

O-429-11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2558214 IN THE NAME OF
WALES AIR AMBULANCE CHARITABLE TRUST

AND

OPPOSITION THERETO UNDER NO 101276 BY
AKFEN HOLDING ANONIM SIRKETI

TRADE MARKS ACT 1994

IN THE MATTER OF application
No 2558214 in the name of
Wales Air Ambulance Charitable
Trust and opposition No 101276
thereto by Akfen Holding Anonim
Sirketi

Background

1. Application No 2558214 was applied for on 10 September 2010 and stands in the name of Wales Air Ambulance Charitable Trust (“Wales”). Registration is sought for the following series of three trade marks:

AMBIWLANS AWYR CYMRU
WALES AIR AMBULANCE 


AMBIWLANS AWYR CYMRU
WALES AIR AMBULANCE


AMBIWLANS AWYR CYMRU
WALES AIR AMBULANCE

2. The application seeks registration in relation to the following services:

Class 36
Financial services; charitable fund-raising services; charitable collections; fund-raising


Class 39

Transport; ambulance and helicopter transport services; emergency ambulance and helicopter transport services; information, advisory and consultancy services; information, advisory and consultancy services relating to ambulance services by air

Class 44

Medical services; medical assistance; medical treatment; emergency assistance and treatment; information, advisory and consultancy services.

3. Following publication in the *Trade Marks Journal*, notice of opposition to the registration was filed on behalf of Akfen Holding Anonim Sirketi. ("Akfen"). The opposition is directed only against those services in class 36 and 39 as set out above. In basing its opposition on grounds under Section 5(2)(b) of the Act, Akfen states in its notice of opposition that it relies on two Community trade marks insofar as they are registered for the following services:

No	Mark	Specification
6309801	 Application/Registration dates: 27.09.2007/29.08.2008	Class 35 Advertising; business management; business administration; office functions Class 36 Insurance; financial affairs; monetary affairs; real estate affairs Class 37 Building construction; repair; installation services Class 39 Transport; packaging and storage of goods; travel arrangement Class 40 Treatment of materials

5649835	 <p>Application/ Registration Dates: 29.01.2007/11.2.2008</p>	<p>Class 35 Bringing together, for the benefit of others, of a variety of clothing, excluding the transport thereof, enabling customers to conveniently view and purchase those goods</p> <p>Class 36 Insurance; financial affairs; monetary affairs; real estate affairs</p> <p>Class 37 Building constructions; repair and installation services excluding the repair and installations of security and fire systems</p> <p>Class 39 Transport; packaging and storage of goods; travel arrangement</p>
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4. Only Wales filed evidence. That takes the form of a witness statement by Steven Jones who is their Development Manager and Health and Safety & Fire Manager. Given that much of the evidence is about the formation, work and running of Wales and how its mark was designed, I do not intend to summarise that evidence but have considered it and will refer to it as necessary in this decision.

5. Neither party requested to be heard but both filed written submissions and this decision is therefore taken after a careful review of all the papers before me.

Decision

6. The opposition is based on grounds under section 5(2)(b) of the Act which 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.”

7. An “earlier trade mark” is defined in section 6 of the Act. It states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.”

8. Akfen relies on two trade marks as set out above. Each qualifies as an earlier trade mark under the above provisions. As neither of the earlier marks completed its registration process more than five years before the publication date of the mark for which registration has been applied, the provisions of section 6A of The Trade Marks (Proof of Use, etc) Regulations 2004 are not relevant.

9. In determining the question under Section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77, *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-

334/05 (Limoncello), as cited with approval in *Och-Ziff Management Europe Ltd and Oz Management LP v Och Capital LLP, Union Investment Management Ltd and Ochoki* [2010] EWCH 2599 (Ch). It is clear from these cases that:

- (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, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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 causes the public to wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

10. In its written submissions, Akfen state that it is relying on its earlier marks insofar as they are registered for services in classes 36, 37, 39 and 43. This differs from the claims made on the notice of opposition as set out above at paragraph 3. Whilst I am prepared to accept the removal of the reliance on the earlier marks insofar as they are registered for services in class 35 (both earlier marks) and class 40 (6309801), I am not prepared to consider the apparently additional claim made without prior notice in submissions in respect of services in class 43 (both earlier marks). That being the case the services to be compared are as follows:

Wales	Akfen (6309801)	Akfen (5649835)
Class 36 Financial services; charitable fund-raising services; charitable collections; fund-raising	Class 36 Insurance; financial affairs; monetary affairs; real estate affairs	Class 36 Insurance; financial affairs; monetary affairs; real estate affairs
	Class 37 Building construction; repair; installation services	Class 37 Building constructions; repair and installation services excluding the repair and installations of security and fire systems
Class 39 Transport; ambulance and helicopter transport services; emergency ambulance and helicopter transport services; information, advisory and consultancy services; information, advisory and consultancy services relating to ambulance services by air	Class 39 Transport; packaging and storage of goods; travel arrangement	Class 39 Transport; packaging and storage of goods; travel arrangement

11. Both parties have made submissions regarding their respective areas of trade however I have to take into account the services as registered and for which registration is applied. I am mindful of the findings of the Court of First Instance (now General Court) in *Saint-Gobain SA v OHIM* Case T-364/05 where it said:

“67... it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods set out in the registration of the earlier mark. That description in no way limits the methods by which the goods covered by the earlier mark are likely to be marketed.”

