

O/0174/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3655237
IN THE NAME OF IGO ANYWHERE LIMITED
FOR THE SERIES OF TWO TRADE MARKS**

#iGO Anywhere

#iGO Cars

IN CLASS 39

AND

**THE OPPOSITION THERETO UNDER NUMBER 428208
BY TRANSPORT FOR GREATER MANCHESTER**

Background and pleadings

1. On 14 June 2021, igo anywhere limited (“the applicant”) filed an application for the series of two trade marks shown on the cover page of this decision (number 3655237) in Class 39 for *Transport; Car transport; Transport services; Taxi transport; Passenger transport; Transport of persons.*

2. The application was published on 13 August 2021 and opposed by Transport for Greater Manchester (“the opponent”) under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following earlier trade mark registration for its section 5(2)(b) ground, as follows:

2566139



Filing date: 3 December 2010; registration date: 10 June 2011.

Class 9: *Concessionary travel passes in the form of smart cards for use within the passenger transport area of Greater Manchester.*

Class 16: *Concessionary travel passes for use within the passenger transport area of Greater Manchester.*

3. Under section 5(2)(b) of the Act, the opponent claims that the parties’ goods and services are similar because they are directed at the same customers, serve the same purpose, are commonly provided by the same undertakings and are complementary. The opponent claims that the marks are similar because the dominant elements of the marks are visually, aurally and conceptually identical. It claims that these factors and

the enhanced distinctiveness of its mark through the use made of it leads to a likelihood of confusion.

4. Under section 5(4)(a) of the Act, the opponent claims that it has used the sign igo in Greater Manchester since 2011 in relation to *travel and passenger transportation services; travel passes*. The opponent claims that its goodwill in the business distinguished by its sign entitles it to prevent the use of the application under the law of passing off.

5. The applicant filed a defence and counterstatement, denying the grounds of opposition. It puts the opponent to proof that it has used its mark.

6. The opponent is professionally represented by Marks & Clerk LLP. The applicant represents itself. Only the opponent filed evidence, which was accompanied by written submissions. Neither party requested a hearing, and neither filed written submissions in lieu of a hearing. I make this decision after a careful reading of all the papers, referring to them as necessary.

Evidence

7. The opponent has filed evidence from Mr Mike Mellor, who has been the opponent's Head of Commercial since 2010.¹ His evidence is aimed at proving that the earlier mark and sign have been used. I will begin by assessing whether, and to what extent, the evidence supports the opponent's statement that it has made genuine use of its mark in relation to the goods for which it is registered. The relevant period for this purpose is the five years ending on the filing date of the contested application: 15 June 2016 to 14 June 2021.

8. Section 6A of the Act states:

“(1) This section applies where

¹ Witness statement dated 28 July 2022 and exhibits.

- (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), (aa) 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)-(5A) [Repealed]

(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.”

9. The onus is on the opponent, as the proprietor of the earlier mark, to show genuine use because Section 100 of the Act states:

“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.”

10. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch), Arnold J (as he then was) summarised the law relating to genuine use, as follows:²

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung 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*

² “CJEU” is the abbreviation for the Court of Justice of the European Union. 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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], [2014] ETMR, Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others 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].”

11. Mr Mellor explains that the opponent is the local government body responsible for delivering and co-ordinating public travel services throughout the Greater Manchester region, operating on a not-for-profit basis. He states that the opponent has used ‘igo’ in relation to travel services for children; in particular, travel cards that enable children between the ages of 5 and 16, who live or go to school within Greater Manchester, to use public transport in that area. For children from 11 to 16, the travel cards constitute proof of age to use child tickets on buses and trams in the area. Mr Mellor states that the ‘igo’ card was one of the first cards to be issued by the opponent which contained a chip with ‘smart’ capabilities.

12. Mr Mellor provides the following figures for the cards which he states have been branded with the mark:

Year	IGO Cards Issued	Value
2017	16,962	£169,620
2018	18,904	£189,040
2019	27,308	£273,080
2020	19,247	£192,470
2021	19,112	£191,120
Total	101,533	£1,015,330

13. I have not included the 2022 figures because the contested application was filed in 2021. Similarly, I will not take into account other evidence which emanates from 2022.

