

O-171-17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3119047

BY IMMAT LIMITED

TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 7, 9, 16, 35, 36,

38 & 41:



AND

OPPOSITION THERETO (NO. 405518) BY ATD TRAVEL SERVICES LTD

Background and pleadings

1. This dispute concerns whether the following trade mark should be registered:



Class 7: Vending machines for printed articles, tickets and vouchers.

Class 9: Automated ticket printing, accounting and seat reservation apparatus; computerised machines for reserving tickets, admission tickets and travel passes; computer apparatus and software for reserving tickets for attractions, concerts, films, shows, sports events and other forms of entertainment, for issuing tickets and for paying therefore.

Class 16: Printed publications; printed timetables; tickets; seat and admission tickets for attractions, concerts, films, shows, sport events and other forms of entertainment.

Class 35: Advertising; accounting services in relation to the purchase and sale of tickets and vouchers; administrative processing of purchase and sales orders; sales promotions for others in relation to attractions, sporting events, musical concerts and other entertainment and cultural events; provision of an online marketplace for buyers and sellers of goods and services; retail services, electronic retail services and mail order retail services all in connection with the sale of tickets for attractions, sporting events, musical concerts, theatre and other entertainment.

Class 36: Insurance services relating to bookings of entertainment events, sporting events or accommodation; financial guarantee services for the reimbursement of payments for attractions and entertainment events.

Class 38: Telecommunications; electronic mail; message sending; transmission of messages and images.

Class 41: Entertainment; booking agencies; ticket reservation services.

2. The mark was filed on 23 July 2015 by IMMAT Limited (“the applicant”) and it was published for opposition purposes on 21 August 2015.

3. ATD Travel Services Ltd (“the opponent”) oppose the registration of the mark under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following earlier marks:

- i) European Union Trade Mark (“EUTM”) registration 13734272 for the mark **Attraction Tickets Direct** which was filed on 12 February 2015 and registered on 18 June 2015 in respect of the following services:

Class 35: Advertising and promotion of sporting, adventure, cultural, educational, artistic and entertainment events and activities for others; provision of an on-line marketplace for the buyers and sellers of tickets from a website specialising in sporting, adventure, attractions, cultural, educational, artistic and entertainment events and activities; accounting and office functions in connection with the reservation, issuing and sales of admission tickets.

Class 39: Arrangement of excursions; arranging excursions for tourists; organisation of excursions; services for the arranging of excursions for tourists; supplying tickets to enable holders to travel; issuing of tickets for travel; agency services for arranging tours; arrangement of tours; provision of tours; services for arranging tours.

Class 41: Booking agencies for theatre tickets and concerts; ticket information services for shows; ticket reservation services, for theme parks, shows, attractions, tours.

Given its date of registration, the mark is not subject to the use conditions set out in section 6A of the Act and may, therefore, be relied upon for all of the services for which it is registered.

ii) UK registration 2390784 for the following series of marks:



The marks were filed on 29 April 2005 and registered on 2 December 2005 in respect of the following services:

Class 35: Advertising and promotion of sporting, adventure, cultural, educational, artistic and entertainment events and activities for others; the bringing together, for the benefit of others of a variety of goods and services, enabling customers to conveniently view and purchase those goods and services by telecommunication or from an Internet web site specialising in the marketing of sporting, adventure, cultural, educational, artistic and entertainment events and activities; accounting and office functions in connection with the reservation, issuing and sales of admission tickets.

Class 41: Ticket agency services.

Given its date of registration, the mark is subject to the use conditions set out in section 6A of the Act. Use is claimed in respect of all of the services for which the marks are registered.

- iii) UK registration 2390785 for the following series of marks:



Real Tickets, Real Value, Real Fast



Real Tickets, Real Value, Real Fast

The marks were filed on 29 April 2005 and registered on 18 November 2005 in respect of the same specification as above. Given its date of registration, the marks are subject to the use conditions set out in section 6A of the Act. Use is claimed in respect of all of the services for which the marks are registered.

- iv) UK registration 3082672 for the mark:



The mark was filed on 21 November 2014 and registered on 10 April 2015 in respect of the following services.

Class 35: Advertising and promotion of sporting, adventure, cultural, educational, artistic and entertainment events and activities for others; Provision of an on-line marketplace for the buyers and sellers of tickets from a website specialising in sporting, adventure, attractions, cultural, educational, artistic and entertainment events and activities; accounting and office functions in connection with the reservation, issuing and sales of admission tickets.

