

O/572/22

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3601620
BY IRELANDIA AVIATION LIMITED
TO REGISTER THE TRADE MARK:**



IN CLASSES 35 & 39

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 425540
BY AVORIS RETAIL DIVISION S.L.**

Background and pleadings

1. On 11 October 2019,¹ Irelandia Aviation Limited (“the applicant”) applied to register the trade mark displayed on the cover page of this decision in the UK, under number 3601620 (“the contested mark”). The contested mark was published for opposition purposes on 14 May 2021. Registration is sought for the following services:

Class 35: Advertising, marketing and promotional services; personnel services; business organisation and management; information and advisory services relating to the aforesaid.

Class 39: Transport; packaging and storage of goods; travel and passenger transportation; airline services; travel arrangement services; travel advisory services; airport check-in services; air transport services; transport and travel reservation services; provision of flight information; information and advisory services relating to the aforesaid.

2. On 14 July 2021, AVORIS Retail Division S.L. (“the opponent”) filed a notice of opposition. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the services of the application. The opponent relies upon its comparable UK trade mark number



916932295,²

¹ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 59 of the Withdrawal Agreement between the UK and EU, applications for EUTMs made before the end of the transition period that had received a filing date can form the basis of a UK application with the same filing date as the corresponding EUTM, provided they were filed within 9 months of the end of the transition period. The applicant’s EUTM 18135514 number was filed at the EUIPO on 11 October 2019, whereas its UK application was filed on 26 February 2021. Accordingly, the UK application was given the same filing date as its EUTM.

² Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent’s EUTM number 16932295 being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original EUTM filing date.

earlier mark was filed on 29 June 2017 and became registered on 31 July 2019 in respect of the following goods and services, all of which are relied upon for the purposes of the opposition:

Class 16: Paper

Class 39: Packaging and storage of goods

3. Given the respective filing dates, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. Consequently, the opponent may rely upon all of the goods and services for which the earlier mark is registered without having to establish genuine use.
4. The opponent essentially argues that the respective goods and services are identical or similar and that the marks are similar, giving rise to a likelihood of confusion.
5. The applicant filed a counterstatement denying the ground of opposition. The applicant denies that the competing marks are similar and that the respective goods and services are identical or similar. It also disputes the existence of a likelihood of confusion.
6. The opponent is professionally represented by Haseltine Lake Kempner LLP, whereas the applicant is professionally represented by FRKelly. Only the opponent filed evidence in these proceedings. Both parties were given the option of an oral hearing, though neither asked to be heard on this matter. Only the opponent filed written submissions in lieu of an oral hearing. Whilst I do not intend to summarise these, I have taken them into consideration and will refer to them as and where appropriate during this decision. This decision is taken following a careful perusal of the papers, keeping in mind all of the evidence and submissions.
7. 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 case law.

Decision

Section 5(2)(b)

8. Sections 5(2)(b) and 5A of the Act read 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”.

“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

9. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-

120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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

10. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

11. Put simply, this means that whether the goods or services are in the same or different classes is not decisive in determining whether they are similar or dissimilar. Therefore, what matters is the actual goods or services at issue and whether they are similar or not having regard to the case law that follows.

12. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, [...] all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

14. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).
15. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that 'complementary' means:

"[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

16. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C., sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes",

whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

17. The goods to be compared are outlined at paragraphs 1 and 2 above.

Class 35

18. In my view, the applicant's services in class 35 differ in nature, method of use and intended purpose to the opponent's class 39 services, as the applicant's services are to provide advertising to promote the goods and services of a company or an individual, or to provide business management advice, whereas the opponent's services are to package goods, typically for businesses, and store them in an appropriate environment before they are collected or distributed. Trade channels for these services are different as consumers would not typically be able to purchase advertising services or business organisation and management services in the same location that they could purchase packaging and storage services; these services are not usually provided by the same undertakings. The respective services are not competitive in nature, nor do they have a complimentary relationship as they are not important or indispensable to one another in such a way that consumers would believe that they are derived from the same undertaking. Users may overlap but this is at far too general a level to engage similarity overall. Therefore, I find that these services are dissimilar.