14. Mr Mellor explains that the travel pass is obtained by parents/guardians completing an application form, of which there have been different versions over the years. Exhibit MM1 comprises examples of proofs of the forms produced in 2017, 2018, 2019, 2020 and 2021, with the different versions being dated accordingly. The earlier mark appears on a picture of a travel card on the front page of each of the

forms. Exhibit MM2 comprises examples of redacted application forms submitted to the opponent between 2017 and 2022. Mr Mellor states that whilst the documents themselves are undated, he can confirm, having cross-referenced the opponent's confidential records database, that the travel passes were applied for/issued in those years. The earlier mark, as for the proofs of the forms, is shown on the cover page of the application forms which were submitted to the opponent by customers. Once the opponent had approved the application, the opponent issued the passes to the applicants via card carrier letters, or issued letters requiring further information. Exhibit MM3 comprises redacted examples of such letters produced in 2017, 2018, 2019, 2020 and 2021. The mark is referred to in plain lower case letters.

15. Exhibit MM4 comprises examples of emails used in the various publicity campaigns in 2019 and 2020. The earlier mark is shown. It is also referred to in the text as "iGo":

27/6/19



Hello,

As an iGo cardholder we need to let you know about some changes which will affect how you use your iGo card.

Each time you board a bus and touch-in at the card reader or use Metrolink and touch-in/out at the card readers on stop, you will automatically be entered into a monthly prize draw. The prize each month will be a £50 High Street Voucher.

You are receiving this email because you are an iGo cardholder and due to the introduction of the monthly prize draw, iGo's terms and conditions have changed.

To view the updated terms and conditions go to www.tfgm.com/igo.

Please note this is NOT a marketing email.


If you want to find out more about the iGo prize draw you can view the terms and conditions at www.tfgm.com/privacy-policy/competitions.

16. I note that the card is used via a 'touch-in' or 'touch-out' card reader.

17. Exhibit MM5 comprises an example of the 2020 information poster for 'igo' fares for bus operators and schools:

Important driver information

New TfGM school bus tickets for igo from September 2020




- **TfGM schools weekly ticket £7.60** – new price and can now be loaded onto an igo card (previously available as a paper ticket)
- **TfGM carnet ticket (10 single trips) £10** – this is a new ticket that can only be loaded onto an igo card. (The customer will have 28 days to use all 10 trips.)

These tickets are only available on dedicated TfGM school services.

Customers should touch-in for all journeys. If a valid ticket is loaded, the smart reader will accept the card for travel.

The card itself does not provide any travel entitlement and it cannot be used as a flash pass.

 Transport for Greater Manchester [tfgm.com/igo](https://www.tfgm.com/igo)

18. I note from this that the weekly ticket was previously available as a paper ticket and that the carnet ticket is a new ticket that is loaded onto an igo card. A similar version of the sample travel card shown in the poster is also shown on promotional

literature used during 2018 to 2021, with the earlier mark on the travel card. Exhibit MM9 comprises screenshots from the opponent's Twitter account from 2018, 2019 and 2020, showing the mark on travel passes, held by cartoon characters. Screenshots from the opponent's website are provided, using the WayBack Machine (internet archive), from 2018 to 2021.³ The mark appears in plain letters, in relation to the travel pass.

19. Mr Mellor states that, as a not-for-profit organisation, the opponent does not spend a lot on marketing. There was a paid media promotion in 2018 at a cost of £4,722. Between 2019 and 2021, the opponent carried out various email and poster campaigns, and issued press releases for parents' information in readiness for new academic years. I note, for example, that on 20 August 2020, 50,992 "IGO holders" were emailed.

20. The earlier mark appears in its registered form on and in relation to goods sold by the opponent. I am satisfied that the evidence shows the mark has been used in relation to goods covered by the registration, in the UK, during the relevant period. Use by a non-profit making association can constitute genuine use.⁴ Whilst not on a grand scale, the level of use has been consistent over the relevant period. The use is warranted in the economic sector concerned to maintain or create a share in the market for goods covered by the earlier mark. Taking the evidence in the round, I conclude that the opponent has made genuine use of its mark.

