O-603-15

In the Matter of THE UK TRADE MARKS ACT 1994

- and -

In the Matter of UK Trade Mark Registration No. 1190993 in the name of PEGAS TOURISTIK UK LIMITED

- and –

In the Matter of Opposition No. 402284 by PEGASUS HAVE TASIMACILIGI ANONIM SIRKETI

Appeal to the Appointed Person from the decision of Ms. Louise White acting on behalf of the Registrar, the Comptroller-General, dated 22nd June 2015.

Ms. Perselli appeared for the Appellant
Mr. Murrey appeared for the Respondent

DECISION of the Appointed Person

MR. IAIN PURVIS QC:

1. This is an appeal by the applicant, who I believe is now known as PEGAS TOURISTIK, from a decision of the hearing officer, Ms. Louise White, in an opposition brought by Pegasus Hava Tasimaciligi. The trade mark applied for ('the Application') is international application number 1190993, which is a device mark comprising the name PEGAS TOURISTIK with PEGAS in much larger letters on the right-hand side with four horizontal stripes and a winged

horse next to it on the left-hand side. It was applied for in four classes, 35, 39, 41 and 43. A representation of the Application is set out below:

2. The opponent relies on two earlier Community trade marks, the closest of which to the Application is registration 4 748 711 for the word PEGASUS next to a winged horse device. A representation of this mark ('the Earlier Mark') is set out below:

The Earlier Mark is registered in class 39 and following an investigation under the Proof of Use Regulation, the hearing officer accepted that the Earlier Mark had been used in relation to 'airline services'.

3. The hearing officer held that the opposition succeeded in part. She allowed the Application to proceed to grant for various services in classes 35, 41 and 43, but she refused the mark in respect of all the services applied for in class 39, which were as follows: *'intermediary services or tourist information services (except for reserving hotels, boarding houses) in connection with travel information and transport information including information on service prices, timetables and means of transport'*. She also refused the mark in

respect of certain services in class 43, namely *'temporary accommodation; hotel reservations, rental of temporary accommodation; temporary accommodation reservations'*.

4. The applicant appeals against the refusal of registration in respect of those services contending that the Application should have been allowed to proceed to grant for all the services for which it was applied for. There is no Respondent's Notice.

5. The thrust of the decision of the Hearing Officer can be summarised relatively shortly. Essentially, she held that there was 'no similarity' between the services for which the Application was made and airline services except in relation to those services which I have set out in classes 39 and 43. As far as those remaining class 39 services were concerned, she held that the similarity with airline services was 'fairly low', but enough to get over the threshold of similarity so as to enable her to consider the likelihood of confusion under s5(2)(b) of the Trade Marks Act 1994. As far as those remaining class 43 services were concerned, she held that they had a 'low to moderate' level of similarity with airline services which again was enough to enable her to consider the question of likelihood of confusion. She then held that the use of the mark which was the subject of the Application in respect of both sets of services in class 39 and class 43 would give rise to a likelihood of confusion with the Earlier Mark used in respect of airline services. In particular, she considered that such confusion was likely to be caused by the common presence of the distinctive winged horse motif in both Marks. Registration in respect of these services was therefore refused under section 5(2)(b).

6. By this appeal the applicant contends that the Hearing Officer was wrong to hold that the class 39 and class 43 services were 'similar' to airline services even at the relatively low level held by the hearing officer. It is rightly accepted and conceded by the appellant (as is of course well established) that multifactorial questions such as the question of similarity of goods or services can only be overturned on appeal where they are shown to be based on an error of law or principle or are plainly wrong, which means in effect that they are decisions which one can confidently say a reasonable tribunal should not have reached.

7. I, therefore, turn to consider, first of all, the law on the threshold question of similarity. The leading case is Canon KK v Metro Goldwyn Meyer C-39/97. In paragraph 23 of that decision the European Court of Justice stated that in assessing similarity all the relevant factors relating to the goods and services should be taken into account and:

> "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."

8. It may be noted that the factors are not said to be exclusive and the test remains one involving a global appreciation of the similarity of the services in issue, taking all factors in to account. That is the test which the hearing officer had to apply and the Hearing Officer did indeed cite the relevant passage of *Canon* at paragraph 21 of her judgment.

9. Another authority that was cited to me and was also cited by the Hearing Officer was the decision of Jacob J in British Sugar v James Robertson 1996 R.P.C. 281, which was a decision reached before the *Canon* case, but which

has been cited a number of times since as a good illustration of the type of factors which could be taken into account. Jacob J listed six different factors which might be considered (partially overlapping with those of Canon), which I will not set out in this decision, but which once again cannot be taken as exclusive since the overall question is one of global appreciation.

10. It is not suggested that the Hearing Officer did not have those two cases properly in mind. However, it is fair to say, as Ms. Perselli for the appellant pointed out, that in quoting the relevant passage of Jacob J in British Sugar, the Hearing Officer accidentally missed out one of his factors, namely the first one - 'the uses of the respective goods or services'.

