

O/562/21

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3449129
IN THE NAME OF PRIVATE CAR SERVICES LIMITED FOR THE TRADE MARK**

Blackwing

IN CLASS 39

AND

**OPPOSITION THERETO UNDER NO. 419827
BY BLACKLANE GMBH**

Background and pleadings

1. Private Car Services Limited (“the applicant”) applied to register the trade mark no. 3449129 for the mark ‘Blackwing’ in the UK on 4 December 2019. It was accepted and published in the Trade Marks Journal on 13 December 2019 in respect of the following services:

Class 39: Passenger transport.

2. Blacklane GmbH (“the opponent”) oppose the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its EU Trade Mark no. 10762847 for the mark ‘BlackLane’.¹ This mark was filed on 27 March 2012 and registered on 26 July 2012 and constitutes an earlier mark within the meaning of section 6 of the Act. The following services are relied upon by the opponent under section 5(2)(b):

Class 39: Transport; Packaging and storage of goods; Travel arrangement; Chauffeur services; Transport of persons.

3. The opponent argues that the respective services are identical and that the marks are highly similar, and that as such, there exists a likelihood of confusion between the marks.
4. The opponent also opposes the application on the basis of section 5(3), relying upon the same EU trade mark registration above, but in respect of its full list of goods and services. These include goods and services in classes 9, 38, 39 and 42, as set out in Annex A to this decision.
5. The opponent argues that it holds an extensive reputation for its goods and services and that the visual, aural and conceptual similarities will “create a link” between the marks, and that in turn this will cause “direct confusion amongst

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information. Although the EUTM relied upon by the opponent now enjoys protection in the UK as a comparable trade mark, because the application was filed before the end of the Implementation Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, the EUTM remains the relevant right in these proceedings.

users as to origin". The opponent submits the believed shared origin would allow the applicant to generate goodwill in its services, and it would result in the applicant "free riding" off its reputation. The opponent argues that as it has no control over the applicant's use of the mark and the quality of its services, this will likely result in the dilution and tarnishing of the opponent's mark and of its reputation. Finally, the opponent argues that the use of this mark will lead to the dilution of the earlier mark's ability to distinguish goods and services from those of other undertakings. It submits that as the average consumer is likely to perceive the marks as coming from the same origin, this will alter their economic behaviour as they may either mistakenly choose the applicant's services on the basis that they are the opponent's, or they may make this purchase based on the assumption the marks are connected.

6. The opponent also opposes the application on a third ground, on the basis of section 5(4)(a) of the Act. The opponent claims to own unregistered rights in the UK in respect of the sign 'BlackLane' in respect of all of the goods and services set out in Annex A, stating it has used the sign throughout the UK since 2013. It claims it has built up significant goodwill in the sign in respect of the goods and services, and that the use of the application as filed would result in an "actionable misrepresentation", leading the public to believe the marks derive from the same or a connected undertaking. The opponent submits on this basis that the application is liable to be refused under section 5(4)(a) of the Act.
7. The applicant filed a counterstatement requesting that the opponent provides proof of use of its earlier trade mark relied upon. In its counterstatement, the applicant denies the similarity of the marks, but admits similarity between the services. It denies the opponent holds a reputation and puts the opponent to proof of the same. Further, the applicant denies that the use of the application would result in dilution or take unfair advantage of the opponent's mark. Finally, the applicant puts the opponent to proof that 'BlackLane' has been used throughout the UK since 2013 in respect of the goods and services and denies there will be any misrepresentation in respect of the claims made under section 5(4)(a).

8. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers. Both parties are professionally represented in these proceedings. The opponent is represented by Birketts LLP, and the applicant is represented by Withers & Rogers LLP.
9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Evidence

10. The opponent filed evidence by way of a witness statement in the name of Frank Steuer, described in the statement as the 'Chief Technical Officer' and director and founder of the opponent. The witness statement introduces a single exhibit, namely Exhibit FS1. This exhibit comprises several different sets of documents and 135 pages.
11. In the witness statement, Mr Steuer states that the mark BlackLane has been in consistent and continuous use in the UK since 2013, and in the EU since 2011,² but that the opponent also runs its business in 51 countries across the world.³ Mr Steuer explains the company is engaged in the "Procurement of chauffeur services (private and personal transportation services) under the mark BLACKLANE",⁴ as well as a web application for limousine service providers, allowing them to register and manage their business relationship with the opponent, and two mobile applications, one being for partners, within which drivers can start, finish and cancel rides, and the other being for consumers.⁵ Mr Steuer explains that the services are offered via a partner system, with

² See paragraph 3

³ See paragraph 7

⁴ See paragraph 8.1

⁵ See paragraphs 8.2-8.3

consumers booking the services via the website or app, and these bookings being offered to a partner using an insured and screened driver in the location of the booking.⁶ Mr Steuer explains the opponent will then raise the invoice under BLACKLANE.⁷

12. In the UK, Mr Steuer confirms the opponent operates across Birmingham, Bristol, Edinburgh, Glasgow, Leeds, Liverpool, London, Newcastle and Manchester. Mr Steuer states Blacklane has 221 “Partners” with 1,295 associated drivers in the UK.⁸

13. Within Exhibit FS1, Mr Steuer provides the financial statements for the business under BLACKLANE.⁹ Mr Steuer breaks down the figures in his witness statement to identify the UK turnover as below:¹⁰

For the period ended 31 December 2014: €9.9million with €824,000 being the UK turnover;

For the period ended 31 December 2015: €20,461,026 with €1,994,691 being the UK turnover;

For the period ended 31 December 2016: €29million with €3.3million being the UK turnover;

For the period ended 31 December 2017: €45million with €5.4million being the UK turnover;

For the period ended 31 December 2018: €74million with €8.9million being the UK turnover; and

For the period ended 31 December 2019: €108 million with €12.7million being the UK turnover.