12. I am also mindful of the findings of the Court of First Instance (now General Court) in the case of *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-414/05:

“71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant’s goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors-whether carried out or not- which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”

13. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 280 (“TREAT”), Jacob J said (at 289):

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.”

He went on (at 295) to set out the following factors as being relevant to the question of similarity of services without reference to the classes in which they may fall:

- (a) the respective uses of the respective services;
- (b) the respective users of the respective services;
- (c) the nature of the services;
- (d) the respective trade channels through which the services are marketed;
- (e) the extent to which the respective services are competitive. This inquiry may take into account how those in trade classify the services, for instance whether market research companies put them into the same or different sectors.

14. Subsequently, in *Canon Kabushiki Kaisha v MGM Inc* the ECJ stated:

“23. 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 end users and their method of use and whether they are in competition with each other or are complementary.”

15. In Case T-420/03 – *El Corte Inglés v OHIM- Abril Sanchez and Ricote Sauger* (Boomerang TV) the CFI commented:

“96.....Goods or services which are complementary are those where 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 the production of those goods or provision of those services lies with the same undertaking (Case T14169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, and judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gomez Frias* (euroMASTER), not published in the ECR, paragraph 35).”

16. I also take into account Jacob J’s comment in *Avnet* (supra) where he said:

“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 meaning attributable to the rather general phrase.”

17. Finally, in *Gérard Meric v OHIM*, Case T-133/05, the General Court said:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

18. *Financial services* as appears in the application are identical to *financial affairs* as appear in both earlier registrations. *Charitable fund-raising services* are those which identify, commission and/or establish methods of raising funds and will be used by charities to assist it in carrying out its business. *Charitable collections* and *fund-raising*, are self-explanatory. Whilst each of these services have the ultimate aim of raising money, the core nature of the services is e.g. to identify, organise, promote and carry out any number of various activities in order to attract those monies. I do not consider these services to be similar services to any of the services

relied on by Akfen. Their purpose, users and channels of trade all differ and they are not complementary services.

19. *Ambulance and helicopter transport services and emergency ambulance and helicopter transport services* are all transport services and therefore identical to these services. As *transport* appears in each of the respective marks, these services are identical.

20. As for the remaining services for which registration is applied, I do not consider them to be in any way similar to any of the services included within the specifications of the earlier marks as their nature, uses, users and channels of trade differ markedly and they are not complementary services.

The average consumer and the nature of the purchasing process

21. Each of the services in class 36 is one which is used by businesses though *financial services* may also be bought by the general public. This is a relatively broad term which encompasses any number of individual services and consequently, the nature of the purchasing process is likely to be equally wide-ranging with some being of relatively minor consequence and purchased on a fairly casual basis but with others purchased only after a good deal of consideration and prior preparation. As for the services in Class 39, these are also likely to be provided to businesses or to the general public but are likely to involve at least a fair degree of consideration in their purchase.

Comparison of marks

22. The application is made for a series of three marks. Each of the marks contains the words AMBIWLANS AWYR CYMRU above its English translation WALES AIR AMBULANCE. Each mark also has a device element of what appears to be eight concentric but incomplete circles broken up into four parts which Mr Jones states is based on “the design [of] a helicopter’s rotary blades”. As each of the four parts making up the device have straight edges to one side and tapering edges to the other, the device is indeed reminiscent of spinning blades with those blades at an acute angle away from the viewer. The three marks in the series differ in respect of the position, within the mark, of the device element and their colour. In the first two marks in the series, the words are presented in two shades of green (the words in Welsh in a lighter shade than those in English) with the device in red. The third mark is presented in black. The words appearing in each mark are descriptive of air ambulance services provided in Wales. The device element is reminiscent of rotor blades which would not be distinctive of helicopter based services. In my view the words are the dominant element of each mark but the distinctiveness of the marks applied for rests, in each case, in the totality of the mark.

23. Earlier mark 6309801 consists of a device of what appear to be three incomplete concentric circles somewhat reminiscent of the crosshairs of a sighting device around what appears to be a letter ‘a’. These are presented face-on to the viewer. Whilst the crosshair element seems to be targeting in on the letter ‘a’ I do not consider that either part is dominant. It is a distinctive mark and the distinctiveness rests in its totality.