21. The next task is to determine in relation to which goods the mark has been used and, if that use is not on everything within the registered specifications, or a reasonable range of goods within the terms in the specifications, to decide upon a reduced, fair specification represented by the use. In so doing, I am guided by *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*, in which Mr Justice Carr summed up the law relating to partial revocation as follows:⁵

³ Exhibit MM7.

⁴ *Verein* at [16]-[23].

⁵ [2016] EWHC 3103 (Ch).

“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.”

22. There is nothing in the evidence that shows that the mark was used in relation to the goods in class 16 during the relevant period. The use relates to the class 9 goods: smart travel passes which can be scanned. Some of the evidence refers to the transition to smart cards, but there is nothing to show that this took place at a point when paper cards or tickets were still in use during the relevant period. I find that the opponent cannot rely upon the goods in class 16, but that it can rely upon all the goods in its class 9 specification. The use has clearly been in relation to smart cards in the Greater Manchester area. Bearing in mind the court's guidance at point (vii) of *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool)*, set out in the previous paragraph of this decision, it would be pernicky to frame that use as only in relation to schoolchildren.

Section 5(2)(b) of the Act

23. Section 5(2)(b) states:

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

(a) ...

(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.”

24. Section 5A states:

“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.”⁶

25. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are taken from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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;

⁶ This section also applies to the ground raised under section 5(4)(a) of the Act.

(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

26. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all

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

27. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

28. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16, Jacob J. (as he then was) stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

29. The parties’ respective goods and services to be compared in accordance with the above caselaw are:

Earlier mark	Application
Class 9: <i>Concessionary travel passes in the form of smart cards for use within the passenger transport area of Greater Manchester.</i>	Class 39: <i>Transport; Car transport; Transport services; Taxi transport; Passenger transport; Transport of persons.</i>

30. In its counterstatement, the applicant points out that the parties’ goods and services are in different classes; that the opponent’s website is clearly not related to class 39; that the opponent’s mark “relates to Manchester bus passes for school children”; and that the application is for a private hire/taxi company licenced in Nottingham. The applicant’s specification is broadly cast. It is not just private hire/taxis, in Nottingham. The applicant’s current mode of business and its business

plans play no part in the assessment under section 5(2)(b) of the Act. This is because a trade mark application (and registration) is a claim to a piece of legal property. The level of protection provided is normally based on a notional assessment of the likelihood of confusion between the earlier trade mark and the later mark. The opponent's earlier mark is entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of the earlier mark for the goods on which I have found genuine use (the class 9 goods). The comparison is made on the basis of notional use of the terms in both parties' specifications.

31. Marks are protected against the use of the same or similar marks in relation to goods or services which are the same or similar, if there is a likelihood of confusion. Goods and services can be similar, even if in different classes, as provided for in section 60A of the Act:

“60A Similarity of goods and services

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

(2)

(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.

(3) 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."

32. That goods and services can be similar, even if in different classes, is therefore the law. A helpful explanation of why the law works this way can be found in *Keystone*

IEA Limited v Keystone Financial Limited.⁷ Mr Daniel Alexander KC, sitting as the Appointed Person stated:

“13. First, the appellant considers that the effect of the hearing officer’s decision is that the opponent is entitled to protection in respect of a wider range of services than those in respect of which the mark has been registered or used. That is true in the sense that a registered trade mark gives protection against registration (and use) of a confusingly similar mark not only in relation to identical goods or services but also in relation to similar goods and services, in the circumstances stated in the Act. That is therefore not a valid objection to the hearing officer’s decision. It is a feature of the law. Section 5(2)(b) of the Act provides that a (later) 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.” Once a finding has been made that there is similarity of services and a likelihood of confusion as a result of the similarity of the services and the respective marks, the Act prevents registration of a later mark to that extent. The appellant may have misunderstood the IPO Guidance referred to in the Grounds of Appeal. That states that a “trade mark will only be protected for the goods and/or services you select in your application.” It is correct so far as registration of the mark is concerned but does not have any impact on the ability of the mark to be asserted in opposition proceedings against registration in respect of other goods and/or services in the circumstances provided for in the Act.”