Class 39: Arrangement of excursions; arranging excursions for tourists; organisation of excursions; services for the arranging of excursions for tourists; supplying tickets to enable holders to travel; issuing of tickets for travel; agency services for arranging tours; arrangement of tours; provision of tours; services for arranging tours.

Class 41: Booking agencies for theatre tickets and concerts; ticket information services for shows; ticket reservation services, for theme parks, shows, attractions, tours.

Given its date of registration, the mark is not subject to the use conditions and may, therefore, be relied upon for all of the services for which it is registered.

4. All of the above marks are relied upon under section 5(2)(b). Only marks i), ii) & iii) are relied upon under section 5(3). A detailed explanation of the pleaded grounds is given in the opponent's statement of case. Some of the points it makes are that:

- There is identity between the respective class 35 and 41 services, and similarity in respect of the other services.
- The marks are highly similar due to the sharing of a number of the words in the marks, that “.com” in the applicant's mark is non-distinctive, that the competing marks [the figurative marks] have a stylised ticket device and a contrasting coloured border (and similar font).
- That the earlier mark(s) are highly distinctive and have a reputation.
- That a likelihood of confusion exists, but if this is not found then a link will nevertheless be made between the marks by the relevant public.
- There could be detriment because the services of the applicant may be/are inferior, that the relevant public will believe that the services are provided by the same or related undertaking which will dilute the distinctiveness of the mark so

reducing its immediate recognition in the field, and that the applicant will gain an unfair advantage “as a vehicle to generate interest in and or sale of the products bearing the applicant’s mark”.

5. The applicant filed a counterstatement denying the claims. It put the opponent to proof of use in respect of the two marks that are subject to the use conditions. It does not believe that the marks are sufficiently similar to cause confusion or for a link to be made. It states that it has a justifiable reason for using the mark, but does not say what that is.

6. Both sides filed evidence. A hearing took place before me on 23 March 2017 at which the opponent was represented by Mr Adam Gamsa, of Counsel, instructed by Lawdit Solicitors; the applicant was represented by Mr Michael Hicks, also of Counsel, instructed by The Trade Marks Bureau. At the hearing Mr Gamsa limited the opponent’s case to the following grounds:

- i) Section 5(2)(b) based on EUTM 13734272 which consists of the word mark **Attraction Tickets Direct**.
- v) Section 5(2)(b) based on UK registration 3082672 which consists of the

stylised mark: 

- ii) Section 5(3) based on EUTM 13734272.

7. The above limiting of the grounds is a helpful approach which also results in it not being necessary to consider the proof of use provisions (because they do not apply to the earlier marks that are left to be considered).

The evidence

The opponent’s evidence

8. This comes in the form of a witness statement from Mr Oliver Brendon, Director and Accounts Manager of the opponent. He states that all references in his evidence to expenditure relates to the marketing, promotion and development of the Attraction

Tickets Direct brand. It should be borne in mind that the relevant date in these proceedings is 23 July 2015. Expenditure and promotion after the relevant date will not assist the opponent. I note the following from Mr Brendon's evidence:

- £500K was spent on pay-per click advertising in 2015 with internet traffic (to the Attraction Tickets Direct website) of 5.8 million sessions. This is not broken down between pre/post relevant date figures.
- "This year" [2016 given the date of the witness statement] £865k was spent on TV advertising campaigns. This is after the relevant date.
- Exhibit OB1 contains a Goggle search results page for the term "Attraction Tickets". The opponent's website is listed first (this appears to be a paid for advertisement) with two further hits on the page. Other entries include: parisattractiontickets.com, attractiontix.co.uk, orlandoattractiontickets.co.uk.
- Exhibit OB2 contains numerous examples of press exposure. Mr Brendon says that in total there were 490 pieces of press coverage in 2015 which have been valued at £4.3 million and have reached an audience of 246 million people. The examples provided are from a range of publications, some of which I accept are national newspapers. They typically relate to travel information and make reference to Attraction Tickets Direct as a company that specialises in providing tickets for places such as Disneyland and Universal. Some are before the relevant date, some on or after. Each of the prints contain the circulation figures and, also, page rate information which is where, I assume, the valuation and audience reach figures have been calculated.
- The opponent has won a number of awards in the travel field for the services it offers and has a 98% public satisfaction rating on Feefo (2011-2013). Some of the awards date back to 2008.
- The opponent has offices in the UK and in Ireland but also sells in two other markets (Germany and Brazil) from its HQ in London. It is stated that a substantial web presence is maintained in each market.