24. As far as the colour of the application is concerned, I take note of the comments made in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch), where Mann J stated:

“119. It is not clear to me that this is a debate which advances the case very much, but the position seems to me to be as follows. As a matter of principle the exercise involves comparing the offending sign with the registered mark and assessing the likelihood of confusion or association. The two things have to be compared. Since we live in a visual world, and signs are visual, some form of appearance has to be considered. If the registered mark is unlimited to colour then it is registered for all colours. This means that the colour of the offending sign becomes irrelevant. It will not be possible to say that its colour prevents there being an infringement. At this point one can take one of two courses, each of which ought to have the same result. The first is to imagine the registered mark in the same colour as the offending sign. The second is to drain the colour from the offending sign,. Either way one then has the material for comparison. One could even imagine them both in a third colour. It does not matter. So in a sense both Mr Purvis and Mr Bloch are right. As a matter of visual convenience it seems to me to be easier to imagine the registered mark in a colour than to imagine the offending sign drained of colour, and I propose to adopt that course.”

25. Akfen’s earlier mark 5649835 consists of a number of elements. There is a rectangular background broken down into two, unequal, parts. On the smaller, left hand, side is the same device element as appears in 6309801. On the much larger right hand side appears the word ‘akfen’. In each case, the device element appears in white on a red background. The word ‘akfen’ as appears in 5649835, appears in white on a black background. The earlier marks make a claim to the colours red, black and white (6309801) and white and red (5649835).

26. I am not aware that the word ‘akfen’ has any meaning in English though it is easily pronounced and is a distinctive element of the earlier mark 5649835. Whilst the device is also a distinctive element of the mark, it is the word ‘akfen’ which is the dominant element of this mark given its size and position within the mark.

27. Each of the respective marks is, therefore, a composite mark. *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*, Case 120/04 provides key guidance on how to approach issues of similarity involving composite marks as follows:

“29. In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case and earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33. If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34. This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35. Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36. It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.”

28. Comparing, first, the marks for which registration is applied and 6309801, to the extent that each of the respective marks include devices made up of incomplete concentric lines, each broken into four, there is a degree of similarity between them from the visual perspective. The marks also have significant differences in the number and presentation of the lines and the fact that the earlier mark has a letter ‘a’ at its centre which is absent from the marks for which registration is applied. Even where the respective marks share some colour, those differences become all the more marked given the inclusion within the application of the Welsh and English words AMBIWLANS AWYR CYMRU/WALES AIR AMBULANCE.

29. The earlier mark consists purely of a device and is unlikely to be articulated. Whilst non-Welsh speakers may attempt to pronounce the words AMBIWLANS AWYR CYMRU, it is more likely that they will refer to the application by the English words within the mark (which may or may not also be the case with Welsh speakers). The marks for which registration is applied will bring to mind an air ambulance service provided by helicopter in Wales. The earlier mark is, essentially, an abstract device and I do not consider that it brings any particular image to mind. The respective marks are aurally and conceptually distinct and dissimilar.

30. As for earlier mark 5649835, again to the extent that each of the respective marks includes devices made up of incomplete concentric lines, each broken into four, there is a degree of visual similarity between them. But there are even greater visual differences given the inclusion in each of very different words coupled with the fact that the earlier mark appears on a strong rectangular background with the device taking up the left hand third and the word 'akfen' the right hand two thirds. The different words within each mark leads to them being aurally dissimilar. I consider the respective marks to be conceptually distinct and dissimilar.

The distinctiveness of the earlier marks

31. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which it has been acquired and, secondly, by reference to the way it is perceived by the relevant public (see *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings (see *Windsurfing Chiemsee v Huber and Attenburger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585).

32. No evidence of any use of the earlier marks has been put before me and therefore I have only the inherent distinctive character to consider. In respect of each of the earlier marks I consider this to be at a relatively high level.

Likelihood of confusion

33. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. I also have to factor in the distinctive character of the earlier marks as the more distinctive they are the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he or she has retained in mind

34. I take all of the above into account when making a global comparison of the respective marks. I have no hesitation in finding that the differences in the marks are

such that even when used on identical services there is no likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) based on each of the earlier marks therefore fails.**

Costs

35. Wales has successfully defended its applications and is entitled to an award of costs in its favour. I make the award on the following basis:

Preparing a statement and considering the other side's statement:	£300
Preparing evidence:	£300
Preparing written submissions and considering the other side's submissions:	£300
Total:	£900

36. I therefore order Akfen Holding, Anonim Sirketi to pay Wales Air Ambulance Charitable Trust the sum of £900 as a contribution towards its costs. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal is unsuccessful.

Dated this 1st day of December 2011

**Ann Corbett
For the Registrar
The Comptroller-General**