33. Returning to the comparison of goods and services, the applicant’s *transport and transport services* can be considered together against the opponent’s goods because these terms are the same in terms of coverage. The same is true of the applicant’s *passenger transport and transport of persons*.

⁷ BL O/0024/23 [Trade Mark Appeals Decision O/0024/23 \(ipo.gov.uk\)](https://ipo.gov.uk/trademark-appeals/decisions/002423/)

Transport; Transport services; Passenger transport; Transport of persons.

34. These four terms are susceptible to the same reasoning. The opponent's goods and the applicant's services are clearly different in nature because the goods are tangible. They differ in purpose because the goods are for accessing discounted travel, whereas the services are for transport or travel. Transport and transport services includes passenger transport. Passengers use travel cards. The users of the services and the goods are the same.

35. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court of the European Union ("GC") stated that "complementary" means:

"82 ... there is a close connection between [the goods], 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..."⁸

36. The channels of trade, or the places from which the services and the goods are obtained, are likely to be the same. For instance, if one wished to buy a obtain a local bus pass, that would be sourced from the local bus company. The provider of the pass and the provider of the bus transport service would be the same. The pass and the transport/bus service would be complementary. There would be no point in a travel pass without the transport service.

Car transport; Taxi transport;

37. The above analysis also applies to these services. There is no reason why concessionary travel would not also be available to people hiring cars and taxis. Schoolchildren are conveyed in cars and taxis where there are no other forms of public transport or school buses. Even without considering schoolchildren, concessionary travel is available to people of different ages and other qualifying categories. The proof of eligibility and access to the service is likely to be the use of a card or pass

⁸ In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods and services.

and, as the opponent's evidence shows, smart cards are replacing the use of traditional paper cards and tickets.

38. I find that all of the applicant's services are similar to a medium degree to the opponent's goods. It follows that, even if I had found a fair specification for the earlier mark to be 'concessionary travel passes in the form of smart cards for schoolchildren for use within the passenger transport area of Greater Manchester', the result of the comparison would have been the same.

The average consumer and the purchasing process


39. As the caselaw cited above in paragraph 25 indicates, it is necessary to decide who the average consumer is for the parties' goods and services and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."⁹ 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*.

40. The average consumer for the parties' goods and services is a member of the general public. The purchasing process for the opponent's goods is likely to be primarily visual: online or by filling in a form. However, the goods may also be purchased orally, via the telephone or through a public transport office or kiosk. The applicant's services are likely to be selected via a website, mobile application, or by telephone. The level of attention paid to the applicant's services will vary. For example, the service sought could be a quick taxi into town, or could be hire of transport to get to an airport in time for a flight. The level of attention paid to the purchase will be at least average. The same is so for the opponent's goods. It will be important to ensure that the travel pass covers what is needed by the purchaser, for all the services, routes and for the duration required.

⁹ *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).

Comparison of marks

41. The marks to be compared are:

The opponent's mark	The applicant's marks
	<p data-bbox="916 611 1158 701">#iGO Anywhere #iGO Cars</p>

42. *Sabel BV v. Puma AG* 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 CJEU 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.”

43. 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.

44. The application is for a series of two marks. In *Comic Enterprises Ltd v. Twentieth Century Fox Film Corporation*, Kitchin L.J. (as he then was) explained that:¹⁰

¹⁰ [2016] EWCA Civ 41.

“...An application for the registration of a series of trade marks is an application to register a bundle of trade marks under a single reference number. Each of the marks in the series must satisfy the requirements of the 1994 Act. If the application is accepted and any opposition proceedings have been resolved in favour of the applicant, then the series of marks will be registered, but it will remain what it always was, namely a bundle of different marks, albeit now registered under the same reference number.”

45. Kitchen L.J. went on to say that:

“...In order to qualify as a series the trade marks must resemble each other in their material particulars. Any differences between the trade marks must be of a non-distinctive character and must leave the visual, aural and conceptual identity of each of the trade marks substantially the same. These matters must be assessed from the perspective of the average consumer of the goods or services in question.”