- The opponent was listed by the Fast Track 100 (which Mr Brendon states is a leading authority in business growth) at no. 18 in 2006 with transactions totalling over £32 million. This had grown to £93 million by 2015.
- The opponent was the first company to sell over 1 million visits to Walt Disney World Florida, a feat achieved every year since 2006.
- Mr Brendon makes a number of submissions about the likelihood of confusion and damage. They are borne in mind but I will not summarise them here. In relation to the applicant's claim (in its counterstatement) that the marks will not be linked, Mr Brendon refer to Exhibit OB3. This is a further Google print for the search term "attractiontickets.com". The applicant's website is listed first (although there is paid for advertisement above for orlandoattractiontickets.co.uk), but the opponent's website is also listed (as the third result). Other hits include: www.attraction-tickets.com, www.attractionticket.com, www.attactiontix.co.uk and www.orlandoattractions.com. Mr Brendon states that this shows that the public, when searching for the applicant, will encounter the opponent's website, and that this equates to a clear and distinct link, and that this is likely to cause confusion.

The applicant's evidence

9. This comes from Mr Matthew Gardener, a "trade mark representative" employed by The Trade Marks Bureau. His evidence relates to the descriptive nature of the words "attraction tickets", which he says is the common element between the respective marks. I note the following:

- He defines (and provides supporting definitions at Exhibit MG1 from Merriam-Webster's Learner's Dictionary) "attraction" as "something interesting or enjoyable that people want to visit, see, or do" and "ticket" as "a piece of paper that allows you to see a show, participate in an event, travel on a vehicle, etc.".

- Mr Gardener states that the combination of words “attraction tickets” is commonplace. In support he provides Exhibit MG2, a Google search for the term “attraction tickets”. Around 30 pages of results are provided where the words attraction tickets are used in domain names and in descriptive text e.g. “Orlando attraction tickets”, “book cheap attraction tickets”, “..theme park and attraction tickets”, “book low cost attraction tickets”, “browse our theme park and attraction tickets”.
- In further support of the above, Exhibit MG3 contains a number of website prints from companies that provide tickets in this field. Descriptive usage includes: “..for Orlando Attraction Tickets”, “Cheap Florida Attraction Tickets”, “book your attraction tickets instantly”, “with our multi-attraction tickets...”, “advanced attraction tickets”, “check out our discounted attraction tickets”, “worldwide attraction tickets”, “how do I collect my attraction tickets”, “book your attraction tickets”.
- Exhibit MG4 contains a further Google search report for the term, “attraction tickets direct”. The applicant’s website is not found in the search report.
- Exhibit MG5 contains a print from the opponent’s website in which it uses the words attraction tickets in a descriptive manner.

10. Mr Gardener completes his evidence by stating that the common element between the respective marks is descriptive and that, without further distinctive elements, will not function as a trade mark. He considers this to mean that confusion will not arise between the marks at issue in these proceedings.

The opponent’s reply evidence

11. This comes, again, from Mr Brendon. In response to the absence of the applicant’s website when searching for the phrase “attraction tickets direct”, Mr Brendon provides a search report for what is essentially the reverse of what Mr Gardener provided, namely, a search for attractiontickets.com (and attraction tickets.com) from which, Mr Brendon notes, a hit for the opponent’s website is returned. The search reports are in

Exhibit OB4 and I note that other results (beyond those of the applicant and opponent) include the words attraction tickets as per those I noted earlier in respect of the other searches the parties have undertaken.

12. Mr Brendon does not accept that the only point of similarity are the words **ATTRACTION TICKETS**. He also states that if the applicant is alleging that the earlier marks are not distinctive, this is denied. I should stress that I have not taken anything the applicant has said in this way. What they allege is that the words **ATTRACTION TICKETS** are descriptive and that this is the only point of similarity between the marks. To support the distinctiveness of the earlier marks, Mr Brendon provides some invoices for pay-per click advertising (Exhibit OB5) and for sales and ticket orders (Exhibit OB6).

Findings based upon the evidence

13. There were two main disputes at the hearing as to what could be taken from the evidence. First, whether the expression **ATTRACTION TICKETS** is wholly descriptive. Second, whether the use the opponent has made is sufficient to have created a reputation (and enhanced distinctness) in respect of the earlier mark(s).