⁶ See paragraph 13

⁷ See paragraph 14

⁸ See paragraph 7

⁹ See pages 13 - 35

¹⁰ See paragraph 9

14. Mr Steuer also breaks down the advertising spend for the UK in his witness statement, identifying this as follows:¹¹

For the period ended 31 December 2014: €2.6million with €108,171 being the UK budget;

For the period ended 31 December 2015: €2,759,119 with €147,728 being the UK budget;

For the period ended 31 December 2016: €2.8million with €200,000 being the UK budget;

For the period ended 31 December 2017: €3.1million with €360,000 being the UK budget;

For the period ended 31 December 2018: €5.1million with €614,000 being the UK budget; and

For the period ended 31 December 2019: €4.5million with €520,000 being the UK budget.

15. Mr Steuer explains in his witness statement that of the advertising budget, over 500,000 euros of the UK spend was allocated to Google Adwords, Facebook and Instagram campaigns.¹²

16. At paragraph 10 of his statement, Mr Steuer also confirms the wider turnover for the EU as a whole between 2014 and 2019, stating:

10. For the same years the annual turnover for the EU was €6.2million in 2014, €11million in 2015 and €15.3million in 2016, €22.6million in 2017, €37.8million in 2018 and €52.2million in 2019. The advertising budgets for the same years in the EU was €637,795 in 2014, €579,858 in 2015 and €695,999 in 2016, €1,532,000 in 2017, €2,607,000 in 2018 and €2,105,000 in 2019.

17. Images from the company website are shown at pages 36 to 40 of Exhibit FS1. The web address is given as www.blacklane.com in the witness statement. The images appear to be undated but show the use of the mark at the top of the page and on the number plates of the vehicles as below:

¹¹ See paragraph 9.2

¹² See paragraph 11



18. Website visits from UK based consumers are confirmed later by Mr Steuer in his witness statement as 201,609 in 2015, 384,045 in 2016, 528,087 in 2017, 673,462 in 2018, and 621,647 in 2018.

19. The number of UK customers using the opponent's services under BLACKLANE has been provided in a table under Exhibit FS1.¹³ This shows the numbers of UK customers increasing from 203 in 2012 up a peak of 18,874 in 2018, dropping slightly to 18,590 in 2019. The figures also show the number of customers being over 5,000 in 2014, over 9,000 in 2015, over 11,000 in 2017 and over 14,000 in 2017.

20. Mr Steuer states that its software is within the apps provided, which is promoted via Google, and via the App store and the Playstore for both Apple and Android phones.¹⁴ In addition, he confirms direct mail marketing takes place, and at the relevant date its email marketing list had 720,000 subscribers, and in the "last 24 months"¹⁵ 43,976 UK recipients had received at least one marketing email, with 33,908 receiving at least one within the last 12 months.¹⁶ Screenshots described by Mr Steuer as "analytics for the Blacklane software in the UK" are provided in Exhibit FS1,¹⁷ which seem to reference the period January – October 2020, and Mr Steuer describes this as being in "real time" on the day of preparing the witness statement. Mr Steuer gives figures for "consumer app

¹³ See page 47

¹⁴ See paragraph 19

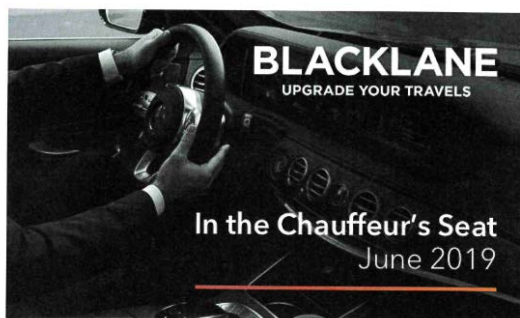
¹⁵ The witness statement is dated 16 November 2020

¹⁶ See paragraph 19.7

¹⁷ See pages 45 - 55

installs” for 1 January 2019 – 31 December 2019 as 29,904.¹⁸ This is shown as UK figures on page 60 of Exhibit FS1. Screen shots of the “app for end users” are provided at page 60. The app itself appears to be called BL Chauffeur, but there is reference to the “easy-to-use Blacklane app for chauffeurs...” within the description and the full mark is shown as used within the image of the app itself.

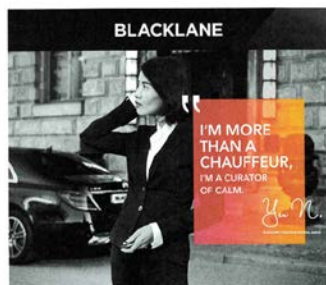
21. Examples of marketing emails sent to customers are provided within Exhibit FS1. The below example of email marketing which Mr Steuer states was sent to “software users” can be found at page 62 of the exhibit:



Something looks different...

This special edition is to celebrate that we've upgraded the entire Blacklane brand! These changes are about more than just refreshing our look, they're about you, our crew. Check out this video message from our Director of Marketing, and read on to find out more about what's in store.

22. Although the image above provides the date of June 2019, the email included within the exhibit itself is dated 19 October 2020. An example the first page of an email described by Mr Steuer in his witness statement as being sent to the “service users”¹⁹ is copied below:



Your calm on the road

Discover a world of calm and relaxed travel.

For Yen and our other chauffeur partners around the

¹⁸ See paragraph 19

¹⁹ See paragraph 19.7

23. Images of an Instagram and Facebook marketing campaign are provided within Exhibit FS1, which Mr Steuer explains date from 2019. He explains they had over 22 thousand link clicks and nearly 3 million 'impressions' based on the campaign.²⁰ The reach of the campaign is given at over 650,000 for the UK in Exhibit FS1. The advertisements run are headed 'blacklane' and Blacklane - Airport Transfers which describe hiring professional chauffeurs and a private black car.