46. In a subsequent judgment in the same case, Kitchen L.J. considered the question as to whether only some marks in a series could be revoked and said:¹¹

“43.If some of the trade marks in the series have been used and others not, then it may be that none is susceptible to revocation as a result of the saving conferred by s.46(2) in respect of use of the mark in a form differing in elements which do not alter its distinctive character. If, however, some of the trade marks in the series which have not been used for some reason do not satisfy the s.46(2) test then the registration of those trade marks may be revoked.”

47. This makes it clear that courts and tribunals are not constrained by the registration of marks as a series to consider them all substantially the same mark: it is not an ‘all or nothing’ approach. It follows that if there is a likelihood of confusion with one of the

¹¹ [2016] EWCA Civ 455.

marks in the series, but not the other mark, then that mark may be refused and the opposition to the other mark rejected.

48. Although the words which are different in the series of marks, 'Anywhere' and 'Cars' are non-distinctive for the services covered by the application, they contribute to the overall impression created by the marks. The caselaw cited above requires marks to be considered as wholes. 'Anywhere' and 'Cars' are not negligible elements that would go unnoticed by average consumers. The first element of both marks in the application is identical, a hash symbol followed by "iGO". The overall impression of the marks lies in the combination of the elements; however, given the non-distinctiveness of 'Anywhere' and 'Cars', and the position of #iGO at the beginning of the marks, it is this element which is more dominant.

49. The overall impression of the earlier mark resides in the single element of which it is composed: 'igo'.

50. The hash symbol and other words in the application are absent from the earlier mark. The marks coincide in the element igo/iGO. The earlier mark is purple, on a diagonal axis and has a three-dimensional appearance. Colour makes no difference to the visual comparison because the applicant's mark could be used in any colour, including purple. The application is for marks in plain lettering, the notional use of which includes lower case and/or upper case. Overall, taking into account the common and differing components, there is a low to medium degree of visual similarity.

51. The level of aural similarity if the hash symbol is not articulated is medium. The common element in both marks will be pronounced as 'eye-go'. I think it so unlikely that the opponent's mark will be pronounced as 'ee-go' that this can be discounted. If the hash symbol is articulated, it is commonly referred to nowadays as 'hashtag' followed by whatever words come next. If 'hash' or 'hashtag' is articulated, the marks have a low to medium degree of aural similarity.

52. Although the earlier mark consists of a lower case 'i' and the conjoining of 'i' and 'go', it will be read through and conceptualised as 'I go', particularly in the context of

the goods. The same concept attaches to the application, with the added idea of a hashtag. It is also possible that the 'i' in the parties' marks will be seen as an indication of 'interactive' or 'intelligent' in the context of smart technology.

53. Apart from the hash/hashtag, the first mark in the application reads as a phrase, 'I go anywhere', meaning unrestricted travel in the context of the services, despite the difference in letter casing. The second mark does not read as a phrase. The concepts of the words in this mark are separate: 'I go' and 'cars'. There is more conceptual similarity between the earlier mark and the first mark in the series than with the second. This is because the earlier mark invites interpretation as 'I go...somewhere', whereas the second mark in the series introduces the concept of a car. 'I go car' is grammatically incorrect and not a natural extension of the pronoun and verb 'I go'. It is possible that the lower case 'i' will be interpreted as meaning 'interactive'; however, I think the more likely concept, given that the services are travel services, is that of "I go..." . I find that there is a medium degree of conceptual similarity between the earlier mark and the first mark in the series and a low degree of conceptual similarity between the earlier mark and the second mark in the series.

Distinctive character of the earlier mark

54. 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.¹² I will begin by considering the inherent distinctive character of the earlier mark before reminding myself of the use that the opponent has made of its mark.

55. "igo" is low in distinctive character for travel passes for individuals because, as I have explained above, it indicates that an individual is going somewhere. The mark also alludes to the consequential travel freedom as a result of purchasing the pass; e.g. 'I go free' or 'I go on buses at a discount'.

56. Distinctive character is a measure of how strongly the earlier mark identifies the goods or services for which it is registered, determined, according to *Lloyd Schuhfabrik*

¹² *Sabel BV v Puma AG*, Case C-251/95.