14. I should say up front that even if I am satisfied that the term **ATTRACTION TICKETS** is wholly descriptive then this is not the end of the matter. This is because the question of whether there exists a likelihood of confusion cannot be reduced down to solely that question. I am conscious of the guidance provided by Mr Daniel Alexander QC (sitting as the Appointed Person) in the *Petmeds* case (BL O/471/11) where he stated:

“36. In *L'Oreal SA v OHIM (Trade Marks and Designs)* [2006] EUECJ C-235/05, [2006] ECR I-57 in which registration of FLEXIAIR was refused because of the prior registration of FLEX, the Court of Justice said at [45]:

“The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given

undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

37. The Court of Justice therefore considered that, while it was a factor, the weak level of distinctiveness of an earlier mark was not invariably determinative of the issue of likelihood of confusion.

38. In my judgment, these cases show that it is impossible to treat a common element which is even accepted to be descriptive in a blanket way in comparing marks in s.5(2)(b) cases. Each case must be considered on its own facts having regard to the particular circumstances of trade. To the extent that the Hearing Officer proceeded on the basis that the PETMEDS element of a mark could not constitute the dominant and distinctive element if it was descriptive does not do full justice to the richness of the descriptiveness/distinctiveness spectrum.”

I accept, though, that the distinctiveness question is still an important factor in this case.

15. Mr Gamsa did not accept that the words were wholly descriptive. His submissions were based on the word ATTRACTION being an Americanism (due to the definition in evidence coming from a US dictionary) and that the various prints in the applicant’s evidence were not all before the relevant date and not all from the UK. Mr Hicks disagreed. He took me to a number of examples in the evidence showing the word(s)

ATTRACTION and ATTRACTION TICKETS being used in a wholly descriptive manner by a number of traders in the UK and in journalistic articles from the UK press. He highlighted that the opponent's own evidence included a picture of some awards it had won over the years which have been awarded in categories of service which use the words ATTRACTION/ ATTRACTION TICKET descriptively (e.g. BEST HOLIDAY ATTRACTION TICKET PROVIDER). In the face of this last point, Mr Gamsa accepted that the evidence did appear to show that the words ATTRACTION TICKETS had become common place in the field.

16. Having considered the submissions (and evidence), I fully agree with Mr Hicks' submission that the words ATTRACTION TICKETS are wholly descriptive. Whilst the provided dictionary definitions come from a US dictionary, it nevertheless fits my own understanding of the word(s). Whilst it has multiple meanings, the word ATTRACTION describes, in my view, a range of places of interest, activities, or other such places which draw visitors to them. For example, the Collins English Dictionary defines ATTRACTION thus:

“An attraction is something that people can go to for interest or enjoyment, for example a famous building.”

17. Ms Gamsa suggested that in the UK consumers were used to terms such as “theme parks”, not attractions. However, whilst I accept that theme parks are well known in the UK, they are, essentially, just one type of attraction. “Attractions” are, therefore, a collective term for a range of things which may be visited. Many attractions require payment and, consequently, tickets to gain entry. Thus, as a whole, ATTRACTION TICKETS simply describes tickets for attractions. I would have come to this view purely on the basis of the normal understandable meanings of the words. However, I also agree with Mr Hicks that there is ample evidence which shows the common use of both ATTRACTION (in the above context) and ATTRACTION TICKETS. The latter is also used descriptively by other traders in the UK to indicate that they are providers of attraction tickets. Indeed, it is clear from the evidence that there is a category of service provider (as per the awards) for operators which provide attraction tickets. My finding is that the words ATTRACTION TICKETS are wholly descriptive.

18. In terms of the use made of the mark(s), Mr Hicks accepted that the hurdle for establishing a reputation was not a high one. In relation to section 5(3) of the Act, the test for establishing a reputation was set out in *General Motors*¹ by the Court of Justice of the European Union (“CJEU”) as follows:

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

19. Mr Hicks was critical of the opponent’s evidence in terms of its capacity to establish a reputation as of the relevant date. The relevant date for the purposes of establishing a reputation is the date of filing of the subject mark, namely, 23 July 2015. Whilst, as Mr Hicks pointed out, the 2015 advertising spend and website sessions is not broken down as between pre and post relevant date data, I accept Mr Gamsa’s submission that it is a reasonable inference that a proportion of this relates to the period of time in 2015 prior to the relevant date. This is particularly so given that the field of business in which the opponent operates, as it is probable that a good deal of business is done in the lead up to the summer holidays. This also applies to the transactions for 2015 which Mr Brendon states grew to £93 million – it is reasonable to infer that some of these significant amounts of transactions took place prior to the relevant date. Further, there is evidence that the business is not just an overnight success with particular milestones being reached in 2006 (first business to sell 1 million visits to Disneyland and transactions worth £38million) and continued business since (evidence by its awards and Feefo feedback).