24. Details of both Apple and Google advertising campaigns are also described by Mr Steuer in his witness statement, including a UK based Google Ad campaign which showed the opponent's advertisement on Google when searching for limousine services.²¹ Mr Steuer also describes the opponent as having been "tagged" by celebrities on social media. Exhibit FS1 shows the twitter account of Alison Hammond, described as "@thismorning TV Broadcaster" and having over 327 thousand followers (in 2020), who posted a tweet about a good experience with "@blacklane" in 2015. The tweet itself received 2 retweets and 8 likes. A tweet on Ronan Keating's twitter account thanking "@blacklane" for its support with a ball was posted on 5 December 2015 and received 10 retweets and 65 likes.

25. In his witness statement, Mr Steuer has provided a list of the awards won, and details of these are shown under Exhibit FS1 referencing the mark



. The awards won are listed by Mr Steuer as below:²²

- British travel Awards 2017 Best Holiday add-ons provider;
- 2018 Luxury Lifestyle Awards Most Outstanding Luxury Chauffeur Services. Mr Steuer states "Lux is a magazine for global influencers and high net worth individuals which is published out of London and is published in hard format four times a year and online which is refreshed more frequently. It has a readership of 250,000-300,000 readers of which 60% are in Europe";

²⁰ See paragraph 20.1


²¹ See paragraph 20.3

²² See paragraph 22 - 22.2 and 23.2

- Business Travel Awards 2019 best company in the ground transportation category.

26. Mr Steuer also describes various articles that were published. He notes the article above, as well stating articles appeared in the publications below:²³

- Eyefortravel.com London edition 2017;
- Monocle magazine August 2019 edition. Mr Steuer explains “Monocle is published out of London with more than 80,00 copies sold per issue”;
- Upward Curve Magazine in 2019. Mr Steuer explains “Upward Curve is an independent air travel magazine which is printed quarterly and issued online too. It claims to have an audience in excess of 400,000 frequent independent air travellers for each issue;
- Business Traveller Magazine September 2020. Mr Steuer explains “Business Traveller is a magazine first launched in the UK in 1976 which is aimed at business travellers and has both hard print and online versions. Its circulation in 2019 was 70,648”;

27. In the articles outlined above, there is use of  as well as



28. Mr Steuer also explains that the opponent was part of the Aviation Travel Festival, and sponsored the Business Travel Show 2018,²⁴ details of which are shown on pages 129 to 131 of Exhibit FS1. The Business Travel show is promoted as taking place in London Olympia on the documents provided, but it isn't clear where the Aviation Travel Festival was located. The material

relating to these events shows the mark  in use on the stands and promotional material.

²³ See paragraphs 23 – 23.6

²⁴ See paragraph 23.5

29. I have summarised the opponent's evidence to the extent I find it necessary to do so. Whilst not every page of the evidence filed has been summarised, this has been considered in full.
30. The applicant's evidence comprises two witness statements introducing a total of two exhibits. The first witness statement is in the name of Tania Clark, described as a Partner at Withers and Rodgers LLP, introducing a single exhibit namely Exhibit TC1. The exhibit is described by Ms Clark as a search of the UK IPO database, and the exhibit itself states they are results of trade marks containing the word BLACK in class 39.
31. The second witness statement is filed in the name of Elouise Rowe, described as an Intellectual Property Investigator at Cerberus IP. In the statement Ms Rowe introduces a single exhibit, namely Exhibit ER1. She describes this as a copy of the report produced following her investigation into the use of the prefix "BLACK" in relation to minicab services, as instructed by the applicant's representative.
32. Exhibit ER1 shows the investigation mentioned produced results as follows:

Numbers of providers using BLACK within their name (in any position):

- 2 minicab services using BLACK inside of London;
- 3 minicab services outside of London;
- 2 chauffeur services within London;
- 3 chauffeur services outside of London;
- 9 private hire "black" taxis within London, offering corporate and event hire;
- 3 private hire "black" taxis outside of London, offering corporate and event hire;

- 17 licensed taxi providers from both in and outside of London (an 18th provided is identified as “BACKTAX” which may be meant to read BLACKTAX but I cannot be sure). The providers include those named BLACK JAG, BLACK PEARL CARS, BLACK SWAN PRIVATE HIRE, BIG BLACK CARS, BLACK TAXI TOURS amongst others.

33. Of the providers above it was identified that the majority relate to hire of a Hackney Carriage Black Taxi on a private or metered taxi basis.

34. Further information is also provided on the companies offering the services above using the word BLACK in their name. Whilst I will not detail these in full at this stage, the content of this evidence has been considered in its entirety.

Form of the mark

35. Before proceeding with my assessment of genuine use, I will briefly address the use of the mark in the varying forms within the evidence. The earlier mark is registered as the word mark “BlackLane”. The registration of a word mark allows for its use in a range of standard fonts and colours. Where the mark appears on its own within the evidence, it appears either in word format or in a slightly stylised standard font, both of which clearly constitute use of the mark as registered.

36. I note the majority of the use of the mark in the exhibits filed show its use with additional wording. These variants include those as copied below:



37. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”. (emphasis added)

38. Where the mark has been used with the additional wording above, I find it still maintains its independence within the marks as a whole, and that it will still act as an independent indicator of origin to the consumer. I therefore find that the use of the mark in these variants is acceptable use of the mark as registered in line with *Colloseum*.

Proof of use

Legislation

39. Section 6A of the Act provides as follows:

“(1) This section applies where

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

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

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

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

(3) The use conditions are met if –

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

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

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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 Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

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

Proof of Use case law

40. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU²⁵ 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 Bundesvereinigung 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 Beheer 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:

²⁵ Court of Justice of the European Union

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 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].”

41. Section 100 of the Act states that:

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

42. The applicant has requested proof of use in respect of the earlier mark. The application was filed on 4 December 2019, at which time the earlier mark had been registered for a period of over five years. As such, the burden is on the proprietor to prove that the earlier mark has been put to genuine use within the

relevant time period of 4 December 2014 – 3 December 2019 in respect of the relevant goods services in the territory of the EU.