19. The applicant's services in class 35 also differ to the opponent's class 16 term, "paper", as the opponent's term is a good, whilst the applicant's terms relate to services, with goods and services being intrinsically different in nature. The method of use and intended purpose also differ as paper is to be written or printed on; conversely, advertising services are for the promotion of goods and services for either individuals or businesses with the intention of gaining more interest in those goods or services. Paper may be needed by advertising companies or business management companies to conduct their services; however, the average

consumer would not expect these companies to produce the paper themselves, therefore, complementarity will not be engaged. Neither are the goods and services in competition. Similarly, trade channels would also differ as advertising services would not typically sell paper, or vice versa. Users may overlap, but again this is at such a generalised level that similarity would not be engaged. Overall, I find that these goods and services are dissimilar.

Class 39

20. To my mind, the opponent's class 39 term "packaging and storage of goods" represents its strongest position against the applicant's class 39 terms. As such, this is the term I shall consider.

Packaging and storage of goods

21. The term "packaging and storage of goods" is explicitly named in both the applicant's and the opponent's specifications and is therefore identical.

Information and advisory services relating to the packaging and storage of goods

22. The above services, although related to packaging and storage of goods, differ in nature, method of use and intended purpose as the applicant's services are to provide information and advice, typically through sales representatives or customer service personnel, for the purpose of gaining a better understanding of the process. However, the nature of the opponent's services is to physically pack and store goods. Nevertheless, these services would be complementary to each other as they are important to one another in such a way that consumers are likely to believe that they derive from the same undertakings. The trade channels would be the same, as companies that offer packaging and storage services will also offer related information and advisory services. Users are also likely to be the same. Overall, I find that these services are similar to at least a medium degree.

Transport; airline services; air transport services; information and advisory services relating to the aforesaid

23. Before considering the similarity of these services I note that the opponent has provided, under Exhibit MC3, information from a Wikipedia page relating to cargo airlines. As Wikipedia is crowdsourced, i.e. the information can be created and edited by anyone, I shall place little evidential weight upon this exhibit.

24. The above terms all describe forms of transportation services which are concerned with transporting people or goods from one place to another. As such, they differ in nature, method of use and intended purpose to the opponent's services which are to package and store goods before they can be distributed. However, their trade channels may overlap, and it is not uncommon for undertakings to offer both the opponent's packaging/storage services and the applicant's transport services in relation to goods. There is also a degree of complementarity between the services, since the opponent's services are, in some circumstances, important to the operation of the applicant's services and consumers are likely to believe that the responsibility for them lies with the same undertaking. For example, packaging and storage companies often also distribute goods, and transport companies often also package and store goods. There is no meaningful competition between the services. Users are likely to overlap; for example, a business that requires packaging and storage services is also likely to use transportation services so that its products can reach the target market. Overall, I find that the level of similarity between these services is low.

Transport reservation services; provision of flight information; information and advisory services relating to the aforesaid

25. The applicant's above terms relate to services required for the use of transportation; they are to provide information relating to transportation or to provide a service to reserve transportation for customers. They differ in nature, method of use and intended purpose from the opponent's service which is to pack and store goods. Trade channels would also be different as undertakings that pack and store goods do not typically offer transport reservation services or provision of flight information services, or vice versa. The respective services are not complementary as customers are not likely to assume that the responsibility for both these services lies with the same undertaking. There is no competition

between the services as the opponent's services cannot fulfil the needs of a consumer looking to reserve transportation and vice versa. Users may overlap, but this is not enough to engage similarity overall. As a result, I find that these services are dissimilar.

Travel and passenger transportation; travel arrangement services; travel advisory services; airport check-in services; information and advisory services relating to the aforesaid

26. The above terms and the opponent's services differ in nature, method of use and intended purpose as the applicant's services relate to the passage of people/passengers, whereas the opponent's services relate to packaging and storage of goods. In the opponent's witness statement,³ it is said that "freight and cargo transportation is also commonly provided by passenger airlines". Examples have also been provided. At its highest, this evidence suggests that some large airlines, such as American Airlines, Cathays Pacific, Emirates and Air Canada may have cargo handling divisions (as subsidiary companies that are part of the overall corporate structure). However, I do not consider that this evidence demonstrates that it is typical in trade for passenger travel services to be provided by the same undertakings that provide services for the packaging and storage of goods. Similarly, the opponent has provided evidence that airport check-in services are provided by the same companies that provide ground handling services for cargo airlines. However, this does not demonstrate that airport check-in services would be provided by the same company that provides packing and storage services. Consequently, in my view, the opposing services differ in trade channels, as a passenger wanting to travel across the world, even for business, would not go to the same company to book a travel ticket that businesses would use if they were seeking to package their goods. Neither are the services competitive in nature. Similarly, the services are not complementary, as they are not important or indispensable to one another in such a way that consumers are likely to believe that they are provided by the same undertakings. Any temporary storage of goods, for example, passenger luggage that has to be checked in before flight departure,