20. It is true that none of the evidence sets out the relevant market share, nevertheless, taking the evidence in the round, I am satisfied that in its field the opponent appears to be a successful player. Indeed, the evidence strikes me as the type of evidence one would see from a market leader. The opponent has a reputation in respect of the mark **Attraction Tickets Direct** at least in relation to the retailing of attraction tickets.

¹ *General Motors*, [1999] ETMR 950

21. Although the legal test for enhancement of distinctive character is not quite the same as that for a reputation, many of the same factors and assessments apply. The distinctive character of **Attraction Tickets Direct** will have been enhanced through use, although, I will return to this question in more detail later.

Section 5(2)(b)

22. Section 5(2)(b) of the Act states that:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

23. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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 creates a risk that the public will 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

24. The applicant accepts that its services in class 35 are identical or similar to the services of the opponent's marks. In denies that the services are similar in the other classes, or, if there is similarity, then this is low. In view of this concession, I will focus on the position with regard to the class 35 services in the first instance (and in particular the retailing of tickets which is common to the class 35 specifications), returning to the other classes/services if it is relevant to do so.

Average consumer and the purchasing act

25. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

26. There was no real dispute between counsel as to the identity of the average consumer. The average consumer is a member of the general public who is interested in obtaining tickets for attractions. I do not consider the selection process of an

appropriate supplier (of tickets) to be a process that involves a higher or lower degree of attention than the norm. Neither counsel submitted otherwise. The only evidence as to the suppliers of tickets comes from the Google searches. It is likely that online supply is common. This suggests that the visual impact of the marks is important. However, I do not rule out that tickets could be ordered over the telephone or advise sought in person, so meaning that the aural impact of the marks must not be overlooked completely.

Distinctiveness of the earlier mark(s)

27. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:


“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

28. From an inherent perspective, I think it self-evident that, as whole, **Attraction Tickets Direct** is low in inherent distinctive character. It is strongly suggestive of the provision of attraction tickets which, in some way, come direct from the supplier or the attraction operator. However, given my earlier finding, the distinctiveness of the mark is enhanced, at least in respect of the retailing of attraction tickets, so that it is a mark of what I believe has a reasonable level of distinctiveness.



29. The other earlier mark is . Given the various elements of the mark, including its figurative aspect, the mark has an average level of distinctiveness overall. There is no evidence of use of this mark so its distinctiveness is not enhanced. Even if it could be said that the use of the words Attraction Tickets Directs spills over to this mark, then its distinctiveness will have been enhanced to that of a reasonable level.

30. I bear in mind that in terms of distinctiveness, it is only apposite to consider the distinctiveness of the point of similarity when it comes to assessing whether there exists a likelihood of confusion, as per the guidance of Mr Iain Purvis QC in the *Kurt Geiger* case (O-075-13).

Comparison of marks

31. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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.”

32. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:



v

Attraction Tickets Direct &



33. In terms of overall impression, and considering first the applicant's mark, it is made up of the words ATTRACTIONTICKETS.COM printed upon something which may be perceived as a ticket. The ticket wraps around the device of a globe, on top of which are a castle, a roller-coaster and a big wheel. Mr Gamsa submitted that the overall impression is dominated by the verbal elements given that the figurative elements were mere representations of the things which may be ticketed. Mr Hicks submitted that the figurative elements of the mark strongly dominated the mark, with the verbal element playing only a minor role. I agree with Mr Hicks, to the extent that the figurative elements do play a strong role in the overall impression of the mark. The mark is

visually striking. Even if some of the pictures that make up the figurative elements may not be that distinctive alone, the combination creates a distinctive figurative component. However, I do not agree with Mr Hicks that ATTRACTIONTICKETS.COM plays only a very minor role. The words are visually prominent (although the figurative elements perhaps shade it on visual prominence alone). Whilst the words could be viewed simply as a domain name, they also have the capacity to be viewed, essentially, as the name (or brand as Mr Gamsa put it) of the undertaking. The figurative elements and the words ATTRACTIONTICKETS.COM make a roughly equal contribution to the overall impression of the mark.