11. Turning to the errors of principle which are said to have been made by the Hearing Officer, first of all Ms. Perselli challenges her approach to the similarity of the services in class 39. The Hearing Officer's decision in relation to class 39 and the question of similarity was as follows:

> *"The earlier services are airline services which transport people from one location to another. The contested services seek to provide information. This is, in terms of respective purpose, quite different. However the information provided is specific to travel and transport and includes service prices, timetables and means of transport. This could easily include information on flight routes, timetables etc. It is considered feasible that such services could be provided by the same undertaking. Further, the end users are highly likely to coincide as one would check the times and prices and then look to book a flight. There is therefore considered to be at least some degree of similarity here. This is pitched as being fairly low."*

12. Ms. Perselli says that the Hearing Officer was wrong in principle because in the end she was finding similarity based simply on a coincidence of end users. She says that this could not be enough, and any decision made simply on that

basis must be wrong in principle. It seems to me that this is an unfair characterisation of the Hearing Officer's decision. The passage that I have cited makes it clear in my view that the Hearing Officer also considered other factors to be relevant and to support a finding of similarity. In particular she plainly regarded the nature of airline services and tourist information services, in particular relating to transport information, including information on timetables and means of transport to be ‘complementary’. Hence she points out that the information within class 39 could easily include information on flight routes, which plainly would be complementary to the provision of airline services. She also considers that it is feasible that the services could be provided by the same undertaking. Ms. Perselli contends, I think, that whether or not the services could be provided by the same undertaking can never be a relevant factor, for the same reason that it was considered irrelevant in British Sugar that you could purchase the two products in that case in the same supermarket. But it seems to me it all depends on the facts of the particular case. In this case the Hearing Officer was considering a highly specialist business, airline services. The limited nature of the services which airlines would ordinarily provide increases the significance of the fact that the services applied for in this case could be provided by airlines. It is a very different matter from saying that two kinds of consumer goods can both be found in supermarkets.

13. Of course, when considering the similarity of services, one also has to bear in mind that the purpose of considering the threshold is ultimately tied up with the overall question of whether there is a likelihood of confusion. If the Hearing Officer considered (as she did) that a consumer who knew of a

particular airline providing services under the Earlier Mark would, seeing the offering of transport information services under the mark of the Application, think that the two were economically linked, it is hard to see how she could sensibly conclude that the Application should be allowed to proceed to grant because the services were insufficiently similar. The services were plainly sufficiently similar for the average consumer to see an economic link between them if a similar mark was used. The structured approach, by which similarity of goods/services must be considered first as a 'threshold' question, followed by the question of likelihood of confusion, is plainly useful, but the first issue cannot and should not be considered as hermetically sealed from the second.

14. I cannot myself therefore see any error of principle in relation to the analysis in paragraph 25 of the Hearing Officer's Decision. On the contrary, the reasoning seems to me to be entirely sound.

15. Turning to class 43, the hearing officer's decision in this respect was given in paragraph 28 as follows:

> *"In respect of the following contested services:* ***Temporary accommodation; hotel reservations, rental of temporary accommodation; temporary accommodation reservations****, it is noted that within the holiday industry, the so called 'package holiday' which include flights, transfers and accommodation are provided by a large number of tour operators. These services can therefore be provided by the same undertaking. Further, they can coincide in respect of their end user. There is at least a degree of similarity. This is pitched as being low to moderate."*

16. So far as this is concerned, Ms. Perselli contended that, first of all, the mere fact that services could be offered by the same service provider to the same people, and even at the same time, is not enough to get over the threshold of similarity. She cited in this respect by way of analogy the spreads and sauces

sold by the same supermarket in the British Sugar case and the shoes and handbags sold by the same high end fashion shops in the Sergio Rossi v OHIM decision of the General Court (C-214/05 P).

17. So far as the Sergio Rossi case is concerned I am not sure that it is particularly authoritative on this issue. It is unclear whether the General Court were, in fact, saying that on the facts of that case (where matching shoes and handbags were held to be commonly offered in high end stores to customers), that the goods were not in fact sufficiently similar at least to get over the threshold of similarity to proceed to consider the likelihood of confusion. In fact, since they did go on and look at the likelihood of confusion it seems to me more likely that they thought the threshold was in fact met. I do not think one can therefore gain very much assistance from that decision for the present case.

18. So far as British Sugar is concerned, the common provider of the goods was a supermarket which may also provide tens of thousands of different goods. Clearly, that is miles away from the present case. The Hearing Officer pointed to a specific practice which was well known and which is accepted by Ms. Perselli by which airlines commonly offer to their customers at the time they are booking flights the provision of hotel reservations and temporary accommodation and indeed will provide temporary accommodation, for example, to users of their services who are stuck in an airport for unforeseeable reasons. The Hearing Officer was plainly influenced by the fact that this particular practice was well known. In those circumstances it was not unreasonable to find that the fact that the services can be and are offered by the same service providers to the same people at the same time was sufficient

to establish at least sufficient degree of similarity to justify going ahead and considering the likelihood of confusion.

19. The other point, I should add, made by Ms. Perselli, was that the Hearing Officer gave too much weight to the factors in favour of similarity and not enough weight to the factors against similarity, as indicated by the fact that she did not mention those contrary factors in paragraph 28. This does not amount to an 'error of principle'. A Hearing Officer is not obliged to set out all the factors (for and against) in relation to any particular decision. It is sufficient to set out a summary of the key factors which led her to reach the view she did. I have seen nothing to indicate that the hearing officer did not take the appropriate global view. I therefore also reject the appeal against the decision in relation to class 43.

20. My decision, therefore, is that the Hearing Officer's decision shall stand and the appeal is refused. I shall award £800 to the Respondent in respect of the costs of the Appeal.

IAIN PURVIS QC

THE APPOINTED PERSON

21 DECEMBER 2015.