Meyer & Co., partly by assessing the proportion of the relevant public which, because of the mark, identify the goods or services as originating from a particular undertaking. At paragraph 23, of its judgment, the CJEU stated:

“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).

57. In *Bovemij Verzekeringen NV v Benelux-Merkenbureau*, (“EUROPOLIS”), Case C-108/05, the CJEU held that:

“..... Article 3(3) of the Directive must be interpreted as meaning that the registration of a trade mark can be allowed on the basis of that provision only if it is proven that that trade mark has acquired distinctive character through use throughout the territory of the Member State or, in the case of Benelux, throughout the part of the territory of Benelux in which there exists a ground for refusal.”

58. Although this case concerned acquired distinctive character for the purposes of considering an absolute grounds objection, I consider the point has application in this case given the geographical restriction to the goods and to the area of use. The assessment as to whether there is a likelihood of confusion includes considering whether the distinctive character of the earlier mark has been enhanced, or more distinctiveness has been acquired, through use. If a mark has an inherently high, or an enhanced, level of distinctiveness, the likelihood of confusion is increased. However, this will only apply to average consumers who know about the earlier mark. The application is for a UK-wide right. The earlier mark has only been used in Greater

Manchester. The mark's inherent capacity to distinguish the goods will not have been made stronger for consumers outside of that area. Consequently, for consumers outside of Greater Manchester, the mark's inherent distinctiveness has not been enhanced. I also find that, even for consumers in Greater Manchester, the distinctiveness of the earlier mark has not been enhanced. It has been used in relation to bus passes for schoolchildren. Although in the last five years about 100,000 passes were issued, a considerable number of these are likely to be repeat purchases of passes for the same children as they go through their school years. This means that the number of unique customers is less than 100,000. The number of original adult consumers aware of the mark will be less still in the likely scenario that the same parents/guardians are buying passes for the eldest child and also for their younger sibling(s).

Likelihood of confusion

59. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. In this case, the parties' goods and services are similar to a medium degree.

60. Direct confusion occurs where marks are mistaken for one another, flowing from the principle 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 which has been retained in the mind. I bear in mind that the earlier mark is distinctive only to a low degree. On the other hand, the element which is identical to the earlier mark is the dominant part of the series of marks in the application. Hash symbol/hashtags are ubiquitous nowadays and the other words are non-distinctive. Those parts of the applicant's marks are less likely to be recalled accurately by the average consumer. On that basis, I find that there is a likelihood that the marks will be mis-recalled and confused for one another, even assuming at least an average degree of attention to the purchasing process.

61. What is even more likely is that the marks will be indirectly confused. Indirect confusion was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *Back Beat Inc v L.A. Sugar (UK) Limited*, BL O/375/10:

“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).”

62. That the three categories in that case are non-exhaustive was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others*.¹³ Arnold LJ said, of the explanation given about how indirect confusion arises in *LA Sugar*:

“12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition. For example, one category of indirect confusion which is not mentioned is where the sign complained of incorporates the trade mark (or a similar sign) in such a way as to lead consumers to believe that the goods or services have been co-branded and thus that there is an economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licensing).”

63. Whilst the *LA Sugar* categories are non-exhaustive, I consider that category (b) is relevant to the present case. The marks in the series both add non-distinctive elements, including the hash symbol, to the dominant element which provides the point of similarity: igo/iGO. As said earlier, notional use of iGO includes lower case and upper case format. Different casing is unlikely to be recalled and will not be enough to point away from a conclusion that the undertakings using the marks are the same or economically related in some way. The assumption will be that the parties’ marks are brand variants, brand updates or indicate expansions to what goods and services are offered. The additional words may be seen as an expansion through licensing, for example. In finding indirect confusion between marks that consist of more than one component, the components do not have to be the same to conclude that there is a likelihood of confusion.¹⁴ I have not forgotten that I should not simply take one component of the applicant’s marks and compare it with the earlier mark. My

¹³ [2021] EWCA Civ 1207

¹⁴ *Aveda Corporation v Dabur India Limited* [2013] EWHC 589 (Ch)

conclusion is based upon imperfect recollection of the common, dominant component, which has the same conceptual hook and is prone to imperfect recollection.