34. The earlier mark **Attraction Tickets Direct** is made up of three words. However, they combine to form a unit which hangs together as a single element. The phrase is suggestive in totality (as I have said already) of attraction tickets which come direct from the supplier/operator. In such a context, I do not think it can be said that any of the individual words dominate the overall impression to the detriment of the others. The words will be perceived as one element, its distinctiveness residing in the totality.

35. In terms of the earlier figurative mark, this is a true composite mark. It consists of the words "Attraction Tickets", the word DIRECT built into a figurative element comprising a swoosh, what may be perceived as a ticket and, also, a star, and the words "Add Happiness". I come to the view that the figurative elements make a roughly equal contribution to the overall impression as the verbal elements. Of the verbal elements, the words Add Happiness probably make the least impact (although it still has some impact and is not negligible) on account of its position, its slightly smaller font, and its suggestiveness. Whilst the words Attraction Tickets are presented as a self-standing element, the perception of the average consumer will likely be that it blends with the word DIRECT to form a phrase (the meaning of which I have already given). If the words Attraction Tickets were perceived purely as a stand-alone element (not blended with the word DIRECT), then they have a degree of visual prominence (roughly equal to DIRECT and the figurative elements) but the average consumer will perceive this purely as a descriptor.

36. Visually, and comparing first the applicant's mark with the opponent's word mark, there is some visual similarity as both marks contain the words ATTRACTION

TICKETS/Attraction Tickets. However, given the overall impressions of the marks, together with the differences which exist (the figurative elements in the applied for mark, the difference between .COM and DIRECT), I consider that visual similarity is only low. In comparison to the earlier figurative mark, I do not consider the opponent to be in any better position. Whilst, as pointed out by Mr Gamsa, both marks have a stylised device of a ticket, the manner of presentation is very different and there are, also, further visual differences due to the presence of the star. In relation to the fonts used in both marks, whilst they are not a million miles from each other, they are fairly unremarkable fonts and I do not consider that the visual similarity is materially increased. The figurative marks have only a low degree of visual similarity.

37. Aurally, Mr Hicks submitted that there could be no aural similarity because figurative marks are not generally articulated and that the figurative element in the applied for mark does not lend itself to articulation. Whilst I agree on the second of these points, I do not agree with the first. I see no reason why a figurative mark such as that of the applicant would not be articulated. It will be articulated on the basis of its verbal element and referred to as ATTRAKT-SHUN-TICK-ITS-DOT-COM. Both earlier marks will be articulated as ATTRAKT-SHUN-TICK-ITS-DIRECT (I accept that Add Happiness may be dropped). This equates, in my view, to a reasonable degree of aural similarity. If Add Happiness were to be articulated then this would reduce aural similarity overall.

38. Conceptually, Mr Gamsa did not pursue a conceptual argument based upon the verbal elements of the marks, but suggested that there was conceptual similarity between the figurative marks as both suggested the provision of desirable tickets. This argument was based upon both marks containing a representation of a ticket and that in some way both demonstrated desirability (due to the presence of a star in the opponent's mark and examples of attractions (although he did not call them that) which stand out from the globe in the applicant's mark). Mr Hicks accepted that the concept of attraction tickets was common to all marks, but that the specific contexts were different (with the opponent's use being part of domain name); he added that the concept of the applied for mark focused on the globe with pictorial representations of attractions which was not the case with either of the opponent's marks. Mr Hicks submitted that this resulted in either no or only a low level of conceptual similarity. In

my view Mr Hicks is correct. All of the marks have a conceptual significance based upon the provision of attraction tickets, but as the exact contexts differ, such conceptual similarity is low and exists in relation to a non-distinctive concept. I do not accept the greater degree of conceptual similarity put forward by Mr Gamsa (desirable or stellar tickets for themes parts etc) as this would require too much in the way of analysis by the average consumer to reach such a view.