³ Paragraph 4

is provided as part of the overall service. As a result, any superficial overlap that this may create is not sufficient as the core services provided are distinct. Users in the main will differ, as predominately, users of packing and storage services will be business users, whereas for passenger travel services users are likely to be the general public. Even where they do overlap, it will be at far too broad a level to engage similarity overall. Therefore, I find that these services are dissimilar.

27. As some degree of similarity between the goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition must fail against services of the application that I have found to be dissimilar, namely:⁴

Class 35: Advertising, marketing and promotional services; personnel services; business organisation and management; information and advisory services relating to the aforesaid.

Class 39: Travel and passenger transportation; travel arrangement services; travel advisory services; airport check-in services; transport and travel reservation services; provision of flight information; information and advisory services relating to the aforesaid.

The average consumer and the nature of the purchasing act

28. 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.

⁴ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49.

29. 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.”

30. In line with my approach to the comparison of the respective goods and services, my assessment below will focus on the average consumer of the class 39 services in respect of which I have found some similarity.

31. I find that the relevant consumers of the services at issue are likely to be business users. On average, business users are likely to purchase these services rather frequently. The price of the services is likely to vary. For example, the price of the purchase will range depending on the type and combination of services required to meet the demands for each order. However, overall, they are relatively moderate purchases. I find that the purchasing process is likely to be more measured, with consideration given to the business needs for a particular order. Businesses will need to consider factors such as quality of service, convenience, and whether it is suitable to meet the business's demands, in particular considering: size and space demands and whether there are varying temperature facilities to store and transport particular items. However, given the frequency that businesses would use these services the purchasing process it is not likely to be the most careful. Taking the above factors into account, I find that businesses will demonstrate an above average level of attention in respect of these services. The services are likely to be advertised in magazines, on the internet and at trade shows. Overall, I am of the view that the purchasing process would be predominantly visual in nature. However, I do not discount aural considerations entirely as it is possible

that the purchasing of these kinds of services would involve discussions with sales representatives at trade shows or telephone enquiries.

Distinctive character of the earlier mark

32. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. 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).”

33. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion, the more distinctive the earlier mark, the greater the likelihood of confusion.
34. Further, although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use (nor was it required to do so). Consequently, I have only the inherent positions to consider.
35. The earlier mark encompasses the words “viva tours” all in lower case, with the first word in red and the second word in blue. The word “viva” is the larger of the two words, with the word “tours” in smaller font positioned under the last two letters of the word “viva”. The distinctive character of the earlier mark lies predominantly in the word “viva” in large, standardised font, which has no easily recognisable meaning in English and would be perceived as an invented word. The word “tours” has an ordinary dictionary definition meaning “a visit to a place or area, especially one during which you look around the place or area and learn about it”⁵ or “a journey made for pleasure, especially as a holiday, visiting several different places in an area”.⁶ As such, it is not descriptive or allusive of the opponent’s packaging and storage services, though it is less distinctive than the word “viva”. In addition to the words, the mark includes a yellow dot positioned at the bottom of the letter “i”, which provides a contribution, though plays a much lesser role. The use of colour within the mark also provides a contribution. The mark as a whole is neither descriptive nor allusive of the services in respect of which it is registered. Overall, I consider that the earlier mark possesses a high degree of inherent distinctive character.

⁵ <https://dictionary.cambridge.org/dictionary/english/tour>

⁶ Ibid

Comparison of the marks

36. It is clear from *Sabel BV v. Puma AG*⁷ that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

“34. [...] 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.”