Use of the mark

43. Whilst the opponent has claimed that use has been made of all of its goods and services as registered under its section 5(3) ground, there are clearly a number of goods and services for which no evidence of use has been filed. These include the goods and services as set out below:

Class 9: 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; CDs, DVDs and other digital recording media; Mechanisms for coin-operated apparatus; Cash registers, calculating machines and data-processing equipment; Fire-extinguishing apparatus; Downloadable electronic publications; Spectacle frames; Pince-nez chains; Mechanical signs.

Class 39: Packaging and storage of goods;

Class 42: Scientific and technological services and research and design relating thereto; Industrial analysis and research services;

44. This leaves the following goods and services for consideration:

Class 9: Computer software; (repeated twice in class 9)

Class 38: Telecommunications.

Class 39: Transport; Travel arrangement; Chauffeur services; Transport of persons.

Class 42: Design and development of computer hardware and software.

45. I will begin by considering if there has been use of the mark in relation to the goods and services above within the relevant territory and within the relevant timeframe. If I find there has been use, I will go on to consider if I find this use to constitute genuine use for the purpose of enforcing the rights within this opposition.
46. I firstly consider the use of the mark in respect of *Computer software* in class 9. In the witness statement, Mr Steuer clearly confirms the opponent's use of the mark in respect of an application offered to both its partners and its service users. This evidence places the use within UK and within the relevant timeframe, by way of UK application download figures of nearly 30,000 for 2019 shown at page 60 of Exhibit FS1. Whilst I note that just under the last month of 2019 falls outside of the relevant timeframe, it appears reasonable to assume that at least a large portion of these downloads of have been made within the relevant timeframe. Whilst I note the evidence in the exhibit references the use of the sign "BL" in relation to the application, I note the text describing the application also refers to this as the "BlackLane" application, and the images showing the mark BLACKLANE appearing within the app itself. I therefore find use of the mark has been made within the relevant territory and timeframe in respect of computer software.
47. Next, I consider if use of the mark has been made in respect of *telecommunications* in class 38. Clearly, there is no evidence positioning the opponent as a telecommunications provider as such, insofar as being the provider of access and network connections to the consumer. However, I note the term *telecommunications* is a fairly broad and general term. I consider the application the opponent has offered to its UK consumers. The evidence shows and explains this app provides the consumer with a platform within which it may communicate with others, by beginning, ending or cancelling journeys. This is shown by the pages detailing the functionality of the application on pages 58 and 59 of Exhibit FS1 which advertises functions for managing rides, calling customers, and getting support through the application. These pages also show BLACKLANE as appearing at the top of the application. I also note that the

consumer will receive text and emails from the driver. Having considered these services, whilst I find the sending of emails and texts per se is not the offering of telecommunications as a service, providing a means by which information and instructions may be exchanged between passengers and drivers via a computer, phone or tablet, does, to my mind, fall within the meaning of telecommunications. The evidence of the application downloads in addition to the information provided in the witness statement places these services within the relevant territory and timeframe.

48. In respect of the services in class 42, I have included these here in order to clarify the reason I find no use of these services shown in the evidence, despite the opponent offering computer software. The services in class 42 comprise the offering of these services to others. Whilst I acknowledge the opponent's evidence it offers an application, there is no evidence of it offering, as a service to others, the design and development of computer hardware and software.

49. This leaves the services covered in class 39. In respect of the services *Transport; Chauffeur services; Transport of persons*, it appears clear that these are the core services offered under the BLACKLANE mark. Whilst I note that the opponent itself may not actually be the same entity that ends up driving the cars, it is clear from the evidence and advertisements provided that these are the services which are advertised by the opponent to the consumer, and these are the services the consumer will receive after engaging with the opponent under the mark. At paragraph 14 of his witness statement, Mr Steuer confirms that both the communication with the consumer to arrange these services and the invoicing will be done by the opponent and under the name of BLACKLANE. Turnover figures, advertising examples and customer numbers are all provided for these services within the evidence for within the relevant timeframe and territory, and as such it is clear that use has been made of the mark in respect of these services within the same.

50. In respect of the services *Travel arrangement* I note that the opponent will take bookings from the consumer and arrange for a chauffeur to meet the consumer at a particular location and will take care of the payment

arrangements for these bookings. To a limited extent, this will constitute travel arrangement, and I find there has been use by the opponent of the mark in respect of these services.

Genuine use

51. Where there is no use of the mark in respect of the goods and services as registered, it follows there has been no genuine use of the mark.

52. In respect of the remaining goods and services, I consider if the use that has been made of the mark constitutes genuine use for the purpose of enforcing the opponent's protection within this opposition. The earlier mark is registered as an EU trade mark, and as such I am to consider if the use constitutes genuine use within the territory of the EU as a whole, as it stood on the date of the application. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union noted that:

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

And

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

Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

53. The court held that:

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

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

trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

54. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

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

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

of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

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

55. The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.
56. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue

in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

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

57. Whilst the opponent has made reference to its services being offered in 51 countries across the world,²⁶ the majority of the evidence provided relates to the use in the UK. However, I note that in addition to the UK turnover figures under the mark, the opponent has provided the turnover for the whole of the EU within the same periods. It is clear from the figures provided that the UK portion of the opponent's business in the EU constitutes roughly a 6th to a 5th of its total EU turnover for the years 2014 to 2019. What is not clear is the exact geographical extent of this use across the EU, and whether this is confined to a couple, or a number of territories. Within the UK it is confirmed that the opponent operates across eight cities, the geographical spread of which is fairly broad, from Bristol in the south west of England up to Edinburgh in the east of Scotland, although it is clear there are parts of the UK not covered at all by the services including Wales and Northern Ireland.

58. The nature of the use appears to clearly be trade mark use, with the mark, or an acceptable variant shown clearly as an indicator of origin on advertising and promotional materials, the website and in the press articles shown.