Likelihood of confusion

39. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

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

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

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

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

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

40. Mr Gamsa accepted that indirect confusion was the most fertile basis for the opponent’s opposition under section 5(2)(b) of the Act given that it was unlikely that the figurative aspects of the applied for mark would be overlooked. He submitted that the presence in the mark of ATTRACTIONTICKETS.COM would indicate a same stable business as Attraction Tickets Direct (including the figurative version) given that ATTRACTION TICKETS per se had some distinctiveness and that .COM and DIRECT were not very memorable. He stressed again the other aspects of similarity such as both figurative marks having a ticket in them. He added that even if I held that ATTRACTION TICKETS per se was not distinctive, it was still the case that ATTRACTIONTICKETS.COM signified the trade origin of the applicant’s services and this could still be confused with the opponent’s mark when one bears in mind imperfect recollection, the identity (in the case I am considering) of the services, and the enhanced distinctiveness of the earlier mark(s). Mr Hicks argued that there would be no confusion, that the verbal element of the applied for mark was simply a domain name, and, in any event, the only real point of similarity was not distinctive and, therefore, the average consumer would not assume that the services were provided by the same or related undertaking.

41. I accept Mr Gamsa's position that ATTRACTIONTICKETS.COM has the capacity to be taken by the average consumer as an indicator of trade origin, performing an independent distinctive role within the mark. However, even accepting this to be the case, there are two primary reasons why I do not consider it likely that the marks will be confused. First, the applied for mark has a significant addition by way of its figurative elements creating a sticking image which is absent from either earlier marks. Second, notwithstanding the other points of similarity highlighted by Mr Gamsa, the primary point of similarity is in respect of a non-distinctive term. I believe the average consumer will recognise this and, thus, they are not likely to put the common presence of such a term down to the undertakings responsible for the marks being the same or being related. They will instead put the commonality down to a simple co-incidental (and unsurprising) use of descriptive language within the context of two different trade marks. This also applies to both figurative marks having a ticket device in them. The identity of the service does not negate this. Neither does the enhanced distinctiveness of the earlier mark(s) materially assist because the enhanced distinctiveness resides in the earlier mark(s) as a whole, not in ATTRACTION TICKETS per se. That the verbal element in the applied for mark has the capacity to be taken as an indication of origin is not enough, when all the factors are considered, to result in confusion. A point was made in Mr Gamsa's skeleton argument about the opponent's mark being returned in a Google search when ATTRACTIONTICKETS.COM is searched for. This, though, is not good evidence that the average consumer will be confused. The average consumer will simply see this as an unsurprising search result bringing back other traders that happen to have the descriptive term ATTRACTION TICKETS in their names. There is no likelihood of confusion.

42. Given the above finding made in relation to identical services, the opponent can be in no better position where the goods/services are merely similar. The ground under section 5(2)(b) is dismissed in its entirety.

Section 5(3) of the Act

43. Section 5(3) of the Act reads:

“5-(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark,

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

44. The leading cases are the following CJEU judgments: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

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

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

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the later mark would cause an average consumer to bring the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

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

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph

68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

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

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

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

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

Reputation

45. I have already dealt with this matter, concluding that the opponent's word mark benefits from a reputation.

The required link

46. In addition to having a reputation, a link must be made between the subject trade mark and the earlier mark. In *Adidas-Salomon*, the CJEU stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

47. In *Intel* the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...”

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;

- the strength of the earlier mark’s reputation;

- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;

- the existence of the likelihood of confusion on the part of the public”.

48. In my view, a member of the relevant public encountering the applicant’s mark will not bring the earlier mark to mind. The marks are visually quite distinct and the only real common element is a descriptor. I see no basis why the applicant’s mark would create a link (to the earlier mark) in the mind of the relevant person. That a Google search may bring back both marks is not a good indicator that a link will be made in the mind of a member of the relevant public.

49. Even if there was a link, I find it difficult to see how any of the heads of damage would arise. There can be no unfair advantage when all that is happening is the applicant using a descriptive term as part of its name/mark, nor would the distinctiveness of the earlier mark (which resides in its totality) be diluted. Any argument on tarnishing is purely hypothetical. Further, the use of a descriptive term within a mark appears to represent a due cause, equivalent to an aspect of fair competition. The ground under section 5(3) is dismissed for all these reasons.

Conclusion

50. The opposition fails and, subject to appeal, the applicant’s mark may proceed to registration.

Costs

51. The applicant has been successful and is entitled to a contribution towards its costs. My assessment is as follows:

Considering the statement of case and preparing the counterstatement – £400

Filing and considering evidence – £800

Attending the hearing - £500

Total – £1700

52. I order ATD Travel Services Ltd to pay IMMAT Limited the sum of £1700 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of April 2017

Oliver Morris

For the Registrar,

The Comptroller-General