37. It would therefore be wrong to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create.

38. The respective trade marks are shown below:

Earlier mark	Contested mark
	

⁷ Case C-251/95, paragraph 23

Overall impressions

39. The earlier mark encompasses the words “viva tours” all in lower case and in standardised font. The word “viva” is presented in large, red font, whereas the word “tours” is in smaller font in blue and positioned below the last two letters of “viva”. The mark also contains a yellow dot positioned below, rather than above, the “i”. The overall impression is dominated by the word “viva”, given its size and positioning. The word “tours” also contributes to the overall impression, though plays a lesser role. The yellow dot also provides a contribution, as does the use of colour. However, these elements would be perceived as decorative and, therefore, play lesser roles.

40. The contested mark contains the words “Viva air”, which is presented in standardised font. The word “Viva” at the beginning of the mark is in large font, while the word “air” is positioned alongside it in a much smaller font. Above the word “air” are three different-sized circles clustered together, the largest in yellow, the medium-sized in blue, and the smallest in red. The mark is dominated by the first word “Viva”, given its size and positioning within the mark. The word “air” has an impact and contributes to the overall impression, but to a lesser degree. The figurative circles and the use of colour also contribute to the overall impression; however, as they are likely to be seen as decorative, they play a lesser role.

Visual comparison

41. The competing marks are similar as they both contain the word “viva” at the beginning of the marks, a position where the attention of the consumer is usually directed. The word “viva” is presented identically in both marks, i.e. in a large, red, standardised font, and in lower case (with the exception of the first letter in the applicant’s mark). The competing marks differ as they include different second words, in different positions within the respective marks and in different case. The earlier mark contains the second word “tours”, in lower case, placed beneath the last two letters of the word “viva”, whereas the contested mark contains the second word “air”, positioned next to the word “Viva”, in smaller letters and in upper case. However, there is a degree of commonality in the way that the second words are

displayed within the respective marks, as they both appear significantly smaller than the shared word “viva” and they are both presented in the same blue colour. The marks also differ with regards to the shape devices. In the earlier mark a yellow dot appears at the bottom of the letter “i” in “viva”; by contrast, the contested mark contains three circular devices in varying sizes that appear to the side of the word “Viva” and above the smaller word “air”. These three shape devices share the same colour scheme found in the earlier mark: i.e. red for the smaller circle, blue for the medium sized circle and yellow (albeit a different shade of yellow) for the larger circle. Taking into account the overall impressions, I find that the competing marks are visually similar to between a medium and high degree.

Aural comparison

42. The competing marks both comprise three syllables i.e. “VEE-VA-TOURS” in the earlier marks and “VEE-VA-AIR” in the contested mark. Consumers will make no attempt to articulate the dot/circular devices in each of the respective marks. The first two syllables are, therefore, identical; however, the additional syllable at the end of the marks varies. As a result, I find that the marks are similar to between a medium and high degree.

Conceptual comparison

43. As noted above, both marks contain the word “viva”. Viva is defined as either a noun or an exclamation. As a noun it is defined as “a cry of ‘viva’ as a salute or cheer”⁸ and as an exclamation it means “long live! (used to express acclaim or support for a specified person or thing)”.⁹ Whilst I accept it is possible that some consumers will know and understand the meaning of “viva”, in my opinion, such individuals would not be great enough in number to constitute a significant proportion of average consumers. Rather, it is my view that the average consumer will perceive it as an invented word with no meaning. The word “tour” in the earlier mark is defined as “a visit to a place or area, especially one during which you look

⁸ <https://www.lexico.com/definition/viva>

⁹ *ibid*

around the place or area and learn about it”¹⁰ or “a journey made for pleasure, especially as a holiday, visiting several different places in an area”.¹¹ The word “air” in the contested mark is defined as “the mixture of gases which forms the Earth's atmosphere and which we breathe.”¹² Both words are meaningful in the context of transport. The word “viva”, within both marks, is conceptually neutral. However, the respective marks also contain additional words which would be easily understood. Therefore, each of the marks as a whole provides a different meaning, i.e. one associated with tours and one associated with air. Insofar as the marks provide a discernible meaning, there is an element of conceptual difference. Therefore, overall, I find that the competing marks are conceptually dissimilar.

Likelihood of confusion

44. Whether there is a likelihood of confusion must be assessed globally, taking into account a number of factors. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services, and vice versa. It is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be aware of the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

45. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods and services down to the responsible undertakings being the same or related.