59. From the evidence provided, it is clear that the opponent's key services are those covered in class 39, namely *Transport; Chauffeur services; Transport of persons*. Whilst I have no breakdown of exactly what the turnover figures cover, on balance it seems reasonable to assume that at least the vast majority of the turnover provided is in relation to the chauffeur and private transport services, which are also covered by the broader categories of transport and transport of

²⁶ See paragraph 7 of Mr Steuer's witness statement

persons. Whilst the 2014 turnover figures will fall largely outside of the relevant time period which begins on 4 December 2014, clearly the 2015, 2016, 2017, 2018 and the vast majority of the 2019 figures will fall inside the same. These figures appear to be reasonably large and are consistently increasing both for the UK and the EU, with the UK figures growing from just under 2 million euros to over 12 million euros between 2015 and 2019, and the EU figures growing from 11 million to over 52 million euros in the same period. Whilst I do not have figures attesting the size of the market, I assume the private transport market in the EU will be fairly large. I also note the cost of these services is unlikely to be particularly low, and whilst I am unaware of the average journey cost it seems likely to be in the region of tens to hundreds of pounds depending on the length of the journey. Numbers of services users in the UK are given at page 47 of Exhibit FS1, and these range from just over 6000 “B2B” and “B2C” users in 2014, increasing steadily to around 25,000 in 2019. Of the figures, the “B2C” section accounts for by far the greatest portion of users. Whilst it is not explained, I find it likely this stands for business to consumer or similar. With consideration to the relevant case law, including the relevant factors as set out above, it is my view that the opponent has made real commercial exploitation of its mark within the territory of the EU and within the relevant timeframe in respect of *Transport; Chauffeur services; Transport of persons* for the purpose of creating and maintaining a market for the same. I therefore find genuine use in respect of the services.

60. I have not been informed of the exact charging system for opponent’s goods and services, including for the application and the telecommunication services, in addition to the travel arrangement. I do note that the invoices for the services will be raised in the name of the opponent, and it seems the most likely scenario that the services charged are at least primarily the actual transport services, and I find it likely the application and its functionality and the arrangement of travel are ancillary to the main service offering. However, this does not mean I must immediately discount the use in respect of these services as not genuine.

61. In *Antartica Srl v OHIM The Nasdaq Stock Market, Inc.* (Case C-320/07P) the CJEU dismissed a complaint by an appellant that there was no genuine use of

an earlier mark because certain services provided under it were not charged. The court stated that:

“29. It is sufficient to note in that respect that, even if part of the services for which the earlier mark is registered are offered by The Nasdaq Stock Market free of charge, that does not of itself mean that that commercial company will not seek, by such use of its trade mark, to create or maintain an outlet for those services in the Community, as against the services of other undertakings.”

62. The territory of the ancillary services is evidenced to at least include the UK, and it is my view this is highly likely to mirror that of the transport services, as it is via these methods that the services are booked and communicated. Further, it is clear that the mark is used as a trade mark in respect of these services in a consistent manner. In my view, the use of the mark in respect of these services is real commercial use for the purpose of generating and maintaining a market for these services alongside its core services. I therefore find genuine use of the mark has been made in respect of the same.

Fair specification

63. Now that I have established whether genuine use has been made of the mark, I must consider what a fair specification for the opponent should look like based on that use.

64. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. 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 consumer of the goods or services concerned.”

65. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), the late 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 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.”

66. I have found the opponent to have made use of the services *Transport; Chauffeur services; Transport of persons and Travel arrangement* in class 39. Whilst I note from the case law that I should not limit down the opponent’s protection to only the specific services it has used, I consider that ‘transport’ itself is broad and would cover a whole manner of subcategories including private transport, public transport, transport of people, transport of goods, as well as transport by air, land and sea. I also find this to be true for travel arrangement. In my view, with consideration to the perception of the average consumer, I find the consumer would consider *private land transport and chauffeur services* and *the arrangement of private land transport and chauffeur services* as a fair description of the opponent’s class 39 services.

67. *Telecommunications* is also a very broad term, capable of being broken down into a large number of subcategories. With consideration to the case law, I find the average consumer would view *the transmission of messages, information, and instructions, for the purpose of arranging private land transport and chauffeur services* as a fair description of the opponent’s services in class 38. In respect of computer software in class 9, that being another exceptionally broad term, I find the consumer would fairly describe the goods offered as *Computer software applications for the arranging, amending and cancelling of private land transport and chauffeur services*.

68. With consideration to the services relied upon under each ground, I will therefore consider the opponent’s position under section 5(2)(b) and 5(3) on the basis of the goods and services below:

Section 5(2)(b):

Class 39: private land transport and chauffeur services; travel arrangement, namely the arrangement of private land transport and chauffeur services.

Section 5(3):

Class 9: Computer software applications for the arranging, amending and cancelling of private land transport and chauffeur services.

Class 38: Telecommunications, namely the transmission of messages, information, and instructions, for the purpose of arranging private land transport and chauffeur services

Class 39: private land transport and chauffeur services; travel arrangement, namely the arrangement of private land transport and chauffeur services.

Decision

Section 5(2)(b)

Legislation

69. Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”. Section 5A of the Act is as follows:

70. Section 5A reads:

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.

The Principles

71. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“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.

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 goods and services

72. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“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 fur 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”.

73. The applicant has applied for *passenger transport* in class 39 only. These services clearly encompass the opponent's services *private transport and chauffeur services* and as such, the services are identical within the meaning of *Meric*.

Comparison of marks

74. 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.”

75. It would be wrong, therefore, to dissect the trade marks artificially, 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.

76. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
BlackLane	Blackwing

77. The applicant argues that BLACK is in common use on the UK and EU register, and in the market, and as such, the marks suffixes LANE and WING are will be given more prominence and are the dominant elements. In this respect, I note firstly that the state of the register evidence alone adds nothing to the applicant's case, as it does not show that the marks listed are on the market for the services covered and as such it cannot assist in showing that the consumer has become accustomed to the word BLACK being used by multiple providers in respect of transport. The evidence that there are a number of other companies using word black for these services does assist to an extent in showing this is not a particularly uncommon or unique word or element to use in respect of the services.

78. Although it is composed as a single word, the earlier mark does appear to comprise of two elements, namely the two English words 'Black' and 'Lane'. However, it is my view that the overall impression resides in the mark as a whole.