64. I find that the section 5(2)(b) ground of opposition succeeds. I have considered whether a reduced specification would avoid a likelihood of confusion. For example, the applicant's specification includes all sorts of transport, such as road haulage. However, it would not benefit the applicant to restrict the specification to such services because it has indicated in its counterstatement that its activities are taxi and private hire services. Tribunal Practice Notice ("TPN") 1/2012 provides the following guidance which is relevant to this case:

"3.2.2 d) ... where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner's business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal."

65. I have also considered whether a limitation to taxi and private car hire services in Nottingham would avoid refusal under section 5(2)(b) of the Act because the earlier mark's specification is limited to goods for use within the passenger transport area of Greater Manchester. However, I have concluded that this is not permissible. The Intellectual Property Office's Examination of Trade Marks Manual indicates that territorial specification limitations are no longer acceptable. Importantly, Richard Arnold QC (as he then was), sitting as the Appointed Person, considered a related point in *The Journal Trade Mark Application*, BL O/237/08. This case concerned an application to register *The Journal* for magazines and newspapers. The mark was objected to as being non-distinctive and descriptive of the goods. The applicant argued that its use of the mark in the area of East Yorkshire entitled it to gain registration of the mark provided it limited its specification to "Lifestyle magazines containing information about and relevant to the area of East Yorkshire". That was rejected by the Appointed Person on the basis of *Bovemij Verzekeringen NV v Benelux-Merkenbureau*, referred to earlier in this decision. Mr Arnold also said that:

“26. ... the Directive does not expressly contemplate registration of trade marks on the basis of honest concurrent use. While this may perhaps be the effect of the provisions of the Directive in certain circumstances, in the present case it seems unlikely that someone who used one of the marks in issue for similar magazines in a different region, say Cornwall, would succeed in obtaining concurrent registration if the present application were to be accepted. Although the goods would not be identical if specified as “lifestyle regional magazines containing information about and relevant to Cornwall”, they would clearly be similar. Unless experience showed to the contrary, one would anticipate a likelihood of confusion, since a consumer who moved from East Yorkshire to Cornwall would be likely to think that the magazines were published by the same or economically-linked undertakings. But in that case the applicant would acquire a national monopoly on the strength of purely local distinctiveness.”

66. The example given here, magazines relating to Cornwall, is geographically further removed from East Yorkshire than Nottingham is from Greater Manchester, so the logic applies with even more force in the present proceedings. For the above reasons, a restriction to taxi and private hire services provided in Nottingham would not avoid refusal under section 5(2)(b) of the Act. As the applicant’s application covers the whole of the UK, including Greater Manchester, the section 5(2)(b) ground succeeds.

Section 5(2)(b) outcome

67. The section 5(2)(b) ground of opposition succeeds in full.

Section 5(4)(a)

68. 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.”

69. 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.”

70. The three elements which the opponent must show are well known. 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).”

Goodwill

71. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

72. In a case where the contested mark is unused, it is the date when the application was made for the contested mark which is the relevant date for the purposes of section 5(4)(a) of the Act. However, if the contested mark has been used prior to the date of application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about. If an applicant for registration was not passing off when it commenced use of the sign, a continuation of the same trade under the same sign is unlikely to amount to passing off at the application date.¹⁵ Although the applicant refers to the provision of taxi and private hire services in its counterstatement, it has not filed evidence that it has used its mark, which means that the relevant date is 14 June 2021. The opponent must show that it had sufficient goodwill at that date to bring the claim. I consider that it has shown evidence of a goodwill in relation to a business selling travel passes for schoolchildren. The sign “igo” is distinctive of that goodwill.

73. The goodwill was local to Greater Manchester. The establishment of a local goodwill is capable of preventing registration of a trade mark under section 5(4)(a) of the Act because a trade mark application/registration is a national right. This was explained in *Caspian Pizza Ltd & Ors v Shah & Another* [2017] EWCA Civ 1874, by Lord Justice Patten:

¹⁵ *Advanced Perimeter Systems Limited v Multisys Computers Limited* [2012] R.P.C. 14, Mr Daniel Alexander KC, sitting as the Appointed Person.