¹⁰ <https://dictionary.cambridge.org/dictionary/english/tour>

¹¹ *Ibid*

¹² <https://www.collinsdictionary.com/dictionary/english/air>

46. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

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

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

47. These examples are not exhaustive but provide helpful focus.
48. I have found that the applicant’s services are either identical, or similar to various degrees to those of the earlier mark. I have found that the average consumer of the services will predominately be business users who will pay an above average degree of attention. I have found that the purchasing process will be largely visual, however, I have not discounted aural considerations. The overall impressions of the competing marks are dominated by the word “viva”, with the additional elements playing lesser roles. I have found that the earlier mark and the contested mark are visually and aurally similar to between a medium and high degree, and conceptually dissimilar. I have also found that the earlier mark has a high level of inherent distinctive character.
49. The marks differ in their respective second words, i.e. “tours” and “air”, which appear in different positions within the competing marks. The circular devices also differ and appear in different positions. However, in my opinion, taking into account the overall levels of similarity between the marks, those differences are likely to be insufficient to distinguish between the marks, especially when considering the commonality of the identical word “viva” which is highly distinctive and dominates the overall impressions of the competing marks. Furthermore, the word “viva” is presented almost identically, appearing in large, standardised font. In addition, the colour pattern of the two words within the contested mark mirrors that of the original, i.e. red for the first larger word and blue for the second smaller word, with yellow present in the figurative elements of each of the marks. In my opinion, these similarities outweigh any conceptual differences between the marks. This is particularly the case, since the conceptual differences arise as a result of the second words, i.e. “air” and “tours”, which each play a lesser role within the marks. In my judgement, taking into account imperfect recollection, it is entirely feasible that, given the marks similar visual appearance and common use of the highly distinctive word “viva”, even consumers paying an above average level of attention during the purchasing process would misremember the marks for one another,

and fail to recall the different respective second words due to their similar small sized font and identical colouring. Consequently, I find that there is a likelihood of direct confusion, even on those services that I have found similar only to a low degree under the principle of interdependency.

50. In the event I am wrong about direct confusion, I will now go on to consider indirect confusion. I bear in mind that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.¹³

51. Even if consumers recognise that there are differences between the competing marks, they will also identify the identical word “viva” which dominates the respective overall impressions. Whether consciously or unconsciously, this will lead the average consumer through the mental process described in *L.A. Sugar*. The word “viva”, as an invented word, is so strikingly distinctive that consumers are likely to believe that only the opponent will be using it in a trade mark. In my view, this is even more likely to be the case as both marks contain the same colour scheme and adopt a similar approach in the size and format used to represent corresponding elements of the marks. Taking all this into account, I am satisfied that consumers, paying even an above average degree of attention, would assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the highly distinctive shared element “viva” and the identical colour scheme. Consequently, I consider there to be a likelihood of indirect confusion between the marks, even on services that are similar only to a low degree, taking into account the interdependency principle.

Conclusion

52. The opposition under section 5(2)(b) of the Act has been partially successful. Subject to any appeal against my decision, the application will be refused in respect of the following services:

¹³ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

Class 39: Packaging and storing of goods; transport; airline services; air transport services; information and advisory services relating to the aforesaid.

53. The application will proceed to registration in relation to the following services, against which the opposition has failed:

Class 35: Advertising, marketing and promotional services; personnel services; business organisation and management; information and advisory services relating to the aforesaid.

Class 39: Travel and passenger transportation; travel arrangement services; travel advisory services; airport check-in services; transport and travel reservation services; provision of flight information; information and advisory services relating to the aforesaid.

Costs

54. Both parties have been successful in part, however the applicant has enjoyed a greater measure of success. Therefore, the applicant is entitled to a contribution towards their costs based upon the scale published in Annex A of Tribunal Practice Notice 2 of 2016, with an appropriate reduction to reflect the opponent's degree of success. Applying this guidance, in the circumstances I award the applicant the sum of **£250** as a contribution toward the costs of reviewing the opponent's notice of opposition and preparing a counterstatement.

55. Accordingly, I hereby order AVORIS Retail Division S.L. to pay Irelandia Aviation Limited the sum of **£250**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of July 2022

Sarah Wallace
For the Registrar