79. The later mark is also composed as a single word, namely Blackwing. Again, although composed in this way, there are two identifiable English words held within the single word mark, namely 'Black' and 'wing'. However, again it is my view that the overall impression resides within the mark as a whole.

Visual comparison

80. The opponent has submitted the marks are visually highly similar. The marks coincide visually through the use of the first five letters B-L-A-C-K. The marks are also of an identical length, both comprising 9 letters in total. Both are filed as word marks meaning they may be used in a range of standard fonts and colours. The marks differ in the use of four different letters at the end of each. Although the letter 'N' is in both marks, it takes a different position in each. Overall, I find the marks to be visually similar to just above a medium degree.

Aural comparison

81. The opponent submitted there is a medium level of aural similarity between the marks. Both marks consist of two syllables and coincide through the use of the same identical syllable 'BLACK' at the beginning of the marks. They differ through the use of a second different sounding syllable in each mark, namely 'wiing' and 'laaane'. I accept the opponent's submission that the marks are aurally similar to a medium degree.

Conceptual comparison

82. The opponent submits the conceptual differences between the marks are outweighed by visual and aural similarities.

83. Whilst the opponent's mark as a whole appears to be a made up word, it conveys a concept to the consumer through the use of the two identifiable elements, namely the words black, which conveys a colour, and a lane, that being a small path or a marked out section on a road. Overall, the mark conveys the meaning of a black coloured lane. Within the context of the services, to some this may allude to a taxi lane, that being the lane within which the black vehicles travel, although I accept some consumers may not make this connection.

84. The applicant's mark again appears to be a made-up word, but comprises two identifiable elements, namely the colour black, and a wing as found on a bird or plane. This conveys an image of a black coloured wing.

85. Other than both making reference to the colour black, the marks convey very different concepts. Overall I find the marks to be conceptually dissimilar. If I am wrong, and the marks share a conceptual similarity due to the reference to the colour black in both, I find the marks to be conceptually similar to only a low degree.

Average consumer and the purchasing act

86. 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.

87. 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.”

88. The opponent claims that the average consumer of the goods and services consist of two groups, namely the opponent's professional partners and the general public. I do not find that the partners of the opponent are consumers of their services as relied upon in class 39. These partners take work on for the opponent, and do not make use of the actual transport services themselves.

89. However, I do agree that the consumers will include both the professional public, as well as the general public requiring private transport services. The opponent submits that where the general public are the consumer of the services, they will pay only a low to average degree of attention, and they are unlikely to give them significant thought. On the contrary, the applicant submits that the consumers, who include high profile clients, will pay a high degree of attention to the services. I find the general public as the consumer will consider elements such as the cost, the convenience, the reliability and perhaps the privacy offered by the services, but I do not find this warrants a consistently high degree of attention from the general public when engaging these services. Instead, I find a slightly above average degree of attention will be paid by these consumers. In respect of the professional consumer, who may be seeking these services on behalf of a client or for a corporate event for example, I find the attention might be increased, but whilst there may be occasions where a high degree of attention is paid, generally I find this will sit at above average.

Distinctive character of the earlier trade mark

90. 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).”

91. The earlier mark appears to be a made-up word, although I note this mark is comprised of two elements that are both known to the UK consumer. Both elements separately are arguably allusive of private transport in some way. I accept from the evidence of the market that the use of the word ‘BLACK’ is not particularly unusual for these services in the UK, and from my own understanding of private chauffeur and transport services, this is a colour often associated with the vehicles offering these services in the UK. As mentioned previously, the use of lane will allude to a small path or a lane on a road. However, I must not artificially dissect the mark and find they hold only the distinctiveness of each of their parts alone. It is my view that the earlier mark as a whole, which will convey the meaning of a black lane, or is at worst mildly allusive of a taxi lane to the consumer, holds an average level of distinctiveness in respect of the services.

92. The opponent has claimed that the mark benefits from an enhanced level of distinctiveness in respect of the services. In this respect, I consider the evidence of use that has been filed for this mark in the UK. In particular, I consider the increasing turnover figures for 2014 to 2019, which are evidenced to reach a peak of 12.7 million euros in 2019, in addition to the advertising spend which is over 500,000 euros for the UK in 2019, and also increased steadily since 2014. I also note the increasing number of people visiting the website from the UK, peaking at 673,462 in 2018 and remaining at over 600,000 in 2019, although I note that these will include repeat visits, and the user

numbers given for the UK are much lower. I also acknowledge the awards won by the opponent in respect of its services, including at the British Travel Awards in 2017, and the Business Travel Awards in 2019, the award given by Lux magazine in 2018, as well as the limited press coverage provided. Whilst I note the transport sector in the UK will likely be very large, I find that the private transport and chauffeur services will undoubtedly be smaller as it will be only part of this market. I have not been provided with evidence of the size of the UK market and so it is difficult to put the figures, promotional spend and the press coverage provided into context in respect of the same. However, the use appears to be consistent and at a reasonable level, and I note there has been a reasonable advertising spend and UK based users throughout the relevant period. Whilst I am unable to determine the market share for private transport and chauffeur services held by the opponent, I am willing to accept from the evidence provided that the distinctive character for the mark will have been moderately enhanced through use, to just above an average degree.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

93. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 71 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held in the earlier marks will have an impact on the likelihood of confusion. I must consider that the likelihood of confusion may be increased where the distinctive character held in the earlier mark is high and may be less likely where it is low. I must remember that the distinctive

character of the earlier mark may be inherent, but that it may also be enhanced through use, and that the distinctiveness of the common elements is key.²⁷ I must keep in mind that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods or services are obtained will have a bearing on how likely the average consumer is to be confused.

94. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.²⁸

95. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

96. I have found services relied upon and applied for to be identical, and the marks to be visually similar to a just above a medium degree. I have found the marks to be aurally similar to a medium degree, and to be conceptually dissimilar, or if I am wrong, conceptually similar to only a low degree through the reference to the colour black. I have found the similarities reside at the beginning of the marks where they tend to have more impact on the

²⁷ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

²⁸ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

consumer.²⁹ I have found the earlier mark to be inherently distinctive to an average degree, and I have found from the evidence that this has been moderately enhanced through use to just above an average level. I found the average consumer of the goods to be both the general public and professional consumers, and that the level of attention will range from slightly above average to above average in respect of the services.

97. Having considered all of the factors, and taken into consideration the interdependency principle and the consumers imperfect recollection, I find that despite the identity of the services, the differences between the marks are too great for the consumer not to notice or recollect the differences between them. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that conceptual differences may help to counteract visual and phonetic similarities between the marks. Here I find the different concepts conveyed by the marks will help them to stick in the consumers mind and assist them with remembering the marks in full and recalling the differences. It is my view that there will be no direct confusion between the marks.

98. I therefore consider if there will be a likelihood of indirect confusion between the marks. Three examples of when indirect confusion may occur were set out by Mr Iain Purvis Q.C. in *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10. In this case, Mr Iain Purvis Q.C. set out at paragraph 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).

²⁹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

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

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

99. Whilst I note the examples set out above are not an exhaustive list of instances in which indirect confusion may occur, I find in this instance, none of the above apply. The common element in the mark, namely ‘BLACK’, is not so strikingly distinctive that it will appear to the consumer that only one entity is likely to use this for these services. My conclusion on this is mildly assisted by the market evidence, but it is also my view without reference to the same. I have found the earlier mark holds a slightly above average level of distinctiveness as a whole in respect of the services, but I do not find LANE or WING constitute the addition of a non-distinctive element to the other mark, nor do I find the marks appear to be a logical brand extension of each other. I consider the possibility that consumer may consider BLACKLANE to relate to land transport due to its connection with a lane on a road or a taxi lane, and BLACKWING to be associated with air transport due to its association with an aeroplane through the use of WING. However, even in these instances, with consideration to all of the relevant factors, I do not find that the use of BLACK in both marks will be enough for the consumer to be confused into believing that the use of these different marks on the different types of transport services would derive from the same economic undertaking. Where these are both used on identical transport services, there is no basis on which to find a logical brand extension exists. I find that whilst both marks consist of two identifiable elements, the overall impression of each mark resides in the marks as a whole, and BLACK does not appear as an independent indicator of the origin within each mark. Keeping in mind that the examples above are non-exhaustive, I consider if there may be another reason for the consumer to believe these marks derive from

the same economic undertaking, and I do not find there is one. Should the consumer notice that BLACK is present as the initial element in both marks, I find it will at best be put down to coincidence. I therefore find no likelihood of indirect confusion.

Section 5(3)

Legislation

100. Section 5(3) states:

“(3) A trade mark which-

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

101. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Case Law

102. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

103. To be successful on this ground, firstly the opponent must establish that the marks are similar. Should this be shown, the opponent must go on to prove that they hold a reputation for the earlier mark in respect of a significant part of the public. If it is found both that the marks are similar, and that the earlier mark holds a qualifying reputation, it must then be shown that the result of this reputation, combined with the similarity between the earlier mark and the applied for mark will result in the public establishing a link between the marks. A link may be found on the basis that the later mark brings the earlier mark to mind. Importantly, if all three of these elements have been established, it must then be shown that the result of the link made by the public will manifest in one of the pleaded types of damage. In this instance, the opponent has pleaded that there will be confusion as to the origin of the later mark and that as such the applicant will gain an unfair advantage by “free riding” off the opponent’s reputation. Further, the opponent claims detriment to its reputation on the basis that they have no control over the quality of the applicant’s services, resulting in dilution and tarnishing of the opponent’s earlier mark and reputation. Finally, the use of the applicant’s mark will dilute the capacity of the opponent’s mark to distinguish its goods and services from those of others, and that there will be a change of economic behaviour by the consumer on the basis that they will purchase services under the application either as a result of the direct confusion between the marks or on the misapprehension that they are connected to the opponent’s mark.

104. The relevant date for establishing if the opponent held a reputation in the marks relied upon is the filing date of the contested application, namely 4 December 2019.

Similarity of the marks

105. I have found under section 5(2)(b) that the marks are visually similar to just above a medium degree, and that the marks are aurally similar to a medium

degree. I have found the marks are conceptually dissimilar, or at best conceptually similar to a low degree only.

Reputation

106. The courts have provided guidance on the factors to consider when assessing if a reputation has been established for a trade mark. In *General Motors*, Case C-375/97, the CJEU held that:

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

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

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

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

107. Whilst the opponent relies on its full list of goods and services under this ground, it is clear that its core services, and its best case for showing a

reputation from the evidence will be those in class 39. As these are also the services which are identical to the applicant's, I find it appropriate to consider the opponent's case based on these services and consider the additional services in detail only if it becomes necessary to do so.

108. The opponent has filed evidence of its use by way of turnover figures, advertising figures, and details of its promotional materials. Much of the key evidence filed is outlined in paragraph 92, where it was found that the opponent has moderately enhanced the distinctive character of its mark through use. It is of course appropriate that I consider the evidence afresh under this ground. Firstly, I note again that it is not possible to determine from the evidence the opponent's market share in respect of private transport or chauffeur services. However, the opponent has shown consistent and increasing use of the sign relied upon shown up until the relevant date, with a reasonable turn over in the UK and the EU for at least a period of approximately six years. Further, whilst I am unaware of the size of the EU market for the services, I note there has been a reasonable advertising spend on the mark over the few years, with an EU spent of over 2 million euros in 2018 and 2019, and 1.5 million euros in 2017, and a UK budget of over 600,000 euros in 2018 and over 500,000 euros in 2019. I also note one Facebook and Instagram campaign in 2019 resulted in nearly 3 million 'impressions'³⁰ and over 22 thousand link clicks, and a had a reach of 673,756 in the UK, although I keep in mind the exact date is not given for this 2019 marketing campaign, and so it is possible that it was either run, or that a portion of the reach falls after the relevant date. I note that the awards and press coverage evidenced is not extensive, but nonetheless it adds to the exposure of the mark on the relevant consumer. Geographically, the evidence shows the use of the mark has been made in both the UK and elsewhere in the EU, although the number of territories of the EU are unclear. The services are offered fairly broadly across at least England and Scotland in the UK, and the promotion of the mark appears to be aimed at least at the UK consumer at large on the website and marketing campaigns. Considering all of the factors, whilst the opponent's market share might be unclear, I find from the evidence as a