“23. It is, I think, implicit in these provisions that opposition under s.5(4) based on earlier use of the mark does not have to be use throughout the UK or alternatively in a geographical area which overlaps with the place where the applicant for registration actually carries on business using the same or a similar mark. As the Hearing Officer explained in *SWORDERS*, the application for a national mark operates as a notional extension of the use of the mark over the whole of the country. The only requirement is that the opponent should have established goodwill in the mark over an identifiable geographical area that would qualify for protection in passing off proceedings. Reputation may be enjoyed on such a small scale that it does not generate goodwill at all: see *Knight v Beyond Properties Pty Ltd & Ors* [2007] EWHC 1251 (Ch). But goodwill which is established in a particular locality will be capable of preventing registration of a countrywide mark.”

74. There is no evidence that the sign relied upon is distinctive of goodwill in a business providing travel and passenger transportation services, also relied upon in addition to travel passes. The evidence is limited to use in relation to travel passes for schoolchildren. This means that the opponent’s case is potentially narrower than that for the section 5(2)(b) ground. In the passing off case, under section 5(4)(a) of the Act, I am considering the actual way in which the opponent’s sign has been used. Although that is also true for the assessment for proof of genuine use of the earlier mark under section 5(2)(b), the caselaw for genuine use stipulates that specifications should not be cut down to the precise goods in relation to which the mark has been used. (as set out earlier in this decision).

75. Although the average consumer test is not strictly the same as the ‘substantial number’ test, in the light of the Court of Appeal’s judgment in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, 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. Even though the goodwill is in relation to travel passes for schoolchildren, rather than wider types of travel passes, I find that the outcome is no different than that for section 5(2)(b). As stated earlier, when I compared the parties’ goods and services, I found

that even if I had restricted the opponent's goods to those being for schoolchildren, I would still have found a medium level of similarity with the services in the applicant's specification.

Misrepresentation

76. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is “is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”.

77. The trade mark application extends notionally into the same locality as the opponent's business. As a consequence, I find that a substantial number of the opponent's actual and potential customers would believe that the opponent had expanded its business to include travel services. This is misrepresentation. In view of the success of the section 5(2)(b) ground, there is nothing to be gained by considering what the effect of a geographical limitation of the applicant's services to Nottingham might be. I am unconvinced that the respective locations of the parties' activities are sufficiently far removed to avoid deception, and there is no evidence that the applicant had used its mark by the relevant date and educated the opponent's customers and potential customers that the businesses are unconnected. In any event, a territorial limitation application under section 13 of the Act must be made by the applicant.¹⁶

Damage

78. In *Ewing v Buttercup Margarine Company, Limited*, [1917] 2 Ch. 1 (COA), Warrington L.J. stated that:

¹⁶ See *SWORDERS (2)* BL O/286/06.

“To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me.”

79. In *W.S. Foster & Son Limited v. Brooks Brothers UK Limited*, Iain Purvis QC, sitting as a deputy judge of the Patents County Court observed:¹⁷

“Although proof of damage is an essential requirement of passing off cases, it will generally be presumed where a misrepresentation leading to a likelihood of deception has been established, since such deception will be likely to lead to loss of sales and/or more general damage to the exclusivity of the Claimant's unregistered mark.”

80. The facts which I have considered above lead me to conclude that use of the application would lead to damage, such as diversion of trade and/or injurious association. I find that, as the contested mark is an application covering the whole of the UK, including Greater Manchester, the opponent was entitled to restrain the applicant under the law of passing off, at the relevant date, from using its marks. This means that the opposition succeeds under section 5(4)(a) of the Act.

Overall outcome

81. The opposition is successful and the application is refused.

Costs

82. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are made on the basis of the scale set out in Tribunal Practice Notice 2/2016. I award costs to the opponent as follows:

¹⁷ [2013] EWPC 18.

Official fee for filing the opposition	£200
Preparing and filing the notice of opposition and considering the counterstatement	£300
Filing evidence and submissions	£600
Total	£1100

83. I order igo anywhere limited to pay to Transport for Greater Manchester the sum of **£1100**. 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 17th day of February 2023

Judi Pike
For the Registrar