impression, given their size and position. A lesser role is played by the phrase Chauffeur Service which, positioned beneath the words JUST AIRPORTS and in a smaller typeface, will be seen as descriptive by the average consumer. The aeroplane and car devices play an insubordinate role in the overall impression of the mark since they simply reinforce the meaning of the textual components i.e. AIRPORTS and Chauffeur Service. The oval device is likely to be seen as little more than a border.

59. The applied-for mark consists of the words Just Airports London written in black in a fairly standard typeface. In front of the textual components is a blue circular device with three orange, curved lines across the width of the circle (presumably to resemble

a jet stream) and a small, blue aeroplane device positioned above the word Just. These figurative elements appear to represent the globe with an aeroplane flying around it. The word London simply suggests that the applicant is a business in London. The figurative elements reinforce the meaning of the textual components i.e. Airports. Consequently, the words Just Airports play the greatest role in the overall impression of the mark.

#### Visual comparison

60. The similarity lies in the first two words of each mark: JUST AIRPORTS and the addition of an aeroplane device. That JUST AIRPORTS is presented as Just Airports (in upper and lower case) in the applied-for mark does not create a difference because, notionally, the mark could be used in all upper-case lettering.

61. In terms of differences, the opponent's mark contains the descriptive phrase Chauffeur Service, a car device and an oval border, none of which are present in the applicant's mark. In addition, the applicant's mark contains the word London and a globe device, neither of which are present in the opponent's mark.

62. Taking all of these factors into account, and bearing in mind the overall impressions I have outlined, I consider the two marks in question to be visually similar to a medium degree.

#### Aural comparison

63. Considering the descriptive nature of the words Chauffeur Service, the opponent's mark will most likely be referred to as JUST AIRPORTS. Similarly, considering London is suggestive of the company's location, the applicant's mark will most likely be referred to as Just Airports. Therefore, the marks at issue are aurally identical. If I am wrong and the average consumer does articulate the marks in full, I would find the aural similarity to be of a medium degree.

## Conceptual comparison

64. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgements of the GC and the CJEU including *Ruiz Picasso v OHIM*.<sup>13</sup> The assessment must be made from the point of view of the average consumer.

65. Both marks used for the services at issue will give the immediate indication to the average consumer that these are transportation services solely to and from airports. I therefore conclude that the marks are conceptually identical.

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

66. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer* 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

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<sup>13</sup> [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

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).”

67. The opponent has not claimed to have used its earlier mark to the extent that it has an enhanced degree of distinctive character. However, even if it had, I have not been provided with sufficient evidence (such as indicating the market share held by the mark, the amount invested in promoting the mark, or the proportion of the public which identifies the services as originating from the opponent, for example), to determine whether the earlier mark has an enhanced distinctive character. Accordingly, I have only the inherent distinctiveness of the earlier mark to consider.

68. As to the distinctiveness of the word JUST, I note that in *Bignell v Just Employment Law Ltd*,<sup>14</sup> Mr Robert Englehart QC, sitting as a Deputy Judge, concluded that the words “Just Employment” were descriptive of, inter alia, legal services relating to employment matters. The Trade Marks Registry’s approach to trade marks containing the word “Just” has been drafted with this decision in mind and indicates that trade marks containing, inter alia, the word “Just” can mean, for example, we specialise in (Just Education) or to denote purity (JUST JUICE) or to mean all that is required (JUST PLUG IT IN). Equally the practice indicates that:

“...this practice will not be applied blindly, and trade marks containing words such as “just” and “simply” will be assessed in their totality.”

69. I take this into account but find that, given the added figurative elements and the fact that a registered trade mark is deemed to have a degree of distinctiveness,<sup>15</sup> the earlier mark has a low degree of inherent distinctive character.

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<sup>14</sup> [2008] FSR 6

<sup>15</sup> *Formula One Licensing BV c OHIM*, Case C-196/11P

## Likelihood of confusion

70. The factors assessed so far have a degree of interdependency (*Canon*); a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel*). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

71. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/services down to the responsible undertaking being the same or related).

72. The marks have been found to be visually similar to a medium degree, aurally identical (or aurally similar to a medium degree if the average consumer articulates all components of the marks) and conceptually identical. The services at issue have been found to be either identical or similar to a low or medium degree.

73. Taking into account the common elements between the marks (i.e. the words JUST AIRPORTS), the figurative elements simply reinforcing the message portrayed by the textual components of the marks (and both marks containing an aeroplane device), and bearing in mind the concept of imperfect recollection, I consider it likely that the average consumer will mistake one mark for the other, resulting in a likelihood of direct confusion. This is so even bearing in mind the earlier mark's low level of inherent distinctive character. In reaching the conclusion that I have, I am mindful that a degree of caution is required before finding a likelihood of confusion on the basis of common elements which are either descriptive or are low in distinctive character.<sup>16</sup> Nevertheless, I maintain that there is a likelihood of confusion. Bearing in mind that 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), I find there to be a likelihood of confusion even for services which are similar to only a low degree.

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<sup>16</sup> *Nicoventures Holdings Limited v The London Vape Company Ltd* [2017] EWHC 3393 (Ch) and *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

74. For the sake of completeness, and in case I am found to be wrong with my finding of direct confusion, I go on to consider indirect confusion.

75. Indirect confusion was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc.*<sup>17</sup>

“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 recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

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

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

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand

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<sup>17</sup> BL O/375/10

or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.).

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

76. I have borne in mind that the examples given by Mr Purvis are not exhaustive. Rather, they were intended to be illustrative of the general approach.<sup>18</sup>

77. I go on now to consider whether the average consumer, if they do recognise that the marks are different, considers the common element of both marks and determines, through an instinctive mental process, that the marks are related and originate from the same, or an economically linked undertaking.

78. In this case I consider there to be two circumstances in which the average consumer will come to this conclusion. Considering that the differences in the marks are descriptive words/phrases (Chauffeur Service versus London) and the figurative elements (an aeroplane and a car versus an aeroplane flying around the globe) reinforce those words, I think it likely that the consumer will either consider the differences in the non-distinctive elements as expected in a sub-brand or brand extension, or consider that the change in figurative elements is entirely logical with a re-branding of one of the marks.

## **CONCLUSION**

79. The opponent’s case under section 5(2)(b) has been successful. Subject to appeal, the applicant’s mark is refused registration.

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<sup>18</sup> See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82]



## **COSTS**

80. As the opponent has been successful, I consider that it is entitled to an award of costs in its favour. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. Using that TPN as a guide, I award costs to the opponent on the following basis:

Official fee: £100

Preparing a statement and  
considering the other side’s statement: £200

Preparing evidence and  
considering the other side’s evidence: £500

Preparing written submissions  
in lieu of a hearing: £300

**Total: £1100**

81. I order Hamid Sheikh to pay Just Airports Chauffeur Services Limited the sum of **£1100**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 17th day of July 2019**

**Emily Venables**  
**For the Registrar,**  
**The Comptroller-General**