³⁰ 'Impressions' are not explained in the evidence, and so I find the figures in respect of reach to be more convincing.

whole that the earlier mark will be known by a significant portion of the relevant consumer within at least a substantial part of the territory of the EU. I am unable to find from the evidence provided that the opponent holds a large reputation for these services, but I accept it will hold a modest reputation in respect of *private transport and chauffeur services*.

Link

109. In order to determine if a link will be established between the marks, I must consider the position globally, taking into account all the factors as set out in the case law, including the degree of similarity between the marks and the services, the extent of the overlap between the relevant consumers, and the strength of the reputation and distinctiveness of the earlier marks.

Although I have not found a likelihood of confusion between the marks under section 5(2)(b), this is not determinative that a link will not be made between the marks, and it is enough simply for the later mark to bring the earlier mark to mind.

110. As mentioned above, I found the opponent to hold a modest reputation in respect of its services, which I have found to be identical to the services of the applicant. There will inevitably be an overlap in the consumers of the services on the basis of the identity. I have found the marks to be visually similar to a slightly above medium degree, aurally similar to a medium degree, and conceptually dissimilar, or at best, conceptually similar to a low degree. I have found that the earlier mark holds an average level of inherent distinctiveness and a slightly above average level of distinctiveness in the UK due to the use made of the same. However, I note the slightly above average level of distinctiveness is held in respect of the mark as a whole, and not the word BLACK alone. With consideration to all of the factors, it is my view that the earlier mark will not be brought to mind by the earlier mark simply due to the use of the element BLACK in both marks. This element alone is not particularly distinctive for the services, and the conceptual differences between the marks 'BlackLane' and 'Blackwing' will result in the marks conjuring different pictures in the mind of the consumer. Keeping in mind the

modest reputation held and the identity of the services which will result in a shared user, and considering all of the other factors, I find it very unlikely a link made between the marks in this instance. However, if a link between the marks is made through the use of the word BLACK, I find this will be weak, and so fleeting that it will not result in damage claimed by the opponent, including to its reputation or distinctive character. Further, I do not find it will result in an unfair advantage for the applicant.

111. Although I find this to be the opponent's best case, I have briefly considered if there are circumstances under which the opponent's 5(3) ground may succeed in respect of the remaining goods and services relied upon, where it has failed based on its class 38 services. I do not believe these circumstances to exist, and as such I do not need to consider the opponent's case based on the remaining goods and services in further detail under this ground.

112. As I have not found that a link will be made between the marks, or if it is made, it will not be capable of causing damage or an unfair advantage, the opposition under section 5(3) of the Act must fail.

Section 5(4)(a)

Legislation

113. Section 5(4)(a) states:

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa)

(b)

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

114. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

General principles of Section 5(4)(a)

115. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a *substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of

them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

116. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

117. The opponent claims to have acquired goodwill in the sign BlackLane in the UK, which it states has been used throughout the UK since 2013. I have no evidence that the applicant’s mark has been in use, and as such, it is the date on which the applicant filed the application, namely 4 December 2019, that is relevant to my consideration. This is the date by which the opponent must establish it held goodwill in its earlier sign. Considering the evidence of consistent use and turnover in the UK provided by the opponent between at least 2014 and 2019, in addition to the details of the promotional spend and the limited awards won and press articles provided, I am satisfied that the opponent will hold a moderate level of goodwill in respect of private transport and chauffeur services for the sign BlackLane in the UK. As these services clearly constitute the opponent’s core services, and are identical to the applicant’s services opposed, it is clear these comprise the opponent’s best case, and I do not find it necessary to consider if goodwill is held in respect of the remaining goods and services relied upon by the opponent under this ground.

118. Under section 5(2)(b), I have found there will be no likelihood of confusion with the opponent’s earlier mark, which is identical to the unregistered sign relied upon under this ground, including where the services are identical. In *Comic Enterprises Ltd v Twentieth Century Fox Film*

Corporation [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

119. Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

120. Despite the doubt as to whether the relevant test for misrepresentation may produce a different result to that under 5(2)(b), I have nonetheless considered if I find there will be misrepresentation amongst a substantial number of consumers in respect of the services filed by the applicant. With careful consideration to all of the factors of the case, it is my view that there will not be a misrepresentation amongst a substantial number of consumers that the marks derive from the same or a connected origin based on the shared use of BLACK in each mark. As it is necessary to find misrepresentation in order for a claim under section 5(4)(a) to be successful, I find the opposition fails on this ground.

Conclusion

121. The opposition has failed, and subject to a successful appeal, the application may proceed to registration in its entirety.

COSTS

The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £1500 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the TM7 filed and preparing the TM8 and counterstatement:	£400
Considering the evidence and filing its evidence:	£700
Preparing and filing its written submissions:	£400
Total	£1500

122. I therefore order Blacklane GmbH to pay Private Car Services Limited the sum of £1500. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 27th day of July 2021

Rosie Le Breton
For the Registrar

Annex A

Class 9: 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; CDs, DVDs and other digital recording media; Mechanisms for coin-operated apparatus; Cash registers, calculating machines and data-processing equipment; Computer software; Fire-extinguishing apparatus; Computer software; Downloadable electronic publications; Spectacle frames; Pince-nez chains; Mechanical signs.

Class 38: Telecommunications.

Class 39: Transport; Packaging and storage of goods; Travel arrangement; Chauffeur services; Transport of persons.

Class 42: Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software.